

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas, Marshall Division on the following
 Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:22-cv-00185	DATE FILED 5/27/2022	U.S. DISTRICT COURT for the Eastern District of Texas, Marshall Division
PLAINTIFF AGIS SOFTWARE DEVELOPMENT LLC		DEFENDANT VERIZON COMMUNICATIONS INC. and CELCO PARTNERSHIP, D/B/A VERIZON WIRELESS
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	7/3/2012	AGIS SOFTWARE DEVELOPMENT LLC
2 9,467,838	10/11/2016	AGIS SOFTWARE DEVELOPMENT LLC
3 9,749,829	8/29/2017	AGIS SOFTWARE DEVELOPMENT LLC
4 9,820,123	11/14/2017	AGIS SOFTWARE DEVELOPMENT LLC
5		

In the above-entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above-entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

(12) **INTER PARTES REVIEW CERTIFICATE** (2323rd)

United States Patent
Beyer, Jr.

(10) **Number:** **US 8,213,970 K1**
(45) **Certificate Issued:** **Sep. 1, 2021**

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

(75) **Inventor:** **Malcolm K. Beyer, Jr.**

(73) **Assignee:** **AGIS SOFTWARE
DEVELOPMENT LLC**

Trial Number:

IPR2018-01079 filed May 15, 2018

Inter Partes Review Certificate for:

Patent No.: **8,213,970**

Issued: **Jul. 3, 2012**

Appl. No.: **12/324,122**

Filed: **Nov. 26, 2008**

The results of IPR2018-01079 are reflected in this inter partes review certificate under 35 U.S.C. 318(b).

INTER PARTES REVIEW CERTIFICATE
U.S. Patent 8,213,970 K1
Trial No. IPR2018-01079
Certificate Issued Sep. 1, 2021

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AS A RESULT OF THE INTER PARTES
REVIEW PROCEEDING, IT HAS BEEN
DETERMINED THAT:

Claims 1 and 3-9 are cancelled.

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* * * * *

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Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:21-cv-00026	DATE FILED 1/29/2021	U.S. DISTRICT COURT for the Eastern District of Texas, Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Uber Technologies Inc., d/b/a Uber
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	7/3/2012	AGIS Software Development LLC
2 7,630,724	12/8/2009	AGIS Software Development LLC
3 7,031,728	4/18/2006	AGIS Software Development LLC
4 10,299,100	5/21/2019	AGIS Software Development LLC
5 10,341,838	7/2/2019	AGIS Software Development LLC

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY	
	<input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/324,122	11/26/2008	Malcolm K. Beyer JR.	10963.3819

CONFIRMATION NO. 9036

POWER OF ATTORNEY NOTICE



22235
Malin Haley DiMaggio & Bowen, P.A.
Spectrum Office Building
4901 NW 17th Way, Suite 308
FORT LAUDERDALE, FL 33309

Date Mailed: 09/18/2020

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/15/2020.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at (571) 272-4000 or (571) 272-4200 or 1-888-786-0101.

/rbell/



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov



Bib Data Sheet

CONFIRMATION NO. 9036

SERIAL NUMBER 12/324,122	FILING OR 371(c) DATE 11/26/2008 RULE	CLASS 455	GROUP ART UNIT 2617	ATTORNEY DOCKET NO. 10963.3819
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AIA (First Inventor to File): NO

INVENTORS

Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;

APPLICANTS

Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;

**** CONTINUING DATA *******

This application is a CIP of 11/612,830 12/19/2006 PAT 7853273
 which is a CIP of 11/308,648 04/17/2006 PAT 7630724
 which is a CIP of 10/711,490 09/21/2004 PAT 7031728

**** FOREIGN APPLICATIONS *******

IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** ** SMALL ENTITY **
 12/08/2008

Foreign Priority claimed 35 USC 119 (a-d) conditions met Verified and Acknowledged	<input type="checkbox"/> yes <input type="checkbox"/> no <input type="checkbox"/> yes <input type="checkbox"/> no <input type="checkbox"/> Met after Allowance Examiner's Signature _____ Initials _____	STATE OR COUNTRY FL	SHEETS DRAWING 6	TOTAL CLAIMS 14	INDEPENDENT CLAIMS 3
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ADDRESS
172615

TITLE

METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

FILING FEE RECEIVED
762

FEES: Authority has been given in Paper
 No. _____ to charge/credit DEPOSIT ACCOUNT
 No. _____ for following:

- All Fees
- 1.16 Fees (Filing)
- 1.17 Fees (Processing Ext. of time)
- 1.18 Fees (Issue)
- Other _____
- Credit

Under the Paperwork Reduction Act of 1995 no person is required to respond to a collection of information unless it displays a valid OMB control number.

REEXAMINATION -- PATENT OWNER POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS	Control Number(s)	90/014,507
	Filing Date(s)	05/15/2020
	First Named Inventor	Beyer Jr., Malcolm K.
	Title	Method of rolling based alerts for proactive remote communications
	Patent Number	8,213,970
	Examiner Name	KISS, ERIC B.
Attorney Docket No(s)	102.0002 REX02	

I hereby revoke all previous patent owner powers of attorney given in the above-identified reexamination proceeding control number(s).

- A Power of Attorney is submitted herewith.
- OR
- I hereby appoint Practitioner(s) associated with the Customer Number identified in the box at right as my/our attorney(s) or agent(s) to prosecute the proceeding(s) identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:
- OR
- I hereby appoint Practitioner(s) named below as my/our attorney(s) or agent(s) to prosecute the proceeding(s) identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Practitioner(s) Name	Registration Number
Vincent J. Rufero, II	89,594
Peter Lamourisakos	89,226
Enrique W. Bernalde	72,885
Alan Zhang	82,897

Please recognize or change the correspondence address for the above-identified reexamination proceeding control number(s) (more than one may be changed only if they are merged proceedings) to be:

- The address associated with the above-identified Customer Number.
- OR
- The address associated with the Customer Number identified in the box at right: **172615**
- OR

Firm or
 Individual Name

Address

City State Zip

Country

Telephone Email

- I am the:
- Inventor, having ownership of the patent being reexamined.
- OR
- Patent owner.
- Statement under 37 CFR 3.73(b) (Form PTO/SB/96) submitted herewith or filed on _____

SIGNATURE of inventor or Patent Owner

Signature	<i>Malcolm K. Beyer Jr.</i>	Date	September 14, 2020
Name	Malcolm K. Beyer, Jr.	Telephone	761-744-5010
Title and Company	CEO, AGMI Software Development LLC		

NOTE: Signatures of all the inventors or patent owners of the entire interest or their representative(s) are required. If more than one signature is required, submit multiple forms, check the box below, and identify the total number of forms submitted in the blank below.

A total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public, which is to update (and by the USPTO to process) the file of a patent or reexamination proceeding. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.34. This collection is estimated to take 15 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)Applicant/Patent Owner: AGIS Software Development LLCApplication No./Patent No.: 9,213,970Filed/Issue Date: 07/03/2012

Titled:

Method of utilizing forced alerts for interactive remote communications

AGIS Software Development LLC

a limited liability company

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc)

states that it is:

1. the assignee of the entire right, title, and interest in;
2. an assignee of less than the entire right, title, and interest in
(The extent (by percentage) of its ownership interest is _____ %); or
3. the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

the patent application/patent identified above, by virtue of either:

- A. An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or a copy* is attached.

OR

- B. A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Malcolm K. Beyer Jr. et al. To: Advanced Ground Information Systems, Inc.

The document was recorded in the United States Patent and Trademark Office at
Reel 028362 Frame 0435 or a copy* is attached.

2. From: Advanced Ground Information Systems, Inc. To: AGIS Holdings, Inc.

The document was recorded in the United States Patent and Trademark Office at
Reel 042759 Frame 0661 or a copy* is attached.

3. From: AGIS Holdings, Inc. To: AGIS Software Development LLC

The document was recorded in the United States Patent and Trademark Office at
Reel 042760 Frame 0102 or a copy* is attached.

Additional documents in the chain of title are listed on a supplemental sheet(s).

*As required by 37 CFR 3.73(b)(1)(i), if a copy/copies is/are attached, the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature

September 14, 2020

Date

Malcolm K. Beyer Jr.

CEO

Printed or Typed Name

Title or Registration Number

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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DOCKET NO. 2:19-cv-00361	DATE FILED November 4, 2019	U.S. DISTRICT COURT Eastern District of Texas, Marshall Division
PLAINTIFF AGIS SOFTWARE DEVELOPMENT LLC		DEFENDANT GOOGLE LLC
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 9,820,123	November 14, 2017	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5 9,749,829	August 29, 2017	AGIS Software Development LLC

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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1 8,213,970	July 3, 2012	AGIS Software Development LLC
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Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00514-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT HTC Corporation
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
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PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT It is ORDERED that all claims asserted by Plaintiff AGIS against Defendant HTC are DISMISSED WITH PREJUDICE and that all counterclaims asserted by Defendant HTC against Plaintiff AGIS are DISMISSED WITHOUT PREJUDICE.
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CLERK <i>David A. O'Poole</i>	(BY) DEPUTY CLERK nkl	DATE 7/2/19
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

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Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00515-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT LG Electronics, inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

It is ORDERED that all claims asserted by Plaintiff AGIS against Defendant LG in Case No. 2:17-cv-00515-JRG are DISMISSED WITH PREJUDICE and that all counterclaims asserted by Defendant LG against Plaintiff AGIS in Case No. 2:17-cv-00515-JRG are DISMISSED WITHOUT PREJUDICE

CLERK <i>David A. O'Poole</i>	(BY) DEPUTY CLERK nkl	DATE 7/1/19
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00516-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Apple, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT The Clerk of Court is DIRECTED TO CLOSE lead case number 2:17-cv-00513 and consolidated case number 2:17-cv-00516.

CLERK <i>David A. O'Poole</i>	(BY) DEPUTY CLERK nkl	DATE 3/14/19
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00513-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Huawei Device USA Inc., et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT The Clerk of Court is DIRECTED TO CLOSE lead case number 2:17-cv-00513 and consolidated case number 2:17-cv-00516.
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CLERK 	(BY) DEPUTY CLERK nkl	DATE 3/14/19
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

U.S. Patent No. 8,213,970
Filing Date: November 26, 2008
Issue Date: July 3, 2012

Inventor: Malcolm K. Beyer, Jr.
Title: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE
REMOTE COMMUNICATIONS

OFFICE OF THE GENERAL COUNSEL
2020 JAN 23 AM 11:52
UNITED STATES PATENT AND
TRADEMARK OFFICE

PATENT OWNER'S NOTICE OF APPEAL

Case No. IPR2018-01079

IPR2018-01079
Patent Owner's Notice of Appeal

Pursuant to 35 U.S.C. §§ 141 and 142 and 37 C.F.R. §§ 90.2 and 90.3, Patent Owner AGIS Software Development LLC ("AGIS" or "Patent Owner") hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered November 19, 2019 (Paper 34) and from all underlying orders, decisions, rulings, and opinions regarding U.S. Patent No. 8,213,970 (the "'970 patent") in Case No. IPR2018-01079. This notice is timely under 37 C.F.R. § 90.3, having been filed within 63 days after the date of the Final Written Decision.

For the limited purpose of providing the Director with the information requested in 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner anticipates that the issues on appeal may include, but are not limited to: the Board's claim constructions, its application of those constructions, its obviousness determinations including that claims 1–3, and 9 of the '970 patent are unpatentable under 35 U.S.C. § 103; the findings, rulings and conclusions supporting or relating to those determinations; the constitutionality of the appointments of Administrative Patent Judges Trevor M. Jefferson, Christa P. Zado, and Kevin C. Trock under U.S. Const. art. II, § 2, cl. 2. in view of *Arthrex v. Smith & Nephew*, No. 18-2140 (Fed. Cir. 2019); and any other issues decided adversely to Patent Owner in any orders, decisions, rulings, or opinions in IPR2018-01079.

IPR2018-01079

Patent Owner's Notice of Appeal

Simultaneous with this submission, three (3) copies of this Notice of Appeal are being filed with the Clerk of the United States Court of Appeals for the Federal Circuit and being submitted electronically through the Court's CM/ECF system, together with the requisite fee in the amount of \$500.00. In addition, a copy of this Notice of Appeal is being filed with the Patent Trial and Appeal Board and served upon counsel of record for Google LLC.

Respectfully submitted,

Dated: January 21, 2020

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

IPR2018-01079
Patent 8,213,970

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision issues pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, we determine that Google LLC (“Petitioner”)¹ has shown, by a preponderance of the evidence, that claims 1 and 3–9 (“challenged claims”) of U.S. Patent No. 8,213,970 B2 (Ex. 1001, “the ’970 patent”) are unpatentable. *See* 35 U.S.C. § 316(e) (2012); 37 C.F.R. § 42.1(d) (2017).

A. Procedural History

Petitioner filed a Petition for *inter partes* review of claims 1 and 3–9 of the ’970 patent. Paper 2 (“Pet.” or “Petition”). AGIS Software Development, LLC (“Patent Owner”)² subsequently filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Petitioner filed an authorized Reply to Patent Owner’s Preliminary Response. Paper 8. On November 20, 2018, the Board entered a decision instituting an *inter partes* review of all claims and all grounds presented in the Petition. Paper 9 (“Institution Decision” or “Inst. Dec.”).

After institution, Patent Owner filed a Response to the Petition. Paper 17 (“Response” or “PO Resp.”). Petitioner thereafter filed a Reply to Patent Owner’s Response. Paper 22 (“Pet. Reply” or “Reply”). Patent Owner filed a Sur-reply to Petitioner’s Reply to Patent Owner’s Response.

¹ Pursuant to 37 C.F.R. § 42.8, Petitioner identifies as real parties-in-interest Google LLC, Huawei Device USA Inc., Huawei Device Co., Ltd., Huawei Device (Dongguan) Co., Ltd., Huawei Technologies USA Inc., Huawei Technologies Co., Ltd., and LG Electronics, Inc. Pet. 79.

² Pursuant to 37 C.F.R. § 42.8, Patent Owner identifies only itself as a real party-in-interest. Paper 5, 1.

Paper 27 (“Sur-reply”). Patent Owner also filed a Request for Rehearing of the Institution Decision, Paper 12, which we denied, Paper 26.

An oral hearing was held on Sept. 5, 2019. A transcript of the hearing is included in the record. Paper 33 (“Tr.”).

B. Related Matters

The parties advise that the ’970 patent has been asserted in *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.); *AGIS Software Development LLC v. HTC Corporation*, No. 2:17-cv-00514 (E.D. Tex.); *AGIS Software Development LLC v. LG Electronics, Inc.*, No. 2:17-cv-00515 (E.D. Tex.); *AGIS Software Development LLC v. Apple Inc.*, No. 2:17-cv-00516-JRG (E.D. Tex.); *AGIS Software Development LLC v. ZTE Corporation et al.*, No. 2:17-cv-00517 (E.D. Tex.). Pet. 79–80; Paper 5, 3–4. Patent Owner further advises that the ’970 patent and patents related to the ’970 patent are the subject of various filings requesting *inter partes* review. Paper 5, 2–3 (table identifying *inter partes* review case numbers)

C. The ’970 Patent

The ’970 patent generally discloses a specialized software application program on a personal computer (“PC”) or PDA/cell phone for creating and processing forced message alerts. Ex. 1001, code (57). The specification of the ’970 patent (“Specification”) discloses it is desirable for a PDA/cell phone user to be able to simultaneously send Digital Smart Message Service (“SMS”) or TCP/IP messages to a large group of PCs or cell phones using cellular technology (such as GSM or CDMA) or WiFi. *Id.* at 1:51–57. The Specification further discloses that in some situations it is additionally desirable to know which PCs and PDA/cell phones received the message, which PCs and PDA/cell phones did not receive the message, and the

response of each recipient of the message. *Id.* at 1:57–61. “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.” *Id.* at 1:65–67. In addressing these issues, the Specification discloses “[t]he heart of the invention lies in [a] forced message alert software application program provided in each PC or PDA/cell phone.” *Id.* at 4:47–49. The software 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.

Id., code (57). The Specification explains that a forced message alert is comprised of a text or voice message and a forced message alert software packet. *Id.* at 2:11–13, 8:23–25

D. Illustrative Claims

Petitioner challenges claims 1 and 3–9 of the '970 patent. Pet. 12.

Claims 1 and 6 are independent. Claim 1, reproduced below, is illustrative.

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

[1.1] a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display and a CPU memory;

[1.2] a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;

[1.3] a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;

[1.4] 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;

[1.5] 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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;

[1.6] means for requiring a required manual response from the response list by the recipient in order to clear the recipient's response list from recipient's cell phone display;

[1.7] 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;

[1.8] means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and

[1.9] 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.

Ex. 1001, 8:65–9:39 (brackets and numbering added).

Claim 6, reproduced below, also is illustrative.

6. 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:

[6.1] accessing a forced message alert software application program on a sender PDA/cell phone;

[6.2] 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;

[6.3] designating one or more recipient PDA/cell phones in the communication network;

[6.4] electronically transmitting the forced message alert to said recipient PDA/cell phones;

[6.5] 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;

[6.6] periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt;

[6.7] receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone; and

[6.8] 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;

[6.9] 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.

Ex, 1001, 10:7-41 (brackets and numbering added).

E. Prior Art and Asserted Grounds of Unpatentability

Petitioner asserts that claims 1 and 3-9 would have been unpatentable on the following grounds (Pet. 12):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3–9	103(a)	Kubala, ³ Hammond ⁴
1, 3–9	103(a)	Hammond, Johnson, ⁵ Pepe ⁶
1, 3–9	103(a)	Hammond, Johnson, Pepe, Banerjee ⁷

Petitioner relies on the declaration of David Hilliard Williams, Ex. 1003 (“Williams Declaration”), and the supplemental declaration of Mr. Williams, Ex. 1023 (“Williams Supplemental Declaration”), to support its contentions.

II. ANALYSIS

A. *Legal Principles*

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness

³ U.S. Patent Publication 2006/0218232 A1, filed March 24, 2005 and published September 29, 2006. Ex. 1005 (“Kubala”).

⁴ U.S. Patent 6,854,007 B1, filed September 17, 1998 and issued February 8, 2005. Ex. 1006 (“Hammond”).

⁵ U.S. Patent 5,325,310, filed June 26, 1992 and issued June 28, 1994. Ex. 1007 (“Johnson”).

⁶ U.S. Patent 5,742,905, filed September 19, 1994 and issued April 21, 1998. Ex. 1008 (“Pepe”).

⁷ U.S. Patent Publication 2003/0128195 A1, filed January 8, 2002 and published July 10, 2003. Ex. 1009 (“Banerjee”).

(i.e., secondary considerations).⁸ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art in the field of the ’970 patent would have had either (1) a Bachelor of Science degree in electrical engineering or an equivalent field, with three to five years of academic or industry experience in the field of electronic communications, or (2) a Master of Science degree in electrical engineering or an equivalent field, with two to four years of academic experience in the same field. Pet. 9–10 (citing Ex. 1003 ¶¶ 29–30).

Patent Owner asserts that a person of ordinary skill in the art would have had at least a bachelor’s degree in computer science, computer engineering, or equivalent with one to two years of experience in the field of computer programming with a focus on building systems such as GPS-based localization and network transmission. PO Resp. 7 (citing Ex. 2005 ¶¶ 18–20). Patent Owner further asserts that extensive experience and technical training might substitute for educational requirements, while advanced degrees might substitute for experience. *Id.* (citing Ex. 2005 ¶¶ 18–20).

The parties agree that an ordinarily skilled artisan in the field of the ’970 patent would have had a bachelor’s degree in the pertinent technical

⁸ Neither party presents arguments or evidence of secondary considerations, which therefore do not constitute part of our analysis.

field, and a few years of experience and/or more advanced education in the pertinent field. Therefore, we determine a person of ordinary skill in the art would have had a bachelor's degree in electrical engineering, computer science, or computer engineering, or equivalent, and two to four years of additional experience, either work or educational, in the field of electrical communications. We do not adopt Patent Owner's assessment that a skilled artisan would have focused on building systems such as GPS-based localization and network transmission. PO Resp. 7. Patent Owner fails to explain how this is pertinent to the field of the '970 patent, which relates to providing computers and/or PDA/cell phones with forced message alert software that enables users to create and send message alerts.

We note that the level of skill in the art also may be reflected in the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

C. Claim Construction

1. Introduction

In an *inter partes* review filed before November 13, 2018, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent.⁹ Consistent with that standard, we assign claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention, in

⁹ This standard applies to *inter partes* reviews filed before November 13, 2018. 77 Fed. Reg. 48727 (Aug. 14, 2012) (codified at 37 C.F.R. § 42.100(b)), as amended at 81 Fed. Reg. 18766 (Apr. 1, 2016); *see also* 83 Fed. Reg. 51340 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b) effective November 13, 2018) (now codified at 37 C.F.R. § 42.100(b) (2019)).

the context of the entire patent disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

We note that the district court issued an order construing terms of the '970 patent in *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.) on October 10, 2018. Ex. 3001, 9–29 (“District Court Claim Construction Order”). We have considered the district court’s constructions.

2. *Terms to be Construed Expressly*

Petitioner proposes that we construe as means-plus-function under 35 U.S.C. § 112, ¶ 6, the terms in claim 1 that include the word “means,” i.e., limitations 1.2 and 1.5 to 1.9. Pet. 10–12. Patent Owner agrees these terms should be construed as means-plus-function, and further argues we should adopt the constructions entered in the district court proceeding for the purposes of consistency across proceedings. Prelim. Resp. 9–14.¹⁰

We agree these terms should be construed under § 112, ¶ 6. A claim limitation is presumed to invoke § 112, ¶ 6, when it uses the term “means” in combination with functional language, as is the case here. *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356 (Fed. Cir. 1999). Having determined limitations 1.2 and 1.5 to 1.9 are to be construed under § 112, ¶ 6, below we set forth identification of the function recited in each

¹⁰ We note that prior to institution, Patent Owner did not provide any proposal regarding construction of limitations 1.2 and 1.5 to 1.9, *see generally* Prelim. Resp., and we adopted preliminary constructions based on Petitioner’s proposals, as well as the evidence in the record at the time, Inst. Dec. 9–16. After institution, Patent Owner proposed that we construe the limitations in accordance with the district court’s constructions, but did not provide any argument or evidence to support its proposal other than to argue that the Board’s constructions should be consistent with that of the district court. PO Resp. 9–14.

limitation and the corresponding structure in the written description of the Specification that performs each function. *See Asyst Techs, Inc. v. Empak, Inc.*, 268 F.3d 1364, 1369 (Fed. Cir. 2001) (“The first step in construing a means-plus function limitation is to identify the function explicitly recited in the claim. The next step is to identify the corresponding structure set forth in the written description that performs the particular function set forth in the claim.”) (citations omitted).

In addition, although neither party proposes a construction for the term “forced message alert,” Patent Owner’s arguments regarding claim limitation 1.5 raise an issue regarding the construction of this term. PO Resp. 14–18. Therefore, we also address Patent Owner’s interpretation of the term “forced message alert.”

We determine that no other claim terms require express construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

3. (limitation 1.2) “*data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations*”

We construe the term “data transmission means” under 35 U.S.C. § 112, ¶ 6. The parties agree that the function is to “facilitate the transmission of electronic files between said PDA/cell phones in different locations,” as recited in limitation 1.2. Pet. 10; PO Resp. 10. We agree that this is the recited function.

Petitioner asserts that the corresponding structure is a server that communicates according to either (1) Wifi, WiMax, or other peer-to-peer communications or (2) SMS, TCP/IP, or other messaging protocols. Pet. 10

(citing Ex. 1001, 4:1–36). Patent Owner proposes we adopt the district court’s determination that the corresponding structure is a “communications network server; and equivalents thereof.” PO Resp. 10; Ex. 3001, 10. In pertinent part, both parties assert the corresponding structure is a *server*.

Neither party, however, explains why the corresponding structure is a server. Petitioner provides a bare assertion, without any explanation as to why its construction is correct, and cites to Mr. William’s declaration which likewise includes a bare assertion without any explanation. Pet. 10 (citing Ex. 1003 ¶ 33). Patent Owner does not explain why we should adopt its construction, other than we should do so “for the purposes of consistency” with the district court’s construction. PO Resp. 10.

Although Petitioner does not provide any explanation, Petitioner cites to a description of a communication server that forwards data addressed from one network participant to another, “thus permitting the transmission of forced message alerts, other text and voice messages, photographs, video, E-mail, and URL data” between network participants. Pet. 10 (citing Ex. 1001, 4:1–6). Notably, the Specification does not refer to a server as a transmission means. Neither party addresses other descriptions in the Specification that refer explicitly to two types of transmission means. The Specification refers to the Internet as a transmission means: “[t]o operate on the network, obviously the PC must be on and have an active connection to the Internet or other digital *transmission means*.” Ex. 1001, 3:43–45 (emphasis added). The Specification also refers to communications protocols, such as TCP/IP, as digital *transmission means*: “[a] plurality of PCs and PDA/cell phones each having forced alert software installed providing a communication network . . . with the ability to: 1) allow an operator to create and transmit (via TCP/IP or another digital *transmission*

means) a forced voice alert.” *Id.* at 2:7–11 (emphasis added). Nor do the parties address claim 2, which depends directly from claim 1, and recites “wherein said data transmission means is TCP/IP or another communications protocol.” *Id.* at 9:40–63.

Based on our review of claim 2 and the above-noted disclosure in the Specification, we determine the corresponding structure for a “data transmission means” is “a PDA/cell phone programmed to implement transmission of a forced message alert using TCP/IP or another communications protocol, and equivalents thereof.”

We note that the district court’s claim construction order does not provide analysis as to why a server is the corresponding structure for a “data transmission means,” instead stating that the construction was agreed upon by the parties. Ex. 3001, 10. Furthermore, there is no indication in the district court’s claim construction order that the court considered the language of claim 2, or the portions of the Specification we discuss above about the network and communications protocols being *transmission means*. *Id.*

4. “*means for . . .*” (limitations 1.5 to 1.9)

a) *Introduction*

As we discussed above, we construe limitations 1.5 to 1.9 under 35 U.S.C. § 112, ¶ 6. *Supra* Sec. III.C.2. For each of limitations 1.5 to 1.9, the parties agree that the recited function is the respective recitation following the words “means for” (except for limitation 1.5, for which Petitioner asserts the function is less than the entire recitation after “means for,” discussed below). Pet. 10–12; PO Resp. 10–14. As set forth below, for each of limitations 1.5 to 1.9, we determine that the recited function is the entire recitation of the respective limitation following the words “means for.”

With regard to the functions specified in limitations 1.5–1.9, Petitioner contends that the corresponding structure is a computer configured to implement or perform the algorithm recited in the function. Pet. 10–12. As to limitations 1.5, 1.6, and 1.8, Patent Owner essentially agrees with Petitioner, except that Patent Owner asserts the structure is a PC or PDA/cell phone configured to implement or perform the algorithm. PO Resp. 10–14. For limitations 1.7 and 1.9, Patent Owner asserts the corresponding structure is a hardware display and hardware transmitter. *Id.* at 12–14.

For reasons discussed below, *infra* Sec. II.C.4.a.1, we determine the corresponding structure in limitations 1.5, 1.6, and 1.8 is a PDA/cell phone, programmed to carry out an algorithm that performs the recited function. For limitations 1.7 and 1.9, we determine that PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof, corresponds to the receiving function. *Infra* Sec. II.C.4.2.

(1) *Limitations 1.5, 1.6, and 1.8*

Limitations 1.5, 1.6, and 1.8 are computer-implemented means-plus-function limitations because the disclosed structure is a special purpose computer programmed to perform a disclosed algorithm. *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999) (explaining that for computer-implemented means-plus-function limitations, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm”). The Specification indicates that PCs and PDA/cell phones are computing devices that include special software—i.e., the forced message alert software application program—programmed to perform the functions recited in limitations 1.5, 1.6, and 1.9. Ex. 1001, 3:41–43 (“Each PC described herein

is like any other contemporary PC, except that it has the forced message alert software application program installed on it.”); *see also id.* at 3:29–31 (“Each PDA/cell phone described herein . . . can function just as any other cell phone . . . [i]n addition . . . it has the forced message alert software application program.”), 4:27, 4:36 (disclosing that the PDA/cell phone includes a CPU).

Because the disclosed structure is a special purpose computer, the Specification must disclose an algorithm for performing the claimed function. *See, e.g., Noah Systems Inc. v. Intuit Inc.*, 675 F.3d 1302, 1312 (Fed. Cir. 2012).

For the foregoing reasons, we determine that the corresponding structure for the respective functions recited in each of limitations 1.5, 1.6, and 1.8 is a PDA/cell phone programmed to carry out an algorithm. Below we identify the algorithm disclosed for performing the claimed functions.

Infra Sec. III.C.4.a.1.a–c.

(a) (limitation 1.5) “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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone”

For limitation 1.5, Petitioner asserts that the specified function is “attach a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by a sender PDA/cell phone to a recipient PDA/cell phone.” Pet. 10 (citing Ex. 1001, 8:65–9:39 (claim 1)). Without explanation, Petitioner omits the remainder of limitation 1.5, which recites “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 PDA/cell phone.”

Petitioner does not adequately explain, nor do we discern why, the remaining language recited in element 1.5 should not be construed as part of the specified function. Patent Owner asserts the recited function includes the entire recitation following “means for” in limitation 1.5. PO Resp. 10. We agree with Patent Owner, and determine the specified function includes the entire recitation following “means for” in limitation 1.5.

For the structure corresponding to the specified function of limitation 1.5, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 7:43–63 and Figure 3A. Pet. 10. Patent Owner asserts we should adopt “the algorithm disclosed . . . at 7:8–8:36; and equivalents thereof.” PO Resp. 11.

We find that the disclosure identified by Petitioner describes the recited function because it discloses the steps of a process for sending a forced message alert, except that it does not expressly describe “attaching” the forced message alert software packet to a voice or text message. Ex. 1001, 7:43–63; Fig. 3A. However, it is implied that this step occurs because a user types a text or records a voice message, and a forced message alert is sent, *id.* at 7:43–63, and elsewhere the Specification explains that the software allows a user to create a forced message alert comprising a voice or text message and forced message alert software packet, *id.* at 2:9–13.

The district court, and Patent Owner, also identify Ex. 1001, 7:8–42 and 8:1–36 as disclosing the algorithm. PO Resp. 11; Ex. 3001, 15–18. We find the disclosure at Ex. 1001, 7:8–20 corresponds to the recited function

because it describes as part of the process that the forced message alert software packet contains a list of possible required responses (*see, e.g.*, limitation 1.5, “said forced message alert software packet containing a list of possible required responses”). We also find Ex. 1001, 8:25–30 corresponds to the recited function because it discloses transmitting an automatic acknowledgement receipt (*see, e.g.*, limitation 1.5, “requiring the forced message alert software . . . to transmit an automatic acknowledgement receipt”).

However, the district court and Patent Owner are over-inclusive in their citation to the '970 patent disclosure. The district court and Patent Owner cite to continuous blocks of text that disclose not just the algorithm corresponding to the recited function, but also features not recited in the function. We do not incorporate into our construction features that do not perform the recited function. “Section 112 paragraph 6 does not ‘permit incorporation of structure from the written description beyond that necessary to perform the claimed function.’ Structural features that do not actually perform the recited function do not constitute corresponding structure and thus do not serve as claims limitations.” *Asyst Techs*, 268 F.3d at 1369–70 (citations omitted).

We find that the features disclosed at Ex. 1001, 7:21–42, 8:1–25 and 8:31–36 are not part of the algorithm for performing the function recited in limitation 1.5. For example, Ex. 1001, 7:21–42 describes repeating a message at a defined rate until a user makes a selection from a required response list. The disclosure at Exhibit 1001, 8:1–25 and 8:31–36 describes features unrelated to the recited function including a sender PC or PDA/cell phone monitoring for manual responses, and a recipient PC or PDA/cell

phone separating a forced message alert packet from a text or voice message. None of these features are part of the function specified in limitation 1.5.

For the foregoing reasons, we determine that the corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof.

(b) (limitation 1.6) “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”

For the structure corresponding to the specified function of limitation 1.6, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 8:39–46 and Figure 4. Pet. 11. Patent Owner asserts we should adopt “the algorithm disclosed . . . at 8:37–57; and equivalents thereof.” PO Resp. 12.

We find that the disclosure identified by Petitioner, which relates to the scenario in which a text message is received, describes the applicable algorithm. The disclosure describes a 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, namely by causing a text message and response list to be shown on a recipient PC or PDA/cell phone until a manual response is selected from the response list, and clearing the forced alert text only after the user of the recipient device has selected a response. Ex. 1001, 8:39–46. We also find the disclosure at Ex. 1001, 8:46–51, which relates to receipt of voice messages, describes the applicable algorithm, as contended by Patent Owner, because the recited function also encompasses scenarios in which voice messages are received.

However, contrary to Patent Owner's assertion, we find the disclosure at Ex. 1001, 8:37–39 and 8:52–57, does not describe the algorithm for the recited function. Patent Owner does not provide any explanation to support its position, other than its argument that the district court included this disclosure in its claim construction. PO Resp. 11–12. The disclosure at Ex. 1001, 8:37–39 and 8:52–57 describes the forced voice alert software application program “effectively tak[ing] control” of the recipient device and releasing effective control of the recipient PDA/cell phone. Ex. 1001, 8:37–39, 8:52–57. However, the function specified in limitation 1.6 does not mention taking or releasing control of the PDA/cell phone. On the other hand, claim 2, which depends directly from claim 1, explicitly claims a means for taking control of the recipient PDA/cell phone. Ex. 1001, 9:46–54 (“means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing . . . the text message and a response list to be shown on the display of the recipient PDA cell phone”). Accordingly, we find the feature of taking and releasing control of the PDA/cell phone does not constitute part of the algorithm that achieves the function recited in limitation 1.6, and does not serve as a limitation on the claim. *Cf. Asyst Techs*, 268 F.3d at 1369–70 (“Structural features that do not actually perform the recited function do not constitute corresponding structure and thus do not serve as claims limitations”).

For the foregoing reasons, we determine that the corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:39–46 and the portions of Figure 4 described at 8:39–46, and equivalents thereof.

(c) (limitation 1.8) “means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert”

For the structure corresponding to the specified function of limitation 1.8, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 8:6–9 and Fig. 3A and 3B. Pet. 11–12. Patent Owner asserts we should adopt the “the algorithm disclosed . . . at 7:64–8:8; and equivalents thereof.” PO Resp. 13.

We are persuaded that Ex. 1001, 8:6–8¹¹ and the corresponding step in Figure 3B (second step) provide sufficient detail to disclose the applicable algorithm because they disclose “[t]he sender PC or PDA/cell phone will then periodically resend the forced message alert to the PC or PDA/cell phone that have not acknowledged receipt,” and “[t]he sender cell phone, integrated PDA/cell phone or PC periodically resends the message alert to the recipient cell phones, integrated PDA/cell phones or PCs that have not acknowledged receipt,” respectively. Ex. 1001, 8:6–8.

Patent Owner is over-inclusive because the disclosure at Ex. 1001, 7:64–8:5 describes features unrelated to the function recited in limitation 1.8. *Cf. Asyst Techs*, 268 F.3d at 1369–70 (“Structural features that do not actually perform the recited function do not constitute corresponding structure and thus do not serve as claims limitations”). The features relate, for example, to monitoring for and receiving acknowledgments of receipt of forced message alerts, Ex. 1001, 7:64–67,

¹¹ Petitioner includes line 9 of column 8, but this appears to be in error. Line 9 begins a new paragraph and contains only the sentence fragment, “The sender PC or PDA/cell phone also monitors for and,” which is unrelated to the recited function. Therefore, we exclude line 9 from the algorithm.

and the sender PC or PDA/cell phone providing an indication on a display of which of the recipients have and have not acknowledged receipt, Ex. 1001, 8:1–5.

For the foregoing reasons, we determine that the corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:6–8 and corresponding step in Fig. 3B (second step in Figure 3B), and equivalents thereof.

- (2) *Limitations 1.7 and 1.9 – (limitation 1.7) “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”; (limitation 1.9) “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 responses from each recipient PDA/cell phone that responded”*

For the structure corresponding to the specified function of limitation 1.7, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 7:64–8:5 and Figures 3A and 3B. Pet. 11. For the structure corresponding to the specified function of limitation 1.9, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 8:9–15 and Figures 3A and 3B. *Id.* at 12.

Patent Owner contends the corresponding structure is “PDA/cell phone hardware including touch screen 16, and wireless transmitter or cellular modem; and equivalents thereof.” PO Resp. 12–14.

Therefore, the dispute raised by the parties’ proposals is whether the corresponding structure is: (1) a computer configured to implement or perform an algorithm, or (2) a hardware transmitter (presumably for “receiving”) and a hardware display (presumably for “displaying”). We

adopt Patent Owner's approach, namely that the corresponding structures are a hardware display and receiver and/or transceiver. With regard to the function of displaying, the Specification discloses a hardware display of the PDA/cell phone (*see, e.g.*, Figure 1, LCD display 16) that displays an indication of which recipients have sent acknowledgements and an indication of the response from each recipient cell phone. Ex. 1001, 8:1–5, 8:12–15. As to the function of receiving, the Specification discloses that the PC and PDA/cell phone can communicate using WiFi or WiMax, both of which are wireless, and the PDA/cell phone can communicate over a wireless cellular network, thereby indicating the PC and PDA/cell phone each have a wireless receiver and/or transceiver for receiving automatic acknowledgements. Ex. 1001, 4:7–11.

Therefore, we find the corresponding structure is PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof.

We decline to adopt Patent Owner's proposal that a wireless *transmitter* performs the receiving function, because a transmitter transmits rather than receives. PO Resp. 12–14. We also decline to adopt Patent Owner's proposal that a "cellular modem" corresponds to the receiving function because Patent Owner does not identify any disclosure in the Specification of a cellular modem performing the receiving function. *Id.*

b) "*forced message alert*"

Claim 1 recites (Ex. 1001, 9:14–23) (emphasis added):

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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone.

Claim 6 recites (Ex. 10:7–11, 14–17) (emphasis added):

A method of sending a forced message alert to one or more recipient PDA/cell phones . . . said method comprising the steps of . . . 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.

Neither party proposes a construction for the term “forced message alert.” *See* Pet. 8–12; *see also* PO Resp. 9–14. However, in its discussion of patentability, Patent Owner argues Kubala’s email message 214 with mandatory response flag 216 (asserted “forced message alert”) is not a “forced message alert” because it is not “forced to the display without any action on the part of the recipient.” PO. Resp. 15–18; Sur-Reply 11–15. In doing so, Patent Owner seeks to write a negative limitation, i.e., forcing a message to the display *without any action on the part of the recipient*, into claims 1 and 6. In light of Patent Owner’s argument, we consider whether a “forced message alert” should be interpreted as a message that must be forced to the display without any action on the part of the recipient.

We begin with the language of the claims viewed in light of the Specification. The negative limitation Patent Owner seeks to write into claims 1 and 6 appears nowhere in the language of the claims. *See, e.g.*, Pet. Reply 4–6 (arguing limitation 1.5 does not impose the restriction asserted by Patent Owner). The claim language makes clear that a “forced message alert” is created by attaching a forced message alert software packet to a voice or text message. Ex. 1001, 9:14–15 (claim 1, “means for attaching a forced message alert software packet to a voice or text message

creating a forced message alert”) (emphasis added); *see also* Ex. 1001, 10:14–17 (claim 6, “*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*”) (emphasis added). Accordingly, by the very language of the claims, a message is *forced* because it is attached to a *forced* message alert software packet. Nothing in the claim language indicates that what makes the message *forced* is forcing its display without any action on the part of the recipient.

The Specification reinforces the understanding that a forced alert is a message with a forced alert software packet attached thereto, disclosing that forced alert software provides the ability 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.” Ex. 1001, 2:7–13.

Accordingly, the claim language viewed in light of the Specification is unambiguously clear—a “forced message alert” is a message (e.g., text or voice) attached to a forced message alert software packet.

Patent Owner argues, nonetheless, that we should read its proposed negative claim limitation into the term “forced message alert” based on disclosure in the Specification that upon detection of a forced message alert, a recipient PDA/cell phone transmits an automatic acknowledgement of receipt to the sender, and after transmitting the receipt, the forced voice alert software application program effectively takes control of the recipient PDA/cell phone. PO Resp. 16 (citing Ex. 1001, 8:25–39). Patent Owner also relies on disclosure in the Specification that states “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.” PO Resp. 17 (citing Ex. 1001, 8:37–44); *see also* Sur-reply 12–14.

Patent Owner’s reliance on the cited disclosure is unavailing for several reasons. First, the disclosure cited by Patent Owner does not specify that the message alert is displayed *without any action on part of the recipient*, and does not preclude a user from first opening the message before being presented with a display of the message. Ex. 1001, 8:25–44. Patent Owner’s argument appears to be that the software’s effective taking control of the PDA/cell phone, disclosed at Ex. 1001, 8:37–39, implies a recipient can no longer perform actions that would cause a forced message alert to be displayed, thereby suggesting messages are forced to the display without any action on the part of the recipient. PO Resp. 16. However, we do not find this persuasive because the Specification does not preclude steps such as a user performing acts, e.g., opening a message, that lead to display of the forced alert message.

Second, even if we were to infer that the Specification is describing forcing the message to a display without any action by the recipient, we do not discern a reason to write such a requirement into the claims that appears nowhere in the claim language. *See SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim.”).

Review of the claims as a whole confirms that we should not read Patent Owner’s proposed requirement into the term “forced message alert.” If we were to adopt Patent Owner’s view, it would be inconsistent with Patent Owner’s, and our, interpretation above of limitation 1.5 of claim 1.

As we discussed above, we construe limitation 1.5 as reciting means-plus-function, and we determine the structure corresponding to the specified function is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof. *Supra* Sec. II.C.4.a.1.a; *see also* PO Resp. 10–11 (Patent Owner submitting this limitation should be construed as a means-plus-function term). Therefore, if we were to read into limitation 1.5 a requirement of forcing a forced message alert to a display without any action on part of the recipient, there would need to be supporting disclosure in the Specification of an algorithm for performing this function. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1312 (Fed. Cir. 2012) (citing *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1238, 1333) (Fed. Cir. 2008)). However, as we discussed above, the Specification does not disclose an algorithm sufficient to perform the negative limitation proposed by Patent Owner, i.e., forcing a message to the display without any action on part of the user.

We note the algorithm we identify for limitation 1.5, *supra* Sec. II.C.4.a.1.a, does not disclose forcing a forced message alert to a display without any action on part of the recipient. Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, Fig. 3A. Furthermore, there is no such requirement even under Patent Owner's proposed construction because not even Patent Owner's proposed algorithm discloses forcing a forced message alert to a display without any action on part of the recipient. PO Resp. 11 (asserting the algorithm is disclosed at Ex. 1001, 7:8–8:36); *see also* Pet. Reply 4–6.

For the foregoing reasons, we conclude that a “forced message alert” should not be interpreted as a message that must be forced to the display without any action on the part of the recipient.

5. *Summary*

Our constructions for limitations 1.2 and 1.5 to 1.9 are summarized below:

Limitation	Specified Function	Corresponding Structure
1.2	facilitate the transmission of electronic files between said PDA/cell phones in different locations	a PDA/cell phone programmed to implement transmission of a forced message alert using TCP/IP or another communications protocol, and equivalents thereof
1.5	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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone	PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof
1.6	requiring a required manual response from the response list by the recipient in order to clear the recipient's response list from recipient's cell phone display	PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:39–46 and the portions of Figure 4 described at 8:39–46, and equivalents thereof
1.7	receiving and displaying a	PDA/cell phone hardware

Limitation	Specified Function	Corresponding Structure
	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	including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof
1.8	periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert	PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:6–8 and corresponding step in Fig. 3B (second step in Figure 3B), and equivalents thereof
1.9	receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the responses from each recipient PDA/cell phone that responded	PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof

D. Asserted Obviousness Over Kubala and Hammond

As noted above, Petitioner asserts claims 1 and 3–9 of the '970 patent would have been obvious over the combination of Kubala and Hammond. Pet. 12; Pet. Reply 2–15. Patent Owner contends Petitioner has not shown unpatentability of claims 1 and 3–9 on this ground. PO Resp. 14–28; Sur-reply 7–15. For the reasons stated below, we determine Petitioner has demonstrated, by a preponderance of the evidence, that claims 1 and 3–9 are unpatentable under § 103 as obvious over the combination of Kubala with Hammond.

1. Kubala (Ex. 1005)

Kubala generally discloses a method, system, apparatus, or computer program product for processing electronic messages. Ex. 1005 ¶ 9. Kubala explains that employee productivity may suffer demonstrably in proportion to the number of email messages the employee receives. *Id.* ¶ 5. This is due in part to the high volume of emails an employee may receive, because the task of responding to emails messages consumes an increasingly larger portion of the employee's workday. *Id.* To address these issues, Kubala states that "it would be advantageous to provide productivity enhancing features within e-mail applications for the handling of email messages so that important messages receive the appropriate attention from the recipient of an e-mail message." *Id.* ¶ 8.

Kubala specifically discloses computing devices such as network-enabled phones and PDAs that directly transfer data between each other across wireless links. *Id.* ¶ 27. The devices include email application software that facilitates email communication between devices, wherein the email software 206 includes enhanced functionality. *Id.* ¶ 35. One of the enhanced features is mandatory response functional unit 210 that operates to request that an outgoing email message be flagged as requiring a mandatory response from the email recipient. *Id.* Enhanced email application 206 relies on functional unit 210 to either assist in generation of the outgoing email message or perform the modifications necessary to flag the outgoing message as requiring a mandatory response. *Id.* Kubala discloses, for example, that email message 214 may contain mandatory response flag 216 indicating to the enhanced email application on the recipient computing device that email message 214 should be handled as an important message

requiring a mandatory response. *Id.* Kubala discloses that mandatory response flag 216 may be implemented in a variety of data formats. *Id.*

2. *Hammond (Ex. 1006)*

Hammond generally discloses a system for enhancing the reliability of communicating with electronic messages. Ex. 1006, code (57). Hammond explains that electronically communicated messages such as email, paging messages, and voice mail have become increasingly pervasive. *Id.* at 1:13–15. According to Hammond, although initial distribution of electronic messages by a sender is quick and convenient, ensuring that a message is received and reviewed by a recipient within a certain timeframe can be inconvenient. *Id.* at 1:21–26. Hammond addresses these issues by disclosing a system that sends an electronic message to designated recipients, and automatically helps ensure that each message has been received and reviewed by the recipient. *Id.* at 2:1–5. If receipt is not confirmed within a certain specified timeframe, the system can automatically resend the electronic message or take other appropriate action. *Id.* at 2:5–8.

In one embodiment, the disclosed system includes a Message Review Server (“MRS”) that sends electronic messages to designated recipients, and automatically helps ensure that each message has been received and reviewed. *Id.* at 3:1–5. The MRS also allows the sender of an electronic message to specify message delivery information that specifies actions to take when a message is not delivered within a specified timeframe. *Id.* at 3:12–15. For example, the sender can specify that if receipt notification is not received within a specified time period, the message will be resent to the recipient. *Id.* at 3:15–18. Message delivery information can also specify

frequency or duration options, such as an option to resend a message every two hours. *Id.* at 3:18–22.

In one embodiment, Kubala discloses that use of the MRS system begins when a sender of an electronic message supplies a message to a Message Sender component. Ex. 1006, 4:48–51. The sender supplies the message, identifies one or more recipients for the message, and specifies various optional message tracking information (e.g., message delivery information, message review information, and message post-review information). *Id.* at 4:51–56. A sender also can supply delivery information such as a resend period of time and can optionally supply other resend options. *Id.* at 4:56–60. The system also includes a Message Receipt Tracker component that attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients. *Id.* at 5:17–20

3. *Claim 1*

Petitioner relies on Kubala as teaching the subject matter of claim 1, but asserts that to the extent Patent Owner argues Kubala does not teach limitations 1.7 to 1.9, Hammond provides the missing disclosure. Pet. 23–40.

Patent Owner argues: (1) Kubala and Hammond do not disclose a “forced message alert” (PO Resp. 14–18), as recited in limitation 1.5, (2) 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,” as recited in limitation 1.6 (PO Resp. 18–22), (3) Kubala and Hammond do not 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,” as recited in limitation 1.7 (PO Resp. 22–27), and (4) Kubala and Hammond do not disclose “displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the responses from each recipient PDA/cell phone that responded,” as recited in limitation 1.9 (PO Resp. 27–28).

Upon review of the record, we determine Petitioner has shown, by a preponderance of the evidence, that claim 1 is unpatentable as obvious over the combination of Kubala with Hammond.

a) Preamble and Limitations 1.1–1.4 and 1.8

Petitioner sets forth where Kubala teaches the preamble and each of limitations 1.1–1.4, and where Kubala, alone or in combination with Hammond, teaches limitation 1.8. Pet. 23–27, 35–37. Petitioner also articulates a rationale to combine Kubala with Hammond. *See, e.g., id.* at 21–23; *see also id.* at 20 (“Like Kubala, Hammond discloses methods and systems for enhancing reliability of electronic messaging”). Patent Owner does not provide argument in the Response contesting Petitioner’s assertions regarding the preamble and limitations 1.1–1.4 and 1.8.¹²

¹² In the Sur-reply, Patent Owner asserts for the first time that its arguments in the Response regarding limitation 1.5’s recitation of “a forced message alert,” PO Resp. 14–18, applies to other claim limitations that recite either “a forced message alert software application program” or “forced message alert,” Sur-reply 7–10. We address Patent Owner’s arguments regarding the phrase “forced message alert” in our discussion of limitation 1.5, *infra* Sec. III.D.3.b.1.

(1) (preamble) “[a] communication system for transmitting, receiving, confirming receipt, and responding to an electronic message”

Petitioner persuasively argues Kubala teaches the preamble of claim 1, because Kubala relates to sending and receiving e-mail messages (e.g., communication system for transmitting and receiving an electronic message) and teaches confirming receipt and responding to an electronic message, disclosing “that it was known 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 email message, thereby providing an acknowledgement that a particular message has been received and/or opened.’” Pet. 23 (citing Ex. 1005 ¶ 6).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to the preamble of claim 1.

(2) (limitation 1.1) “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”

Petitioner persuasively argues Kubala teaches limitation 1.1 because Kubala shows, in Figure 1A, a plurality of PDAs 107 and 112 connected through wireless link 116, and connected through network 101 through various other links shown in Figure 1A, that form a predetermined network. Pet. 24. Kubala further discloses that each PDA includes at least one CPU 22, a memory 124, 126, and a user interface adapter 148 that can be coupled to a touch-screen display, as can be seen in Figure 1B. *Id.* at 24–25 (citing Ex. 1005 ¶¶ 26, 27, 29–30, Fig. 1A, Fig. 1B; Ex. 1003 ¶¶ 92–93).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.1.

(3) (limitation 1.2) “a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations”

Petitioner argues, based on its construction of “data transmission means,” that the structure corresponding to the function specified in limitation 1.2 is a server that communicates according to certain enumerated messaging protocols. Pet. 10. However, as we discussed above, we disagree with Petitioner’s construction and determine that the pertinent corresponding structure is “a PDA/cell phone programmed to implement transmission of a forced message alert using TCP/IP or another communications protocol, and equivalents thereof.” *Supra* Sec. II.C.3. Although Petitioner’s proposed construction differs from ours, Petitioner nonetheless sets forth a sufficient showing for this limitation. Petitioner argues that the server in Kubala communicates according to, inter alia, peer-to-peer communications (e.g., WiFi or WiMax) or other messaging protocols (e.g., SMS or TCP/IP). Pet. 25. In particular, Petitioner argues that the asserted PDA/cell phones in Kubala communicate with one another using, for example, “Transport Control Protocol/Internet Protocol (TCP/IP)” or WiFi technology (IEEE 802.11), *id.* (citing Ex. 1006 ¶ 27, Fig. 1A), both of which teach or suggest a PDA/cell phone implementing transmission of a forced message alert using a communications protocol, such as TCP/IP.¹³

¹³ The outcome of this Final Decision would not be affected had we adopted the district court’s construction. Petitioner shows, and Patent Owner does not dispute, that the asserted prior art teaches a communications network server. Pet. 25 (“In Kubala, a server supports a network 109 and a client 110, allowing the PDAs/cell phones to (1) ‘communicate with one another’ using, for example, ‘Transport Control Protocol/Internet Protocol (TCP/IP)’ or (2) ‘directly transfer data between themselves’ using, for example, ‘Bluetooth™ wireless technology or WiFi technology (IEEE 802.11).’

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.2.

(4) (limitation 1.3) “a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message” (limitation 1.3)

Petitioner persuasively argues Kubala teaches limitation 1.3, because Kubala discloses a plurality of PDAs that communicate with each other, wherein one PDA (i.e., the sender PDA) sends an electronic message to another PDA (i.e., the recipient PDA). Pet. 26 (citing Ex. 1006 ¶¶ 27, 32, 33, Fig. 1A; Ex. 1003 ¶ 95).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.3.

(5) (limitation 1.4) “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”

Petitioner persuasively argues Kubala teaches limitation 1.4, because Kubala discloses an enhanced email application (asserted forced message alert software application program) that includes mandatory-response functional unit 212 that sends email messages, and embedding in a sender email message a menu of possible responses 1120 to the sender’s message (asserted list of required possible responses to be selected by a recipient), as shown in Figure 11C. Pet. 26–27 (citing Ex. 1005 ¶¶ 13, 22, 33, 35, 36, 47, 54, 55, 57, 60, Fig. 2, Fig. 11C; Ex. 1003 ¶¶ 96–98).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.4.

(Kubala, ¶0027, FIG. 1A.) Kubala therefore expressly discloses this limitation. (See Williams, ¶94.)”; *see generally* PO Resp.

(6) (limitation 1.8) “means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert”

Petitioner has not shown Kubala alone teaches limitation 1.8; however, Petitioner argues persuasively that Kubala combined with Hammond teaches this limitation. Petitioner relies on Kubala’s description with reference to Figure 10 of resending an email message that has a mandatory-response flag (i.e, the asserted forced message alert) if a reply to the email message has not been made. Pet. 35–36 (citing Ex. 1005 ¶ 53, Fig. 10). With reference to Figure 10, Kubala appears to disclose neither (1) the reply to the e-mail message is an *automatic* acknowledgement of receipt rather than, for example, a manual response, nor (2) the e-mail message is sent *periodically*. Ex. 1005 ¶ 53, Fig. 10. Petitioner does not explain how Kubala’s disclosure teaches *automatic* acknowledgement that is sent *periodically*. Pet. 35–36.

However, Petitioner contends that to the extent Kubala does not teach limitation 1.8, Hammond provides the missing disclosure, and a skilled artisan would have been motivated to combine Kubala with Hammond. Pet. 36–37 (citing Ex. 1006, Abstract, 2:1–8, 4:21–28, 5:5–6:19, 6:66–7:63, Fig. 2, Fig. 3A, Fig. 3B, Fig. 4, Fig. 5A, Fig. 5B; Ex. 1003 ¶¶ 117–118). We are persuaded Hammond provides the missing disclosure because Hammond teaches a recipient “[provid[ing] receipts when messages are received,” Ex. 1006, 5:20–23, and resending messages periodically (every specified Resend Time period) until the recipient sends a receipt of delivery notification, Ex. 1006, 7:7–13 (setting Resend Times to 1 hour or 2 hours), 7:14–17 (explaining that when a message is received by recipient in less than the specified Resend Time, the message is not resent). Hammond also

explains the benefit of periodically resending messages for which a return receipt has not been received, namely to help ensure that each message has been successfully delivered. Ex. 1006, 2:1–10.

Petitioner also provides a rationale to combine Hammond with Kubala, arguing that a skilled artisan would have been motivated to combine these references because both are directed to tracking responses to mandatory-response messages, and both disclose use of acknowledgement receipts. Pet. 36–37 (citing the discussion regarding limitation 1.7 at Pet. 34–35 and Ex. 1003 ¶¶ 117–118). We find Petitioner’s arguments persuasive. We find that both Hammond and Kubala relate to enhancing communication that involves electronic messages such as email, both are directed to the same field of endeavor, and both address the same problem—i.e., to ensure that important email messages receive timely responses. Pet. 20–22; Ex. 1005, code (57); Ex. 1006, code (57). Moreover, as Petitioner points out, Kubala already discloses the use of automatic acknowledgement receipts (although not in connection with Figure 10), explaining that such was well known in the art. *Id.* at 30 (citing Ex. 1005 ¶ 6). Hammond further confirms that use of return receipts was well known in the art, *see, e.g.*, Ex. 1006, 1:21–26, 2:1–10, and confirms Mr. Williams’ assertion that due to uncertainty as to whether an e-mail message was received, return receipts provided a well-known benefit, Ex. 1003 ¶ 103.

Accordingly, we are persuaded that “implementing Hammond’s tracking features in Kubala’s system would have been an obvious design choice,” and “represents no more than ‘the predictable use of prior art elements according to their established functions.’” Pet. 22–23. Moreover, we are persuaded that “[b]ecause Hammond merely discloses details about tracking features that are already suggested by Kubala’s system that collects

and records information about the recipients response to a message, this combination of Kubala and Hammond would not ‘result in a difference in function or give unexpected results.’” *Id.* (citing *In re Rice*, 341 F.2d 309, 314 (CCPA 1965)).

Therefore, we are persuaded a skilled artisan would have been motivated to modify Kubala to periodically resend messages for which a return receipt has not been received to help ensure that each message has been successfully delivered, as taught by Hammond.

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.8

b) Limitations 1.5–1.7 and 1.9

Petitioner sets forth where Kubala teaches each of limitations 1.5 and 1.6, and where Kubala, alone or in combination with Hammond, teaches limitations 1.7 and 1.9. Pet. 28–35, 37–40. Petitioner also articulates a rationale to combine Kubala with Hammond. *See, e.g., id.* at 20–23. As noted above, Patent Owner disputes Petitioner’s assertions regarding limitations 1.5–1.7 and 1.9. PO Resp. 14–28; Sur-reply 7–15.

(1) (limitation 1.5) “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”

As we determined in our claim construction, limitation 1.5 is construed as means-plus-function under § 112, ¶ 6. *Supra* Sec. II.C.2. The function is the entire recitation of limitation 1.5 following the words “means for.” *Supra* Sec. II.C.4.a.1.a. The corresponding structure is a PDA/cell

phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof. *Supra* Sec. III.C.4.a.1.a.

Petitioner persuasively argues that the corresponding structure in Kubala is, e.g., computing device 202, which may be a PDA, with enhanced email application 206 installed on it. Pet. 28 (citing Ex. 1005 ¶¶ 33–36; Ex. 1003 ¶ 99).

Petitioner also persuasively argues that Kubala’s enhanced email application software performs the functions specified in limitation 1.5. *Id.* at 28–30. In particular, Petitioner shows Kubala teaches a voice or text message, based on Kubala’s disclosure that message 214—i.e., the message transmitted from the asserted PDA/cell phone to the asserted recipient PDA/cell phone—may be a text message, audio message, video message, or other type of message. *Id.* at 29 (citing Ex. 1005 ¶ 32).

Petitioner also shows Kubala teaches a forced message alert software packet, based on Kubala’s mandatory response flag 216 that indicates to the enhanced email application on the recipient computing device that email message 214 should be handled as an important message requiring a mandatory response. *Id.* at 28–29 (citing Ex. 1005 ¶¶ 35–41, 54–61, Fig. 3, Fig. 4; Ex. 1003 ¶ 100).

Furthermore, Petitioner shows Kubala teaches attaching a forced message alert software packet to a voice or text message, because Kubala discloses that the mandatory response flag 214 is attached to email message 214, and “may be implemented in a variety of data formats.” *Id.* at 28–29 (quoting Ex. 1005 ¶ 35 and citing *id.* ¶¶ 36, 41, 54–61).

Petitioner also shows Kubala teaches “a list of possible required responses,” based on menu 1120 displayed on the recipient device, which is

shown in the exemplary embodiment in Figure 11C to include as responses, “too busy right now,” “looks okay,” and “request declined.” *Id.* at 29 (citing Ex. 1005 ¶¶ 22, 47, 57, Fig. 11C). We are persuaded that Kubala teaches or suggests attaching the asserted list of possible responses, e.g., text strings such as “too busy right now” that are used as menu items, to the asserted forced message alert software packet, i.e., flag 216, based on Kubala’s disclosure that the responses may be “extracted from the original e-mail message that was received from the sender.” *Id.* (quoting Ex. 1005 ¶ 57, and citing *id.* ¶¶ 40–41).

Petitioner shows, furthermore, that Kubala teaches “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 PDA/cell phone,” based on Kubala’s disclosure that it was known in the art to transmit automatic acknowledgements to a sender of a voice or text message:

Kubala discloses that it was known “to generate return receipts to the sender when the sender’s email 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.”

Pet. 30 (quoting Ex. 1005 ¶ 6). Mr. Williams agrees that the need for acknowledgement of email messages was well understood. Ex. 1003 ¶ 102–103. He explains that at the time, email systems were not completely reliable, and there was uncertainty as to whether, and if, an email message would “get through” to a recipient. *Id.* He states that it would have been obvious, therefore, to include a return receipt to provide the sender with confirmation that the email message has been received by the recipient so the sender would not have “to worry about whether a message was received

or not.” *Id.* We credit Mr. Williams testimony, in light of Kubala’s disclosure that use of return receipts was well known in order to provide a sender with confirmation that a message had been received. Ex. 1005 ¶ 6.

For the foregoing reasons, Petitioner has shown that Kubala teaches or suggests the subject matter of limitation 1.5.

Patent Owner contends Petitioner has not shown that Kubala, alone or in combination with Hammond, teaches or suggests a “forced message alert,” arguing the e-mail messages with attached flag 216 (asserted forced message alerts) in Kubala are not *forced*. PO Resp. 14–18; Sur-reply 11–15. To arrive at this conclusion, Patent Owner asserts that a *forced* message is one in which the message is “forced to the display without any action on the part of the recipient.” *Id.* at 15. According to Patent Owner, Kubala does not satisfy this requirement because a user of a recipient PDA/cell phone in Kubala must manually open a received e-mail message. *Id.* at 15. For the reasons discussed in our claim construction, we reject Patent Owner’s contention that a “forced message alert” must be “forced to the display without any action on the part of the recipient.” *Supra* Sec. II.C.4.a.1.a.

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.5.

(2) (*limitation 1.6*) “*means for requiring a required manual response from the response list by the recipient in order to clear the recipient’s response list from recipient’s cell phone display*”

As we determined in our claim construction, limitation 1.6 is construed as means-plus-function under § 112, ¶ 6. *Supra* Sec. II.C.2. The function is the entire recitation of limitation 1.6 following the words “means for.” *Supra* Sec. II.C.4.a. The corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:39–46 and

the portions of Figure 4 described at 8:39–46, and equivalents thereof.

Supra Sec. III.C.4.a.1.b.

Petitioner persuasively argues that the corresponding structure in Kubala is, e.g., computing device 202, which may be a PDA, with enhanced email application 206 installed on it. Pet. 30–31 (citing Ex. 1005 ¶¶ 33–36, Fig. 2; Ex. 1003 ¶ 106).

Petitioner also persuasively argues that Kubala’s enhanced email application software performs the functions specified in limitation 1.6. *Id.* at 30–32.

Petitioner persuasively argues Figure 11C of Kubala teaches the specified function of requiring a manual response by the recipient from the response list in order to clear the response list from the recipient’s cell phone display. Petitioner relies on disclosure that menu 1120 includes a list of possible responses from which a recipient can choose, and argues that this list is a “response list” as recited in limitation 1.6. *Id.* at 31. We find Petitioner’s argument persuasive in light of Figure 11C, reproduced below, and Figure 11A.

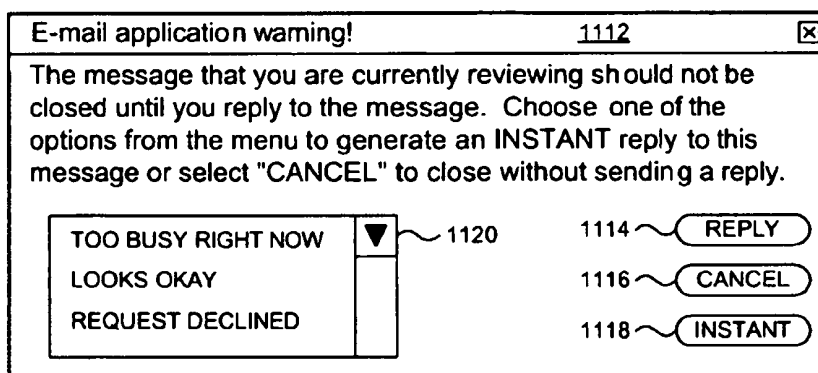


FIG. 11C

“Fig. 11C showing GUI display window 112”

Ex. 1005, Fig. 11C. Figure 11C illustrates GUI display window 1112 that is displayed on a recipient device if a user attempts to close an email without

replying to it. *Id.* ¶ 57. Window 1112 contains an error message informing the recipient that a reply is needed before closing the email. Window 1112 also includes menu 1120 comprising a list of responses from which a recipient can select a response to provide to the sender (e.g., a response list). *Id.* Although window 1112 also includes CANCEL button 1116, that allows a user to close an email message without selecting and sending a response message to the sender, Kubala also teaches explicitly that a user of a recipient PDA/cell phone can be prevented from closing, exiting, or deleting the e-mail message until the recipient has responded to the message. Pet. 31–32 (citing Ex. 1005 ¶¶ 9, 55). This is shown in Figure 11A, where the error message in window 1102 states the message cannot be closed until the user replies to the message. Ex. 1005, Figure 11A (“[t]he message that you are currently viewing cannot be closed until you reply to the message”); *id.* Fig. 11C. The description of Figure 11A explains the message in window 1102 may be displayed in “a strict process in which a user is not permitted to perform another action with respect to a message that contains a mandatory response flag unless the user first responds or replies to the message, thereby fulfilling the request of the sender of the message that the user must respond to the message.” Ex. 1005 ¶ 55. The Summary of the Invention in Kubala also describes this strict process, in which “actions are *required* by the recipient with respect to usage of a data processing system until the recipient uses the data processing system to send a response for the received electronic message to the sender.” *Id.* ¶ 9 (emphasis added). Kubala explains, “the recipient can be prevented from closing a review of the received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received email message.” *Id.*

We are persuaded a skilled artisan viewing Kubala's disclosure of (1) a response list from which a user selects a response, and (2) a feature preventing a user from exiting or deleting an e-mail or exiting the application until a response is sent, would have been motivated to combine these features, because the Summary of Invention of Kubala just discussed describes using a strict process requiring a recipient to respond and preventing a recipient from closing/deleting an e-mail or exiting the e-mail application until the recipient responds as the invention. *Id.* Moreover, Kubala explicitly teaches that the features of Figures 11A through 11D can be combined in different ways, *see, e.g.*, Pet. 19–20, 31–32, Pet. Reply 10:

FIGS. 11A-11D may be used in different scenarios depending upon the manner in which the enhanced e-mail application is implemented or configured to handle an e-mail message that contains a mandatory response flag. Other scenarios could be handled in different ways that are not illustrated within FIGS. 11A-11D, and these different processes would also be considered as embodiments of the present invention because each different process would represent a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.

Ex. 1005 ¶ 54. This teaching provides further persuasive evidence that a skilled artisan would have been motivated to combine the feature in Figure 11A of window 1102 stating the message cannot be closed until the user replies to the message, with a response list (e.g., menu 1120) as shown in Figure 11C.

For the foregoing reasons, we find based on Kubala's teachings it would have been obvious to have a window that displays a response list that cannot be cleared until the user replies.

Patent Owner submits 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 the recipient's cell phone display. PO Resp. 18–20. Patent Owner erroneously states that “Petitioner elects a single embodiment that corresponds to Figure 11C.” *Id.* at 18. This argument is unavailing because, as we discussed above, Petitioner does not rely solely on Figure 11C as teaching limitation 1.6. Pet. 30–32; Pet. Reply 10. Patent Owner, a few pages later, contradicts its earlier argument that Petitioner relies solely on Figure 11C, acknowledging that Petitioner relies on disclosures in Kubala in addition to Figure 11C. PO Resp. 20 (citing Pet. 31) (asserting Petitioner “acknowledges this missing element [from Figure 11C] and alleges generally that other embodiments disclose preventing the recipient from closing a review of the received e-mail message, from deleting the e-mail message, and from exiting the e-mail application until the recipient has responded to the message.”). Patent Owner argues the Petition is deficient, nonetheless, on grounds that the Petition presents no obviousness analysis or motivation to combine the distinct embodiments in Kubala. *Id.* at 20–21. However, as argued by Petitioner and discussed above, Kubala itself teaches that the scenarios shown in Figures 11A through 11D can be combined in different ways. Pet. Reply 10–11; Ex. 1005 ¶ 54. Petitioner explains “Kubala explicitly provide[s] the motivation to combine,” citing to numerous disclosures in Kubala describing, for example, combining Figures 11A–11D, and describing preventing closing review of a received e-mail message and exiting the e-mail application until the recipient has responded. Pet. Reply 10–11 (citing Ex. 1005 ¶¶ 9, 54, 55, 59–60).

As we discussed above, we agree with Petitioner that Kubala teaches combining features, because it explicitly teaches combining features such as those shown in Figures 11A–11D and described in paragraph 9, and because Kubala teaches “strict” scenarios in which a user is not permitted to perform another action with respect to a message unless the user first responds to the message. *See, e.g.*, Ex. 1005 ¶¶ 9, 54, 55, 59–60. We find these explicit teachings provide sufficient rationale to combine a response list from which a user selects a response with a feature preventing a user from exiting or deleting an e-mail or exiting the application until a response is sent.

Patent Owner also asserts that even if the Board accepts that Figures 11A through 11D can be combined, Petitioner fails to show how the combination discloses a response list because “these embodiments lack menu 1120 [e.g., a response list].” PO Resp. 22. Patent Owner does not explain this single sentence assertion. This assertion is incorrect, because Figure 11C includes menu 1120. Moreover, in the very next sentence, Patent Owner acknowledges the embodiments upon which Petitioner relies include a response list. *Id.*

Finally, Patent Owner asserts that “the additional embodiments” cited by Petitioner pertain to clearing the *received message* from the display, rather than clearing the *response list* from the display. *Id.* This argument, too, is unavailing because the response list is part of the received message, and therefore would be cleared from the display when the message is closed. *See, e.g.*, Fig. 11C (showing menu 1120 is part of the message being viewed by the recipient); *see also* Pet. Reply 11–12 (explaining that neither the Petition, Kubala’s teachings, nor Mr. Williams’ testimony are limited to clearing a received message from the display).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.6.

(a) New Argument

We note that during the oral hearing, Patent Owner attempted to introduce a new argument regarding limitation 1.6 found nowhere in the Patent Owner Response or Sur-reply. Patent Owner argued for the first time that Petitioner failed to demonstrate that the prior art teaches “taking control” of a PDA until a response is made, then releasing control of the PDA. *See, e.g.*, Tr. 27:23–28:6. Patent Owner explained that to show unpatentability the art must teach “taking control,” arguing that the algorithm for performing the function recited in limitation 1.6 requires “taking control of the device until a response is made, and then releasing control of the device.” *See, e.g.*, Tr. 28:4–6; 28:25–30.

Parties are not permitted to present new evidence or arguments during the oral hearing. 37 C.F.R. § 42.70 (a) (“A party may request oral argument on *an issue raised in a paper* at a time set by the Board”) (emphasis added); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 12, 2012) (“A party may rely upon evidence that has been previously submitted in the proceeding and may only present arguments relied upon in the papers previously submitted. No new evidence or arguments may be presented at the oral argument.”).

In an attempt to pass the new argument as previously submitted, Patent Owner’s counsel indicated for the first time its interpretation of the construction proposed in the Petition and adopted in the Board’s preliminary construction in the Institution Decision as requiring taking and releasing control of a PDA. Tr. 29:12–30:10. Specifically, at the hearing Patent Owner expressed for the first time that because we identified Figure 4 as

providing disclosure of the algorithm corresponding to the function specified in limitation 1.6, we intended to include every feature shown in Figure 4 including taking and releasing control of a PDA. *Id.*

Patent Owner's argument strains credibility. In the Institution Decision, we identified written description of algorithms by column and line numbers, and to the extent we identified Figures, it is evident that we intended to include only the portion[s] of the Figures described in the identified column and line numbers. Inst. Dec. 13–16. For limitation 1.6, our intent to include in the algorithm only certain steps shown in Figure 4 is clear. *Id.* at 14. We did not identify the Specification's entire description of Figure 4, but rather identified only the column and line numbers we considered to disclose the algorithm, which excluded the explicit disclosure of taking and releasing control. Specifically, we identified Ex. 1001, 8:39–46. *Id.* Had we intended to include description of taking and releasing control of the PDA, we would have also identified the disclosure at Ex. 1001, 8:37–39 and 8:52–57, which explicitly mentions taking and releasing control of the PDA.

Our intent to include in the algorithm only portions of Figures that correspond to descriptions in the Specification that we explicitly identified by column and line numbers is also evident in view of our construction of other limitations. For example, for limitation 1.7, we identified Figures 3A and 3B, Inst. Dec. 15, even though certain steps in the Figures clearly relate not to limitation 1.7, but to other limitations. *See, e.g.*, Ex. 1001, Fig. 3A, Fig. 3B. For example, the second step of Figure 3B describes periodically resending message alerts, which clearly pertains to limitation 1.8 (reciting means for periodically resending said forced message alert), and the third step in Figure 3B describes receiving and displaying an indication of

responses (rather than *automatic acknowledgements* as recited in limitation 1.7), which clearly pertains to limitation 1.9. *Id.* Fig. 3B. Accordingly, for limitation 1.7 we identified the column and line numbers corresponding to the first step of Figure 3B, Ex. 1001, 7:64–8:5, which describes the function recited in limitation 1.7 (i.e., receiving and displaying automatic acknowledgements); however, we did not identify the column and lines numbers describing the second and third steps of Figure 3B, i.e., Ex. 1001, 8:6–15, describing the functions recited in limitations 1.8 and 1.9. Inst. Dec. 15. Therefore, we identified algorithms by column and line numbers, and to the extent we identified Figures, it is evident that we intended to include only the portion[s] of the Figures corresponding to the identified column and line numbers.

Even if we were to credit Patent Owner's assertion at the hearing as to its understanding of our preliminary construction, this does not address the fact that Patent Owner neither expressed its understanding nor argued Kubala does not teach taking and releasing control of a PDA, prior to the hearing. *See generally* PO Resp.; *see generally* Sur-reply. In the Response, Patent Owner's proposed construction for limitation 1.6 identified the disclosure at Ex. 1001, 8:37–57 as disclosing the algorithm. PO Resp. 12. Notably, Patent Owner included lines not included in our preliminary construction, namely Ex. 1001, 8:37–39 and 8:52–57 describing taking and releasing control. *Id.* However, Patent Owner did not express an understanding that our preliminary construction is consistent with requiring taking and releasing control. *Id.* at 11–12. Patent Owner did not argue that taking and releasing control of a PDA is a requirement of limitation 1.6, much less explain why it should be a requirement. *Id.* Indeed, Patent Owner's only commentary and argument concerning construction of this

limitation was that we should adopt the construction adopted in district court. *Id.* Patent Owner's failure to argue that taking and releasing control should be written into limitation 1.6, coupled with the lack of any argument by Patent Owner that Kubala fails to teach taking and releasing control, *see generally* PO Resp. and Sur-reply, left Petitioner and the Board entirely in the dark as to Patent Owner's positions until the oral hearing, thereby depriving Petitioner the opportunity to develop a response.

For the foregoing reasons, we do not consider Patent Owner's untimely arguments in rendering our Final Decision. However, had we considered Patent Owner's new arguments made at the hearing, it would not have affected the outcome of this Final Decision.

The claim construction adopted in this Final Decision renders moot Patent Owner's new argument. As we discussed above, Patent Owner's argument assumes the construction of limitation 1.6 includes, as part of the algorithm, the discussion in the Specification of taking and releasing control of a PDA. However, our construction does not include such description as part of the algorithm. As we clarified above, *supra* Sec. II.C.4.a.1.b, we do not adopt Patent Owner's proposed construction of limitation 1.6. Namely, unlike in Patent Owner's proposal, we do not include in the algorithm the description of taking and releasing control at Ex. 1001, 8:37–39, 8:52–57, and portions of Figure 4 not described at 8:39–51. We do not read into limitation 1.6 a requirement of taking control of a PDA/cell phone—a requirement that is not expressly stated in claim 1, *supra* Sec. II.C.4.a.1.b.

Our interpretation is consistent with the '970 patent disclosure taken as a whole. Claim 2, which depends directly from claim 1, explicitly recites means for controlling a PDA/cell phone, supporting our determination that claim 1 does not require taking control of a PDA/cell phone. Ex. 1001,

9:46–54, Claim 2 (“means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display”).

Even if we were to agree with Patent Owner that claim 1 requires taking control of a PDA/cell phone, this would not alter the outcome of our Final Decision. In light of the claim language and Specification, we would interpret the forced message alert software application program “effectively tak[ing] control” of a PDA/cell phone to mean that the application program does not allow a recipient to clear a text message and response list or stop a voice message from repeating until the recipient selects a response, because this is the only written description associated with taking control of a PDA/cell phone. *Id.*; *see also id.* at 8:52–57 (explaining that when the recipient selects a response, the application program “releases control” of the recipient device, clearing the display and stopping repeating the voice message). The Specification offers no support for a broader interpretation of taking control of a PDA/cell phone.

Under the hypothetical interpretation in the preceding paragraph, we would find Petitioner has made a persuasive showing because, as we discussed above, Petitioner has shown Kubala teaches 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. We note that a finding that Kubala teaches e-mail application 206 taking control of a PDA/cell phone would be further supported by Kubala’s disclosure that “the

user must reply to the received e-mail in some manner *before the e-mail application will allow the user to perform some other action.*” Ex. 1005 ¶ 53 (emphasis added).

We note that at the hearing, when asked if how the algorithm takes control of a PDA is limited to the description in the Specification, Patent Owner took the untenable position that taking control includes physically grabbing someone’s PDA out of their hands:

JUDGE TROCK: It [the algorithm] explains how it takes control. It’s very limited in how it takes control; is it not?

MR RUBINO: No Your Honor. It says –

JUDGE TROCK: It doesn’t say it grabs the cell phone out of the recipient’s hand, does it?

MR. RUBINO: It does, Your Honor.

Tr. 30:14–20; *see also* Tr. 34:17–35:14. When asked why a skilled artisan wouldn’t have understood “taking control” to be limited to the only written description in the Specification of what happens when the application program effectively takes control of a PDA (i.e., Ex. 1001, 8:39–51 and corresponding portion of Figure 4), Patent Owner responded that “taking control” must mean more because Figure 4 states “the forced voice alert software takes control of the recipient’s cell phone . . . *and causes*” display of the text message or repeating the voice message until a response is sent—the “and” indicating taking control must mean something other than displaying the text message or repeating the voice message until a response is sent, according to Patent Owner. Tr. 36:18–37:25. Patent Owner’s position appeared to be that because “taking control” must mean more than what is described at 8:39–51 and corresponding portion of Figure 4, and

because the Specification doesn't explicitly describe any other form of taking control, taking control could be so broad as to include physically grabbing a phone away from someone's hands. *Id.* If we were to consider this belated argument, we would reject Patent Owner's conclusion that "take control" is so broad. The broadest reasonable interpretation of a claim that invokes 35 U.S.C. § 112, ¶ 6 is the structure, material, or act described in the specification as performing the entire claimed function and equivalents thereof. *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). Therefore, we would not interpret limitation 1.6 more broadly than what is described in the Specification as taking control of a PDA. As we discussed above, the only possible description of taking control of a PDA/cell phone is at 8:39–51 and the corresponding portion of Figure 4.

For the foregoing reasons, even if we had considered Patent Owner's new argument, it would not have altered the outcome of our Final Decision.

(3) *"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" (limitation 1.7); "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 responses from each recipient PDA/cell phone that responded" (limitation 1.9)*

Petitioner persuasively argues that Kubala teaches limitations 1.7 and 1.9. Although Petitioner's analysis is based on a construction different from that adopted above, *supra* Sec. II.C.4.a.2, Petitioner still shows Kubala teaches limitations 1.7 and 1.9 under our construction. We determined that the structure corresponding to the functions recited in limitations 1.7 and 1.9 is PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof. *Supra*

Sec. II.C.4.a.2. Petitioner has shown Kubala discloses a hardware display because Petitioner shows each PDA/cell phone in Kubala includes a touch screen display. Pet. 24 (citing Ex. 1005 ¶¶ 29–30; Ex. 1003 ¶ 93).

Petitioner has shown Kubala discloses a wireless receiver and/or transceiver because Petitioner shows the PDA/cell phones in Kubala communicate using wireless technology. *Id.* at 25 (citing Ex. 1005 ¶ 27, Figure 1A). Patent Owner does not dispute that Kubala discloses a PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver. *See generally* PO Resp.

Petitioner also shows, for reasons discussed below, that the structures in Kubala perform the functions specified in limitations 1.7 and 1.9 through its showing that the software application program (e.g., enhanced email application 206, 208) in Kubala results in the functions being performed on Kubala’s touch screen display and wireless receiver and/or transceiver. Pet. 32–35, 37–40.

(a) Limitation 1.7

Petitioner persuasively shows that Kubala teaches receiving “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,” as recited in limitation 1.7, because Kubala discloses that 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 acknowledgement that a particular message has been received and/or opened.” Pet. 32 (quoting Ex. 1005 ¶ 6). Furthermore, we are persuaded that a skilled artisan would have understood that the listing is accessible, e.g., available for display, on

the sender PDA/cell phone because the user of the sender PDA/cell phone would have wanted to access the information regarding acknowledgement receipts. *Id.* at 33 (citing Ex. 1003 ¶ 111); *see also* Tr. 18:8–15 (Petitioner’s counsel explaining “accessible” means accessible by the user and the only way a user could access the information would be to view it).

Petitioner also presents a contingent argument in the event “it is argued that Kubala doesn’t teach this limitation [1.7].” *Id.* Petitioner argues that in the event we find Kubala does not teach use of acknowledgement receipts, Hammond, like Kubala, also teaches this feature. Pet. 33. (citing Ex. 1006, Abstract, 2:11–18, 5:20–23). Petitioner persuasively shows Hammond teaches use of such receipts. *Id.* at 33–35 (citing Ex. 1006, 3:1–4:28, 5:31–37, 6:56–8:45, 10:6–22, Fig. 2). Indeed, Hammond discloses that the sender of an electronic message supplies a message to a Message Sender component, and can specify optional message tracking information, including message delivery (e.g., receipt) information. Ex. 1006, 4:48–56. In one embodiment a recipient “provide[s] receipts when messages are received” and a Message Receipt Tracker is notified of these receipts. *Id.* at 5:20–23. The Message Receipt Tracker in turn stores information, such as notification of receipts, in a Message Tracking Table, such as that shown in Figure 2 of Hammond. *Id.* at 5:32–37.

Petitioner also provides a rationale to combine Hammond with Kubala, arguing that a skilled artisan would have been motivated to combine these references because both are directed to tracking responses to mandatory-response messages, and both disclose use of acknowledgement receipts. Pet. 34–35. We find Petitioner’s argument persuasive. Hammond, like Kubala, relates to enhancing communication that involves electronic messages such as e-mail. Ex. 1005, code at (57); Ex. 1006, code (57). As

Petitioner points out, Kubala already discloses the use of automatic acknowledgement receipts, explaining that such was well known in the art. *Id.* (citing Ex. 1005 ¶ 6). Hammond further confirms Kubala's teaching that use of return receipts was well known in the art, *see, e.g.*, Ex. 1006, 1:21–26, 2:1–10, and confirms Mr. Williams' assertion that due to uncertainty as to whether an e-mail message was received, return receipts provided a well-known benefit, Ex. 1003 ¶ 103. For the foregoing reasons, we find persuasive Petitioner's assertion that the combination of Kubala with Hammond teaches receiving "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," as recited in limitation 1.7.

Patent Owner's contentions and arguments do not undermine Petitioner's showing. Patent Owner contends that "Petitioner does not rely on Kubala to disclose the recited function," but instead "Petitioner submits that Hammond discloses the claim elements required by the recited function of displaying the required listing." PO Resp. 23. Patent Owner is incorrect. Petitioner unambiguously asserts that Kubala alone teaches the recited function. Pet. 32–33 ("Kubala discloses the claimed structure and the claimed function of this [1.7] limitation."); Pet. Reply 13–15. As we discussed above, Petitioner relies on Hammond only for a contingent argument, stating explicitly that Hammond is relied on "[t]o the extent it is argued that Kubala doesn't teach this [1.7] limitation." Pet. 33. Accordingly, Patent Owner's assertion that Petitioner does not rely on Kubala to disclose the recited function is incorrect.

Patent Owner also criticizes an argument that is not made by Petitioner. Patent Owner argues that Hammond's Message Tracking Table

(as shown in Figure 2) does not depict a display screen, but rather illustrates a data structure stored in memory. PO Resp. 23–27. However, Petitioner never asserts that the Message Tracking Table shown in Figure 2 depicts a display screen. Pet. 33–35. Rather, Petitioner explains that (1) Hammond’s Message Tracking Tables show tracking of acknowledgement receipts, (2) Hammond is relied on for its teaching of tracking acknowledgement receipts, and (3) a skilled artisan would have combined Hammond based on its disclosure as it relates to exchanging and tracking recipient-devices. *Id.* (citing Ex. 1006, 3:1–4:28, 5:31–37, 6:56–8:45, 10:6–22, Fig. 2; Ex. 1003 ¶ 112). Nowhere does the Petition argue that the Message Tracking Table in Figure 2 depicts a display. *Id.* Accordingly, Patent Owner’s argument that Petitioner’s expert, Mr. Williams, “conceded during his deposition that Hammond’s ‘Message Tracking Table’ depicted in Figure 2 is located and stored in the server’s memory,” is irrelevant. PO Resp. 24 (citing Ex. 2007, 63:13–65:1, 66:16–6:22). Nor do we find persuasive Patent Owner’s argument that Mr. Williams testified that the existence of the Message Tracking Table itself is not sufficient to show how the table is displayed. PO Resp. 24 (citing Ex. 2007, 75:14–76:8). Nowhere does Petitioner assert that Hammond is relied on for displaying information. Pet. 33–35. As we discussed above, Petitioner relies on Kubala for displaying tracked information, and relies on Hammond for its teaching of the kind of information that is tracked, namely return receipt information. *Id.* at 32–35.

Even if we were to find Patent Owner’s arguments regarding Hammond to be persuasive, and we do not, they relate to a contingency in the event we find Kubala does not teach the function recited in limitation 1.7. However, for reasons discussed above, we find Petitioner has shown Kubala teaches limitation 1.7.

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.7 in view of Kubala, either alone or in combination with Hammond.

(b) Limitation 1.9

Petitioner persuasively shows that Kubala teaches receiving “a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the responses from each recipient PDA/cell phone that responded,” as recited in limitation 1.9. Pet. 37–38. Kubala discloses that a sending PDA (e.g., computing device 202) can receive and display a response from a recipient PDA (e.g. computing device 204). *Id.* at 37 (citing Ex. 1005 ¶¶ 26–41, Fig. 2; Ex. 1003 ¶ 121). Petitioner argues that a skilled artisan would have known, in addition to receiving and displaying responses from recipient PDAs, also to display a listing of which recipient PDA’s have transmitted a response. *Id.* at 27–30. We find this persuasive because, as noted by Petitioner, Kubala discloses that receiving e-mail application 208 may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag, wherein the information may include mandatory-response return-status codes included within the reply e-mail. Pet. 38 (citing Ex. 1005 ¶¶ 50, 51, 61, Fig 9). We are persuaded by Petitioner’s argument that a skilled artisan would have known that the collected information regarding which recipients have responded to the e-mail messages was available and accessible, e.g., available for display, on the sender PDA/cell phone because the user of the sender PDA/cell phone would have wanted to access the information regarding acknowledgement receipts. *Id.* (citing Ex. 1003 ¶ 122); *see also* Tr. 18:8–15 (Petitioner’s

counsel explaining “accessible” means accessible by the user and the only way a user could access the information would be to view it).

Patent Owner does not provide argument specific to limitation 1.9.

For the foregoing reasons, we find Petitioner has made a persuasive showing as to limitation 1.9 in view of Kubala.

Although Petitioner provides argument that Kubala alone teaches “receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert,” Petitioner also argues that “Hammond also provides this disclosure.” *Id.* at 38. Petitioner provides evidence and argument that Hammond, like Kubala, teaches tracking information about electronic messages that have been read by recipients. *Id.* at 38–39 (citing Ex. 1006, 5:17–8:45, 10:5–11:48, Fig. 4, Fig. 5A, Fig. 5B; Ex. 1003 ¶ 123). However, Petitioner does not explain how Kubala is being combined with Hammond. *Id.* at 40. Rather, Petitioner refers to its argument regarding limitation 1.7; but, limitations 1.7 and 1.9 are distinct, and Petitioner fails to address the differences in the limitations and explain how limitation 1.9 is taught by the combination. *Id.* at 40.

For the foregoing reasons, we are not persuaded as to Petitioner’s arguments regarding the combination of Kubala with Hammond.

c) Conclusion

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 1 of the ’970 patent is unpatentable under § 103 as obvious over the combination of Kubala with Hammond.

4. Claim 3

Claim 3 depends directly from claim 1, and recites the system as in claim 1, “wherein said data transmission means is TCP/IP or another communication protocol.” Ex. 1001, 9:64–65.

Petitioner argues persuasively that Kubala discloses the limitation of claim 3 because Kubala discloses PDAs/cell phones communicating according to TCP/IP or another communication protocol, such as Wi-Fi. Pet. 40 (citing Ex. 1005 ¶ 27, Fig. 1A; Ex. 1003 ¶ 127).

Patent Owner does not dispute Petitioner’s contentions as to claim 3. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 3 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

5. Claim 4

Claim 4 depends directly from claim 1, and recites the system as in claim 1, “wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.” Ex. 1001, 9:66–10:2.

As we discussed above with regard to limitation 1.4 of claim 1, Petitioner argues persuasively that Kubala’s menu 1120 in Figure 11C teaches a response list that is transmitted within the forced message alert software packet. *Supra* Sec. II.D.3.a.5. Petitioner argues that Kubala teaches that the responses in the transmitted list of possible responses, e.g., the text strings “too busy right now,” “looks okay,” and “requested declined,” can be default responses. Pet. 40–41 (citing Ex. 1005 ¶ 57, Fig. 11C). We are persuaded that Kubala teaches the text string that are

used as menu items can be default responses because, as Petitioner points out, “Kubala also explains that the text strings may be ‘required and standardized within a data format specification, e.g., in a standard similar to RFC 2822.’” *Id.* at 41 (citing Ex. 1005 ¶¶ 57, 60; Ex. 1003 ¶¶ 129–130). Patent Owner does not dispute Petitioner’s contentions as to claim 4. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 4 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

6. Claim 5

Claim 5 depends directly from claim 1, and recites the system as in claim 1, “wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.” Ex. 1001, 10:3–6.

As we discussed above with regard to limitation 1.4 of claim 1, Petitioner argues persuasively that Kubala’s menu 1120 in Figure 11C teaches a response list that is transmitted within the forced message alert software packet. *Supra* Sec. II.D.3.a.5. Petitioner argues that Kubala teaches that the text strings used as menu items in the response list can be configurable. Pet. 41–42 (citing Ex. 1003 ¶¶ 132–133). We find Petitioner’s argument persuasive because Kubala discloses “[t]he text strings that are used as menu items may be obtained in a variety of manners,” and discloses an example in which the text strings are configurable:

the text strings may be configurable through the enhanced e-mail application by allowing user-specifiable or system-administrator-specifiable parameters. As another alternative, the text strings may be extracted from the original e-mail message

that was received from the sender, in which case the text strings may have been configured as user-specifiable or system-administrator-specifiable parameters in the sender's instance of the enhanced e-mail application.

Id. (quoting Ex. 1005 ¶ 57). Patent Owner does not dispute Petitioner's contentions as to claim 5. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 4 of the '970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

7. Claim 6

Claim 6 is similar to claim 1. However, claim 6 recites a method, whereas claim 1 recites a communication system. Petitioner sets forth where the preamble and each limitation of claim 6 is taught by the combination of Kubala and Hammond. Pet. 42–47. Patent Owner disputes Petitioner's contentions. Patent Owner's arguments are made together with, and are the same, as those for claim 1. PO Resp. 14–28.

Regarding the preamble of claim 6, Petitioner argues that, as set forth in its arguments and evidence for limitations 1.1 and 1.3 of claim 1, "Kubala discloses a method for sending a forced-message alert to one or more recipient PDA/cell phones within a predetermined communication network." Pet. 42 (citing Ex. 1005 ¶¶ 26–27, 32–33, Fig. 1A; Ex. 1003 ¶ 135). Moreover, for the reasons argued for limitation 1.7, Petitioner argues Hammond discloses the ability to track the receipt and response to forced-message alerts. *Id.* (citing Ex. 1006, code (57), 2:11–18, 3:1–4:28, 5:20–37, 10:6–22, 6:56–8:45, FIG. 2). For our reasons stated above for limitations 1.1, 1.3, and 1.7, we are persuaded Petitioner has shown the combination of Kubala and Hammond teaches or suggests the preamble of claim 6.

For limitation 6.1, Petitioner shows persuasively that Kubala teaches “accessing a forced message alert software application program on a sender PDA/cell phone,” relying on Kubala’s enhanced email application program on a sender PDA and its arguments for limitation 1.4 of claim 1 as to why Kubala’s enhanced email application program teaches a forced message alert software application program. Pet. 43 (citing Ex. 1005 ¶¶ 13, 33–36, Fig. 2; Ex. 1003 ¶ 136). For the same reasons we stated above for limitation 1.4, we are persuaded Kubala’s enhanced email application teaches a forced message alert software application program on a sender PDA/cell phone.

For limitation 6.2, Petitioner shows persuasively that Kubala teaches “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,” relying on its evidence and arguments for limitation 1.5 that Kubala’s email message 214 with mandatory response flag 216 created on the sender PDA is a forced message alert. Pet. 43 (citing Ex. 1005 ¶¶ 32–41, 54–61, Fig. 1A, 1B, 2–4; Ex. 1003 ¶ 137). For the same reasons we stated above for limitation 1.5, we are persuaded Kubala’s email message with mandatory response flag created on the sender PDA is a forced message alert, and that Kubala teaches limitation 6.2

For limitation 6.3, Petitioner shows persuasively that Kubala teaches “designating one or more recipient PDA/cell phones in the communication network,” relying on disclosure in Kubala that email messages are sent to a recipient. Pet. 43 (citing Ex. 1005 ¶¶ 32–44, 54–61, Fig. 1A, 1B, 2–5; Ex. 1003 ¶ 138). We credit Mr. William’s testimony that a person of ordinary skill in the art would have recognized that an email messaging application to which recipients receive an email involves designating a

recipient within the communication network. Ex. 1003 ¶ 138. Indeed, Kubala discloses that emails have message headers that provide information about the recipient of a message, suggesting a recipient has been designated. Ex. 1005 ¶ 37. For the reasons stated above, we are persuaded Kubala teaches limitation 6.3

For limitation 6.4, Petitioner shows persuasively that Kubala teaches “electronically transmitting the forced message alert to said recipient PDA/cell phones,” relying on Kubala’s disclosure of sending outgoing email messages flagged as a message to which a recipient is required to provide a mandatory response. Pet. 44 (citing Ex. 1005 ¶¶ 32–44, 54–61, Fig. 1A, 1B, 2–5; Ex. 1003 ¶ 139). We are persuaded that Kubala teaches limitation 6.4 because the email (i.e., electronic mail) message is transmitted electronically to a recipient PDA. *See, e.g.*, Ex. 1005 ¶ 35.

For limitation 6.5, we are persuaded by Petitioner’s showing. Petitioner relies on its evidence and arguments for limitation 1.5 of claim 1, Pet. 44, for which we find, above, Petitioner shows Kubala teaches requiring the recipient PDA/cell phone to transmit an automatic acknowledgement to the sender PDA/cell phone as soon as the forced message alert is received by the recipient PDA/cell phone, *supra* Sec. II.D.3.b.1. Petitioner further relies on its evidence and argument for limitation 1.7 of claim 1, Pet. 44, for which we find, above, Petitioner shows Kubala, either alone or in combination with Hammond, teaches 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, *supra* Sec. II.D.3.b.3.a. For our reasons stated above as to limitation 1.5 and 1.7, we are persuaded Kubala, either alone or in combination with Hammond, teaches limitation 6.5.

For limitation 6.6, Petitioner shows persuasively that the combination of Kubala and Hammond teach “periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt,” relying on its evidence and arguments for limitation 1.8 of claim 1. Pet. 44. As we discussed for limitation 1.8, we are persuaded the combination of Kubala and Hammond teach “periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert. *Supra* Sec. II.D.3.a.6. For the same reasons, we are persuaded the combination of Kubala and Hammond teaches limitation 6.6.

For limitation 6.7, Petitioner shows persuasively that Kubala teaches “receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone,” relying on Kubala’s disclosure that the sending PDA (e.g., computing device 202) may receive an email message 218 from a recipient PDA (e.g., computing device) in response to email message 214 with mandatory response flag 216. Pet. 45 (citing Ex. 1005 ¶¶ 33–36; Ex. 1003 ¶ 142). Petitioner argues persuasively that the received email would have been displayed on the PDA, relying on Mr. William’s testimony that the ability to display email has been in place at least since 1993 with the IBM Simon. *Id.* (citing Ex. 1003 ¶ 143). We credit Mr. William’s testimony. Indeed, Kubala depicts PDAs as having display screens in Figure 1A, Ex. 1005, Fig. 1A, and we find credible Mr. William’s assertion that emails were displayed, based on our observation that the message comprises text, which we find indicates the message would be viewed on a display. For the foregoing reasons, we are persuaded Kubala teaches limitation 6.7.

For limitation 6.8, Petitioner shows persuasively that Kubala teaches “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,” relying on its evidence and arguments for limitations 1.5 and 1.6 of claim 1. Pet. 46 (citing Ex. 1005 ¶¶ 9, 33–36, 40, 41, 47, 54–60, Fig. 2, 8, 10, 11A, 11C; Ex. 1003 ¶ 144). For reasons we discussed above for limitation 1.5, we are persuaded Kubala teaches providing a manual response list on the display of a recipient PDA, as is illustrated in Figure 11C. For reasons we discussed above for limitation 1.6, we are persuaded Kubala teaches 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. Therefore, we are persuaded Kubala teaches limitation 6.8

For limitation 6.9, Petitioner persuasively shows Kubala teaches “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,” because Kubala discloses that a user can select a response from a menu of responses, and after selecting a response, a user presses the INSTANT button, thereby closing the window and clearing the display and generating a reply message. Pet. 46–47 (citing Ex. 1005 ¶ 57, Fig. 11C; Ex. 1003 ¶ 145–147). Petitioner points out that although the embodiment illustrated in Figure 11C shows that a user can select CANCEL to close the window without sending a reply, Kubala also teaches that a recipient can be prevented from closing a review of the received email message, from deleting the received email message, and from exiting the email application until the recipient has responded to the received email

message. *Id.* at 47 (citing Ex. 1005 ¶ 9). Furthermore, as we discussed above for limitation 1.6, Petitioner has shown persuasively that Kubala teaches combining these features. For the foregoing reasons, Petitioner has shown that Kubala teaches limitation 6.9.

Patent Owner disputes Petitioner has shown unpatentability, but its arguments are made together with claim 1, PO Resp. 14–28, and we addressed such arguments in our discussion above for claim 1. For the same reasons as above, we find Patent Owner’s arguments unavailing.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 6 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

8. *Claim 7*

Claim 7 depends directly from claim 6, and recites the method as in claim 1, “wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.” Ex. 1001, 10:42–45.

As we discussed above with regard to limitations 1.1 and 1.4 of claim 1, Petitioner argues persuasively that Kubala teaches a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone (limitation 1.1) and a forced message alert application software application program loaded on each participating PDA/cell phone (limitation 1.4). *Supra* Sec. II.D.3.a.2, II.D.3.a.5; Pet. 48–50. Patent Owner does not dispute Petitioner’s contentions as to claim 7. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 7 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

9. *Claim 8*

Claim 8 depends directly from claim 6, and recites the method as in claim 1, “wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.” Ex. 1001, 10:46–49.

As we discussed above with regard to claim 4, Petitioner argues persuasively that Kubala teaches a response list that is transmitted within the forced message alert software packet that is a default list that is embedded in the forced message alert software application program. *Supra* Sec. II.D.5; Pet. 50. Patent Owner does not dispute Petitioner’s contentions as to claim 8. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 8 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

10. *Claim 9*

Claim 9 depends directly from claim 6, and recites the method as in claim 1, “wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.” Ex. 1001, 10:50–54.

As we discussed above with regard to claim 5, Petitioner argues persuasively that Kubala teaches a response list that is transmitted within the forced message alert software packet that is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone. *Supra* Sec. II.D.6; Pet. 50–51. Patent Owner does not dispute Petitioner’s contentions as to claim 9. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 9 of the '970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

E. Asserted Obviousness Over Hammond, Johnson, and Pepe; Asserted Obviousness Over Hammond, Johnson, Pepe, and Banerjee

Petitioner contends that claims 1 and 3–9 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hammond, Johnson, and Pepe, or alternatively, over the combination of Hammond, Johnson, and Pepe with Banerjee. Pet. 12, 51–78. Patent Owner disputes Petitioner's contentions. PO Resp. 28–39.

1. Johnson (Ex. 1007)

Johnson generally discloses a method and system having a plurality of enrolled users and electronic mail objects that may be transmitted and received between users. Ex. 1007, [57]. The method and system include designating an electronic mail object as requiring a specific response and transmitting the electronic mail object to a recipient. *Id.* The recipient of the electronic mail object is prompted for a specific response when the recipient opens the electronic mail object and is prohibited from performing other actions until the required specific response is entered by the recipient. *Id.*

2. Pepe (Ex. 1008)

Pepe generally discloses a personal communications internetwork ("PCI") that provides a network subscriber with the ability to remotely control receipt and delivery of wireless and wireline voice and text messages. Ex. 1008, 3:45–48. The PCI operates as an interface between various wireless and wireline networks, and also performs media translation where necessary. *Id.* at 3:48–51. The PCI permits the subscriber to send

and receive messages between disparate networks and messaging systems. *Id.* at 5:56–59. A database maintains the subscriber’s message receipt and delivery options. *Id.* at 3:51–54.

3. *Analysis*

After considering the arguments and evidence submitted by the parties, we determine Petitioner has not shown claims 1 and 3–9 would have been obvious over the combination of Hammond, Johnson, and Pepe, or alternatively, over the combination of Hammond, Johnson, and Pepe with Banerjee, because the Petition fails to specify with particularity what element in the prior art discloses a “forced message alert software packet,” as recited in independent claim 1, and a “forced message alert application software packet,” as recited in independent claim 6. Petitioner’s showing as to claims 3–5 and 7–9, which depend either from claim 1 or 6, are deficient for the same reasons.

Claims 1 and 6 recite that a “forced message alert” is created by attaching a “forced message alert [application] software packet” to a voice or text message. Ex. 1001, 9:14–23, 10:14–17. For claim 1, Petitioner asserts that Hammond, Johnson, and Pepe alone each disclose transmission to a recipient computer of a forced message alert, but does not specify what element in the prior art it contends is the asserted forced message alert, much less how the forced message alert includes a *forced message alert [application] software packet*. Pet. 60. Petitioner’s argument is reproduced below:

The combination of Hammond, Johnson, and Pepe disclose this limitation [limitation 1.5]. In particular, Hammond and Johnson each alone disclose the transmission of forced message alerts to recipient computers. (See Hammond at Abstract, 1:66-2:50, 3:1-

4:28, 5:17-61, 6:3-19; Johnson, 1:58-61, 2:1-35, 3:64-4:42, 6:60-65.)

Id. Petitioner’s argument for claim 6 merely refers to the argument for claim 1, and therefore is likewise deficient:

As set forth above (*supra* claim [1.5]), the combination of Hammond, Johnson, and Pepe teaches or suggests the features of this limitation. (See Hammond, Abstract, 1:66-2:50, 3:1-4:28, 5:17-61; Johnson, 1:58-61, 2:1-35, 3:64-4:42, 6:60-65; Pepe, 34:8-36:51, 5:17-20, FIGS. 28-45.)

Id. at 71.

Petitioner’s contentions are insufficient for two reasons. First, Petitioner does not identify what element in each reference it contends is the “forced message alert.” Instead, Petitioner places the burden on Patent Owner and the Board to sift through several columns of text to guess what Petitioner contends is a “forced message alert.” Second, even if we were to identify a potential candidate “forced message alert,” we would next have to speculate as to which part Petitioner contends is the “message” and which part is the “packet”—a task which we do not undertake. Our rules require that a petition specify with particularity where each element of a claim is found in the prior art, and include a detailed explanation of the relevance of the prior art to the claim. 37 C.F.R. § 42.104(b)(4) (“[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon”); *id.* § 42.22(a)(2) (“[e]ach petition . . . must include . . . a detailed explanation of the significance of the evidence including material facts”); *id.* § 42.104(b)(5) (“[t]he petition must set forth . . . the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge”). As the Federal Circuit has explained, “[i]n an IPR, the petitioner has the burden

from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). Petitioner’s citation to several columns of text is not sufficient to specify where the claimed “packet” is found in the prior art. 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4), 42.104(b)(5).

Therefore, we find the Petition fails to show with particularity why the challenged claims are unpatentable.

In the Institution Decision, we identified the deficiency in the Petition:

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.*

Inst. Dec. 36. Patent Owner agrees in the Response that the Petition is deficient:

Patent Owner agrees with and adopts the Board’s findings that each and every element is not disclosed or suggested by the prior art references in Grounds 2–3 [Hammond, Johnson, and Pepe, with or without Banerjee], and that the Petition neither identifies nor describes how the references in Grounds 2–3 comprise a voice or text message and a forced message alert software packet. Paper 9 at 36; Ex. 2005, ¶ 48.

PO Resp. 29.

Petitioner attempts, improperly, to cure the defect in the Petition by introducing more specific contentions in the Reply. The Reply specifies with particularity Petitioner’s contentions, for the first time, regarding what elements in the prior art disclose the claimed “packet,” and provides at least

some indication as to how the packet is attached to a message. Pet. Reply 19. Petitioner explicitly identifies Hammond's "message delivery information" as disclosing the claimed "packet," explaining that the "message delivery information" can be stored with a message as a header. *Id.* Petitioner also explicitly identifies Johnson's "persistent reply attribute" as disclosing the claimed "packet," explaining that the "persistent reply attribute" is described as a mechanism for forcing a recipient to reply to an electronic mail object. *Id.* These contentions in the Reply exemplify the level of specificity that could have been, but were not, in the Petition. Moreover, these contentions illustrate the challenge we would have faced had we tried to speculate, based on the Petition, as to Petitioner's positions on what constitutes the claimed "packet." Neither Hammond nor Johnson use the term "forced message alert [application] software packet," and there is need for identification, and an explanation as to why Hammond's "message delivery information" and Johnson's "persistent reply attributes," would have been considered to be the claimed "packet." *See id.* Petitioner's identification and explanation for the first time in the Reply comes too late.

The Reply may only respond to argument raised in the Patent Owner Response. 37 C.F.R. § 42.23(b) ("A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or other patent owner response"). However, even if responsive, a reply is not an opportunity to cure a deficiency in the petition, such as by providing the argument necessary to make out a prima facie case of unpatentability. *See Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756 at 48,767 (Aug. 14, 2012) ("Patent Trial Practice Guide").* ("While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned . . . [e]xamples

of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing”).

Because the new contentions in the Reply are introduced belatedly, to make out a *prima facie* case of unpatentability that could have been presented in the Petition, we do not consider them in issuing our Final Decision. Patent Trial Practice Guide at 48,767; *Harmonic Inc.*, 815 F.3d at 1363.

For the foregoing reasons, Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1 and 3–9 of the ’970 patent are unpatentable under § 103 over the combination of Hammond, Johnson, and Pepe or over the combination of Hammond, Johnson, Pepe, and Banerjee.¹⁴

III. CONCLUSION¹⁵

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 3–9	§ 103(a)	Kubala, Hammond	1, 3–9	

¹⁴ Petitioner relies on Banerjee for the teaching of a touchscreen display only, and does not provide arguments that alter our analysis. Pet. 77–78.

¹⁵ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Final Decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

1, 3-9	§ 103(a)	Kubala, Hammond, Johnson, Pepe		1, 3-9
1, 3-9	§ 103(a)	Kubala, Hammond, Johnson, Pepe, Banerjee		1, 3-9
Overall Outcome			1, 3-9	

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 3-9 of U.S. Patent No. 8,213,970 B2 are *unpatentable*; and

FURTHER ORDERED that because this is a Final Written Decision, any party to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2

IPR2018-01079
Patent 8,213,970 B2

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CERTIFICATE OF FILING

Pursuant to 37 C.F.R. §§ 90.2(a)(1) and 104.2(b), the undersigned hereby certifies that on January 21, 2020, the original of the foregoing Notice of Appeal was filed with the Director of the United States Patent and Trademark Office by **hand-delivery**, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of General Counsel
10B20, Madison Building East
600 Dulany Street
Alexandria, VA 22314-5793

In addition, pursuant to 37 C.F.R. § 90.2(a)(1) and 37 C.F.R. §42.6(b), the undersigned certifies that on January 21, 2020, a copy of the foregoing Notice of Appeal was filed **electronically** with the Board through the Board's Patent Review Processing System.

In addition, pursuant to 37 C.F.R. § 90.2(a)(2) and Federal Circuit Rule 15(a)(1), the undersigned certifies that on January 21, 2020, the requisite fee for the appeal and a true and correct copy of the foregoing Notice of Appeal were **electronically** filed with the Clerk of Court of the United States Court of Appeals for the Federal Circuit at the following address <http://ecf.cafc.uscourts.gov>.

IPR2018-01079
Patent Owner's Notice of Appeal

Respectfully Submitted,

Dated: January 21, 2020

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4) and 37 C.F.R. § 90.2(a)(3)(ii), the undersigned certifies that on January 21, 2020, a true and correct copy of the foregoing the PATENT OWNER'S NOTICE OF APPEAL was served **via email** on the Petitioner by serving the correspondence email addresses of record below:

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January 21, 2020

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

IPR2018-01079
Patent 8,213,970

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision issues pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, we determine that Google LLC (“Petitioner”)¹ has shown, by a preponderance of the evidence, that claims 1 and 3–9 (“challenged claims”) of U.S. Patent No. 8,213,970 B2 (Ex. 1001, “the ’970 patent”) are unpatentable. *See* 35 U.S.C. § 316(e) (2012); 37 C.F.R. § 42.1(d) (2017).

A. Procedural History

Petitioner filed a Petition for *inter partes* review of claims 1 and 3–9 of the ’970 patent. Paper 2 (“Pet.” or “Petition”). AGIS Software Development, LLC (“Patent Owner”)² subsequently filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Petitioner filed an authorized Reply to Patent Owner’s Preliminary Response. Paper 8. On November 20, 2018, the Board entered a decision instituting an *inter partes* review of all claims and all grounds presented in the Petition. Paper 9 (“Institution Decision” or “Inst. Dec.”).

After institution, Patent Owner filed a Response to the Petition. Paper 17 (“Response” or “PO Resp.”). Petitioner thereafter filed a Reply to Patent Owner’s Response. Paper 22 (“Pet. Reply” or “Reply”). Patent Owner filed a Sur-reply to Petitioner’s Reply to Patent Owner’s Response.

¹ Pursuant to 37 C.F.R. § 42.8, Petitioner identifies as real parties-in-interest Google LLC, Huawei Device USA Inc., Huawei Device Co., Ltd., Huawei Device (Dongguan) Co., Ltd., Huawei Technologies USA Inc., Huawei Technologies Co., Ltd., and LG Electronics, Inc. Pet. 79.

² Pursuant to 37 C.F.R. § 42.8, Patent Owner identifies only itself as a real party-in-interest. Paper 5, 1.

Paper 27 (“Sur-reply”). Patent Owner also filed a Request for Rehearing of the Institution Decision, Paper 12, which we denied, Paper 26.

An oral hearing was held on Sept. 5, 2019. A transcript of the hearing is included in the record. Paper 33 (“Tr.”).

B. Related Matters

The parties advise that the ’970 patent has been asserted in *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.); *AGIS Software Development LLC v. HTC Corporation*, No. 2:17-cv-00514 (E.D. Tex.); *AGIS Software Development LLC v. LG Electronics, Inc.*, No. 2:17-cv-00515 (E.D. Tex.); *AGIS Software Development LLC v. Apple Inc.*, No. 2:17-cv-00516-JRG (E.D. Tex.); *AGIS Software Development LLC v. ZTE Corporation et al.*, No. 2:17-cv-00517 (E.D. Tex.). Pet. 79–80; Paper 5, 3–4. Patent Owner further advises that the ’970 patent and patents related to the ’970 patent are the subject of various filings requesting *inter partes* review. Paper 5, 2–3 (table identifying *inter partes* review case numbers)

C. The ’970 Patent

The ’970 patent generally discloses a specialized software application program on a personal computer (“PC”) or PDA/cell phone for creating and processing forced message alerts. Ex. 1001, code (57). The specification of the ’970 patent (“Specification”) discloses it is desirable for a PDA/cell phone user to be able to simultaneously send Digital Smart Message Service (“SMS”) or TCP/IP messages to a large group of PCs or cell phones using cellular technology (such as GSM or CDMA) or WiFi. *Id.* at 1:51–57. The Specification further discloses that in some situations it is additionally desirable to know which PCs and PDA/cell phones received the message, which PCs and PDA/cell phones did not receive the message, and the

response of each recipient of the message. *Id.* at 1:57–61. “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.” *Id.* at 1:65–67. In addressing these issues, the Specification discloses “[t]he heart of the invention lies in [a] forced message alert software application program provided in each PC or PDA/cell phone.” *Id.* at 4:47–49. The software 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.

Id., code (57). The Specification explains that a forced message alert is comprised of a text or voice message and a forced message alert software packet. *Id.* at 2:11–13, 8:23–25

D. Illustrative Claims

Petitioner challenges claims 1 and 3–9 of the ’970 patent. Pet. 12.

Claims 1 and 6 are independent. Claim 1, reproduced below, is illustrative.

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

[1.1] a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display and a CPU memory;

[1.2] a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;

[1.3] a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;

[1.4] 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;

[1.5] 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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;

[1.6] means for requiring a required manual response from the response list by the recipient in order to clear the recipient's response list from recipient's cell phone display;

[1.7] 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;

[1.8] means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and

[1.9] 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.

Ex. 1001, 8:65–9:39 (brackets and numbering added).

Claim 6, reproduced below, also is illustrative.

6. 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:

[6.1] accessing a forced message alert software application program on a sender PDA/cell phone;

[6.2] 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;

[6.3] designating one or more recipient PDA/cell phones in the communication network;

[6.4] electronically transmitting the forced message alert to said recipient PDA/cell phones;

[6.5] 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;

[6.6] periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt;

[6.7] receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone; and

[6.8] 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;

[6.9] 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.

Ex, 1001, 10:7–41 (brackets and numbering added).

E. Prior Art and Asserted Grounds of Unpatentability

Petitioner asserts that claims 1 and 3–9 would have been unpatentable on the following grounds (Pet. 12):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3-9	103(a)	Kubala, ³ Hammond ⁴
1, 3-9	103(a)	Hammond, Johnson, ⁵ Pepe ⁶
1, 3-9	103(a)	Hammond, Johnson, Pepe, Banerjee ⁷

Petitioner relies on the declaration of David Hilliard Williams, Ex. 1003 (“Williams Declaration”), and the supplemental declaration of Mr. Williams, Ex. 1023 (“Williams Supplemental Declaration”), to support its contentions.

II. ANALYSIS

A. *Legal Principles*

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness

³ U.S. Patent Publication 2006/0218232 A1, filed March 24, 2005 and published September 29, 2006. Ex. 1005 (“Kubala”).

⁴ U.S. Patent 6,854,007 B1, filed September 17, 1998 and issued February 8, 2005. Ex. 1006 (“Hammond”).

⁵ U.S. Patent 5,325,310, filed June 26, 1992 and issued June 28, 1994. Ex. 1007 (“Johnson”).

⁶ U.S. Patent 5,742,905, filed September 19, 1994 and issued April 21, 1998. Ex. 1008 (“Pepe”).

⁷ U.S. Patent Publication 2003/0128195 A1, filed January 8, 2002 and published July 10, 2003. Ex. 1009 (“Banerjee”).

(i.e., secondary considerations).⁸ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art in the field of the ’970 patent would have had either (1) a Bachelor of Science degree in electrical engineering or an equivalent field, with three to five years of academic or industry experience in the field of electronic communications, or (2) a Master of Science degree in electrical engineering or an equivalent field, with two to four years of academic experience in the same field. Pet. 9–10 (citing Ex. 1003 ¶¶ 29–30).

Patent Owner asserts that a person of ordinary skill in the art would have had at least a bachelor’s degree in computer science, computer engineering, or equivalent with one to two years of experience in the field of computer programming with a focus on building systems such as GPS-based localization and network transmission. PO Resp. 7 (citing Ex. 2005 ¶¶ 18–20). Patent Owner further asserts that extensive experience and technical training might substitute for educational requirements, while advanced degrees might substitute for experience. *Id.* (citing Ex. 2005 ¶¶ 18–20).

The parties agree that an ordinarily skilled artisan in the field of the ’970 patent would have had a bachelor’s degree in the pertinent technical

⁸ Neither party presents arguments or evidence of secondary considerations, which therefore do not constitute part of our analysis.

field, and a few years of experience and/or more advanced education in the pertinent field. Therefore, we determine a person of ordinary skill in the art would have had a bachelor's degree in electrical engineering, computer science, or computer engineering, or equivalent, and two to four years of additional experience, either work or educational, in the field of electrical communications. We do not adopt Patent Owner's assessment that a skilled artisan would have focused on building systems such as GPS-based localization and network transmission. PO Resp. 7. Patent Owner fails to explain how this is pertinent to the field of the '970 patent, which relates to providing computers and/or PDA/cell phones with forced message alert software that enables users to create and send message alerts.

We note that the level of skill in the art also may be reflected in the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

C. Claim Construction

1. Introduction

In an *inter partes* review filed before November 13, 2018, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent.⁹ Consistent with that standard, we assign claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention, in

⁹ This standard applies to *inter partes* reviews filed before November 13, 2018. 77 Fed. Reg. 48727 (Aug. 14, 2012) (codified at 37 C.F.R. § 42.100(b)), as amended at 81 Fed. Reg. 18766 (Apr. 1, 2016); *see also* 83 Fed. Reg. 51340 (Oct. 11, 2018) (amending 37 C.F.R. § 42.100(b) effective November 13, 2018) (now codified at 37 C.F.R. § 42.100(b) (2019)).

the context of the entire patent disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

We note that the district court issued an order construing terms of the '970 patent in *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.) on October 10, 2018. Ex. 3001, 9–29 (“District Court Claim Construction Order”). We have considered the district court’s constructions.

2. *Terms to be Construed Expressly*

Petitioner proposes that we construe as means-plus-function under 35 U.S.C. § 112, ¶ 6, the terms in claim 1 that include the word “means,” i.e., limitations 1.2 and 1.5 to 1.9. Pet. 10–12. Patent Owner agrees these terms should be construed as means-plus-function, and further argues we should adopt the constructions entered in the district court proceeding for the purposes of consistency across proceedings. Prelim. Resp. 9–14.¹⁰

We agree these terms should be construed under § 112, ¶ 6. A claim limitation is presumed to invoke § 112, ¶ 6, when it uses the term “means” in combination with functional language, as is the case here. *Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352, 1356 (Fed. Cir. 1999). Having determined limitations 1.2 and 1.5 to 1.9 are to be construed under § 112, ¶ 6, below we set forth identification of the function recited in each

¹⁰ We note that prior to institution, Patent Owner did not provide any proposal regarding construction of limitations 1.2 and 1.5 to 1.9, *see generally* Prelim. Resp., and we adopted preliminary constructions based on Petitioner’s proposals, as well as the evidence in the record at the time, Inst. Dec. 9–16. After institution, Patent Owner proposed that we construe the limitations in accordance with the district court’s constructions, but did not provide any argument or evidence to support its proposal other than to argue that the Board’s constructions should be consistent with that of the district court. PO Resp. 9–14.

limitation and the corresponding structure in the written description of the Specification that performs each function. *See Asyst Techs, Inc. v. Empak, Inc.*, 268 F.3d 1364, 1369 (Fed. Cir. 2001) (“The first step in construing a means-plus function limitation is to identify the function explicitly recited in the claim. The next step is to identify the corresponding structure set forth in the written description that performs the particular function set forth in the claim.”) (citations omitted).

In addition, although neither party proposes a construction for the term “forced message alert,” Patent Owner’s arguments regarding claim limitation 1.5 raise an issue regarding the construction of this term. PO Resp. 14–18. Therefore, we also address Patent Owner’s interpretation of the term “forced message alert.”

We determine that no other claim terms require express construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

3. (limitation 1.2) “*data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations*”

We construe the term “data transmission means” under 35 U.S.C. § 112, ¶ 6. The parties agree that the function is to “facilitate the transmission of electronic files between said PDA/cell phones in different locations,” as recited in limitation 1.2. Pet. 10; PO Resp. 10. We agree that this is the recited function.

Petitioner asserts that the corresponding structure is a server that communicates according to either (1) Wifi, WiMax, or other peer-to-peer communications or (2) SMS, TCP/IP, or other messaging protocols. Pet. 10

(citing Ex. 1001, 4:1–36). Patent Owner proposes we adopt the district court’s determination that the corresponding structure is a “communications network server; and equivalents thereof.” PO Resp. 10; Ex. 3001, 10. In pertinent part, both parties assert the corresponding structure is a *server*.

Neither party, however, explains why the corresponding structure is a server. Petitioner provides a bare assertion, without any explanation as to why its construction is correct, and cites to Mr. William’s declaration which likewise includes a bare assertion without any explanation. Pet. 10 (citing Ex. 1003 ¶ 33). Patent Owner does not explain why we should adopt its construction, other than we should do so “for the purposes of consistency” with the district court’s construction. PO Resp. 10.

Although Petitioner does not provide any explanation, Petitioner cites to a description of a communication server that forwards data addressed from one network participant to another, “thus permitting the transmission of forced message alerts, other text and voice messages, photographs, video, E-mail, and URL data” between network participants. Pet. 10 (citing Ex. 1001, 4:1–6). Notably, the Specification does not refer to a server as a transmission means. Neither party addresses other descriptions in the Specification that refer explicitly to two types of transmission means. The Specification refers to the Internet as a transmission means: “[t]o operate on the network, obviously the PC must be on and have an active connection to the Internet or other digital *transmission means*.” Ex. 1001, 3:43–45 (emphasis added). The Specification also refers to communications protocols, such as TCP/IP, as digital *transmission means*: “[a] plurality of PCs and PDA/cell phones each having forced alert software installed providing a communication network . . . with the ability to: 1) allow an operator to create and transmit (via TCP/IP or another digital *transmission*

means) a forced voice alert.” *Id.* at 2:7–11 (emphasis added). Nor do the parties address claim 2, which depends directly from claim 1, and recites “wherein said data transmission means is TCP/IP or another communications protocol.” *Id.* at 9:40–63.

Based on our review of claim 2 and the above-noted disclosure in the Specification, we determine the corresponding structure for a “data transmission means” is “a PDA/cell phone programmed to implement transmission of a forced message alert using TCP/IP or another communications protocol, and equivalents thereof.”

We note that the district court’s claim construction order does not provide analysis as to why a server is the corresponding structure for a “data transmission means,” instead stating that the construction was agreed upon by the parties. Ex. 3001, 10. Furthermore, there is no indication in the district court’s claim construction order that the court considered the language of claim 2, or the portions of the Specification we discuss above about the network and communications protocols being *transmission means*. *Id.*

4. “*means for . . .*” (limitations 1.5 to 1.9)

a) *Introduction*

As we discussed above, we construe limitations 1.5 to 1.9 under 35 U.S.C. § 112, ¶ 6. *Supra* Sec. III.C.2. For each of limitations 1.5 to 1.9, the parties agree that the recited function is the respective recitation following the words “means for” (except for limitation 1.5, for which Petitioner asserts the function is less than the entire recitation after “means for,” discussed below). Pet. 10–12; PO Resp. 10–14. As set forth below, for each of limitations 1.5 to 1.9, we determine that the recited function is the entire recitation of the respective limitation following the words “means for.”

With regard to the functions specified in limitations 1.5–1.9, Petitioner contends that the corresponding structure is a computer configured to implement or perform the algorithm recited in the function. Pet. 10–12. As to limitations 1.5, 1.6, and 1.8, Patent Owner essentially agrees with Petitioner, except that Patent Owner asserts the structure is a PC or PDA/cell phone configured to implement or perform the algorithm. PO Resp. 10–14. For limitations 1.7 and 1.9, Patent Owner asserts the corresponding structure is a hardware display and hardware transmitter. *Id.* at 12–14.

For reasons discussed below, *infra* Sec. II.C.4.a.1, we determine the corresponding structure in limitations 1.5, 1.6, and 1.8 is a PDA/cell phone, programmed to carry out an algorithm that performs the recited function. For limitations 1.7 and 1.9, we determine that PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof, corresponds to the receiving function. *Infra* Sec. II.C.4.2.

(1) *Limitations 1.5, 1.6, and 1.8*

Limitations 1.5, 1.6, and 1.8 are computer-implemented means-plus-function limitations because the disclosed structure is a special purpose computer programmed to perform a disclosed algorithm. *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999) (explaining that for computer-implemented means-plus-function limitations, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm”). The Specification indicates that PCs and PDA/cell phones are computing devices that include special software—i.e., the forced message alert software application program—programmed to perform the functions recited in limitations 1.5, 1.6, and 1.9. Ex. 1001, 3:41–43 (“Each PC described herein

is like any other contemporary PC, except that it has the forced message alert software application program installed on it.”); *see also id.* at 3:29–31 (“Each PDA/cell phone described herein . . . can function just as any other cell phone . . . [i]n addition . . . it has the forced message alert software application program.”), 4:27, 4:36 (disclosing that the PDA/cell phone includes a CPU).

Because the disclosed structure is a special purpose computer, the Specification must disclose an algorithm for performing the claimed function. *See, e.g., Noah Systems Inc. v. Intuit Inc.*, 675 F.3d 1302, 1312 (Fed. Cir. 2012).

For the foregoing reasons, we determine that the corresponding structure for the respective functions recited in each of limitations 1.5, 1.6, and 1.8 is a PDA/cell phone programmed to carry out an algorithm. Below we identify the algorithm disclosed for performing the claimed functions. *Infra* Sec. III.C.4.a.1.a–c.

(a) (limitation 1.5) “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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone”

For limitation 1.5, Petitioner asserts that the specified function is “attach a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by a sender PDA/cell phone to a recipient PDA/cell phone.” Pet. 10 (citing Ex. 1001, 8:65–9:39 (claim 1)). Without explanation, Petitioner omits the remainder of limitation 1.5, which recites “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 PDA/cell phone.”

Petitioner does not adequately explain, nor do we discern why, the remaining language recited in element 1.5 should not be construed as part of the specified function. Patent Owner asserts the recited function includes the entire recitation following “means for” in limitation 1.5. PO Resp. 10. We agree with Patent Owner, and determine the specified function includes the entire recitation following “means for” in limitation 1.5.

For the structure corresponding to the specified function of limitation 1.5, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 7:43–63 and Figure 3A. Pet. 10. Patent Owner asserts we should adopt “the algorithm disclosed . . . at 7:8–8:36; and equivalents thereof.” PO Resp. 11.

We find that the disclosure identified by Petitioner describes the recited function because it discloses the steps of a process for sending a forced message alert, except that it does not expressly describe “attaching” the forced message alert software packet to a voice or text message. Ex. 1001, 7:43–63; Fig. 3A. However, it is implied that this step occurs because a user types a text or records a voice message, and a forced message alert is sent, *id.* at 7:43–63, and elsewhere the Specification explains that the software allows a user to create a forced message alert comprising a voice or text message and forced message alert software packet, *id.* at 2:9–13.

The district court, and Patent Owner, also identify Ex. 1001, 7:8–42 and 8:1–36 as disclosing the algorithm. PO Resp. 11; Ex. 3001, 15–18. We find the disclosure at Ex. 1001, 7:8–20 corresponds to the recited function

because it describes as part of the process that the forced message alert software packet contains a list of possible required responses (*see, e.g.*, limitation 1.5, “said forced message alert software packet containing a list of possible required responses”). We also find Ex. 1001, 8:25–30 corresponds to the recited function because it discloses transmitting an automatic acknowledgement receipt (*see, e.g.*, limitation 1.5, “requiring the forced message alert software . . . to transmit an automatic acknowledgement receipt”).

However, the district court and Patent Owner are over-inclusive in their citation to the '970 patent disclosure. The district court and Patent Owner cite to continuous blocks of text that disclose not just the algorithm corresponding to the recited function, but also features not recited in the function. We do not incorporate into our construction features that do not perform the recited function. “Section 112 paragraph 6 does not ‘permit incorporation of structure from the written description beyond that necessary to perform the claimed function.’ Structural features that do not actually perform the recited function do not constitute corresponding structure and thus do not serve as claims limitations.” *Asyst Techs*, 268 F.3d at 1369–70 (citations omitted).

We find that the features disclosed at Ex. 1001, 7:21–42, 8:1–25 and 8:31–36 are not part of the algorithm for performing the function recited in limitation 1.5. For example, Ex. 1001, 7:21–42 describes repeating a message at a defined rate until a user makes a selection from a required response list. The disclosure at Exhibit 1001, 8:1–25 and 8:31–36 describes features unrelated to the recited function including a sender PC or PDA/cell phone monitoring for manual responses, and a recipient PC or PDA/cell

phone separating a forced message alert packet from a text or voice message. None of these features are part of the function specified in limitation 1.5.

For the foregoing reasons, we determine that the corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof.

(b) (limitation 1.6) “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”

For the structure corresponding to the specified function of limitation 1.6, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 8:39–46 and Figure 4. Pet. 11. Patent Owner asserts we should adopt “the algorithm disclosed . . . at 8:37–57; and equivalents thereof.” PO Resp. 12.

We find that the disclosure identified by Petitioner, which relates to the scenario in which a text message is received, describes the applicable algorithm. The disclosure describes a 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, namely by causing a text message and response list to be shown on a recipient PC or PDA/cell phone until a manual response is selected from the response list, and clearing the forced alert text only after the user of the recipient device has selected a response. Ex. 1001, 8:39–46. We also find the disclosure at Ex. 1001, 8:46–51, which relates to receipt of voice messages, describes the applicable algorithm, as contended by Patent Owner, because the recited function also encompasses scenarios in which voice messages are received.

However, contrary to Patent Owner's assertion, we find the disclosure at Ex. 1001, 8:37–39 and 8:52–57, does not describe the algorithm for the recited function. Patent Owner does not provide any explanation to support its position, other than its argument that the district court included this disclosure in its claim construction. PO Resp. 11–12. The disclosure at Ex. 1001, 8:37–39 and 8:52–57 describes the forced voice alert software application program “effectively tak[ing] control” of the recipient device and releasing effective control of the recipient PDA/cell phone. Ex. 1001, 8:37–39, 8:52–57. However, the function specified in limitation 1.6 does not mention taking or releasing control of the PDA/cell phone. On the other hand, claim 2, which depends directly from claim 1, explicitly claims a means for taking control of the recipient PDA/cell phone. Ex. 1001, 9:46–54 (“means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing . . . the text message and a response list to be shown on the display of the recipient PDA cell phone”). Accordingly, we find the feature of taking and releasing control of the PDA/cell phone does not constitute part of the algorithm that achieves the function recited in limitation 1.6, and does not serve as a limitation on the claim. *Cf. Asyst Techs*, 268 F.3d at 1369–70 (“Structural features that do not actually perform the recited function do not constitute corresponding structure and thus do not serve as claims limitations”).

For the foregoing reasons, we determine that the corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:39–46 and the portions of Figure 4 described at 8:39–46, and equivalents thereof.

(c) (limitation 1.8) “means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert”

For the structure corresponding to the specified function of limitation 1.8, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 8:6–9 and Fig. 3A and 3B. Pet. 11–12. Patent Owner asserts we should adopt the “the algorithm disclosed . . . at 7:64–8:8; and equivalents thereof.” PO Resp. 13.

We are persuaded that Ex. 1001, 8:6–8¹¹ and the corresponding step in Figure 3B (second step) provide sufficient detail to disclose the applicable algorithm because they disclose “[t]he sender PC or PDA/cell phone will then periodically resend the forced message alert to the PC or PDA/cell phone that have not acknowledged receipt,” and “[t]he sender cell phone, integrated PDA/cell phone or PC periodically resends the message alert to the recipient cell phones, integrated PDA/cell phones or PCs that have not acknowledged receipt,” respectively. Ex. 1001, 8:6–8.

Patent Owner is over-inclusive because the disclosure at Ex. 1001, 7:64–8:5 describes features unrelated to the function recited in limitation 1.8. *Cf. Asyst Techs*, 268 F.3d at 1369–70 (“Structural features that do not actually perform the recited function do not constitute corresponding structure and thus do not serve as claims limitations”). The features relate, for example, to monitoring for and receiving acknowledgments of receipt of forced message alerts, Ex. 1001, 7:64–67,

¹¹ Petitioner includes line 9 of column 8, but this appears to be in error. Line 9 begins a new paragraph and contains only the sentence fragment, “The sender PC or PDA/cell phone also monitors for and,” which is unrelated to the recited function. Therefore, we exclude line 9 from the algorithm.

and the sender PC or PDA/cell phone providing an indication on a display of which of the recipients have and have not acknowledged receipt, Ex. 1001, 8:1–5.

For the foregoing reasons, we determine that the corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:6–8 and corresponding step in Fig. 3B (second step in Figure 3B), and equivalents thereof.

(2) Limitations 1.7 and 1.9 – (limitation 1.7) “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”; (limitation 1.9) “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 responses from each recipient PDA/cell phone that responded”

For the structure corresponding to the specified function of limitation 1.7, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 7:64–8:5 and Figures 3A and 3B. Pet. 11. For the structure corresponding to the specified function of limitation 1.9, Petitioner identifies the forced message alert software application program functionality described at Ex. 1001, 8:9–15 and Figures 3A and 3B. *Id.* at 12.

Patent Owner contends the corresponding structure is “PDA/cell phone hardware including touch screen 16, and wireless transmitter or cellular modem; and equivalents thereof.” PO Resp. 12–14.

Therefore, the dispute raised by the parties’ proposals is whether the corresponding structure is: (1) a computer configured to implement or perform an algorithm, or (2) a hardware transmitter (presumably for “receiving”) and a hardware display (presumably for “displaying”). We

adopt Patent Owner's approach, namely that the corresponding structures are a hardware display and receiver and/or transceiver. With regard to the function of displaying, the Specification discloses a hardware display of the PDA/cell phone (*see, e.g.*, Figure 1, LCD display 16) that displays an indication of which recipients have sent acknowledgements and an indication of the response from each recipient cell phone. Ex. 1001, 8:1–5, 8:12–15. As to the function of receiving, the Specification discloses that the PC and PDA/cell phone can communicate using WiFi or WiMax, both of which are wireless, and the PDA/cell phone can communicate over a wireless cellular network, thereby indicating the PC and PDA/cell phone each have a wireless receiver and/or transceiver for receiving automatic acknowledgements. Ex. 1001, 4:7–11.

Therefore, we find the corresponding structure is PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof.

We decline to adopt Patent Owner's proposal that a wireless *transmitter* performs the receiving function, because a transmitter transmits rather than receives. PO Resp. 12–14. We also decline to adopt Patent Owner's proposal that a "cellular modem" corresponds to the receiving function because Patent Owner does not identify any disclosure in the Specification of a cellular modem performing the receiving function. *Id.*

b) "forced message alert"

Claim 1 recites (Ex. 1001, 9:14–23) (emphasis added):

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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone.

Claim 6 recites (Ex. 10:7–11, 14–17) (emphasis added):

A method of sending a forced message alert to one or more recipient PDA/cell phones . . . said method comprising the steps of . . . 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.

Neither party proposes a construction for the term “forced message alert.” *See* Pet. 8–12; *see also* PO Resp. 9–14. However, in its discussion of patentability, Patent Owner argues Kubala’s email message 214 with mandatory response flag 216 (asserted “forced message alert”) is not a “forced message alert” because it is not “forced to the display without any action on the part of the recipient.” PO. Resp. 15–18; Sur-Reply 11–15. In doing so, Patent Owner seeks to write a negative limitation, i.e., forcing a message to the display *without any action on the part of the recipient*, into claims 1 and 6. In light of Patent Owner’s argument, we consider whether a “forced message alert” should be interpreted as a message that must be forced to the display without any action on the part of the recipient.

We begin with the language of the claims viewed in light of the Specification. The negative limitation Patent Owner seeks to write into claims 1 and 6 appears nowhere in the language of the claims. *See, e.g.*, Pet. Reply 4–6 (arguing limitation 1.5 does not impose the restriction asserted by Patent Owner). The claim language makes clear that a “forced message alert” is created by attaching a forced message alert software packet to a voice or text message. Ex. 1001, 9:14–15 (claim 1, “means for attaching a forced message alert software packet to a voice or text message

creating a forced message alert”) (emphasis added); *see also* Ex. 1001, 10:14–17 (claim 6, “*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”) (emphasis added). Accordingly, by the very language of the claims, a message is *forced* because it is attached to a *forced* message alert software packet. Nothing in the claim language indicates that what makes the message *forced* is forcing its display without any action on the part of the recipient.

The Specification reinforces the understanding that a forced alert is a message with a forced alert software packet attached thereto, disclosing that forced alert software provides the ability 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.” Ex. 1001, 2:7–13.

Accordingly, the claim language viewed in light of the Specification is unambiguously clear—a “forced message alert” is a message (e.g., text or voice) attached to a forced message alert software packet.

Patent Owner argues, nonetheless, that we should read its proposed negative claim limitation into the term “forced message alert” based on disclosure in the Specification that upon detection of a forced message alert, a recipient PDA/cell phone transmits an automatic acknowledgement of receipt to the sender, and after transmitting the receipt, the forced voice alert software application program effectively takes control of the recipient PDA/cell phone. PO Resp. 16 (citing Ex. 1001, 8:25–39). Patent Owner also relies on disclosure in the Specification that states “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.” PO Resp. 17 (citing Ex. 1001, 8:37–44); *see also* Sur-reply 12–14.

Patent Owner’s reliance on the cited disclosure is unavailing for several reasons. First, the disclosure cited by Patent Owner does not specify that the message alert is displayed *without any action on part of the recipient*, and does not preclude a user from first opening the message before being presented with a display of the message. Ex. 1001, 8:25–44. Patent Owner’s argument appears to be that the software’s effective taking control of the PDA/cell phone, disclosed at Ex. 1001, 8:37–39, implies a recipient can no longer perform actions that would cause a forced message alert to be displayed, thereby suggesting messages are forced to the display without any action on the part of the recipient. PO Resp. 16. However, we do not find this persuasive because the Specification does not preclude steps such as a user performing acts, e.g., opening a message, that lead to display of the forced alert message.

Second, even if we were to infer that the Specification is describing forcing the message to a display without any action by the recipient, we do not discern a reason to write such a requirement into the claims that appears nowhere in the claim language. *See SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim.”).

Review of the claims as a whole confirms that we should not read Patent Owner’s proposed requirement into the term “forced message alert.” If we were to adopt Patent Owner’s view, it would be inconsistent with Patent Owner’s, and our, interpretation above of limitation 1.5 of claim 1.

As we discussed above, we construe limitation 1.5 as reciting means-plus-function, and we determine the structure corresponding to the specified function is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof. *Supra* Sec. II.C.4.a.1.a; *see also* PO Resp. 10–11 (Patent Owner submitting this limitation should be construed as a means-plus-function term). Therefore, if we were to read into limitation 1.5 a requirement of forcing a forced message alert to a display without any action on part of the recipient, there would need to be supporting disclosure in the Specification of an algorithm for performing this function. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1312 (Fed. Cir. 2012) (citing *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1238, 1333) (Fed. Cir. 2008)). However, as we discussed above, the Specification does not disclose an algorithm sufficient to perform the negative limitation proposed by Patent Owner, i.e., forcing a message to the display without any action on part of the user.

We note the algorithm we identify for limitation 1.5, *supra* Sec. II.C.4.a.1.a, does not disclose forcing a forced message alert to a display without any action on part of the recipient. Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, Fig. 3A. Furthermore, there is no such requirement even under Patent Owner's proposed construction because not even Patent Owner's proposed algorithm discloses forcing a forced message alert to a display without any action on part of the recipient. PO Resp. 11 (asserting the algorithm is disclosed at Ex. 1001, 7:8–8:36); *see also* Pet. Reply 4–6.

For the foregoing reasons, we conclude that a “forced message alert” should not be interpreted as a message that must be forced to the display without any action on the part of the recipient.

5. *Summary*

Our constructions for limitations 1.2 and 1.5 to 1.9 are summarized below:

Limitation	Specified Function	Corresponding Structure
1.2	facilitate the transmission of electronic files between said PDA/cell phones in different locations	a PDA/cell phone programmed to implement transmission of a forced message alert using TCP/IP or another communications protocol, and equivalents thereof
1.5	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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone	PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof
1.6	requiring a required manual response from the response list by the recipient in order to clear the recipient's response list from recipient's cell phone display	PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:39–46 and the portions of Figure 4 described at 8:39–46, and equivalents thereof
1.7	receiving and displaying a	PDA/cell phone hardware

Limitation	Specified Function	Corresponding Structure
	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	including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof
1.8	periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert	PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:6–8 and corresponding step in Fig. 3B (second step in Figure 3B), and equivalents thereof
1.9	receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the responses from each recipient PDA/cell phone that responded	PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof

D. Asserted Obviousness Over Kubala and Hammond

As noted above, Petitioner asserts claims 1 and 3–9 of the '970 patent would have been obvious over the combination of Kubala and Hammond. Pet. 12; Pet. Reply 2–15. Patent Owner contends Petitioner has not shown unpatentability of claims 1 and 3–9 on this ground. PO Resp. 14–28; Sur-reply 7–15. For the reasons stated below, we determine Petitioner has demonstrated, by a preponderance of the evidence, that claims 1 and 3–9 are unpatentable under § 103 as obvious over the combination of Kubala with Hammond.

1. Kubala (Ex. 1005)

Kubala generally discloses a method, system, apparatus, or computer program product for processing electronic messages. Ex. 1005 ¶ 9. Kubala explains that employee productivity may suffer demonstrably in proportion to the number of email messages the employee receives. *Id.* ¶ 5. This is due in part to the high volume of emails an employee may receive, because the task of responding to emails messages consumes an increasingly larger portion of the employee's workday. *Id.* To address these issues, Kubala states that "it would be advantageous to provide productivity enhancing features within e-mail applications for the handling of email messages so that important messages receive the appropriate attention from the recipient of an e-mail message." *Id.* ¶ 8.

Kubala specifically discloses computing devices such as network-enabled phones and PDAs that directly transfer data between each other across wireless links. *Id.* ¶ 27. The devices include email application software that facilitates email communication between devices, wherein the email software 206 includes enhanced functionality. *Id.* ¶ 35. One of the enhanced features is mandatory response functional unit 210 that operates to request that an outgoing email message be flagged as requiring a mandatory response from the email recipient. *Id.* Enhanced email application 206 relies on functional unit 210 to either assist in generation of the outgoing email message or perform the modifications necessary to flag the outgoing message as requiring a mandatory response. *Id.* Kubala discloses, for example, that email message 214 may contain mandatory response flag 216 indicating to the enhanced email application on the recipient computing device that email message 214 should be handled as an important message

requiring a mandatory response. *Id.* Kubala discloses that mandatory response flag 216 may be implemented in a variety of data formats. *Id.*

2. *Hammond (Ex. 1006)*

Hammond generally discloses a system for enhancing the reliability of communicating with electronic messages. Ex. 1006, code (57). Hammond explains that electronically communicated messages such as email, paging messages, and voice mail have become increasingly pervasive. *Id.* at 1:13–15. According to Hammond, although initial distribution of electronic messages by a sender is quick and convenient, ensuring that a message is received and reviewed by a recipient within a certain timeframe can be inconvenient. *Id.* at 1:21–26. Hammond addresses these issues by disclosing a system that sends an electronic message to designated recipients, and automatically helps ensure that each message has been received and reviewed by the recipient. *Id.* at 2:1–5. If receipt is not confirmed within a certain specified timeframe, the system can automatically resend the electronic message or take other appropriate action. *Id.* at 2:5–8.

In one embodiment, the disclosed system includes a Message Review Server (“MRS”) that sends electronic messages to designated recipients, and automatically helps ensure that each message has been received and reviewed. *Id.* at 3:1–5. The MRS also allows the sender of an electronic message to specify message delivery information that specifies actions to take when a message is not delivered within a specified timeframe. *Id.* at 3:12–15. For example, the sender can specify that if receipt notification is not received within a specified time period, the message will be resent to the recipient. *Id.* at 3:15–18. Message delivery information can also specify

frequency or duration options, such as an option to resend a message every two hours. *Id.* at 3:18–22.

In one embodiment, Kubala discloses that use of the MRS system begins when a sender of an electronic message supplies a message to a Message Sender component. Ex. 1006, 4:48–51. The sender supplies the message, identifies one or more recipients for the message, and specifies various optional message tracking information (e.g., message delivery information, message review information, and message post-review information). *Id.* at 4:51–56. A sender also can supply delivery information such as a resend period of time and can optionally supply other resend options. *Id.* at 4:56–60. The system also includes a Message Receipt Tracker component that attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients. *Id.* at 5:17–20

3. *Claim 1*

Petitioner relies on Kubala as teaching the subject matter of claim 1, but asserts that to the extent Patent Owner argues Kubala does not teach limitations 1.7 to 1.9, Hammond provides the missing disclosure. Pet. 23–40.

Patent Owner argues: (1) Kubala and Hammond do not disclose a “forced message alert” (PO Resp. 14–18), as recited in limitation 1.5, (2) 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,” as recited in limitation 1.6 (PO Resp. 18–22), (3) Kubala and Hammond do not 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,” as recited in limitation 1.7 (PO Resp. 22–27), and (4) Kubala and Hammond do not disclose “displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the responses from each recipient PDA/cell phone that responded,” as recited in limitation 1.9 (PO Resp. 27–28).

Upon review of the record, we determine Petitioner has shown, by a preponderance of the evidence, that claim 1 is unpatentable as obvious over the combination of Kubala with Hammond.

a) Preamble and Limitations 1.1–1.4 and 1.8

Petitioner sets forth where Kubala teaches the preamble and each of limitations 1.1–1.4, and where Kubala, alone or in combination with Hammond, teaches limitation 1.8. Pet. 23–27, 35–37. Petitioner also articulates a rationale to combine Kubala with Hammond. *See, e.g., id.* at 21–23; *see also id.* at 20 (“Like Kubala, Hammond discloses methods and systems for enhancing reliability of electronic messaging”). Patent Owner does not provide argument in the Response contesting Petitioner’s assertions regarding the preamble and limitations 1.1–1.4 and 1.8.¹²

¹² In the Sur-reply, Patent Owner asserts for the first time that its arguments in the Response regarding limitation 1.5’s recitation of “a forced message alert,” PO Resp. 14–18, applies to other claim limitations that recite either “a forced message alert software application program” or “forced message alert,” Sur-reply 7–10. We address Patent Owner’s arguments regarding the phrase “forced message alert” in our discussion of limitation 1.5, *infra* Sec. III.D.3.b.1.

(1) (preamble) “[a] communication system for transmitting, receiving, confirming receipt, and responding to an electronic message”

Petitioner persuasively argues Kubala teaches the preamble of claim 1, because Kubala relates to sending and receiving e-mail messages (e.g., communication system for transmitting and receiving an electronic message) and teaches confirming receipt and responding to an electronic message, disclosing “that it was known 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 email message, thereby providing an acknowledgement that a particular message has been received and/or opened.’” Pet. 23 (citing Ex. 1005 ¶ 6).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to the preamble of claim 1.

(2) (limitation 1.1) “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”

Petitioner persuasively argues Kubala teaches limitation 1.1 because Kubala shows, in Figure 1A, a plurality of PDAs 107 and 112 connected through wireless link 116, and connected through network 101 through various other links shown in Figure 1A, that form a predetermined network. Pet. 24. Kubala further discloses that each PDA includes at least one CPU 22, a memory 124, 126, and a user interface adapter 148 that can be coupled to a touch-screen display, as can be seen in Figure 1B. *Id.* at 24–25 (citing Ex. 1005 ¶¶ 26, 27, 29–30, Fig. 1A, Fig. 1B; Ex. 1003 ¶¶ 92–93).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.1.

(3) (limitation 1.2) “a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations”

Petitioner argues, based on its construction of “data transmission means,” that the structure corresponding to the function specified in limitation 1.2 is a server that communicates according to certain enumerated messaging protocols. Pet. 10. However, as we discussed above, we disagree with Petitioner’s construction and determine that the pertinent corresponding structure is “a PDA/cell phone programmed to implement transmission of a forced message alert using TCP/IP or another communications protocol, and equivalents thereof.” *Supra* Sec. II.C.3. Although Petitioner’s proposed construction differs from ours, Petitioner nonetheless sets forth a sufficient showing for this limitation. Petitioner argues that the server in Kubala communicates according to, inter alia, peer-to-peer communications (e.g., WiFi or WiMax) or other messaging protocols (e.g., SMS or TCP/IP). Pet. 25. In particular, Petitioner argues that the asserted PDA/cell phones in Kubala communicate with one another using, for example, “Transport Control Protocol/Internet Protocol (TCP/IP)” or WiFi technology (IEEE 802.11), *id.* (citing Ex. 1006 ¶ 27, Fig. 1A), both of which teach or suggest a PDA/cell phone implementing transmission of a forced message alert using a communications protocol, such as TCP/IP.¹³

¹³ The outcome of this Final Decision would not be affected had we adopted the district court’s construction. Petitioner shows, and Patent Owner does not dispute, that the asserted prior art teaches a communications network server. Pet. 25 (“In Kubala, a server supports a network 109 and a client 110, allowing the PDAs/cell phones to (1) ‘communicate with one another’ using, for example, ‘Transport Control Protocol/Internet Protocol (TCP/IP)’ or (2) ‘directly transfer data between themselves’ using, for example, ‘Bluetooth™ wireless technology or WiFi technology (IEEE 802.11).’

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.2.

(4) (limitation 1.3) “a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message” (limitation 1.3)

Petitioner persuasively argues Kubala teaches limitation 1.3, because Kubala discloses a plurality of PDAs that communicate with each other, wherein one PDA (i.e., the sender PDA) sends an electronic message to another PDA (i.e., the recipient PDA). Pet. 26 (citing Ex. 1006 ¶¶ 27, 32, 33, Fig. 1A; Ex. 1003 ¶ 95).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.3.

(5) (limitation 1.4) “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”

Petitioner persuasively argues Kubala teaches limitation 1.4, because Kubala discloses an enhanced email application (asserted forced message alert software application program) that includes mandatory-response functional unit 212 that sends email messages, and embedding in a sender email message a menu of possible responses 1120 to the sender’s message (asserted list of required possible responses to be selected by a recipient), as shown in Figure 11C. Pet. 26–27 (citing Ex. 1005 ¶¶ 13, 22, 33, 35, 36, 47, 54, 55, 57, 60, Fig. 2, Fig. 11C; Ex. 1003 ¶¶ 96–98).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.4.

(Kubala, ¶0027, FIG. 1A.) Kubala therefore expressly discloses this limitation. (See Williams, ¶94.)”; *see generally* PO Resp.

(6) (limitation 1.8) “means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert”

Petitioner has not shown Kubala alone teaches limitation 1.8; however, Petitioner argues persuasively that Kubala combined with Hammond teaches this limitation. Petitioner relies on Kubala’s description with reference to Figure 10 of resending an email message that has a mandatory-response flag (i.e, the asserted forced message alert) if a reply to the email message has not been made. Pet. 35–36 (citing Ex. 1005 ¶ 53, Fig. 10). With reference to Figure 10, Kubala appears to disclose neither (1) the reply to the e-mail message is an *automatic* acknowledgement of receipt rather than, for example, a manual response, nor (2) the e-mail message is sent *periodically*. Ex. 1005 ¶ 53, Fig. 10. Petitioner does not explain how Kubala’s disclosure teaches *automatic* acknowledgement that is sent *periodically*. Pet. 35–36.

However, Petitioner contends that to the extent Kubala does not teach limitation 1.8, Hammond provides the missing disclosure, and a skilled artisan would have been motivated to combine Kubala with Hammond. Pet. 36–37 (citing Ex. 1006, Abstract, 2:1–8, 4:21–28, 5:5–6:19, 6:66–7:63, Fig. 2, Fig. 3A, Fig. 3B, Fig. 4, Fig. 5A, Fig. 5B; Ex. 1003 ¶¶ 117–118). We are persuaded Hammond provides the missing disclosure because Hammond teaches a recipient “[provid[ing] receipts when messages are received,” Ex. 1006, 5:20–23, and resending messages periodically (every specified Resend Time period) until the recipient sends a receipt of delivery notification, Ex. 1006, 7:7–13 (setting Resend Times to 1 hour or 2 hours), 7:14–17 (explaining that when a message is received by recipient in less than the specified Resend Time, the message is not resent). Hammond also

explains the benefit of periodically resending messages for which a return receipt has not been received, namely to help ensure that each message has been successfully delivered. Ex. 1006, 2:1–10.

Petitioner also provides a rationale to combine Hammond with Kubala, arguing that a skilled artisan would have been motivated to combine these references because both are directed to tracking responses to mandatory-response messages, and both disclose use of acknowledgement receipts. Pet. 36–37 (citing the discussion regarding limitation 1.7 at Pet. 34–35 and Ex. 1003 ¶¶ 117–118). We find Petitioner’s arguments persuasive. We find that both Hammond and Kubala relate to enhancing communication that involves electronic messages such as email, both are directed to the same field of endeavor, and both address the same problem—i.e., to ensure that important email messages receive timely responses. Pet. 20–22; Ex. 1005, code (57); Ex. 1006, code (57). Moreover, as Petitioner points out, Kubala already discloses the use of automatic acknowledgement receipts (although not in connection with Figure 10), explaining that such was well known in the art. *Id.* at 30 (citing Ex. 1005 ¶ 6). Hammond further confirms that use of return receipts was well known in the art, *see, e.g.*, Ex. 1006, 1:21–26, 2:1–10, and confirms Mr. Williams’ assertion that due to uncertainty as to whether an e-mail message was received, return receipts provided a well-known benefit, Ex. 1003 ¶ 103.

Accordingly, we are persuaded that “implementing Hammond’s tracking features in Kubala’s system would have been an obvious design choice,” and “represents no more than ‘the predictable use of prior art elements according to their established functions.’” Pet. 22–23. Moreover, we are persuaded that “[b]ecause Hammond merely discloses details about tracking features that are already suggested by Kubala’s system that collects

and records information about the recipients response to a message, this combination of Kubala and Hammond would not ‘result in a difference in function or give unexpected results.’” *Id.* (citing *In re Rice*, 341 F.2d 309, 314 (CCPA 1965)).

Therefore, we are persuaded a skilled artisan would have been motivated to modify Kubala to periodically resend messages for which a return receipt has not been received to help ensure that each message has been successfully delivered, as taught by Hammond.

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.8

b) Limitations 1.5–1.7 and 1.9

Petitioner sets forth where Kubala teaches each of limitations 1.5 and 1.6, and where Kubala, alone or in combination with Hammond, teaches limitations 1.7 and 1.9. Pet. 28–35, 37–40. Petitioner also articulates a rationale to combine Kubala with Hammond. *See, e.g., id.* at 20–23. As noted above, Patent Owner disputes Petitioner’s assertions regarding limitations 1.5–1.7 and 1.9. PO Resp. 14–28; Sur-reply 7–15.

(1) (limitation 1.5) “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”

As we determined in our claim construction, limitation 1.5 is construed as means-plus-function under § 112, ¶ 6. *Supra* Sec. II.C.2. The function is the entire recitation of limitation 1.5 following the words “means for.” *Supra* Sec. II.C.4.a.1.a. The corresponding structure is a PDA/cell

phone programmed to carry out the algorithm disclosed at Ex. 1001, 2:11–13, 7:8–20, 7:43–63, 8:25–30, and Fig. 3A, and equivalents thereof. *Supra* Sec. III.C.4.a.1.a.

Petitioner persuasively argues that the corresponding structure in Kubala is, e.g., computing device 202, which may be a PDA, with enhanced email application 206 installed on it. Pet. 28 (citing Ex. 1005 ¶¶ 33–36; Ex. 1003 ¶ 99).

Petitioner also persuasively argues that Kubala’s enhanced email application software performs the functions specified in limitation 1.5. *Id.* at 28–30. In particular, Petitioner shows Kubala teaches a voice or text message, based on Kubala’s disclosure that message 214—i.e., the message transmitted from the asserted PDA/cell phone to the asserted recipient PDA/cell phone—may be a text message, audio message, video message, or other type of message. *Id.* at 29 (citing Ex. 1005 ¶ 32).

Petitioner also shows Kubala teaches a forced message alert software packet, based on Kubala’s mandatory response flag 216 that indicates to the enhanced email application on the recipient computing device that email message 214 should be handled as an important message requiring a mandatory response. *Id.* at 28–29 (citing Ex. 1005 ¶¶ 35–41, 54–61, Fig. 3, Fig. 4; Ex. 1003 ¶ 100).

Furthermore, Petitioner shows Kubala teaches attaching a forced message alert software packet to a voice or text message, because Kubala discloses that the mandatory response flag 214 is attached to email message 214, and “may be implemented in a variety of data formats.” *Id.* at 28–29 (quoting Ex. 1005 ¶ 35 and citing *id.* ¶¶ 36, 41, 54–61).

Petitioner also shows Kubala teaches “a list of possible required responses,” based on menu 1120 displayed on the recipient device, which is

shown in the exemplary embodiment in Figure 11C to include as responses, “too busy right now,” “looks okay,” and “request declined.” *Id.* at 29 (citing Ex. 1005 ¶¶ 22, 47, 57, Fig. 11C). We are persuaded that Kubala teaches or suggests attaching the asserted list of possible responses, e.g., text strings such as “too busy right now” that are used as menu items, to the asserted forced message alert software packet, i.e., flag 216, based on Kubala’s disclosure that the responses may be “extracted from the original e-mail message that was received from the sender.” *Id.* (quoting Ex. 1005 ¶ 57, and citing *id.* ¶¶ 40–41).

Petitioner shows, furthermore, that Kubala teaches “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 PDA/cell phone,” based on Kubala’s disclosure that it was known in the art to transmit automatic acknowledgements to a sender of a voice or text message:

Kubala discloses that it was known “to generate return receipts to the sender when the sender’s email 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.”

Pet. 30 (quoting Ex. 1005 ¶ 6). Mr. Williams agrees that the need for acknowledgement of email messages was well understood. Ex. 1003 ¶ 102–103. He explains that at the time, email systems were not completely reliable, and there was uncertainty as to whether, and if, an email message would “get through” to a recipient. *Id.* He states that it would have been obvious, therefore, to include a return receipt to provide the sender with confirmation that the email message has been received by the recipient so the sender would not have “to worry about whether a message was received

or not.” *Id.* We credit Mr. Williams testimony, in light of Kubala’s disclosure that use of return receipts was well known in order to provide a sender with confirmation that a message had been received. Ex. 1005 ¶ 6.

For the foregoing reasons, Petitioner has shown that Kubala teaches or suggests the subject matter of limitation 1.5.

Patent Owner contends Petitioner has not shown that Kubala, alone or in combination with Hammond, teaches or suggests a “forced message alert,” arguing the e-mail messages with attached flag 216 (asserted forced message alerts) in Kubala are not *forced*. PO Resp. 14–18; Sur-reply 11–15. To arrive at this conclusion, Patent Owner asserts that a *forced* message is one in which the message is “forced to the display without any action on the part of the recipient.” *Id.* at 15. According to Patent Owner, Kubala does not satisfy this requirement because a user of a recipient PDA/cell phone in Kubala must manually open a received e-mail message. *Id.* at 15. For the reasons discussed in our claim construction, we reject Patent Owner’s contention that a “forced message alert” must be “forced to the display without any action on the part of the recipient.” *Supra* Sec. II.C.4.a.1.a.

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.5.

(2) (limitation 1.6) “*means for requiring a required manual response from the response list by the recipient in order to clear the recipient’s response list from recipient’s cell phone display*”

As we determined in our claim construction, limitation 1.6 is construed as means-plus-function under § 112, ¶ 6. *Supra* Sec. II.C.2. The function is the entire recitation of limitation 1.6 following the words “means for.” *Supra* Sec. II.C.4.a. The corresponding structure is a PDA/cell phone programmed to carry out the algorithm disclosed at Ex. 1001, 8:39–46 and

the portions of Figure 4 described at 8:39–46, and equivalents thereof.

Supra Sec. III.C.4.a.1.b.

Petitioner persuasively argues that the corresponding structure in Kubala is, e.g., computing device 202, which may be a PDA, with enhanced email application 206 installed on it. Pet. 30–31 (citing Ex. 1005 ¶¶ 33–36, Fig. 2; Ex. 1003 ¶ 106).

Petitioner also persuasively argues that Kubala’s enhanced email application software performs the functions specified in limitation 1.6. *Id.* at 30–32.

Petitioner persuasively argues Figure 11C of Kubala teaches the specified function of requiring a manual response by the recipient from the response list in order to clear the response list from the recipient’s cell phone display. Petitioner relies on disclosure that menu 1120 includes a list of possible responses from which a recipient can choose, and argues that this list is a “response list” as recited in limitation 1.6. *Id.* at 31. We find Petitioner’s argument persuasive in light of Figure 11C, reproduced below, and Figure 11A.

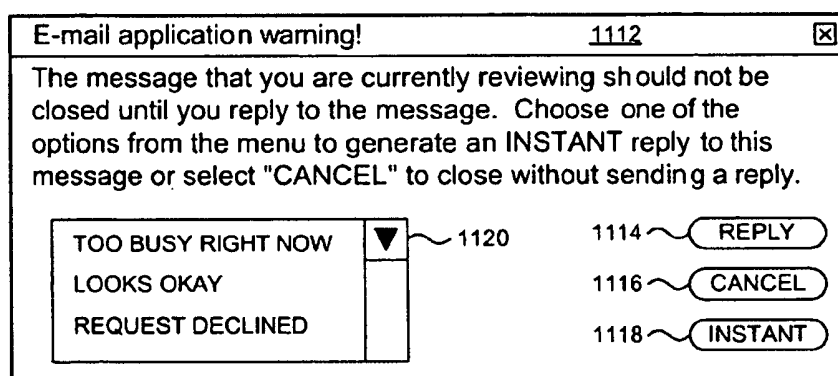


FIG. 11C

“Fig. 11C showing GUI display window 112”

Ex. 1005, Fig. 11C. Figure 11C illustrates GUI display window 1112 that is displayed on a recipient device if a user attempts to close an email without

replying to it. *Id.* ¶ 57. Window 1112 contains an error message informing the recipient that a reply is needed before closing the email. Window 1112 also includes menu 1120 comprising a list of responses from which a recipient can select a response to provide to the sender (e.g., a response list). *Id.* Although window 1112 also includes CANCEL button 1116, that allows a user to close an email message without selecting and sending a response message to the sender, Kubala also teaches explicitly that a user of a recipient PDA/cell phone can be prevented from closing, exiting, or deleting the e-mail message until the recipient has responded to the message. Pet. 31–32 (citing Ex. 1005 ¶¶ 9, 55). This is shown in Figure 11A, where the error message in window 1102 states the message cannot be closed until the user replies to the message. Ex. 1005, Figure 11A (“[t]he message that you are currently viewing cannot be closed until you reply to the message”); *id.* Fig. 11C. The description of Figure 11A explains the message in window 1102 may be displayed in “a strict process in which a user is not permitted to perform another action with respect to a message that contains a mandatory response flag unless the user first responds or replies to the message, thereby fulfilling the request of the sender of the message that the user must respond to the message.” Ex. 1005 ¶ 55. The Summary of the Invention in Kubala also describes this strict process, in which “actions are *required* by the recipient with respect to usage of a data processing system until the recipient uses the data processing system to send a response for the received electronic message to the sender.” *Id.* ¶ 9 (emphasis added). Kubala explains, “the recipient can be prevented from closing a review of the received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received email message.” *Id.*

We are persuaded a skilled artisan viewing Kubala's disclosure of (1) a response list from which a user selects a response, and (2) a feature preventing a user from exiting or deleting an e-mail or exiting the application until a response is sent, would have been motivated to combine these features, because the Summary of Invention of Kubala just discussed describes using a strict process requiring a recipient to respond and preventing a recipient from closing/deleting an e-mail or exiting the e-mail application until the recipient responds as the invention. *Id.* Moreover, Kubala explicitly teaches that the features of Figures 11A through 11D can be combined in different ways, *see, e.g.*, Pet. 19–20, 31–32, Pet. Reply 10:

FIGS. 11A-11D may be used in different scenarios depending upon the manner in which the enhanced e-mail application is implemented or configured to handle an e-mail message that contains a mandatory response flag. Other scenarios could be handled in different ways that are not illustrated within FIGS. 11A-11D, and these different processes would also be considered as embodiments of the present invention because each different process would represent a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.

Ex. 1005 ¶ 54. This teaching provides further persuasive evidence that a skilled artisan would have been motivated to combine the feature in Figure 11A of window 1102 stating the message cannot be closed until the user replies to the message, with a response list (e.g., menu 1120) as shown in Figure 11C.

For the foregoing reasons, we find based on Kubala's teachings it would have been obvious to have a window that displays a response list that cannot be cleared until the user replies.

Patent Owner submits 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 the recipient's cell phone display. PO Resp. 18–20. Patent Owner erroneously states that “Petitioner elects a single embodiment that corresponds to Figure 11C.” *Id.* at 18. This argument is unavailing because, as we discussed above, Petitioner does not rely solely on Figure 11C as teaching limitation 1.6. Pet. 30–32; Pet. Reply 10. Patent Owner, a few pages later, contradicts its earlier argument that Petitioner relies solely on Figure 11C, acknowledging that Petitioner relies on disclosures in Kubala in addition to Figure 11C. PO Resp. 20 (citing Pet. 31) (asserting Petitioner “acknowledges this missing element [from Figure 11C] and alleges generally that other embodiments disclose preventing the recipient from closing a review of the received e-mail message, from deleting the e-mail message, and from exiting the e-mail application until the recipient has responded to the message.”). Patent Owner argues the Petition is deficient, nonetheless, on grounds that the Petition presents no obviousness analysis or motivation to combine the distinct embodiments in Kubala. *Id.* at 20–21. However, as argued by Petitioner and discussed above, Kubala itself teaches that the scenarios shown in Figures 11A through 11D can be combined in different ways. Pet. Reply 10–11; Ex. 1005 ¶ 54. Petitioner explains “Kubala explicitly provide[s] the motivation to combine,” citing to numerous disclosures in Kubala describing, for example, combining Figures 11A–11D, and describing preventing closing review of a received e-mail message and exiting the e-mail application until the recipient has responded. Pet. Reply 10–11 (citing Ex. 1005 ¶¶ 9, 54, 55, 59–60).

As we discussed above, we agree with Petitioner that Kubala teaches combining features, because it explicitly teaches combining features such as those shown in Figures 11A–11D and described in paragraph 9, and because Kubala teaches “strict” scenarios in which a user is not permitted to perform another action with respect to a message unless the user first responds to the message. *See, e.g.*, Ex. 1005 ¶¶ 9, 54, 55, 59–60. We find these explicit teachings provide sufficient rationale to combine a response list from which a user selects a response with a feature preventing a user from exiting or deleting an e-mail or exiting the application until a response is sent.

Patent Owner also asserts that even if the Board accepts that Figures 11A through 11D can be combined, Petitioner fails to show how the combination discloses a response list because “these embodiments lack menu 1120 [e.g., a response list].” PO Resp. 22. Patent Owner does not explain this single sentence assertion. This assertion is incorrect, because Figure 11C includes menu 1120. Moreover, in the very next sentence, Patent Owner acknowledges the embodiments upon which Petitioner relies include a response list. *Id.*

Finally, Patent Owner asserts that “the additional embodiments” cited by Petitioner pertain to clearing the *received message* from the display, rather than clearing the *response list* from the display. *Id.* This argument, too, is unavailing because the response list is part of the received message, and therefore would be cleared from the display when the message is closed. *See, e.g.*, Fig. 11C (showing menu 1120 is part of the message being viewed by the recipient); *see also* Pet. Reply 11–12 (explaining that neither the Petition, Kubala’s teachings, nor Mr. Williams’ testimony are limited to clearing a received message from the display).

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.6.

(a) New Argument

We note that during the oral hearing, Patent Owner attempted to introduce a new argument regarding limitation 1.6 found nowhere in the Patent Owner Response or Sur-reply. Patent Owner argued for the first time that Petitioner failed to demonstrate that the prior art teaches “taking control” of a PDA until a response is made, then releasing control of the PDA. *See, e.g.*, Tr. 27:23–28:6. Patent Owner explained that to show unpatentability the art must teach “taking control,” arguing that the algorithm for performing the function recited in limitation 1.6 requires “taking control of the device until a response is made, and then releasing control of the device.” *See, e.g.*, Tr. 28:4–6; 28:25–30.

Parties are not permitted to present new evidence or arguments during the oral hearing. 37 C.F.R. § 42.70 (a) (“A party may request oral argument on *an issue raised in a paper* at a time set by the Board”) (emphasis added); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 12, 2012) (“A party may rely upon evidence that has been previously submitted in the proceeding and may only present arguments relied upon in the papers previously submitted. No new evidence or arguments may be presented at the oral argument.”).

In an attempt to pass the new argument as previously submitted, Patent Owner’s counsel indicated for the first time its interpretation of the construction proposed in the Petition and adopted in the Board’s preliminary construction in the Institution Decision as requiring taking and releasing control of a PDA. Tr. 29:12–30:10. Specifically, at the hearing Patent Owner expressed for the first time that because we identified Figure 4 as

providing disclosure of the algorithm corresponding to the function specified in limitation 1.6, we intended to include every feature shown in Figure 4 including taking and releasing control of a PDA. *Id.*

Patent Owner's argument strains credibility. In the Institution Decision, we identified written description of algorithms by column and line numbers, and to the extent we identified Figures, it is evident that we intended to include only the portion[s] of the Figures described in the identified column and line numbers. Inst. Dec. 13–16. For limitation 1.6, our intent to include in the algorithm only certain steps shown in Figure 4 is clear. *Id.* at 14. We did not identify the Specification's entire description of Figure 4, but rather identified only the column and line numbers we considered to disclose the algorithm, which excluded the explicit disclosure of taking and releasing control. Specifically, we identified Ex. 1001, 8:39–46. *Id.* Had we intended to include description of taking and releasing control of the PDA, we would have also identified the disclosure at Ex. 1001, 8:37–39 and 8:52–57, which explicitly mentions taking and releasing control of the PDA.

Our intent to include in the algorithm only portions of Figures that correspond to descriptions in the Specification that we explicitly identified by column and line numbers is also evident in view of our construction of other limitations. For example, for limitation 1.7, we identified Figures 3A and 3B, Inst. Dec. 15, even though certain steps in the Figures clearly relate not to limitation 1.7, but to other limitations. *See, e.g.,* Ex. 1001, Fig. 3A, Fig. 3B. For example, the second step of Figure 3B describes periodically resending message alerts, which clearly pertains to limitation 1.8 (reciting means for periodically resending said forced message alert), and the third step in Figure 3B describes receiving and displaying an indication of

responses (rather than *automatic acknowledgements* as recited in limitation 1.7), which clearly pertains to limitation 1.9. *Id.* Fig. 3B. Accordingly, for limitation 1.7 we identified the column and line numbers corresponding to the first step of Figure 3B, Ex. 1001, 7:64–8:5, which describes the function recited in limitation 1.7 (i.e., receiving and displaying automatic acknowledgements); however, we did not identify the column and lines numbers describing the second and third steps of Figure 3B, i.e., Ex. 1001, 8:6–15, describing the functions recited in limitations 1.8 and 1.9. Inst. Dec. 15. Therefore, we identified algorithms by column and line numbers, and to the extent we identified Figures, it is evident that we intended to include only the portion[s] of the Figures corresponding to the identified column and line numbers.

Even if we were to credit Patent Owner's assertion at the hearing as to its understanding of our preliminary construction, this does not address the fact that Patent Owner neither expressed its understanding nor argued Kubala does not teach taking and releasing control of a PDA, prior to the hearing. *See generally* PO Resp.; *see generally* Sur-reply. In the Response, Patent Owner's proposed construction for limitation 1.6 identified the disclosure at Ex. 1001, 8:37–57 as disclosing the algorithm. PO Resp. 12. Notably, Patent Owner included lines not included in our preliminary construction, namely Ex. 1001, 8:37–39 and 8:52–57 describing taking and releasing control. *Id.* However, Patent Owner did not express an understanding that our preliminary construction is consistent with requiring taking and releasing control. *Id.* at 11–12. Patent Owner did not argue that taking and releasing control of a PDA is a requirement of limitation 1.6, much less explain why it should be a requirement. *Id.* Indeed, Patent Owner's only commentary and argument concerning construction of this

limitation was that we should adopt the construction adopted in district court. *Id.* Patent Owner's failure to argue that taking and releasing control should be written into limitation 1.6, coupled with the lack of any argument by Patent Owner that Kubala fails to teach taking and releasing control, *see generally* PO Resp. and Sur-reply, left Petitioner and the Board entirely in the dark as to Patent Owner's positions until the oral hearing, thereby depriving Petitioner the opportunity to develop a response.

For the foregoing reasons, we do not consider Patent Owner's untimely arguments in rendering our Final Decision. However, had we considered Patent Owner's new arguments made at the hearing, it would not have affected the outcome of this Final Decision.

The claim construction adopted in this Final Decision renders moot Patent Owner's new argument. As we discussed above, Patent Owner's argument assumes the construction of limitation 1.6 includes, as part of the algorithm, the discussion in the Specification of taking and releasing control of a PDA. However, our construction does not include such description as part of the algorithm. As we clarified above, *supra* Sec. II.C.4.a.1.b, we do not adopt Patent Owner's proposed construction of limitation 1.6. Namely, unlike in Patent Owner's proposal, we do not include in the algorithm the description of taking and releasing control at Ex. 1001, 8:37–39, 8:52–57, and portions of Figure 4 not described at 8:39–51. We do not read into limitation 1.6 a requirement of taking control of a PDA/cell phone—a requirement that is not expressly stated in claim 1, *supra* Sec. II.C.4.a.1.b.

Our interpretation is consistent with the '970 patent disclosure taken as a whole. Claim 2, which depends directly from claim 1, explicitly recites means for controlling a PDA/cell phone, supporting our determination that claim 1 does not require taking control of a PDA/cell phone. Ex. 1001,

9:46–54, Claim 2 (“means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display”).

Even if we were to agree with Patent Owner that claim 1 requires taking control of a PDA/cell phone, this would not alter the outcome of our Final Decision. In light of the claim language and Specification, we would interpret the forced message alert software application program “effectively tak[ing] control” of a PDA/cell phone to mean that the application program does not allow a recipient to clear a text message and response list or stop a voice message from repeating until the recipient selects a response, because this is the only written description associated with taking control of a PDA/cell phone. *Id.*; *see also id.* at 8:52–57 (explaining that when the recipient selects a response, the application program “releases control” of the recipient device, clearing the display and stopping repeating the voice message). The Specification offers no support for a broader interpretation of taking control of a PDA/cell phone.

Under the hypothetical interpretation in the preceding paragraph, we would find Petitioner has made a persuasive showing because, as we discussed above, Petitioner has shown Kubala teaches 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. We note that a finding that Kubala teaches e-mail application 206 taking control of a PDA/cell phone would be further supported by Kubala’s disclosure that “the

user must reply to the received e-mail in some manner *before the e-mail application will allow the user to perform some other action.*” Ex. 1005 ¶ 53 (emphasis added).

We note that at the hearing, when asked if how the algorithm takes control of a PDA is limited to the description in the Specification, Patent Owner took the untenable position that taking control includes physically grabbing someone’s PDA out of their hands:

JUDGE TROCK: It [the algorithm] explains how it takes control. It’s very limited in how it takes control; is it not?

MR RUBINO: No Your Honor. It says –

JUDGE TROCK: It doesn’t say it grabs the cell phone out of the recipient’s hand, does it?

MR. RUBINO: It does, Your Honor.

Tr. 30:14–20; *see also* Tr. 34:17–35:14. When asked why a skilled artisan wouldn’t have understood “taking control” to be limited to the only written description in the Specification of what happens when the application program effectively takes control of a PDA (i.e., Ex. 1001, 8:39–51 and corresponding portion of Figure 4), Patent Owner responded that “taking control” must mean more because Figure 4 states “the forced voice alert software takes control of the recipient’s cell phone . . . *and* causes” display of the text message or repeating the voice message until a response is sent—the “and” indicating taking control must mean something other than displaying the text message or repeating the voice message until a response is sent, according to Patent Owner. Tr. 36:18–37:25. Patent Owner’s position appeared to be that because “taking control” must mean more than what is described at 8:39–51 and corresponding portion of Figure 4, and

because the Specification doesn't explicitly describe any other form of taking control, taking control could be so broad as to include physically grabbing a phone away from someone's hands. *Id.* If we were to consider this belated argument, we would reject Patent Owner's conclusion that "take control" is so broad. The broadest reasonable interpretation of a claim that invokes 35 U.S.C. § 112, ¶ 6 is the structure, material, or act described in the specification as performing the entire claimed function and equivalents thereof. *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). Therefore, we would not interpret limitation 1.6 more broadly than what is described in the Specification as taking control of a PDA. As we discussed above, the only possible description of taking control of a PDA/cell phone is at 8:39–51 and the corresponding portion of Figure 4.

For the foregoing reasons, even if we had considered Patent Owner's new argument, it would not have altered the outcome of our Final Decision.

(3) *"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" (limitation 1.7); "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 responses from each recipient PDA/cell phone that responded" (limitation 1.9)*

Petitioner persuasively argues that Kubala teaches limitations 1.7 and 1.9. Although Petitioner's analysis is based on a construction different from that adopted above, *supra* Sec. II.C.4.a.2, Petitioner still shows Kubala teaches limitations 1.7 and 1.9 under our construction. We determined that the structure corresponding to the functions recited in limitations 1.7 and 1.9 is PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver, and equivalents thereof. *Supra*

Sec. II.C.4.a.2. Petitioner has shown Kubala discloses a hardware display because Petitioner shows each PDA/cell phone in Kubala includes a touch screen display. Pet. 24 (citing Ex. 1005 ¶¶ 29–30; Ex. 1003 ¶ 93).

Petitioner has shown Kubala discloses a wireless receiver and/or transceiver because Petitioner shows the PDA/cell phones in Kubala communicate using wireless technology. *Id.* at 25 (citing Ex. 1005 ¶ 27, Figure 1A). Patent Owner does not dispute that Kubala discloses a PDA/cell phone hardware including a display, such as display 16, and a wireless receiver and/or transceiver. *See generally* PO Resp.

Petitioner also shows, for reasons discussed below, that the structures in Kubala perform the functions specified in limitations 1.7 and 1.9 through its showing that the software application program (e.g., enhanced email application 206, 208) in Kubala results in the functions being performed on Kubala’s touch screen display and wireless receiver and/or transceiver. Pet. 32–35, 37–40.

(a) *Limitation 1.7*

Petitioner persuasively shows that Kubala teaches receiving “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,” as recited in limitation 1.7, because Kubala discloses that 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 acknowledgement that a particular message has been received and/or opened.” Pet. 32 (quoting Ex. 1005 ¶ 6). Furthermore, we are persuaded that a skilled artisan would have understood that the listing is accessible, e.g., available for display, on

the sender PDA/cell phone because the user of the sender PDA/cell phone would have wanted to access the information regarding acknowledgement receipts. *Id.* at 33 (citing Ex. 1003 ¶ 111); *see also* Tr. 18:8–15 (Petitioner’s counsel explaining “accessible” means accessible by the user and the only way a user could access the information would be to view it).

Petitioner also presents a contingent argument in the event “it is argued that Kubala doesn’t teach this limitation [1.7].” *Id.* Petitioner argues that in the event we find Kubala does not teach use of acknowledgement receipts, Hammond, like Kubala, also teaches this feature. Pet. 33. (citing Ex. 1006, Abstract, 2:11–18, 5:20–23). Petitioner persuasively shows Hammond teaches use of such receipts. *Id.* at 33–35 (citing Ex. 1006, 3:1–4:28, 5:31–37, 6:56–8:45, 10:6–22, Fig. 2). Indeed, Hammond discloses that the sender of an electronic message supplies a message to a Message Sender component, and can specify optional message tracking information, including message delivery (e.g., receipt) information. Ex. 1006, 4:48–56. In one embodiment a recipient “provide[s] receipts when messages are received” and a Message Receipt Tracker is notified of these receipts. *Id.* at 5:20–23. The Message Receipt Tracker in turn stores information, such as notification of receipts, in a Message Tracking Table, such as that shown in Figure 2 of Hammond. *Id.* at 5:32–37.

Petitioner also provides a rationale to combine Hammond with Kubala, arguing that a skilled artisan would have been motivated to combine these references because both are directed to tracking responses to mandatory-response messages, and both disclose use of acknowledgement receipts. Pet. 34–35. We find Petitioner’s argument persuasive. Hammond, like Kubala, relates to enhancing communication that involves electronic messages such as e-mail. Ex. 1005, code at (57); Ex. 1006, code (57). As

Petitioner points out, Kubala already discloses the use of automatic acknowledgement receipts, explaining that such was well known in the art. *Id.* (citing Ex. 1005 ¶ 6). Hammond further confirms Kubala's teaching that use of return receipts was well known in the art, *see, e.g.*, Ex. 1006, 1:21–26, 2:1–10, and confirms Mr. Williams' assertion that due to uncertainty as to whether an e-mail message was received, return receipts provided a well-known benefit, Ex. 1003 ¶ 103. For the foregoing reasons, we find persuasive Petitioner's assertion that the combination of Kubala with Hammond teaches receiving "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," as recited in limitation 1.7.

Patent Owner's contentions and arguments do not undermine Petitioner's showing. Patent Owner contends that "Petitioner does not rely on Kubala to disclose the recited function," but instead "Petitioner submits that Hammond discloses the claim elements required by the recited function of displaying the required listing." PO Resp. 23. Patent Owner is incorrect. Petitioner unambiguously asserts that Kubala alone teaches the recited function. Pet. 32–33 ("Kubala discloses the claimed structure and the claimed function of this [1.7] limitation."); Pet. Reply 13–15. As we discussed above, Petitioner relies on Hammond only for a contingent argument, stating explicitly that Hammond is relied on "[t]o the extent it is argued that Kubala doesn't teach this [1.7] limitation." Pet. 33. Accordingly, Patent Owner's assertion that Petitioner does not rely on Kubala to disclose the recited function is incorrect.

Patent Owner also criticizes an argument that is not made by Petitioner. Patent Owner argues that Hammond's Message Tracking Table

(as shown in Figure 2) does not depict a display screen, but rather illustrates a data structure stored in memory. PO Resp. 23–27. However, Petitioner never asserts that the Message Tracking Table shown in Figure 2 depicts a display screen. Pet. 33–35. Rather, Petitioner explains that (1) Hammond’s Message Tracking Tables show tracking of acknowledgement receipts, (2) Hammond is relied on for its teaching of tracking acknowledgement receipts, and (3) a skilled artisan would have combined Hammond based on its disclosure as it relates to exchanging and tracking recipient-devices. *Id.* (citing Ex. 1006, 3:1–4:28, 5:31–37, 6:56–8:45, 10:6–22, Fig. 2; Ex. 1003 ¶ 112). Nowhere does the Petition argue that the Message Tracking Table in Figure 2 depicts a display. *Id.* Accordingly, Patent Owner’s argument that Petitioner’s expert, Mr. Williams, “conceded during his deposition that Hammond’s ‘Message Tracking Table’ depicted in Figure 2 is located and stored in the server’s memory,” is irrelevant. PO Resp. 24 (citing Ex. 2007, 63:13–65:1, 66:16–6:22). Nor do we find persuasive Patent Owner’s argument that Mr. Williams testified that the existence of the Message Tracking Table itself is not sufficient to show how the table is displayed. PO Resp. 24 (citing Ex. 2007, 75:14–76:8). Nowhere does Petitioner assert that Hammond is relied on for displaying information. Pet. 33–35. As we discussed above, Petitioner relies on Kubala for displaying tracked information, and relies on Hammond for its teaching of the kind of information that is tracked, namely return receipt information. *Id.* at 32–35.

Even if we were to find Patent Owner’s arguments regarding Hammond to be persuasive, and we do not, they relate to a contingency in the event we find Kubala does not teach the function recited in limitation 1.7. However, for reasons discussed above, we find Petitioner has shown Kubala teaches limitation 1.7.

For the foregoing reasons, we determine Petitioner has made a persuasive showing as to limitation 1.7 in view of Kubala, either alone or in combination with Hammond.

(b) Limitation 1.9

Petitioner persuasively shows that Kubala teaches receiving “a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the responses from each recipient PDA/cell phone that responded,” as recited in limitation 1.9. Pet. 37–38. Kubala discloses that a sending PDA (e.g., computing device 202) can receive and display a response from a recipient PDA (e.g. computing device 204). *Id.* at 37 (citing Ex. 1005 ¶¶ 26–41, Fig. 2; Ex. 1003 ¶ 121). Petitioner argues that a skilled artisan would have known, in addition to receiving and displaying responses from recipient PDAs, also to display a listing of which recipient PDA’s have transmitted a response. *Id.* at 27–30. We find this persuasive because, as noted by Petitioner, Kubala discloses that receiving e-mail application 208 may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag, wherein the information may include mandatory-response return-status codes included within the reply e-mail. Pet. 38 (citing Ex. 1005 ¶¶ 50, 51, 61, Fig 9). We are persuaded by Petitioner’s argument that a skilled artisan would have known that the collected information regarding which recipients have responded to the e-mail messages was available and accessible, e.g., available for display, on the sender PDA/cell phone because the user of the sender PDA/cell phone would have wanted to access the information regarding acknowledgement receipts. *Id.* (citing Ex. 1003 ¶ 122); *see also* Tr. 18:8–15 (Petitioner’s

counsel explaining “accessible” means accessible by the user and the only way a user could access the information would be to view it).

Patent Owner does not provide argument specific to limitation 1.9.

For the foregoing reasons, we find Petitioner has made a persuasive showing as to limitation 1.9 in view of Kubala.

Although Petitioner provides argument that Kubala alone teaches “receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert,” Petitioner also argues that “Hammond also provides this disclosure.” *Id.* at 38. Petitioner provides evidence and argument that Hammond, like Kubala, teaches tracking information about electronic messages that have been read by recipients. *Id.* at 38–39 (citing Ex. 1006, 5:17–8:45, 10:5–11:48, Fig. 4, Fig. 5A, Fig. 5B; Ex. 1003 ¶ 123). However, Petitioner does not explain how Kubala is being combined with Hammond. *Id.* at 40. Rather, Petitioner refers to its argument regarding limitation 1.7; but, limitations 1.7 and 1.9 are distinct, and Petitioner fails to address the differences in the limitations and explain how limitation 1.9 is taught by the combination. *Id.* at 40.

For the foregoing reasons, we are not persuaded as to Petitioner’s arguments regarding the combination of Kubala with Hammond.

c) Conclusion

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 1 of the ’970 patent is unpatentable under § 103 as obvious over the combination of Kubala with Hammond.

4. Claim 3

Claim 3 depends directly from claim 1, and recites the system as in claim 1, “wherein said data transmission means is TCP/IP or another communication protocol.” Ex. 1001, 9:64–65.

Petitioner argues persuasively that Kubala discloses the limitation of claim 3 because Kubala discloses PDAs/cell phones communicating according to TCP/IP or another communication protocol, such as Wi-Fi. Pet. 40 (citing Ex. 1005 ¶ 27, Fig. 1A; Ex. 1003 ¶ 127).

Patent Owner does not dispute Petitioner’s contentions as to claim 3. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 3 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

5. Claim 4

Claim 4 depends directly from claim 1, and recites the system as in claim 1, “wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.” Ex. 1001, 9:66–10:2.

As we discussed above with regard to limitation 1.4 of claim 1, Petitioner argues persuasively that Kubala’s menu 1120 in Figure 11C teaches a response list that is transmitted within the forced message alert software packet. *Supra* Sec. II.D.3.a.5. Petitioner argues that Kubala teaches that the responses in the transmitted list of possible responses, e.g., the text strings “too busy right now,” “looks okay,” and “requested declined,” can be default responses. Pet. 40–41 (citing Ex. 1005 ¶ 57, Fig. 11C). We are persuaded that Kubala teaches the text string that are

used as menu items can be default responses because, as Petitioner points out, “Kubala also explains that the text strings may be ‘required and standardized within a data format specification, e.g., in a standard similar to RFC 2822.’” *Id.* at 41 (citing Ex. 1005 ¶¶ 57, 60; Ex. 1003 ¶¶ 129–130). Patent Owner does not dispute Petitioner’s contentions as to claim 4. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 4 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

6. Claim 5

Claim 5 depends directly from claim 1, and recites the system as in claim 1, “wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.” Ex. 1001, 10:3–6.

As we discussed above with regard to limitation 1.4 of claim 1, Petitioner argues persuasively that Kubala’s menu 1120 in Figure 11C teaches a response list that is transmitted within the forced message alert software packet. *Supra* Sec. II.D.3.a.5. Petitioner argues that Kubala teaches that the text strings used as menu items in the response list can be configurable. Pet. 41–42 (citing Ex. 1003 ¶¶ 132–133). We find Petitioner’s argument persuasive because Kubala discloses “[t]he text strings that are used as menu items may be obtained in a variety of manners,” and discloses an example in which the text strings are configurable:

the text strings may be configurable through the enhanced e-mail application by allowing user-specifiable or system-administrator-specifiable parameters. As another alternative, the text strings may be extracted from the original e-mail message

that was received from the sender, in which case the text strings may have been configured as user-specifiable or system-administrator-specifiable parameters in the sender's instance of the enhanced e-mail application.

Id. (quoting Ex. 1005 ¶ 57). Patent Owner does not dispute Petitioner's contentions as to claim 5. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 4 of the '970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

7. Claim 6

Claim 6 is similar to claim 1. However, claim 6 recites a method, whereas claim 1 recites a communication system. Petitioner sets forth where the preamble and each limitation of claim 6 is taught by the combination of Kubala and Hammond. Pet. 42–47. Patent Owner disputes Petitioner's contentions. Patent Owner's arguments are made together with, and are the same, as those for claim 1. PO Resp. 14–28.

Regarding the preamble of claim 6, Petitioner argues that, as set forth in its arguments and evidence for limitations 1.1 and 1.3 of claim 1, "Kubala discloses a method for sending a forced-message alert to one or more recipient PDA/cell phones within a predetermined communication network." Pet. 42 (citing Ex. 1005 ¶¶ 26–27, 32–33, Fig. 1A; Ex. 1003 ¶ 135). Moreover, for the reasons argued for limitation 1.7, Petitioner argues Hammond discloses the ability to track the receipt and response to forced-message alerts. *Id.* (citing Ex. 1006, code (57), 2:11–18, 3:1–4:28, 5:20–37, 10:6–22, 6:56–8:45, FIG. 2). For our reasons stated above for limitations 1.1, 1.3, and 1.7, we are persuaded Petitioner has shown the combination of Kubala and Hammond teaches or suggests the preamble of claim 6.

For limitation 6.1, Petitioner shows persuasively that Kubala teaches “accessing a forced message alert software application program on a sender PDA/cell phone,” relying on Kubala’s enhanced email application program on a sender PDA and its arguments for limitation 1.4 of claim 1 as to why Kubala’s enhanced email application program teaches a forced message alert software application program. Pet. 43 (citing Ex. 1005 ¶¶ 13, 33–36, Fig. 2; Ex. 1003 ¶ 136). For the same reasons we stated above for limitation 1.4, we are persuaded Kubala’s enhanced email application teaches a forced message alert software application program on a sender PDA/cell phone.

For limitation 6.2, Petitioner shows persuasively that Kubala teaches “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,” relying on its evidence and arguments for limitation 1.5 that Kubala’s email message 214 with mandatory response flag 216 created on the sender PDA is a forced message alert. Pet. 43 (citing Ex. 1005 ¶¶ 32–41, 54–61, Fig. 1A, 1B, 2–4; Ex. 1003 ¶ 137). For the same reasons we stated above for limitation 1.5, we are persuaded Kubala’s email message with mandatory response flag created on the sender PDA is a forced message alert, and that Kubala teaches limitation 6.2

For limitation 6.3, Petitioner shows persuasively that Kubala teaches “designating one or more recipient PDA/cell phones in the communication network,” relying on disclosure in Kubala that email messages are sent to a recipient. Pet. 43 (citing Ex. 1005 ¶¶ 32–44, 54–61, Fig. 1A, 1B, 2–5; Ex. 1003 ¶ 138). We credit Mr. William’s testimony that a person of ordinary skill in the art would have recognized that an email messaging application to which recipients receive an email involves designating a

recipient within the communication network. Ex. 1003 ¶ 138. Indeed, Kubala discloses that emails have message headers that provide information about the recipient of a message, suggesting a recipient has been designated. Ex. 1005 ¶ 37. For the reasons stated above, we are persuaded Kubala teaches limitation 6.3

For limitation 6.4, Petitioner shows persuasively that Kubala teaches “electronically transmitting the forced message alert to said recipient PDA/cell phones,” relying on Kubala’s disclosure of sending outgoing email messages flagged as a message to which a recipient is required to provide a mandatory response. Pet. 44 (citing Ex. 1005 ¶¶ 32–44, 54–61, Fig. 1A, 1B, 2–5; Ex. 1003 ¶ 139). We are persuaded that Kubala teaches limitation 6.4 because the email (i.e., electronic mail) message is transmitted electronically to a recipient PDA. *See, e.g.*, Ex. 1005 ¶ 35.

For limitation 6.5, we are persuaded by Petitioner’s showing. Petitioner relies on its evidence and arguments for limitation 1.5 of claim 1, Pet. 44, for which we find, above, Petitioner shows Kubala teaches requiring the recipient PDA/cell phone to transmit an automatic acknowledgement to the sender PDA/cell phone as soon as the forced message alert is received by the recipient PDA/cell phone, *supra* Sec. II.D.3.b.1. Petitioner further relies on its evidence and argument for limitation 1.7 of claim 1, Pet. 44, for which we find, above, Petitioner shows Kubala, either alone or in combination with Hammond, teaches 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, *supra* Sec. II.D.3.b.3.a. For our reasons stated above as to limitation 1.5 and 1.7, we are persuaded Kubala, either alone or in combination with Hammond, teaches limitation 6.5.

For limitation 6.6, Petitioner shows persuasively that the combination of Kubala and Hammond teach “periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt,” relying on its evidence and arguments for limitation 1.8 of claim 1. Pet. 44. As we discussed for limitation 1.8, we are persuaded the combination of Kubala and Hammond teach “periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert. *Supra* Sec. II.D.3.a.6. For the same reasons, we are persuaded the combination of Kubala and Hammond teaches limitation 6.6.

For limitation 6.7, Petitioner shows persuasively that Kubala teaches “receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone,” relying on Kubala’s disclosure that the sending PDA (e.g., computing device 202) may receive an email message 218 from a recipient PDA (e.g., computing device) in response to email message 214 with mandatory response flag 216. Pet. 45 (citing Ex. 1005 ¶¶ 33–36; Ex. 1003 ¶ 142). Petitioner argues persuasively that the received email would have been displayed on the PDA, relying on Mr. William’s testimony that the ability to display email has been in place at least since 1993 with the IBM Simon. *Id.* (citing Ex. 1003 ¶ 143). We credit Mr. William’s testimony. Indeed, Kubala depicts PDAs as having display screens in Figure 1A, Ex. 1005, Fig. 1A, and we find credible Mr. William’s assertion that emails were displayed, based on our observation that the message comprises text, which we find indicates the message would be viewed on a display. For the foregoing reasons, we are persuaded Kubala teaches limitation 6.7.

For limitation 6.8, Petitioner shows persuasively that Kubala teaches “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,” relying on its evidence and arguments for limitations 1.5 and 1.6 of claim 1. Pet. 46 (citing Ex. 1005 ¶¶ 9, 33–36, 40, 41, 47, 54–60. Fig. 2, 8, 10, 11A, 11C; Ex. 1003 ¶ 144). For reasons we discussed above for limitation 1.5, we are persuaded Kubala teaches providing a manual response list on the display of a recipient PDA, as is illustrated in Figure 11C. For reasons we discussed above for limitation 1.6, we are persuaded Kubala teaches 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. Therefore, we are persuaded Kubala teaches limitation 6.8

For limitation 6.9, Petitioner persuasively shows Kubala teaches “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,” because Kubala discloses that a user can select a response from a menu of responses, and after selecting a response, a user presses the INSTANT button, thereby closing the window and clearing the display and generating a reply message. Pet. 46–47 (citing Ex. 1005 ¶ 57, Fig. 11C; Ex. 1003 ¶ 145–147). Petitioner points out that although the embodiment illustrated in Figure 11C shows that a user can select CANCEL to close the window without sending a reply, Kubala also teaches that a recipient can be prevented from closing a review of the received email message, from deleting the received email message, and from exiting the email application until the recipient has responded to the received email

message. *Id.* at 47 (citing Ex. 1005 ¶ 9). Furthermore, as we discussed above for limitation 1.6, Petitioner has shown persuasively that Kubala teaches combining these features. For the foregoing reasons, Petitioner has shown that Kubala teaches limitation 6.9.

Patent Owner disputes Petitioner has shown unpatentability, but its arguments are made together with claim 1, PO Resp. 14–28, and we addressed such arguments in our discussion above for claim 1. For the same reasons as above, we find Patent Owner’s arguments unavailing.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 6 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

8. *Claim 7*

Claim 7 depends directly from claim 6, and recites the method as in claim 1, “wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.” Ex. 1001, 10:42–45.

As we discussed above with regard to limitations 1.1 and 1.4 of claim 1, Petitioner argues persuasively that Kubala teaches a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone (limitation 1.1) and a forced message alert application software application program loaded on each participating PDA/cell phone (limitation 1.4). *Supra* Sec. II.D.3.a.2, II.D.3.a.5; Pet. 48–50. Patent Owner does not dispute Petitioner’s contentions as to claim 7. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 7 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

9. *Claim 8*

Claim 8 depends directly from claim 6, and recites the method as in claim 1, “wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.” Ex. 1001, 10:46–49.

As we discussed above with regard to claim 4, Petitioner argues persuasively that Kubala teaches a response list that is transmitted within the forced message alert software packet that is a default list that is embedded in the forced message alert software application program. *Supra* Sec. II.D.5; Pet. 50. Patent Owner does not dispute Petitioner’s contentions as to claim 8. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 8 of the ’970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

10. *Claim 9*

Claim 9 depends directly from claim 6, and recites the method as in claim 1, “wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.” Ex. 1001, 10:50–54.

As we discussed above with regard to claim 5, Petitioner argues persuasively that Kubala teaches a response list that is transmitted within the forced message alert software packet that is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone. *Supra* Sec. II.D.6; Pet. 50–51. Patent Owner does not dispute Petitioner’s contentions as to claim 9. *See generally* PO Resp.

For the foregoing reasons, Petitioner has demonstrated, by a preponderance of the evidence, that claim 9 of the '970 patent is unpatentable under § 103 over the combination of Kubala with Hammond.

E. Asserted Obviousness Over Hammond, Johnson, and Pepe; Asserted Obviousness Over Hammond, Johnson, Pepe, and Banerjee

Petitioner contends that claims 1 and 3–9 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hammond, Johnson, and Pepe, or alternatively, over the combination of Hammond, Johnson, and Pepe with Banerjee. Pet. 12, 51–78. Patent Owner disputes Petitioner's contentions. PO Resp. 28–39.

1. Johnson (Ex. 1007)

Johnson generally discloses a method and system having a plurality of enrolled users and electronic mail objects that may be transmitted and received between users. Ex. 1007, [57]. The method and system include designating an electronic mail object as requiring a specific response and transmitting the electronic mail object to a recipient. *Id.* The recipient of the electronic mail object is prompted for a specific response when the recipient opens the electronic mail object and is prohibited from performing other actions until the required specific response is entered by the recipient. *Id.*

2. Pepe (Ex. 1008)

Pepe generally discloses a personal communications internetwork ("PCI") that provides a network subscriber with the ability to remotely control receipt and delivery of wireless and wireline voice and text messages. Ex. 1008, 3:45–48. The PCI operates as an interface between various wireless and wireline networks, and also performs media translation where necessary. *Id.* at 3:48–51. The PCI permits the subscriber to send

and receive messages between disparate networks and messaging systems. *Id.* at 5:56–59. A database maintains the subscriber’s message receipt and delivery options. *Id.* at 3:51–54.

3. *Analysis*

After considering the arguments and evidence submitted by the parties, we determine Petitioner has not shown claims 1 and 3–9 would have been obvious over the combination of Hammond, Johnson, and Pepe, or alternatively, over the combination of Hammond, Johnson, and Pepe with Banerjee, because the Petition fails to specify with particularity what element in the prior art discloses a “forced message alert software packet,” as recited in independent claim 1, and a “forced message alert application software packet,” as recited in independent claim 6. Petitioner’s showing as to claims 3–5 and 7–9, which depend either from claim 1 or 6, are deficient for the same reasons.

Claims 1 and 6 recite that a “forced message alert” is created by attaching a “forced message alert [application] software packet” to a voice or text message. Ex. 1001, 9:14–23, 10:14–17. For claim 1, Petitioner asserts that Hammond, Johnson, and Pepe alone each disclose transmission to a recipient computer of a forced message alert, but does not specify what element in the prior art it contends is the asserted forced message alert, much less how the forced message alert includes a *forced message alert [application] software packet*. Pet. 60. Petitioner’s argument is reproduced below:

The combination of Hammond, Johnson, and Pepe disclose this limitation [limitation 1.5]. In particular, Hammond and Johnson each alone disclose the transmission of forced message alerts to recipient computers. (See Hammond at Abstract, 1:66-2:50, 3:1-

4:28, 5:17-61, 6:3-19; Johnson, 1:58-61, 2:1-35, 3:64-4:42, 6:60-65.)

Id. Petitioner’s argument for claim 6 merely refers to the argument for claim 1, and therefore is likewise deficient:

As set forth above (*supra* claim [1.5]), the combination of Hammond, Johnson, and Pepe teaches or suggests the features of this limitation. (See Hammond, Abstract, 1:66-2:50, 3:1-4:28, 5:17-61; Johnson, 1:58-61, 2:1-35, 3:64-4:42, 6:60-65; Pepe, 34:8-36:51, 5:17-20, FIGS. 28-45.)

Id. at 71.

Petitioner’s contentions are insufficient for two reasons. First, Petitioner does not identify what element in each reference it contends is the “forced message alert.” Instead, Petitioner places the burden on Patent Owner and the Board to sift through several columns of text to guess what Petitioner contends is a “forced message alert.” Second, even if we were to identify a potential candidate “forced message alert,” we would next have to speculate as to which part Petitioner contends is the “message” and which part is the “packet”—a task which we do not undertake. Our rules require that a petition specify with particularity where each element of a claim is found in the prior art, and include a detailed explanation of the relevance of the prior art to the claim. 37 C.F.R. § 42.104(b)(4) (“[t]he petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon”); *id.* § 42.22(a)(2) (“[e]ach petition . . . must include . . . a detailed explanation of the significance of the evidence including material facts”); *id.* § 42.104(b)(5) (“[t]he petition must set forth . . . the relevance of the evidence to the challenge raised, including identifying specific portions of the evidence that support the challenge”). As the Federal Circuit has explained, “[i]n an IPR, the petitioner has the burden

from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). Petitioner’s citation to several columns of text is not sufficient to specify where the claimed “packet” is found in the prior art. 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4), 42.104(b)(5).

Therefore, we find the Petition fails to show with particularity why the challenged claims are unpatentable.

In the Institution Decision, we identified the deficiency in the Petition:

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.*

Inst. Dec. 36. Patent Owner agrees in the Response that the Petition is deficient:

Patent Owner agrees with and adopts the Board’s findings that each and every element is not disclosed or suggested by the prior art references in Grounds 2–3 [Hammond, Johnson, and Pepe, with or without Banerjee], and that the Petition neither identifies nor describes how the references in Grounds 2–3 comprise a voice or text message and a forced message alert software packet. Paper 9 at 36; Ex. 2005, ¶ 48.

PO Resp. 29.

Petitioner attempts, improperly, to cure the defect in the Petition by introducing more specific contentions in the Reply. The Reply specifies with particularity Petitioner’s contentions, for the first time, regarding what elements in the prior art disclose the claimed “packet,” and provides at least

some indication as to how the packet is attached to a message. Pet. Reply 19. Petitioner explicitly identifies Hammond's "message delivery information" as disclosing the claimed "packet," explaining that the "message delivery information" can be stored with a message as a header. *Id.* Petitioner also explicitly identifies Johnson's "persistent reply attribute" as disclosing the claimed "packet," explaining that the "persistent reply attribute" is described as a mechanism for forcing a recipient to reply to an electronic mail object. *Id.* These contentions in the Reply exemplify the level of specificity that could have been, but were not, in the Petition. Moreover, these contentions illustrate the challenge we would have faced had we tried to speculate, based on the Petition, as to Petitioner's positions on what constitutes the claimed "packet." Neither Hammond nor Johnson use the term "forced message alert [application] software packet," and there is need for identification, and an explanation as to why Hammond's "message delivery information" and Johnson's "persistent reply attributes," would have been considered to be the claimed "packet." *See id.* Petitioner's identification and explanation for the first time in the Reply comes too late.

The Reply may only respond to argument raised in the Patent Owner Response. 37 C.F.R. § 42.23(b) ("A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or other patent owner response"). However, even if responsive, a reply is not an opportunity to cure a deficiency in the petition, such as by providing the argument necessary to make out a prima facie case of unpatentability. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756 at 48,767 (Aug. 14, 2012) ("Patent Trial Practice Guide"). ("While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned . . . [e]xamples

of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing”).

Because the new contentions in the Reply are introduced belatedly, to make out a *prima facie* case of unpatentability that could have been presented in the Petition, we do not consider them in issuing our Final Decision. Patent Trial Practice Guide at 48,767; *Harmonic Inc.*, 815 F.3d at 1363.

For the foregoing reasons, Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1 and 3–9 of the ’970 patent are unpatentable under § 103 over the combination of Hammond, Johnson, and Pepe or over the combination of Hammond, Johnson, Pepe, and Banerjee.¹⁴

III. CONCLUSION¹⁵

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 3–9	§ 103(a)	Kubala, Hammond	1, 3–9	

¹⁴ Petitioner relies on Banerjee for the teaching of a touchscreen display only, and does not provide arguments that alter our analysis. Pet. 77–78.

¹⁵ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Final Decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

1, 3-9	§ 103(a)	Kubala, Hammond, Johnson, Pepe		1, 3-9
1, 3-9	§ 103(a)	Kubala, Hammond, Johnson, Pepe, Banerjee		1, 3-9
Overall Outcome			1, 3-9	

IV. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Petitioner has demonstrated by a preponderance of the evidence that claims 1 and 3-9 of U.S. Patent No. 8,213,970 B2 are *unpatentable*; and

FURTHER ORDERED that because this is a Final Written Decision, any party to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2

IPR2018-01079
Patent 8,213,970 B2

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, HTC AMERICA, INC., AND ZTE (USA), INC.,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2019-00485
Patent 8,213,970 B2

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

HTC Corporation, HTC America, Inc., and ZTE (USA), INC. (collectively, “Petitioner”)¹ filed a request for *inter partes* review of claims 1 and 3–9 (the “challenged claims”) of U.S. Patent No. 8,213,970 B2 (Ex. 1001, “the ’970 patent”). Paper 3 (“Pet.” or “Petition”). Concurrent with the filing of the Petition, Petitioner filed a Motion for Joinder to *Inter Partes* Review (35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b)), seeking to join IPR2018-01079 instituted on November 20, 2018 (“the ’1079 IPR”). Paper 4 (“Mot.” or “Motion”). AGIS Software Development, LLC (“Patent Owner”)² filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Under 35 U.S.C. § 315(a)(1), “[a]n *inter partes* review may not be instituted if, before that date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” 35 U.S.C. § 315(a)(1). Upon considering the evidence presented and the arguments made, we determine that *inter partes* review is barred under 35 U.S.C. § 315(a)(1). Accordingly, we do not institute an *inter partes* review.

A. Related Proceedings

The parties advise that the ’970 patent has been asserted in various district court proceedings, including, in pertinent part, *ZTE (USA), Inc. v. AGIS Software Development LLC et al.*, No. 4:18-cv-06185 (N.D. Cal.) (filed October 9, 2018). Pet. 79–81; Paper 6, 3. Patent Owner further

¹ The Petition identifies as real parties-in-interest HTC Corporation, HTC America, Inc., ZTE (USA), Inc., and ZTE (TX) Inc. Pet. 79.

² Patent Owner identifies itself, pursuant to 37 C.F.R. § 42.8(b)(2), as the real party-in-interest. Paper 6, 1.

advises that the '970 patent and patents related to the '970 patent are the subject of various filings requesting *inter partes* review. Paper 6, 2–3 (see table identifying *inter partes* review case numbers).

B. The '970 Patent

The '970 patent generally discloses a specialized software application program on a personal computer (“PC”) or PDA/cell phone for creating and processing forced message alerts. Ex. 1001, Abstract. The specification of the '970 patent (“Specification”) discloses it is desirable for a PDA/cell phone user to be able to simultaneously send Digital Smart Message Service (“SMS”) or TCP/IP messages to a large group of PCs or cell phones using cellular technology (such as GSM or CDMA) or WiFi. *Id.* at 1:51–57. The Specification further discloses that in some situations it is additionally desirable to know which PCs and PDA/cell phones received the message, which PCs and PDA/cell phones did not receive the message, and the response of each recipient of the message. *Id.* at 1:57–61. “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.” *Id.* at 1:62–67. In addressing these issues, the Specification discloses “[t]he heart of the invention lies in [a] forced message alert software application program provided in each PC or PDA/cell phone.” *Id.* at 4:47–49. The software 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.

Id., Abstract. The Specification explains that a forced message alert is comprised of a text or voice message and a forced message alert software packet. *Id.* at 2:11–13, 8:23–25.

C. Challenged Claims

Petitioner challenges claims 1 and 3–9 of the '970 patent. Claims 1 and 6 are independent. Claim 1 is illustrative (brackets and numbering added).

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

[1.1] a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display and a CPU memory;

[1.2] a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;

[1.3] a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;

[1.4] 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;

[1.5] 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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;

[1.6] means for requiring a required manual response from the response list by the recipient in order to clear the recipient's response list from recipient's cell phone display;

[1.7] 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;

[1.8] means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and

[1.9] 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 responses from each recipient PDA/cell phone that responded.

Ex. 1001, 8:65-9:39.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1 and 3–9 on the following grounds.

Pet. 12.

References	Ground	Claims
Kubala ³ and Hammond ⁴	§ 103(a)	1 and 3–9
Hammond, Johnson, ⁵ and Pepe ⁶	§ 103(a)	1 and 3–9
Hammond, Johnson, Pepe, and Banerjee ⁷	§ 103(a)	1 and 3–9

Petitioner relies on the declaration of David Hilliard Williams to support its contentions. Ex. 1003 (“Williams declaration”).

II. DISCUSSION

A. Principles of Law

Section 315 of Title 35 creates two bars to institution of *inter partes* review. § 315(a)(1) bars *inter partes* review if the petitioner files a civil action challenging the patent’s validity before filing the petition: “[a]n *inter partes* review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” 35 U.S.C.

³ U.S. Patent Publication 2006/0218232 A1, filed March 24, 2005 and published September 28, 2006. Ex. 1005 (“Kubala”).

⁴ U.S. Patent 6,854,007 B1, filed September 17, 1998 and issued February 8, 2005. Ex. 1006 (“Hammond”).

⁵ U.S. Patent 5,325,310, filed June 26, 1992 and issued June 28, 1994. Ex. 1007 (“Johnson”).

⁶ U.S. Patent 5,742,905, filed September 19, 1994 and issued April 21, 1998. Ex. 1008 (“Pepe”).

⁷ U.S. Patent Publication 2003/0128195 A1, filed January 8, 2002 and published July 10, 2003. Ex. 1009 (“Banerjee”).

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§ 315(a)(1); *see also* 37 C.F.R. § 42.101(a). § 315(b) bars *inter partes* review if the petitioner is served with a complaint alleging infringement of the patent more than one year before the petition is filed: “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b); *see also* 37 C.F.R. § 42.101(b). Section 315(b) provides an exception to the one-year statutory bar when a request for joinder is filed under 35 U.S.C. § 315(c), stating that “[t]he time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection(c).” 35 U.S.C. § 315(b). However, § 315(a)(1) does not provide such an exception.

Our rules specify that a party must file a request for joinder as a motion under 37 C.F.R. § 42.22 no later than one month after institution of the proceeding the party seeks to join. 37 C.F.R. § 42.122(b).

B. 35 U.S.C. § 315(a)(1) and 35 U.S.C. § 315(c)

Neither the Petition nor the Motion addresses whether the Petition is barred under § 315(a)(1). The Petition states only that “Petitioners certify that it is not barred or estopped from requesting *inter partes* review on the grounds proposed herein,” without further explanation. Pet. 3. The Motion purports to be timely because it was filed within one month of institution of the ’1079 IPR, Mot. 1 (citing 37 C.F.R. § 42.122(b)), but the Motion does not address whether the Petition is barred and whether Petitioner may, nonetheless, join the ’1079 IPR.

Patent Owner contends that the Petition is barred under 35 U.S.C. § 315(a)(1) because ZTE (USA) Inc. (“ZTE”)—named Petitioner and real party-in-interest in this proceeding—filed a civil action challenging the

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validity of the '970 patent *prior to* filing the Petition. Prelim. Resp. 4. As we noted above, Section 315(a)(1) states that “[a]n inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” 35 U.S.C. § 315(a)(1).

We agree with Patent Owner that § 315(a)(1) bars institution of *inter partes* review in this case. There is no dispute that ZTE is the petitioner and a real party-in-interest in this proceeding. *See* Pet. 1 (identifying ZTE as the petitioner); *see also id.* at 79 (identifying ZTE as a real party-in-interest). Patent Owner contends, and Petitioner does not dispute, that on October 9, 2018, prior to the December 20, 2018 filing date of the Petition, ZTE filed a complaint for declaratory judgment alleging invalidity of the '970 patent. Prelim. Resp. 4 (citing *ZTE (USA), Inc. v. AGIS Software Development LLC et al.*, No. 4:18-cv-06185 (N.D. Cal.) (filed October 9, 2018) (“ZTE action”)). Because ZTE filed a civil action challenging the validity of the '970 patent before the date on which it filed the Petition, we agree with Patent Owner that *inter partes* review is barred by ZTE’s civil action. 35 U.S.C. § 315(a)(1).

Patent Owner points out that, after the filing of the Petition, Patent Owner informed ZTE that the Petition is barred under 35 U.S.C. § 315(a)(1), and requested the Petition be withdrawn. Prelim. Resp. 4 (citing Ex. 2001). In particular, counsel for Patent Owner sent a letter to counsel for ZTE, stating,

I write to request that ZTE immediately withdraw its frivolous IPR petitions against AGIS . . . in IPR2019-00485 . . . ZTE filed these petitions after filing its October 9, 2018 complaint for declaratory judgment for invalidity of the same patents . . . Section 315(a)(1)

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prohibits a declaratory-judgment plaintiff from filing an IPR petition if the plaintiff filed a declaratory judgement complaint for invalidity before filing the IPR petition.

Ex. 2001. Patent Owner alleges that, in a responsive correspondence, “ZTE refused to withdraw its [Petition] without addressing 35 U.S.C. § 315(a)(1).” Prelim. Resp. 4 (citing Ex. 2002). However, although the responsive correspondence from ZTE did not specifically address § 315(a)(1), ZTE disagreed that the Petition is statutorily barred “at least because we filed a joinder petition.” Ex. 2002. We note that Petitioner has not made this argument to the Board in this proceeding. Even if Petitioner had made this argument, it would not have resulted in a different outcome.

Unlike 35 U.S.C. § 315(b), which provides an exception to the statutory time bar when a request for joinder is filed, nothing in the language of § 315(a)(1) indicates that the time bar does not apply if a party files for joinder. Consistent with the plain language of § 315(a)(1), which does not include a joinder exception, the Board has expressly held that a motion for joinder does not exempt a petitioner from the statutory bar under this section. Prelim. Resp. 5 (citing *Colas Sols. Inc. v. Blacklidge Emulsions, Inc.*, Case IPR2018-00243, slip op. at 6, 9 (PTAB Feb. 27, 2018) (Paper 10) (informative)).

Patent Owner also points out that on February 5, 2019, ZTE amended the complaint in the ZTE action, removing the invalidity challenges to the ’970 patent. *Id.* at 4. Patent Owner asserts that this amendment does not remove the statutory bar. *Id.* at 4–5. According to Patent Owner, amending a declaratory judgment action to remove invalidity challenges is akin to a voluntary dismissal of a civil action. *Id.* at 5. Applying the Federal Circuit’s decision in *Click-to-Call Tech., LP v. Ingenio, Inc.*, 899 F.3d 1321, 1338

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(Fed. Cir. 2018), which held that voluntary dismissal of a civil action does not remove the statutory bar under § 315(b), Patent Owner argues that amendment of a declaratory judgment action does not remove the statutory bar under § 315(a)(1). Prelim. Resp. 5 (citing *Cisco Sys., Inc. v. Chrimar Sys., Inc.*, Case IPR2018-01511, slip op. at 2, 8 (PTAB Jan. 13, 2019) (Paper 11)). Petitioner has not presented any argument regarding the impact on the statutory bar under § 315(a)(1), if any, of amending the complaint in the ZTE action.

In determining whether amendment of the complaint in the ZTE action impacts the statutory bar in this case, we begin our analysis with the language of the statute. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“[s]tart[ing] where the statute does”). “The first step ‘is to determine whether the language at issue has a plain and unambiguous meaning with regard to the particular dispute in the case.’” *Barnhart v. Sigmon Coal Co., Inc.*, 534 U.S. 438, 450 (2002) (quoting *Robinson v. Shell Oil Co.*, 519 U.S. 337, 340 (1997)). The language of § 315(a)(1) is plain on its face and unambiguous. It states that “[a]n inter partes review may not be instituted if, before the date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” 35 U.S.C. § 315(a)(1). This language refers only to the date on which the petitioner or real party in interest filed the civil action alleging infringement. *Cf. Click-to-Call*, 899 F.3d at 1332 (explaining that § 315(b) “clearly and unmistakably considers only the date on which the petitioner, its privy, or a real party in interest was properly served with a complaint”). Petitioner has not identified, nor do we discern, any language in the statute indicating that amending the complaint in the ZTE action has any impact on the statutory bar. Because the statutory

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language is unambiguous, our inquiry regarding statutory interpretation ceases, and we determine that the amendment does not remove the statutory bar. *See id.* (citations omitted) (explaining that “[b]ecause ‘the statutory language is unambiguous and ‘the statutory scheme is coherent and consistent,’ our inquiry ceases”).

For the foregoing reasons, we determine that under the circumstances presented here, institution of *inter partes* review is barred under 35 U.S.C. § 315(a)(1). Therefore, we do not institute an *inter partes* review in this proceeding. In addition, because institution of *inter partes* review is barred under § 315(a)(1) and this section does not provide an exception for joinder under 35 U.S.C. § 315(c), we dismiss Petitioner’s Motion as moot.

C. Additional Arguments by Patent Owner

Patent Owner argues that we should exercise our discretion to deny the Petition under 35 U.S.C. § 314(a). Prelim. Resp. 16–20. Patent Owner also argues that we should deny the Petition for failure to show there is a reasonable likelihood that Petitioner would prevail in demonstrating at least one claim of the ’970 patent is unpatentable. *Id.* at 6–16. Because we deny the Petition on other grounds, *supra* Sec. II.B, we need not, and do not, address Patent Owner’s arguments regarding § 314(a) and patentability.

III. CONCLUSION

For the foregoing reasons, we determine that institution of *inter partes* review is barred under 35 U.S.C. § 315(a)(1). Therefore, we do not institute an *inter partes* review.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is denied and no trial is instituted.

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Patent 8,213,970 B2

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT LLC,
Patent Owner.

Case IPR2019-00411
Patent 8,213,970 B2

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Dismiss

37 C.F.R. § 42.71(a)

Granting Request to Treat Settlement Document
as Confidential Business Information

35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

On March 22, 2019, pursuant to 37 C.F.R. § 42.71(a), the parties filed a Joint Motion to Dismiss the Petition. Paper 7 (“Joint Motion”).

Accompanying the Joint Motion, the parties filed what they assert is a true and correct copy of a settlement agreement along with a Joint Request to Treat Settlement Agreement as Business Confidential, to be kept separate from the patent file under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 8 (“Joint Request”); Ex. 1022 (“Settlement Agreement”). We authorized the filing of these papers in an email sent on March 20, 2019.

The instant proceeding is still in the preliminary stages, as we have not yet entered a decision on institution. Under these circumstances, Petitioner has demonstrated that dismissal of its petition is warranted, and we grant the parties’ Joint Motion and Joint Request. *See* 37 C.F.R. § 42.71(a) (authorizing the Board to dismiss a petition).

Accordingly, it is:

ORDERED that the parties’ Joint Motion to Dismiss the Petition is *granted* and the petition is *dismissed*;

FURTHER ORDERED that the parties’ Joint Request to Treat Settlement Agreement as Business Confidential is *granted*; and

FURTHER ORDERED that the Settlement Agreement, Ex. 1022, shall be treated as business confidential information and kept separate from the patent file, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2018-01079
Patent 8,213,970 B2

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Google LLC (“Petitioner”)¹ filed a request for *inter partes* review of claims 1 and 3–9 (the “challenged claims”) of U.S. Patent No. 8,213,970 B2 (Ex. 1001, “the ’970 patent”). Paper 2 (“Pet.”). AGIS Software Development, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Petitioner filed a Reply to the Preliminary Response. Paper 8.

Under 35 U.S.C. § 314, an *inter partes* review must not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon considering the evidence presented and the arguments made, we determine Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we institute an *inter partes* review.

A. Related Proceedings

The parties advise that the ’970 patent has been asserted in *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.); *AGIS Software Development LLC v. HTC Corporation*, No. 2:17-cv-00514 (E.D. Tex.); *AGIS Software Development LLC v. LG Electronics, Inc.*, No. 2:17-cv-00515 (E.D. Tex.); *AGIS Software Development LLC v. Apple Inc.*, No. 2:17-cv-00516-JRG (E.D. Tex.); *AGIS*

¹ The Petition identifies as real parties-in-interest Google LLC, Huawei Device USA Inc., Huawei Device Co., Ltd., Huawei Device (Dongguan) Co., Ltd., Huawei Technologies USA Inc., Huawei Technologies Co., Ltd., and LG Electronics, Inc. Paper 2, 79.

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Software Development LLC v. ZTE Corporation et al., No. 2:17-cv-00517 (E.D. Tex.). Pet. 79–80; Paper 5, 3–4. Patent Owner further advises that the '970 patent and patents related to the '970 patent are the subject of various filings requesting *inter partes* review. Paper 5, 2–3 (*see* table identifying *inter partes* review case numbers).

B. The '970 Patent

The '970 patent generally discloses a specialized software application program on a personal computer (“PC”) or PDA/cell phone for creating and processing forced message alerts. Ex. 1001, Abstract. The specification of the '970 patent (“Specification”) discloses it is desirable for a PDA/cell phone user to be able to simultaneously send Digital Smart Message Service (“SMS”) or TCP/IP messages to a large group of PCs or cell phones using cellular technology (such as GSM or CDMA) or WiFi. *Id.* at 1:51–57. The Specification further discloses that in some situations it is additionally desirable to know which PCs and PDA/cell phones received the message, which PCs and PDA/cell phones did not receive the message, and the response of each recipient of the message. *Id.* at 1:57–61. “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.” *Id.* at 1:65–67. In addressing these issues, the Specification discloses “[t]he heart of the invention lies in [a] forced message alert software application program provided in each PC or PDA/cell phone.” *Id.* at 4:47–49. The software 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.

Id., Abstract. The Specification explains that a forced message alert is comprised of a text or voice message and a forced message alert software packet. *Id.* at 2:11–13, 8:23–25.

C. Challenged Claims

Petitioner challenges claims 1 and 3–9 of the '970 patent. Claims 1 and 6 are independent. Claim 1 is illustrative.

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

[1.1] a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display and a CPU memory;

[1.2] a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;

[1.3] a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;

[1.4] 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;

[1.5] 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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;

[1.6] means for requiring a required manual response from the response list by the recipient in order to clear the recipient's response list from recipient's cell phone display;

[1.7] 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;

[1.8] means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and

[1.9] 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 responses from each recipient PDA/cell phone that responded.

Ex. 1001, 8:65-9:39 (brackets and numbering added).

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1 and 3-9 on the following grounds.

Pet. 12.

References	Ground	Claims
Kubala ² and Hammond ³	§ 103(a)	1 and 3-9
Hammond, Johnson, ⁴ and Pepe ⁵	§ 103(a)	1 and 3-9
Hammond, Johnson, Pepe, and Banerjee ⁶	§ 103(a)	1 and 3-9

Petitioner relies on the declaration of David Hilliard Williams to support its contentions. Ex. 1003 (“Williams declaration”).

E. Priority of the '970 Patent

The '970 patent was filed November 26, 2008 (“the '970 filing date”), and claims priority through a chain of continuation-in-part applications to an application, U.S. Patent Application 10/711,490 (“the '490 application”), filed on September 21, 2004 (“the '490 filing date”). Ex. 1001, [22], [63]. However, Petitioner asserts the earliest filing date to which the '970 patent may claim priority is the '970 filing date. Pet. 13. Petitioner argues that the claims of the '970 patent lack sufficient written description support in the

² U.S. Patent Publication 2006/0218232 A1, filed March 24, 2005 and published September 29, 2006. Ex. 1005 (“Kubala”).

³ U.S. Patent 6,854,007 B1, filed September 17, 1998 and issued February 8, 2005. Ex. 1006 (“Hammond”).

⁴ U.S. Patent 5,325,310, filed June 26, 1992 and issued June 28, 1994. Ex. 1007 (“Johnson”).

⁵ U.S. Patent 5,742,905, filed September 19, 1994 and issued April 21, 1998. Ex. 1008 (“Pepe”).

⁶ U.S. Patent Publication 2003/0128195 A1, filed January 8, 2002 and published July 10, 2003. Ex. 1009 (“Banerjee”).

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earlier-filed applications through which priority is claimed, and therefore the '970 patent is not entitled to claim priority back to the '490 filing date. *Id.* Patent Owner asserts that Petitioner bears the burden of showing that the '970 patent is not entitled to a priority date of September 21, 2004, and that Petitioner has not met this burden. Prelim. Resp. 29.

Patent Owner is incorrect as to who bears the burden of production, at this stage, of demonstrating that the '970 patent is entitled to claim priority to a date earlier than the '970 filing date. Petitioner bears the ultimate burden of demonstrating unpatentability of the challenged claims. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015). However, a different burden, the burden of production, shifts to the patent owner once a petitioner provides invalidating art that predates the filing date of the challenged patent, where the patent-at-issue claims priority through continuations-in-part (which may add, or remove, subject matter) and the Examiner did not expressly address the priority issue. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1305-06 (Fed. Cir. 2008); *Research Corp. Techs. v. Microsoft Corp.*, 627 F.3d 859, 871 (Fed. Cir. 2010). Petitioner has presented art (*see* Sec. I.D above) that predates the filing date of the '970 patent, which claims priority through continuations-in-part, and the Examiner has not expressly addressed the priority issue. Therefore, the burden of production has shifted to Patent Owner, who must show not only the existence of the earlier applications through which Patent Owner seeks to claim priority, but also how the written description in the earlier applications supports the challenged claims. *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008). “[T]o gain the benefit of the filing date of an earlier application under 35 U.S.C. § 120, each application in the chain leading back to the earlier application must comply

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with the written description requirement of 35 U.S.C. § 112.” *Zenon Envtl., Inc. v. U.S. Filter Corp.*, 506 F.3d 1370, 1378 (Fed.Cir.2007) (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed.Cir.1997)); *see also In re Hogan*, 559 F.2d 595, 609 (CCPA 1977) (“[T]here has to be a continuous chain of copending applications each of which satisfies the requirements of § 112 with respect to the subject matter presently claimed.” (quoting *In re Schneider*, 481 F.2d 1350, 1356 (CCPA 1973)) (alteration in original). Thus, Patent Owner must show that each application in the priority chain makes the requisite disclosure of subject matter, otherwise the ’970 patent is not entitled to the benefit of the filing date of applications preceding a break in the priority chain.

Patent Owner, at this stage, has made no attempt to show that the ’490 application, or any intervening applications through which the ’970 patent claims priority, satisfy the written description requirement of 35 U.S.C. § 112. Because Patent Owner has not yet met its burden, Patent Owner has not established that the ’970 patent is entitled to rely on a filing date earlier than November 26, 2008, the filing date of the ’970 patent.

II. DISCUSSION

A. Level of Ordinary Skill

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966). “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

Petitioner argues that a person of ordinary skill in the art in the field of

the '970 patent would have had either (1) a Bachelor of Science degree in electrical engineering or an equivalent field, with three to five years of academic or industry experience in the field of electronic communications, or (2) a Master of Science degree in electrical engineering or an equivalent field, with two to four years of academic experience in the same field.

Pet. 9–10 (citing Ex. 1003 ¶¶ 29–30).

Patent Owner does not provide any evidence or argument as to the level of ordinary skill in the art. *See generally* Prelim. Resp. 1–49.

For purposes of this Decision, and based on the record before us, we adopt Petitioner's assessment of the level of ordinary skill in the art.

B. Claim Construction

Presently, in an *inter partes* review claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent. 37 C.F.R. § 42.100(b). Consistent with that standard, we assign claim terms their ordinary and customary meaning, as would be understood by one of ordinary skill in the art at the time of the invention, in the context of the entire patent disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

1. Proposed Constructions

Petitioner proposes that we construe the terms in claim 1 that include the word “means” as means-plus-function under 35 U.S.C. § 112(6).

Pet. 10–12. Patent Owner does not propose constructions for any claim

terms. *See generally* Prelim. Resp. 1–49. The district court issued an order construing these terms in *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.) on October 10, 2018. Ex. 3001, 9–29 (“District Court Claim Construction Order”). We have considered the district court’s constructions.

2. Preliminary Constructions

We adopt the following preliminary claim constructions based on the current record. We determine, for purposes of this Decision, that no other claim terms require express construction.

- a. *“data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations” (limitation 1.2)*

We construe the term “data transmission means” under 35 U.S.C. § 112(6). Petitioner asserts that the specified function is to “facilitate the transmission of electronic files between said PDA/cell phones in different locations,” as recited in limitation 1.2 Pet. 10. We agree that this is the specified function. Petitioner asserts that the corresponding structure is a server that communicates according to either (1) Wifi, WiMax, or other peer-to-peer communications or (2) SMS, TCP/IP, or other messaging protocols. *Id.* (citing Ex. 1001, 4:1–36). The disclosure upon which Petitioner relies describes a communication server that acts as a forwarder of data addressed from one network participant to another, “thus permitting the transmission of forced message alerts, other text and voice messages, photographs, video, E-mail, and URL data” between network participants. Ex. 1001, 4:1–6. However, the Specification does not refer to the server as a data transmission means. Rather, the Specification refers to a network such as the Internet as a transmission means: “[t]o operate on the network,

obviously the PC must be on and have an active connection to the Internet or other digital *transmission means*.” Ex. 1001, 3:43–45 (emphasis added). The Specification also refers to TCP/IP as transmission means: “[a] plurality of PCs/ and PDA/cell phones each having forced alert software installed providing a communication network . . . with the ability to: a) allow an operator to create and transmit (via TCP/IP or another digital *transmission means*) a forced voice alert.” *Id.* at 2:7–11 (emphasis added). The Specification also refers to cellular telephony as including the ability to access local WiFi connections, thereby allowing cell phones to “utilize cellular phone *data transmission* technology as well as the *data transmission* ability of the Internet.” *Id.* at 1:39–43. Based on these disclosures, we are not persuaded that a server is a “data transmission means.” Rather, we determine for purposes of this Decision that the corresponding structure is “a data transmission network such as the Internet, and equivalents thereof.”

The District Court Claim Construction Order finds that the corresponding structure is a “communications network server; and equivalents thereof,” but does not provide analysis, instead stating that the construction was agreed upon by the parties. Ex. 3001, 10. Furthermore, there is no indication in the Order that the court considered the portions of the Specification we highlighted above about the *Internet* or other digital *transmission means* and the *data transmission* ability of the *Internet*. *Id.*

b. “means for . . .” limitations (limitations 1.5 to 1.9)

Petitioner treats limitations 1.5 to 1.9 similarly. For each of these limitations, Petitioner identifies as the specified function some or all of the language of the limitation following the words “means for.” Pet. 10–12. For the corresponding structure, Petitioner identifies either “a computer configured to perform a portion of the forced-message alert software-

application program” or “the forced-message alert software application program on the recipient[/sender’s] PDA/cell[ular] phone” that performs certain specified functions. *Id.*

- c. *“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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone” (limitation 1.5)*

For limitation 1.5, Petitioner asserts that the specified function is to attach a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by a sender PDA/cell phone to a recipient PDA/cell phone. Pet. 10. We agree that the function includes the language Petitioner recites. However, without explanation, Petitioner omits the remaining recitation of limitation 1.5. Petitioner does not adequately explain, nor do we discern why, the remaining language recited in element 1.5 should not be construed as part of the specified function.

Petitioner asserts that the corresponding structure is a computer configured to perform a portion of the forced-message alert software-application program that allows a user to create a message, select recipients of that message, select a default or new response list to be sent with the message, and send the message to the recipients. Pet. 10 (citing Ex. 1001, 7:43–63; Fig. 3A). The disclosure upon which Petitioner relies refers to a personal computer (“PC”) or PDA/cell phone. Ex. 1001, 7:44–46. The Specification indicates that these are general computing devices, except that

they include special software—the forced message alert software application program. *Id.* at 3:41–43 (“Each PC described herein is like any other contemporary PC, except that it has the forced message alert software application program installed on it.”); *see also id.* at 3:29–31 (“Each PDA/cell phone described herein . . . can function just as any other cell phone . . . [i]n addition . . . it has the forced message alert software application program.”). Accordingly, we find that the corresponding structure is a PC or PDA/cell phone and the portion of the forced message alert software application program that performs the recited function. Furthermore, because the disclosed PC or PDA/cell phone is described as a computing device that includes special software for performing various functions, the Specification must include sufficient disclosure of an algorithm for performing the specified function.

We are persuaded at this stage that the disclosure identified by Petitioner provides sufficient detail to disclose an algorithm because it describes the steps of a process for sending a forced message alert, except that it does not specifically describe “attaching” the forced message alert software packet to a voice or text message. Ex. 1001, 7:43–63; Fig. 3A. However, it implies that this step occurs because a user types a text or records a voice message, and a forced message alert is sent, *id.*, and elsewhere the Specification discloses that the software allows a user to create a forced message alert comprising a voice or text message and forced message alert software packet, *id.* at 2:11–13.

We determine, therefore, that the recited function is the entire recitation of limitation 1.5 following the words “means for,” and that the corresponding structure is a PC or PDA/cell phone and software that performs the steps disclosed at Ex. 1001, 7:43–63, Fig. 3A, 2:11–13, and

d. “means for . . . “ (limitations 1.6 to 1.9)

As with limitation 1.5, for each of limitations 1.6 to 1.9, we determine that the specified function is the language of the respective limitation following the words “means for.” For the reasons stated above, *supra* Section. II.B.c, we also determine that the corresponding structure for each specified function is a PC or PDA/cell phone and software that performs the respective applicable algorithm disclosed in the Specification, and equivalents thereof. Below, we discuss the applicable algorithm corresponding to each specified function.

i. “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” (limitation 1.6)

For the structure corresponding to the specified function of limitation 1.6, Petitioner identifies the forced message alert software application program functionality described in Figure 4 and column 8, lines 39 through 46, of the Specification. Pet. 10–11. We are persuaded at this stage that the disclosure identified by Petitioner provides sufficient detail to disclose the applicable algorithm. We determine, therefore, that the corresponding structure is a PC or PDA/cell phone and software that performs the steps disclosed at Ex. 1001, 8:39–46 and Fig. 4, and equivalents thereof.

ii. “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” (limitation 1.7)

For the structure corresponding to the specified function of

limitation 1.7, Petitioner identifies the forced message alert software application program functionality described in Figures 3A and 3B and column 7, line 64 through column 8, line 5, of the Specification. Pet. 11. We are persuaded at this stage that the disclosure identified by Petitioner provides sufficient detail to disclose the applicable algorithm. We determine, therefore, that the corresponding structure is a PC or PDA/cell phone and software that performs the steps disclosed at Ex. 1001, 7:64–8:5 and Figs. 3A and 3B, and equivalents thereof.

iii. “means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert” (limitation 1.8)

For the structure corresponding to the specified function of limitation 1.8, Petitioner identifies the forced message alert software application program functionality described in Figures 3A and 3B and column 6, lines 6–9, of the Specification. Pet. 11–12. We are persuaded at this stage that the disclosure identified by Petitioner provides sufficient detail to disclose the applicable algorithm. We determine, therefore, that the corresponding structure is a PC or PDA/cell phone and software that performs the steps disclosed at Ex. 1001, 8:6–9 and Figs. 3A and 3B, and equivalents thereof.

iv. “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 responses from each recipient PDA/cell phone that responded” (limitation 1.9)

For the structure corresponding to the specified function of limitation 1.9, Petitioner identifies the forced message alert software application program functionality described in Figures 3A and 3B and

column 8, lines 9–15, of the Specification. Pet. 12. We are persuaded at this stage that the disclosure identified by Petitioner provides sufficient detail to disclose the applicable algorithm. We determine, therefore, that the corresponding structure is a PC or PDA/cell phone and software that performs the steps disclosed at Ex. 1001, 8:9–15 and Figs. 3A and 3B, and equivalents thereof.

3. *Sufficiency of Petitioner’s Proposed Claim Constructions*

Patent Owner contends the Petition should be denied on grounds that the Petition fails to satisfy the requirements of 37 C.F.R. § 42.104(b)(3). Prelim. Resp. 2–20. Namely, Patent Owner argues the Petition has failed to identify for the Board how each claim term is to be construed because Petitioner’s claim construction positions in this proceeding are inconsistent with those taken by real parties in interest to the Petition in district court. *Id.* at 4–24. Patent Owner asserts “the Petition is deficient because Petitioner fails to meet its burden under 37 C.F.R. § 42.104(b)(3) to propose claim constructions that the real parties in interest believe are correct under applicable law.” *Id.* at 4. Patent Owner further contends that Petitioner has violated its duty of candor under 37 C.F.R. §§ 42.11, 11.18(b)(2) on grounds that Petitioner and the real parties in interest in this case “have knowingly advanced conflicting positions in the District Court Litigation and in this proceeding.” *Id.* at 20–24.

Petitioner asserts that several claim terms written in means-plus-function format should be construed under 35 U.S.C. § 112(6). Pet. 9–12. For each such term, Petitioner identifies a specified function and cites to portions of the Specification Petitioner asserts provide disclosure of corresponding structure. *Id.* Patent Owner asserts this contradicts the position in district court of real parties in interest to the Petition, who argued

these claim terms are indefinite because the Specification fails to disclose corresponding structures for the specified functions. Prelim. Resp. 5–17 (citing Ex. 2001, 1–20; Ex. 2003, 1–13).

Patent Owner also asserts that in district court the real parties in interest to the Petition proposed constructions for the terms “forced message alert software application program,” “manual response,” and “repeating voice alert,” whereas in this proceeding the Petition does not propose an express construction for these terms. Pet. 19.

Contrary to Patent Owner’s arguments, the applicable provisions of 37 C.F.R. §§ 42.104(b)(3), 42.11, and 11.18(b)(2) do not require Petitioner to express its subjective belief regarding the correctness of its proposed claim constructions. See *Western Digital Corp. v. SPEX Techs, Inc.*, IPR2018–00084, Paper 14, slip op. at 10–12 (PTAB April 25, 2018) (rejecting the same argument made here, and distinguishing *Toyota Motor Corp. v. Blitzsafe Texas LLC*, IPR2016–00422, Paper 12 (PTAB July 6, 2016)). Moreover, the standards used for claim construction and the burdens of proof are different in the district court than they are in this AIA proceeding, such that different constructions may be appropriate depending on the context. In district court proceedings, claims in issued patents are construed using the framework set forth in *Phillips v. AWH Corp.*, which emphasizes considering the plain meaning of the claim terms in light of the intrinsic record. *In re CSB-Sys. Int’l, Inc.*, 832 F.3d 1335, 1341 (Fed. Cir. 2016) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–15 (Fed. Cir. 2005) (en banc)). In this AIA proceeding, however, we must apply the broadest reasonable construction consistent with the specification, otherwise known as “BRI.” See *Cuozzo Speed Tech., LLC v. Lee*, 136 S. Ct. 2131 (2016) (affirming the use of broadest reasonable construction standard in

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AIA proceedings despite the possibility of inconsistent results in district court litigation).

In addition, Fed. R. Civ. P. 8(d)(3) allows a party to take different, alternative, or even inconsistent positions. *See Bancorp Services v. Sun Life Assur. Co. of Canada*, 687 F.3d 1266, 1280 (Fed. Cir. 2012) (citing Fed. R. Civ. P. 8(d)(3), and holding the party was entitled to take inconsistent positions); *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010) (claims are indefinite, and in the alternative, anticipated); *Nippon Suisan Kaisha Ltd. v. Pronova Biopharma Norge, AS*, PGR2017–0033, Paper 7 (Jan. 17, 2018) (instituting review of alternative positions of indefiniteness and anticipation/obviousness).

Here, Petitioner proposes that the claim terms written in means-plus-function format should be construed under 35 U.S.C. § 112(6), and for each such term Petitioner identifies a specified function and cites to portions of the Specification that Petitioner asserts provide disclosure of corresponding structure. Pet. 9–12.

For the reasons stated above, we decline to deny the Petition for failure to comply with 37 C.F.R. §§ 104(b)(3), 42.11, and 11.18(b)(2) on the grounds requested by Patent Owner.

C. Kubala (Ex. 1005)

Kubala generally discloses a method, system, apparatus, or computer program product for processing electronic messages. Ex. 1005 ¶ 9. Kubala explains that employee productivity may suffer demonstrably in proportion to the number of email messages the employee receives. *Id.* ¶ 5. This is due in part to the high volume of emails an employee may receive, because the task of responding to emails messages consumes an increasingly larger portion of the employee’s workday. *Id.* ¶ 5. To address these issues,

Kubala states that “it would be advantageous to provide productivity enhancing features within e-mail applications for the handling of email messages so that important messages receive the appropriate attention from the recipient of an e-mail message.” *Id.* ¶ 8.

Kubala specifically discloses computing devices such as network-enabled phones and PDAs that directly transfer data between each other across wireless links. *Id.* ¶ 27. The devices include email application software that facilitates email communication between devices, wherein the email software 206 includes enhanced functionality. *Id.* ¶ 35. One of the enhanced features is mandatory response functional unit 210 that operates to request that an outgoing email message be flagged as requiring a mandatory response from the email recipient. *Id.* Enhanced email application 206 relies on functional unit 210 to either assist in generation of the outgoing email message or perform the modifications necessary to flag the outgoing message as requiring a mandatory response. *Id.* Kubala discloses, for example, that email message 214 may contain mandatory response flag 216 indicating to the enhanced email application on the recipient computing device that email message 214 should be handled as an important message requiring a mandatory response. *Id.* Kubala discloses that mandatory response flag 216 may be implemented in a variety of data formats. *Id.*

D. Hammond (Ex. 1006)

Hammond generally discloses a system for enhancing the reliability of communicating with electronic messages. Ex. 1006, [57]. Hammond explains that electronically communicated messages such as email, paging messages, and voice mail have become increasingly pervasive. *Id.* at 1:13–15. According to Hammond, although initial distribution of electronic messages by a sender is quick and convenient, ensuring that a message is

received and reviewed by a recipient within a certain timeframe can be inconvenient. *Id.* at 1:21–26. Hammond addresses these issues by disclosing a system that sends an electronic message to designated recipients, and automatically helps ensure that each message has been received and reviewed by the recipient. *Id.* at 2:1–5. If receipt is not confirmed within a certain specified timeframe, the system can automatically resend the electronic message or take other appropriate action. *Id.* at 2:5–8.

In one embodiment, the disclosed system includes a Message Review Server (“MRS”) that sends electronic messages to designated recipients, and automatically helps ensure that each message has been received and reviewed. *Id.* at 3:1–5. The MRS also allows the sender of an electronic message to specify message delivery information that specifies actions to take when a message is not delivered within a specified timeframe. *Id.* at 3:12–15. For example, the sender can specify that if receipt notification is not received within a specified time period, the message will be resent to the recipient. *Id.* at 3:15–18. Message delivery information can also specify frequency or duration options, such as an option to resend a message every two hours. *Id.* at 3:18–22.

In one embodiment, Kubala discloses that use of the MRS system begins when a sender of an electronic message supplies a message to a Message Sender component. Ex. 1006, 4:48–51. The sender supplies the message, identifies one or more recipients for the message, and specifies various optional message tracking information (e.g., message delivery information, message review information, and message post-review information). *Id.* at 4:51–56. A sender also can supply delivery information such as a resend period of time and can optionally supply other resend

options. *Id.* at 4:56–60. The system also includes a Message Receipt Tracker component that attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients. *Id.* at 5:17–20.

E. Johnson (Ex. 1007)

Johnson generally discloses a method and system having a plurality of enrolled users and electronic mail objects that may be transmitted and received between users. Ex. 1007, [57]. The method and system include designating an electronic mail object as requiring a specific response and transmitting the electronic mail object to a recipient. *Id.* The recipient of the electronic mail object is prompted for a specific response when the recipient opens the electronic mail object and is prohibited from performing other actions until the required specific response is entered by the recipient. *Id.*

F. Pepe (Ex. 1008)

Pepe generally discloses a personal communications internetwork (“PCI”) that provides a network subscriber with the ability to remotely control receipt and delivery of wireless and wireline voice and text messages. Ex. 1008, 3:45–48. The PCI operates as an interface between various wireless and wireline networks, and also performs media translation where necessary. *Id.* at 3:48–51. The PCI permits the subscriber to send and receive messages between disparate networks and messaging systems. *Id.* at 5:56–59. A database maintains the subscriber’s message receipt and delivery options. *Id.* at 3:51–54.

G. Principles of Law on Obviousness

Section 103(a) forbids issuance of a patent when “the differences

between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Court set out a framework for applying the statutory language of § 103. Under § 103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art resolved.

The Supreme Court has made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415 (2007). Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *KSR Int’l Co.*, 550 U.S. at 417. Reaching this conclusion, however, requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Id.*

H. Patentability Analysis

As noted above, Petitioner contends claims 1 and 3–9 of the ’970 patent are unpatentable under 35 U.S.C. §103 as obvious over various combinations of Kubala, Hammond, Johnson, Pepe, and Banerjee. Pet. 12. Claims 1 and 6 are independent.

a. Obviousness over Kubala and Hammond

Claim 1

Petitioner relies on Kubala for disclosure of claim 1, but asserts that to the extent Patent Owner argues Kubala does not disclose limitations 1.7 and 1.8, Hammond provides the missing disclosure. Pet. 23–40. Patent Owner argues that Kubala is not prior art and that the Petition is deficient for failing to set forth constructions Petitioner *believes* to be correct, both discussed above. *Supra* Sections I.E and II.B.3. Patent Owner also argues that Petitioner has not provided sufficient rationale to combine Kubala and Hammond. Prelim. Resp. 31–34. Patent Owner also argues that Petitioner has not shown Kubala discloses limitations 1.5 and 1.6. *Id.* at 34–40. Patent Owner does not otherwise dispute Petitioner’s contentions as to claim 1.

We have reviewed Petitioner’s arguments and evidence, and we 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.

i. rationale to combine Kubala and Hammond

Petitioner relies primarily on Kubala as disclosing the limitations of claim 1. However, for limitations 1.7 and 1.8, Petitioner argues that to the extent it is argued that Kubala does not teach these limitations, Hammond does. Pet. 33–40. For example, with regard to limitation 1.7, Petitioner argues that to the extent it is argued that Kubala does not disclose automatically acknowledging receipt of a forced message alert, Hammond discloses tracking tables for tracking acknowledgement receipts. Pet. 33. Petitioner argues a skilled artisan would have been motivated to combine Kubala with Hammond because Kubala discloses that it was known to provide return receipts and record details about responses to emails having

mandatory response flags, and Hammond discloses tracking such receipts.

Pet. 34–35.

Patent Owner does not identify any particular combination proposed by Petitioner, but rather argues generally that a skilled artisan would not have been motivated to combine Kubala and Hammond on grounds that they relate to different technological fields. Prelim. Resp. 32–34. In particular, Patent Owner argues that in Hammond the device sending messages is a server, rather than a device such as the “first device” recited in claim 1. *Id.* at 34. We do not find this argument persuasive, however, because Hammond states that the sender of the electronic message may be a server computer *or another computer attached to network 140*. Ex. 1006, 4:48–51.

We find that Petitioner has made a sufficient showing of a rationale to combine Kubala with Hammond.

ii. “[1.2] data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations”

Petitioner argues that the structure corresponding to the function specified in this limitation is a server that communicates according to certain enumerated messaging protocols. *Supra* Section II.B.2.a; Pet. 10. However, as we discussed above, we disagree with Petitioner’s construction and determine that the pertinent corresponding structure is “a data transmission network such as the Internet, and equivalents thereof.” *Supra* Section II.B.2.a. Although Petitioner’s proposed construction differs from ours, Petitioner nonetheless sets forth a sufficient showing for this limitation. Petitioner argues that the server in Kubala communicates according to, *inter alia*, peer-to-peer communications (e.g., WiFi or WiMax) or other messaging protocols (e.g., SMS or TCP/IP). Pet. 25. In addition, Petitioner

argues that the asserted PDA/cell phones in Kubala communicate with one another using, for example, “Transport Control Protocol/Internet Protocol (TCP/IP)” or WiFi technology (IEEE 802.11), *id.*, both of which teach or suggest transmission of data between the asserted PDA/cell phones over a data transmission network such as the Internet. Patent Owner does not provide any arguments regarding this limitation beyond its arguments that the Petition fails to set forth a sufficient statement of how this term should be construed, discussed above. *Supra* Section II.B.3.

For the foregoing reasons, we find that Petitioner has made a sufficient showing as to limitation 1.2.

iii. “[1.5] 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 acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone”

Petitioner argues that the structure in Kubala corresponding to the recited means in limitation 1.5 is the enhanced email application software installed on Kubala’s computing device. Pet. 28. According to Petitioner, the enhanced email application software performs the functions specified in limitation 1.5. *Id.* For disclosure of a voice or text message, Petitioner relies on Kubala’s disclosure that e-mail message 214—i.e., the message transmitted from the asserted PDA/cell phone to the asserted recipient PDA/cell phone—may be a text message, audio message, video message, or other type of message. *Id.* at 29 (citing Ex. 1005 ¶ 32). For disclosure of a

forced message alert software packet, Petitioner relies on Kubala's mandatory response flag 216. *Id.* at 28-29. Petitioner argues that this flag is attached to email message 214, and "may be implemented in a variety of data formats." *Id.* at 28-29 (quoting Ex. 1005 ¶ 35 and citing *id.* ¶¶ 36, 41, 54-61). For disclosure of "a list of possible required responses," Petitioner relies on menu 1120 displayed on the recipient device, which is shown in the exemplary embodiment in Figure 11C to include as responses, "too busy right now," "looks okay," and "request declined." *Id.* at 29 (citing Ex. 1005 ¶¶ 22, 47, 57, Fig. 11C). Petitioner argues Kubala teaches or suggests attaching the asserted list of possible responses, e.g., text strings such as "too busy right now" that are used as menu items, to the asserted forced message alert software packet, i.e., flag 216, based on Kubala's disclosure that the responses may be "extracted from the original e-mail message that was received from the sender." *Id.* (quoting Ex. 1005 ¶ 57, and citing *id.* ¶¶ 40-41).

For disclosure of "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 PDA/cell phone," Petitioner relies on Kubala's disclosure that it was known in the art

to generate return receipts to the sender when the sender's email 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.

Pet. 30 (quoting Ex. 1005 ¶ 6).

Patent Owner raises two contentions as to limitation 1.5. First, Patent Owner contends that Kubala does not disclose a "forced message alert

software packet,” on the grounds that Petitioner has not explained how Kubala’s flag 216 constitutes this claimed feature. Prelim. Resp. 35. Patent Owner argues that flag 216 is “merely a single line of text” added to either a standard header or body of an email, and therefore is part of the email. *Id.* According to Patent Owner, Petitioner has not shown that “an email may constitute a ‘forced message [alert] software packet.’” *Id.* For reasons discussed below, we are not persuaded that Kubala’s flag 216 is *part of* the asserted voice or text message, and therefore cannot be a packet that is *attached* to a voice or text message, as required by limitation 1.5.

First, we are not persuaded at this stage that a header of an email necessarily forms part of the message, and therefore cannot be attached to the message. The Specification does not define the term “forced message alert software packet.” This term, or a very near version of it, appears only twice in the Specification. The Specification states that a “forced voice alert is comprised of a text or voice message, wherein said voice alert is comprised of a text or voice message file and a forced alert software packet.” Ex. 1001, 2:11–13. The Specification also states that when a recipient PDA/cell phone identifies a received transmission as a forced message alert, the forced message alert software application program on the recipient PDA/cell phone separates the text or voice message and the forced message alert software packet. *Id.* at 8:20–25. Aside from describing forced [message] alert software packets as being attachable to, and separable from, a voice or text message, the Specification does not describe these packets. Similarly, the Specification does not define the terms “text message” and “voice message.” The Specification describes creating, sending, and receiving such messages, but does not define the boundary as to where the message ends, and other, attached, information begins. However, the

Specification indicates that the *message* is information that is typed or recorded by a user. For example, the Specification explains that “[t]he sender can . . . type a text message or record a voice message.” Ex. 1001, 7:47–49. The text or voice message does not include, for example, the intended recipient(s), because selection of the recipient(s) is performed in a step that is distinct from creating the voice or text message. “Once the sender types a text message or records a voice message . . . the sender can then use a soft switch or selection from a list to send the forced alert to,” for example, another network participant or a predefined list of network participants. *Id.* at 7:49–56. Based on disclosure such as this, we find that, although the Specification does not use the term “body,” the text or voice message described in the Specification essentially is the body of the forced alert message. Therefore, we are not persuaded that the header information in Kubala is necessarily part of the message. Rather, it may be considered to be attached to the message.

Our preliminary finding is supported, for example, by one of the references relied on by Petitioner that describes the “Internet email message format” defined by RFC 5322, stating that Internet email messages consist of a message header and message body. Ex. 1017, 4. This reference further states that the header is structured into fields that provide information about the email, and that the body *contains the message*. *Id.*

We are persuaded, therefore, that the body of the email in Kubala forms a message, and the header information in Kubala comprises information that is *attached* to the message.

Also, we disagree with Patent Owner’s characterization of Kubala’s flag 216 as a *standard* email header. Prelim. Resp. 35. In its argument, Patent Owner characterizes Kubala’s e-mail header insertion process as

“changing a binary text string value in a data field of a *standard* email header from ‘0’ to ‘1.’” *Id.* (emphasis added). Contrary to Patent Owner’s characterization, Kubala expressly discloses that the header at issue is *non-standard*. Kubala discloses that email message headers provide information including about the manner in which messages should be handled or processed. Ex. 1005 ¶ 37. Kubala states that *non-standard* headers are required to commence with the string “X-” in order to indicate their non-standard nature. *Id.* Kubala depicts flag 216 as being non-standard. Flag 216, in one non-limiting embodiment, is implemented as header 304, which commences with the string “X-,” as shown in Figure 3. *Id.* at Fig. 3. Kubala, therefore, unambiguously discloses flag 216 as a *non-standard* header.

Furthermore, Kubala discloses that e-mail application 206 has been enhanced to include mandatory response functional unit 206 to allow users to flag e-mail messages as requiring a mandatory response. Ex. 1005 ¶ 35. This enhanced functionality is described as being part of the “invention.” *Id.* ¶ 35 (“The present invention addresses this need by enhancing the functionality of an e-mail application in the following manner. A user of e-mail application 206, which contains mandatory response functional unit 210, operates e-mail application 206 to request that an important outgoing e-mail message is flagged.”). This further supports a finding that flag 216, which requires a mandatory response, is non-standard.

Also, Patent Owner’s criticism of Kubala focuses on a non-limiting embodiment relating to an e-mail message having a header and a body, such as a message compliant with RFC 2882. Prelim. Resp. 35; Ex. 1005 ¶ 37. However, Kubala’s disclosure is not limited to e-mail messages of this format. As Petitioner points out, Kubala states that the term “e-mail

message” comprises “various types of electronic messages, e.g., text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages; the present invention is applicable to various types of electronic communication applications and/or devices within which the various types of electronic messages can be processed.” Ex. 1005 ¶ 32; Pet. 29 (citing *id.*).

Although we are persuaded that flag 216, when in an email header, is attached to a message, we note that neither party proposes a construction for the term “packet,” or explains whether a flag as taught by Kubala is a “packet.” The Specification does not define this term. During trial, the parties should provide their proposed construction for the term “packet.” Given the lack of description of this term in the Specification, the parties should consider whether a definition from a technical dictionary would be helpful to show how the term was used in the art.

Patent Owner’s second contention is that Petitioner has not shown that Kubala discloses “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 PDA/cell phone,” as recited in limitation 1.5. Prelim. Resp. 36. Patent Owner argues that to satisfy this limitation, Petitioner relies on Kubala’s description of solutions prior to Kubala’s alleged invention that involved sending a return receipt to the sender of an e-mail when such e-mail is received by a recipient. *Id.* at 37 (citing Ex. 1005 ¶ 6). According to Patent Owner, the alleged invention of Kubala, involving an enhanced e-mail application that inserts a mandatory response flag into messages, was intended to be a solution to problems that arose from the prior return receipt method. *Id.* Patent Owner argues that Kubala, therefore, teaches against use

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of return receipts. *Id.*

We disagree that Kubala teaches against the use of return receipts. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 53 (Fed. Cir. 1994). Kubala does not discourage the use of return receipts. Kubala describes “[p]roductivity-enhancing features” that were “added to e-mail applications to assist workers in handling the larger workload that is represented by the larger volume of e-mail.” Ex. 1005 ¶ 6. Kubala discloses that one such feature was generation of return receipts, the benefit of which was to provide the sender of an email with an acknowledgement that the email had been received by the intended recipient. *Id.* ¶ 7. Kubala states, however, that there still existed a need to provide features that reduce the amount of time it takes for an email recipient to generate a response to a received email. *Id.* Kubala addresses this alleged need by including indication that a message requires action by the recipient, and by preventing an email recipient from closing review of, deleting, or exiting the received e-mail message until the recipient has responded to the email message. *Id.* ¶ 9.

We do not discern any teaching in Kubala of an incompatibility between using both features, namely a return receipt notifying a sender that a message has been received, and flagging a message so that it requires a mandatory response from the recipient. Contrary to Patent Owner’s argument that a skilled artisan would have been discouraged from using a return receipt, Petitioner’s expert, Mr. Williams, describes an additional, well-known benefit of a return receipt. Ex. 1003 ¶ 103. He explains that at the time, email systems were not completely reliable, and there was

uncertainty as to whether, and if, an email message would “get through” to a recipient. *Id.* He states that it would have been obvious, therefore, to include a return receipt to provide the sender with confirmation that the email message has been received by the recipient. *Id.* Therefore, we are not persuaded that Kubala teaches away from use of a return receipt.

For the foregoing reasons, we find that Petitioner has made a sufficient showing as to limitation 1.5.

iv. “[1.6] means for requiring a required manual response from the response list by the recipient in order to clear the recipient’s response list from recipient’s cell phone display”

For disclosure of the structure corresponding to the means specified in limitation 1.6, Petitioner relies on Kubala’s disclosure of enhanced email application 206 installed on Kubala’s PDA. Pet. 30–31. As to the recited function of requiring a manual response by the recipient from the response list in order to clear the response list from the recipient’s cell phone display, Petitioner relies in part on Figure 11C of Kubala. Petitioner relies on disclosure that menu 1120 in this Figure includes a list of possible responses from which a recipient can choose, and argues that this list is a “response list” as recited in limitation 1.6. *Id.* at 31. Figure 11C is reproduced below.

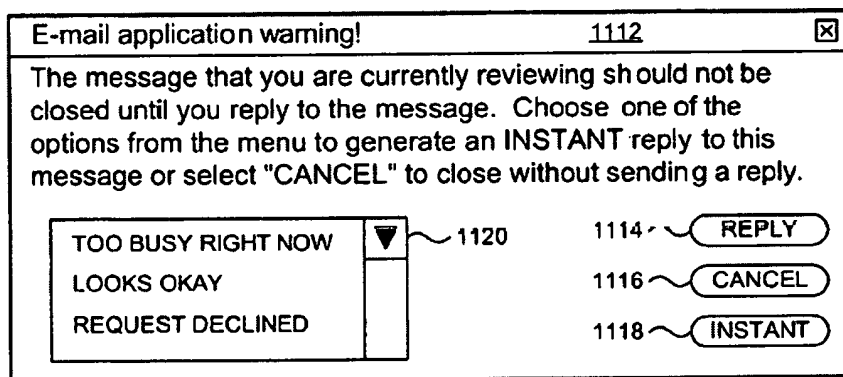


FIG. 11C

Ex. 1005, Fig. 11C. Figure 11C, shown above, illustrates GUI display

window 1112 that is displayed on a recipient device if a user attempts to close an email without replying to it. *Id.* ¶ 57. Window 1112 contains an error message informing the recipient that a reply is needed before closing the email. Window 1112 also includes menu 1120 comprising a list of responses from which a recipient can select a response to provide to the sender. *Id.* Window 1112 also includes CANCEL button 1116, which allows a user to close an email message without creating and sending a response message to the sender. *Id.*

Patent Owner argues that Kubala does not disclose limitation 1.6 because window 1112, e.g., the asserted display, is not cleared *only in response to a manual selection of a required response*. Prelim. Resp. 40. Rather, Kubala discloses that a user may clear window 1112 by “simply closing the email or exiting the application,” according to Patent Owner. *Id.* Petitioner agrees that Figure 11C shows a user can select CANCEL to close window 1112 without manually selecting a response from those listed in menu 1120. Pet. 31. However, for a limitation similar to limitation 1.6, Petitioner also points to Figure 11A of Kubala, which depicts a different message in GUI window 1102, which states “[t]he message that you are currently viewing should not be closed until you reply to the message.” *Id.* at 46 (citing Ex. 1005, Fig. 11A). We are persuaded that this teaches requiring a manual response from a recipient in order to clear window 1112. And, as discussed above, Figure 11C teaches presenting a user with menu 1120 listing responses from which a user can select a response to send to the sender to satisfy the requirement that the recipient provide a mandatory response. Ex. 1005 ¶ 57. The features of these two windows are not mutually exclusive. Kubala explains that Figures 11A–11D represent a set of GUI windows through which the email application alerts a user by

displaying warning and error messages, and that “[o]ther scenarios could be handled in different ways that are not illustrated within FIGS. 11A–11D.”

Ex. 1005 ¶ 54. Kubala further discloses that each “would represent a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.” *Id.* We are persuaded that disclosure such as these teaches or suggests “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,” as recited in limitation 1.6.

For the foregoing reasons, we find that Petitioner has made a sufficient showing as to limitation 1.6.

v. Summary

On this record, for the reasons stated above, we are persuaded Petitioner has demonstrated a reasonable likelihood it would prevail in showing claim 1 is unpatentable under § 103 as obvious over the combination of Kubala and Hammond.

b. Obviousness over Hammond, Johnson, and Pepe

As we discussed above, Petitioner asserts that claims 1 and 3–9 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Hammond, Johnson, and Pepe. Pet. 12. In addition to arguments relating to the sufficiency of Petitioner’s proposed claim constructions, discussed above, Patent Owner argues that Petitioner has not shown sufficient rationale to combine the asserted references, and has not shown the combination teaches limitations 1.2, 1.5, and 1.6. We discuss rationale to combine and limitation 1.5, below.

i. rationale to combine Hammond, Johnson and Pepe

Petitioner provides its rationale for combining Hammond, Johnson, and Pepe in its argument for limitation 1.1, and cites to this rationale in its arguments for the remaining limitations of claim 1. Petitioner's rationale is less than one page. Pet. 56–57. Petitioner explains that each of these references is directed to sending and receiving electronic messages. *Id.* at 56. Hammond and Johnson each describe electronic messaging, and systems and methods for requiring responses and tracking responses, but do not expressly describe using cellular phones for such messaging. *See, e.g., supra* Sections II.D and II.E (describing Hammond and Johnson). Pepe does not describe forced responses, but Pepe discloses using PDA's and cell phones for electronic messaging. *See, e.g., supra* Section II.F (describing Pepe). Petitioner argues that a skilled artisan would have been motivated to combine Pepe with Hammond and/or Johnson, because the latter references describe wireless RF as a transmission medium, and disclose that electronic messages may be in the form of text or voice. Pet. 56. At this stage, we are not persuaded that this provides sufficient rationale to combine across all limitations of claim 1.

For example, for limitation 1.6, which recites a means for requiring a required manual response by a recipient, Petitioner argues that Johnson discloses the specified function, and Pepe discloses the corresponding structure. Pet. 61. As to corresponding structure, Petitioner relies on Pepe's disclosure of application software installed on the asserted PDA/cell phone. *Id.* However, as we discussed above with regard to claim construction, Petitioner must identify an algorithm corresponding to the specified function. 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. 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.

- i. “[1.5] means for attaching a forced message alert software packet to a voice or text message . . .”

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.*

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated there is a reasonable likelihood it would prevail in establishing claim 1 of the ’970 patent is unpatentable under 35 U.S.C. § 103 as obvious over the combination of Kubala and Hammond. Because Petitioner has satisfied the threshold for institution as to at least one claim, we institute *inter partes* review on all claims and all grounds raised in the Petition. *See*

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SAS Institute Inc. v. Iancu, 138 S. Ct. 1348, 1359–60 (2018) (holding that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition).

IV. ORDER

Accordingly, it is

ORDERED that an *inter partes* review is hereby instituted as to all challenged claims and all grounds raised in the Petition; and

FURTHER ORDERED that *inter partes* review of the '970 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00516-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Apple, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00517-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT ZTE Corporation , et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
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DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00514-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT HTC Corporation
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
--	---

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00513-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Huawei Device USA Inc., et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00515-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT LG Electronics, inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

TO: <p style="text-align: center;">Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450</p>	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00514-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT HTC Corporation
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above--entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
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In the above--entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
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TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00516-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Apple, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

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Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00513-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Huawei Device USA Inc., et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 2:17-cv-00515-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT LG Electronics, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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2 9,408,055	August 2, 2016	AGIS Software Development LLC
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Trademarks or Patents. (the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 2:17-cv-00517-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT ZTE Corporation , et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
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PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy



APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/324,122	07/03/2012	8213970	10963.3819	9036

22235 7590 06/13/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment is 367 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;

PART B - FEE(S) TRANSMITTAL

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 or Fax (571)-273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

22235 7590 04/25/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
 1936 S ANDREWS AVENUE
 FORT LAUDERDALE, FL 33316

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
Filed Electronically
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/324,122	11/26/2008	Malcolm K. Beyer JR.	10963.3819	9036

TITLE OF INVENTION: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$870	\$300	\$0	\$1170	07/25/2012

EXAMINER	ART UNIT	CLASS-SUBCLASS
LEBASSI, AMANUEL	2617	455-424000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
 "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 MALIN HALEY DIMAGGIO
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 BOWEN & LHOTA, P.A.
 3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE: Advanced Ground Information Systems, Inc. (B) RESIDENCE: (CITY and STATE OR COUNTRY) Jupiter, Florida

Please check the appropriate assignee category or categories (will not be printed on the patent): Individual Corporation or other private group entity Government

4a. The following fee(s) are submitted:

- Issue Fee
 Publication Fee (No small entity discount permitted)
 Advance Order - # of Copies 10

4b. Payment of Fee(s); (Please first reapply any previously paid issue fee shown above)

- A check is enclosed.
 Payment by credit card. Form PTO-2038 is attached.
 The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number 13-1130 (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature /barry l. haley/ Date May 24, 2012
 Typed or printed name Barry L. Haley Registration No. 25,339

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Electronic Patent Application Fee Transmittal

Application Number:	12324122
Filing Date:	26-Nov-2008
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Filer:	Barry Lee Haley/Amy Allen
Attorney Docket Number:	10963.3819

Filed as Small Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Utility Appl issue fee	2501	1	870	870

Extension-of-Time:

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Printed copy of patent - no color	8001	10	3	30
Total in USD (\$)				900

Electronic Acknowledgement Receipt

EFS ID:	12854129
Application Number:	12324122
International Application Number:	
Confirmation Number:	9036
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Customer Number:	22235
Filer:	Barry Lee Haley/Amy Allen
Filer Authorized By:	Barry Lee Haley
Attorney Docket Number:	10963.3819
Receipt Date:	24-MAY-2012
Filing Date:	26-NOV-2008
Time Stamp:	11:11:08
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$900
RAM confirmation Number	10940
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Issue Fee Payment (PTO-85B)	10_IssueFeeTransmittal.pdf	141692 <small>3f2c967da2a77726b3f472de20f7a91a3927b82f</small>	no	1

Warnings:**Information:**

2	Fee Worksheet (SB06)	fee-info.pdf	31994 <small>61febb4bd13c1ffac7c44e4236805f9ab3e08db3</small>	no	2
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Warnings:**Information:**

Total Files Size (in bytes):	173686
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Electronic Patent Application Fee Transmittal

Application Number:	12324122
Filing Date:	26-Nov-2008
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Filer:	Barry Lee Haley/Amy Allen
Attorney Docket Number:	10963.3819

Filed as Large Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Publ. Fee- early, voluntary, or normal	1504	1	300	300

Extension-of-Time:

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				300

Electronic Acknowledgement Receipt

EFS ID:	12858491
Application Number:	12324122
International Application Number:	
Confirmation Number:	9036
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Customer Number:	22235
Filer:	Barry Lee Haley/Amy Allen
Filer Authorized By:	Barry Lee Haley
Attorney Docket Number:	10963.3819
Receipt Date:	24-MAY-2012
Filing Date:	26-NOV-2008
Time Stamp:	15:16:58
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$300
RAM confirmation Number	1651
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Fee Worksheet (SB06)	fee-info.pdf	30373 ca3132211ac0f96780f83e7d56a7c5bc840aa8d1	no	2

Warnings:**Information:**

Total Files Size (in bytes):	30373
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

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National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



NOTICE OF ALLOWANCE AND FEE(S) DUE

22235 7590 04/25/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

Table with 2 columns: EXAMINER (LEBASSI, AMANUEL), ART UNIT, PAPER NUMBER

2617
DATE MAILED: 04/25/2012

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.

12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963.3819 9036
TITLE OF INVENTION: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

Table with 7 columns: APPLN. TYPE, SMALL ENTITY, ISSUE FEE DUE, PUBLICATION FEE DUE, PREV. PAID ISSUE FEE, TOTAL FEE(S) DUE, DATE DUE

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 or Fax (571)-273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

22235 7590 04/25/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
 1936 S ANDREWS AVENUE
 FORT LAUDERDALE, FL 33316

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

_____ (Depositor's name)
_____ (Signature)
_____ (Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963.3819 9036

TITLE OF INVENTION: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
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nonprovisional YES \$870 \$300 \$0 \$1170 07/25/2012

EXAMINER	ART UNIT	CLASS-SUBCLASS
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LEBASSI, AMANUEL 2617 455-424000

<p>1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).</p> <p><input type="checkbox"/> Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.</p> <p><input type="checkbox"/> "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.</p>	<p>2. For printing on the patent front page, list</p> <p>(1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 _____</p> <p>(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 _____</p> <p>3 _____</p>
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3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE _____ (B) RESIDENCE: (CITY and STATE OR COUNTRY) _____

Please check the appropriate assignee category or categories (will not be printed on the patent) : Individual Corporation or other private group entity Government

<p>4a. The following fee(s) are submitted:</p> <p><input type="checkbox"/> Issue Fee</p> <p><input type="checkbox"/> Publication Fee (No small entity discount permitted)</p> <p><input type="checkbox"/> Advance Order - # of Copies _____</p>	<p>4b. Payment of Fee(s); (Please first reapply any previously paid issue fee shown above)</p> <p><input type="checkbox"/> A check is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).</p>
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5. Change in Entity Status (from status indicated above)

a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
Values: 12/324,122, 11/26/2008, Malcolm K. Beyer JR., 10963.3819, 9036

22235 7590 04/25/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

LEBASSI, AMANUEL

ART UNIT PAPER NUMBER

2617

DATE MAILED: 04/25/2012

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)

(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 254 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 254 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Notice of Allowability

Application No.

12/324,122

Examiner

AMANUEL LEBASSI

Applicant(s)

BEYER, MALCOLM K.

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

- 1. This communication is responsive to 09/09/2011.
- 2. An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 3. The allowed claim(s) is/are 2-14.
- 4. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some* c) None of the:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. ____ .
 - 3. Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: ____.

Applicant has **THREE MONTHS FROM THE "MAILING DATE"** of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in **ABANDONMENT** of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

- 5. A **SUBSTITUTE OATH OR DECLARATION** must be submitted. Note the attached **EXAMINER'S AMENDMENT** or **NOTICE OF INFORMAL PATENT APPLICATION (PTO-152)** which gives reason(s) why the oath or declaration is deficient.
 - 6. **CORRECTED DRAWINGS** (as "replacement sheets") must be submitted.
 - (a) including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) hereto or 2) to Paper No./Mail Date ____.
 - (b) including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date ____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
- 7. **DEPOSIT OF and/or INFORMATION** about the deposit of **BIOLOGICAL MATERIAL** must be submitted. Note the attached Examiner's comment regarding **REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL**.

Attachment(s)

- 1. Notice of References Cited (PTO-892)
- 2. Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3. Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date ____
- 4. Examiner's Comment Regarding Requirement for Deposit of Biological Material
- 5. Notice of Informal Patent Application
- 6. Interview Summary (PTO-413), Paper No./Mail Date ____ .
- 7. Examiner's Amendment/Comment
- 8. Examiner's Statement of Reasons for Allowance
- 9. Other ____.

/A. L./
Examiner, Art Unit 2617

4/17/2012

DETAILED ACTION
EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with **Attorney Barry L. Haley Reg. No. 25,339** on **4/17/2012**.

The application has been amended as follows:

1. (Cancelled)

2. (Currently Amended) 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 ~~PC or~~ 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 PCs and~~ said PDA/cell phones in different locations;
 - a sender ~~PC or~~ PDA/cell phone and at least one recipient ~~PC or~~ PDA/cell phone for each electronic message;

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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 ~~PC or~~ 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 ~~PC or~~ PDA/cell phone to the recipient ~~PC or~~ 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 ~~PC or~~ PDA/cell phone to transmit an automatic acknowledgment to the sender ~~PC or~~ PDA/cell phone as soon as said forced message alert is received by the recipient ~~PC or~~ 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 ~~PCs or~~ PDA/cell phones have automatically acknowledged the forced message alert and which recipient ~~PCs or~~ PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient ~~PCs or~~ PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient ~~PCs or~~ PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient ~~PC or~~ PDA/cell phone that responded.

3. (Currently amended) The system as in claim 2, wherein the forced message alert software application program on the recipient ~~PC or~~ PDA/cell phone includes:

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means for transmitting the acknowledgment of receipt to said sender ~~PC or~~ PDA/cell phone immediately upon receiving a forced message alert from the sender ~~PC or~~ PDA/cell phone;

means for controlling of the recipient ~~PC or~~ PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient ~~PC or~~ PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient ~~PC or~~ PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender ~~PC or~~ PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient ~~PC or~~ PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient ~~PC or~~ PDA/cell phone once the manual response is transmitted.

4. (Previously presented) The system as in claim 2, wherein said data transmission means is TCP/IP or another communications protocol.

5. (Previously presented) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

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6. (Currently Amended) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender ~~PC or~~ PDA/cell phone.

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

accessing a forced message alert software application program on a sender ~~PC or~~ PDA/cell phone;

creating the forced message alert on said sender ~~PC or~~ 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 ~~PCs or~~ PDA/cell phones in the communication network;

electronically transmitting the forced message alert to said recipient ~~PCs or~~ PDA/cell phones;

receiving automatic acknowledgements from the recipient ~~PCs or~~ PDA/cell phones that received the message and displaying a listing of which recipient ~~PCs or~~ PDA/cell phones have acknowledged receipt of the forced message alert and which recipient ~~PCs or~~ PDA/cell phones have not acknowledged receipt of the forced message alert;

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periodically resending the forced message alert to the recipient ~~PCs or~~ PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient ~~PCs or~~ PDA/cell phones and displaying the response from each recipient ~~PC or~~ PDA/cell phone; and

providing a manual response list on the display of the recipient ~~PC or~~ 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.

8. (Currently Amended) The method as in claim 7, wherein each ~~PC or~~ PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

9. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. (Currently Amended) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender ~~PC or~~ PDA/cell phone.

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11. (Currently amended) A method of receiving, acknowledging and responding to a forced message alert from a sender ~~PC or~~ PDA/cell phone to a recipient ~~PC or~~ PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of: receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient ~~PC or~~ PDA/cell phone; transmitting an automatic acknowledgment of receipt to the sender ~~PC or~~ PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient ~~PC or~~ PDA/cell phone and show the content of the text message and a required response list on the display recipient ~~PC or~~ PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient ~~PC or~~ PDA/cell phone and show the required response list on the display recipient ~~PC or~~ PDA/cell phone; and transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient ~~PC or~~ PDA/cell phone and stop showing the content of the text message and a response list on the display recipient ~~PC or~~ PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient ~~PC or~~ PDA/cell phone;

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displaying the response received from the ~~PC or~~ PDA cell phone that transmitted the response on the sender of the forced alert ~~PC or~~ PDA/cell phone; and

providing a list of the recipient ~~PC or~~ PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message. 12. (Original)

12. (Currently amended) The method as in claim 11, wherein each ~~PC or~~ PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

13. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. (Currently amended) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender ~~PC or~~ PDA/cell phone.

Allowable Subject Matter

1. Claims 2-14 are allowed.
2. The following is an **examiner's statement of reasons for allowance:**

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The following is an examiner's statement of reasons for allowance: claims 2-14 have been found to be novel and the inventive because prior art record fails to show or teach 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.

2. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

1. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amanuel Lebassi, whose telephone number is (571) 270-5303. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached at (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Amanuel Lebassi
/A. L/
4/17/2012

/NICK CORSARO/
Supervisory Patent Examiner, Art Unit 2617

Search Notes 	Application/Control No. 12324122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.
	Examiner AMANUEL LEBASSI	Art Unit 2617

SEARCHED			
Class	Subclass	Date	Examiner
455	41.1, 416, 518, 519	9/9/2010	AL
455	41.3, 88, 404.2, 412.1, 412.2, 414.4 ,415 ,416, 418, 419, 420, 456.1, 456.3, 457, 458, 463	4/17/2012	AL
701	213, 482	4/17/2012	AL

SEARCH NOTES		
Search Notes	Date	Examiner
Inventor Search	9/9/2010	AL
Updated Search	4/17/2012	AL

INTERFERENCE SEARCH			
Class	Subclass	Date	Examiner
455	41.3, 88, 404.2, 412.1, 412.2, 414.4 ,415 ,416, 418, 419, 420, 456.1, 456.3, 457, 458, 463	4/17/2012	AL

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EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S100	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 13:14
S101	67	(Beyer near2 Jr\$1).in.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:29
S102	42	(Beyer near2 Jr\$1).in.	USPAT	ADJ	OFF	2012/04/17 15:29
S103	0	455/41.3, "88", "404.2", "412.1", "412.2", "414.4", "415", "416", "418", "419", "420", "456.1", "456.3", "457", "458", "463".ccls.	USPAT	ADJ	OFF	2012/04/17 15:54
S104	0	455/41.3,88,404.2,412.1,412.2,414.4 ",415,416,418,419,420,456"" ""1,456"" ""3,457,458,463".ccls.	USPAT	ADJ	OFF	2012/04/17 15:55
S105	11944	455/41.3,88,404.2,412.1,412.2,414.4,415,416,418,419,420,456.1,456.3,457,458,463.ccls.	USPAT	ADJ	OFF	2012/04/17 15:56
S106	756	(periodic\$4 same (resend\$3 or re-send\$3 or retransmit\$4)) and alert\$3	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:57
S107	268	S106 and (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:57
S108	180	((@prad < "20040921") or (@rlad < "20040921") or (@ad < "20040921")) and S107	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:57
S109	0	(forced near3 (alert\$4)) same (participat\$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:58

4/ 17/ 2012 6:13:24 PM

C:\Users\alebassi\Documents\EAST\Workspaces\12324122.wsp

Issue Classification 	Application/Control No. 12324122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.
	Examiner AMANUEL LEBASSI	Art Unit 2617

ORIGINAL						INTERNATIONAL CLASSIFICATION														
CLASS		SUBCLASS				CLAIMED					NON-CLAIMED									
455		466				H	0	4	W	4 / 00 (2009.01.01)										
CROSS REFERENCE(S)																				
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)																			
455	88	404.2	412.1	412.2	414.4															
455	415	416	418	419	420															
455	456.1	456.3	457	458	463															
455	500	517	518	519	556.2															
701	213	482																		

<input type="checkbox"/> Claims renumbered in the same order as presented by applicant <input type="checkbox"/> CPA <input type="checkbox"/> T.D. <input type="checkbox"/> R.1.47															
Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
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/AMANUEL LEBASSI/ Examiner.Art Unit 2617 (Assistant Examiner)	4/17/2012 (Date)	Total Claims Allowed: 13	
/NICK CORSARO/ Supervisory Patent Examiner.Art Unit 2617 (Primary Examiner)	04/19/2012 (Date)	O.G. Print Claim(s) 2	O.G. Print Figure Fig. 1a

EAST Search History

EAST Search History (Interference)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S110	12074	455/41.3,88,404.2,412.1,412.2,414.4,415,416,418,419,420,456.1,456.3,457,458,463.ccls.	USPAT; UPAD	ADJ	OFF	2012/04/17: 15:56
S111	0	S110 and (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).clm.	USPAT; UPAD	ADJ	OFF	2012/04/17: 15:57
S112	0	S110 and (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).clm.	USPAT; UPAD	AND	OFF	2012/04/17: 15:57
S113	0	S110 and (requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient'\$1 cell phone display).clm.	USPAT; UPAD	AND	OFF	2012/04/17: 15:57
S114	0	S110 and (requiring a required manual response from the response list by the recipient in order to clear recipient\$1 response list from recipient\$1 cell phone display).clm.	USPAT; UPAD	AND	OFF	2012/04/17: 15:57

4/ 17/ 2012 6:13:42 PM

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963.3819 9036

22235 7590 02/03/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

LEBASSI, AMANUEL

ART UNIT PAPER NUMBER

2617

NOTIFICATION DATE DELIVERY MODE

02/03/2012

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@mhdpatents.com

<i>Applicant-Initiated Interview Summary</i>	Application No. 12/324,122	Applicant(s) BEYER, MALCOLM K.	
	Examiner AMANUEL LEBASSI	Art Unit 2617	

All participants (applicant, applicant's representative, PTO personnel):

- (1) AMANUEL LEBASSI. (3) _____.
- (2) Attorney Barry L. Haley, Esq. (Reg. No. 25,339). (4) _____.

Date of Interview: 12/15/2011.

Type: Telephonic Video Conference
 Personal [copy given to: applicant applicant's representative]

Exhibit shown or demonstration conducted: Yes No.
If Yes, brief description: _____.

Issues Discussed 101 112 102 103 Others
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: _____.

Identification of prior art discussed: _____.

Substance of Interview

(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicant received an advisory instead of final office action. Therefore the examiner agreed the last office acti will be vacated.

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

Attachment

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.



UNITED STATES DEPARTMENT OF COMMERCE

U.S. Patent and Trademark Office

Address : COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
12/324,122	26 November, 2008	BEYER, MALCOLM K.	10963.3819

MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A. 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316	EXAMINER	
	AMANUEL LEBASSI	
	ART UNIT	PAPER
	2617	20120124

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Applicant received an advisory on 10/07/2011 instead of final action. The final rejection of 3/11/2011 should be entered as non final on edan. Therefore the previoius office action dated "03/11/2011" is hereby vacated.

Attached: Interview summary date "12/15/2011"

/Amanuel Lebassi/
Examiner, Art Unit 2617

/Nick Corsaro/ SPE AU2617



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963.3819 9036

22235 7590 10/07/2011
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

LEBASSI, AMANUEL

ART UNIT PAPER NUMBER

2617

NOTIFICATION DATE DELIVERY MODE

10/07/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@mhdpatents.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 12/324,122	Applicant(s) BEYER, MALCOLM K.
	Examiner AMANUEL LEBASSI	Art Unit 2617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 September 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) They raise new issues that would require further consideration and/or search (see NOTE below);

(b) They raise the issue of new matter (see NOTE below);

(c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The amendment of Independent claims 2, 7 and 11 raise new issues and require further search & considerations. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____

13. Other: _____.

/NICK CORSARO/ Supervisory Patent Examiner, Art Unit 2617	
--	--

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: BEYER, JR., Malcolm K.)
)
Serial No.: 12/324,122)
)
Filed: November 26, 2008)
)
Entitled: METHOD OF UTILIZING)
FORCED ALERTS FOR)
INTERACTIVE REMOTE)
COMMUNICATIONS)
_____)

Confirmation No: 9036
Group Art Unit: 2617
Examiner: LEBASSI, Amanuel

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

September 9, 2011
Filed Electronically

RESPONSE AND AMENDMENT

Dear Sir:

In response to the Office Action dated March 11, 2011, please amend the above referenced patent application as follows and consider the remarks below. This Response is filed within six months of the mailing date of the Office Action; therefore, a petition for a three-month extension of time is submitted herewith. In the event that any further extension of time is required, please consider this a request therefor. The Commissioner is authorized to charge any additional fees due or credit any overpayment to Deposit Account 13-1130.

Please amend the claims as shown on pages 2-7.

Remarks begin on page 8.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: BEYER, JR., Malcolm K.)	
)	
Serial No.: 12/324,122)	
)	Confirmation No: 9036
Filed: November 26, 2008)	
)	Group Art Unit: 2617
Entitled: METHOD OF UTILIZING)	
FORCED ALERTS FOR)	Examiner: LEBASSI, Amanuel
INTERACTIVE REMOTE)	
COMMUNICATIONS)	

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

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Please amend the claims as shown on pages 2-7.

Remarks begin on page 8.

CLAIM AMENDMENTS

Please amend the claims (~~strike through~~ indicating deletion and underline indicating insertion) as follows:

1. (Cancelled)

2. (Currently amended) 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 PC or 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 PCs and said PDA/cell phones in different locations;

a sender PC or PDA/cell phone and at least one recipient PC or 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 PC or 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 PC or PDA/cell phone to the recipient PC or PDA/cell phone, said forced message alert software packet containing a list of possible required responses ~~response list~~ and requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or 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 PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

3. (Currently amended) The system as in claim 2, wherein the forced message alert software application program on the recipient PC or PDA/cell phone includes:

means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone;

means for controlling of the recipient PC or PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the ~~force~~ forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PC or PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted.

4. (Previously presented) The system as in claim 2, wherein said data transmission means is TCP/IP or another communications protocol.

5. (Previously presented) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

6. (Previously presented) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

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

accessing a forced message alert software application program on a sender PC or PDA/cell phone;

creating the forced message alert on said sender PC or 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 PCs or PDA/cell phones in the communication network;

electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones;

receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert;

periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone; and

providing a manual response list on the display of the recipient PC or PDA/cell phone that can only be cleared by the recipient providing a required response from the list;

clearing the ~~receiver's~~ 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.

8. (Original) The method as in claim 7, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

9. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

11. (Currently amended) A method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message;

identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a required response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PC or PDA/cell phone and show the required response list on the display recipient PC or PDA/cell phone; and

transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, ~~whether said selected response is a chosen option from the response list,~~ causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone;

displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone; and

providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.

12. (Original) The method as in claim 11, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

13. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone

REMARKS

The Office Action mailed March 11, 2011 has been received and reviewed. By the present Response and Amendment, Claims 2, 3, 7 and 11 have been amended. No new matter is introduced. Claim 1 has been cancelled previously.

Claim Rejections – 35 U.S.C. § 103

The Examiner's rejection of Claims 2-10 under U.S.C. § 103(a) as being unpatentable over Keating et al. (US 2004/0082352) in view of Maggenti et al. (US 2002/0061762) is respectfully traversed.

The Keating (US 2004/0082352) reference describes an enhanced group call implementation having nothing to do with Applicant's claimed invention providing a forced message alert and requiring a specific response from a recipient selected from the prepared list of responses prior to the recipients display being cleared of the message and required response.

Figures 2 and 4 of Keating show flowcharts delineating the essence of the communication system disclosed in Keating. The flowcharts are described in detail in paragraphs 0022 and 0031 of Keating. There is no discussion or disclosure that would suggest the system and method recited in amended Claims 2, 7 and 11 concerning the initiation of a required response from a recipient which is automatically transmitted by the recipient's device and the requirement in response to the forced message alert that the recipient must respond with a particular answer selected from previously provided list of potential answers especially before the recipient's display screen can be cleared. In fact, Keating is concerned with the accurate billing that reflects specific time spent by the mobile station participating in a group call. See paragraph 0030 Keating. The purpose and function of the group calling system in Keating is

completely different than Applicant's claimed system and methods recited in the amended Claims 2, 7 and 11. The statement of the Examiner that "Keating discloses a forced message alert software application program" Applicant respectfully submits is incorrect and has a stretched interpretation of what is actually disclosed in Keating.

The Maggenti et al. (US 2002/0061762) reference discloses a method for sending a message to a communication device to determine whether the communication device wishes to be a participant and then lists the communication device as a participant if there is a response to a message within a predetermined time. See paragraphs 0010 and 0011. There is no teaching or disclosure of Applicant's claimed system and method in Maggenti et al.

The communication system recited in amended Claims 7 and 11 includes a forced message alert software system that requires a response from the recipient of a specific answer from a selected list before the recipient can clear the recipient's display. This is completely different in function and structure than a system asking whether a participant wants to stay as a participant in the net.

It is Applicant's position – even if a person of ordinary skill in the art were to combine the Keating reference with the Maggenti et al. reference, Applicant's claimed invention as recited in the amended Claims 2 and 7 at issue could not possibly result because of the lack of relevant disclosure in the references when combined. Therefore, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to Claims 2 - 10.

The Examiner's rejection of Claims 11 - 14 under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. (US 2004/0082352) in view of Dalton et al. (US 2004/0192365) is respectfully traversed.

The Dalton (US 2004/0192365) communication system is a completely different system than Applicant's claimed communication system and method recited in Claims 11 - 14. A key element in Dalton is a data concentrator computer with a gateway device for communicating with the data concentrator computer so that the gateway device provides communications data between a first mobile data acquisition device and a second mobile data acquisition device without communication with the data concentrator computer. Paragraphs 0010, 0014 and 0015 in Dalton describe a system to manage two or more mobile devices forming a business data collection and to communicate asynchronously in the operational needs of a business application. None of the functions described in the Dalton reference have anything to do with providing a forced message alert as required in Claims 11 - 14 as amended. Applicant reiterates the comments above with respect to the Keating reference. Again, the combination of Keating and Dalton cannot result in Applicant's claimed invention because the references together fail to suggest Applicant's claimed invention. It is Applicant's position that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claims 11 - 14.

As an initial matter, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP § 2143. A claim is obvious under 35 U.S.C. §103 if and only if the references relied on teach or suggest each and every element of the claimed invention, and it would be obvious to one skilled in the art to combine the references so relied on. A rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the

elements as claimed by known methods with no change in their respective known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007); see also, *KSR International Co. v. Teleflex Inc.*, 550 U.S. at 415-417 (2007) citing *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950), *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63 (1969), and *Sakraida v. AG Pro., Inc.*, 425 U.S. 273, 282 (1976).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. § MPEP 2141.02; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Additionally, an obviousness rejection cannot be based on a reference or combination of references that are non-analogous to the invention at issue. MPEP § 2141.01(a).

CONCLUSION

In view of the amendments submitted herein and the above comments, it is believed that all grounds of rejection are overcome and that the application has now been placed in full condition for allowance. Accordingly, Applicant earnestly solicits early and favorable action. Should there be any further questions or reservations, the Examiner is urged to telephone Applicant's undersigned attorney at (954) 763-3303.

Respectfully submitted,

/Barry L. Haley/
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PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) FY 2009 <i>(Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).)</i>		Docket Number (Optional) 10963.3819	
Application Number 12/324,122		Filed November 26, 2008	
For METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS			
Art Unit 2617		Examiner LEBASSI, Amanuel	
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.			
The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):			
		<u>Fee</u>	<u>Small Entity Fee</u>
<input type="checkbox"/>	One month (37 CFR 1.17(a)(1))	\$130	\$65 \$ _____
<input type="checkbox"/>	Two months (37 CFR 1.17(a)(2))	\$490	\$245 \$ _____
<input checked="" type="checkbox"/>	Three months (37 CFR 1.17(a)(3))	\$1110	\$555 \$ <u>555</u>
<input type="checkbox"/>	Four months (37 CFR 1.17(a)(4))	\$1730	\$865 \$ _____
<input type="checkbox"/>	Five months (37 CFR 1.17(a)(5))	\$2350	\$1175 \$ _____
<input checked="" type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27.		
<input type="checkbox"/>	A check in the amount of the fee is enclosed.		
<input type="checkbox"/>	Payment by credit card. Form PTO-2038 is attached.		
<input type="checkbox"/>	The Director has already been authorized to charge fees in this application to a Deposit Account.		
<input checked="" type="checkbox"/>	The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number <u>13-1130</u> .		
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.			
I am the	<input type="checkbox"/>	applicant/inventor.	
	<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96).	
	<input checked="" type="checkbox"/>	attorney or agent of record. Registration Number <u>25,339</u>	
	<input type="checkbox"/>	attorney or agent under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	
		<u>/barry l. haley/</u>	<u>September 9, 2011</u>
		Signature	Date
		<u>Barry L. Haley</u>	<u>(954) 763-3303</u>
		Typed or printed name	Telephone Number
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/>	Total of _____ forms are submitted.		

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Patent Application Fee Transmittal

Application Number:	12324122
Filing Date:	26-Nov-2008
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Filer:	Barry Lee Haley/Amy Allen
Attorney Docket Number:	10963.3819

Filed as Small Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				
Extension - 3 months with \$0 paid	2253	1	555	555

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				555

Electronic Acknowledgement Receipt

EFS ID:	10916464
Application Number:	12324122
International Application Number:	
Confirmation Number:	9036
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Customer Number:	22235
Filer:	Barry Lee Haley/Amy Allen
Filer Authorized By:	Barry Lee Haley
Attorney Docket Number:	10963.3819
Receipt Date:	09-SEP-2011
Filing Date:	26-NOV-2008
Time Stamp:	16:11:18
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$555
RAM confirmation Number	3059
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

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File Listing:					
Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		07_RespToOAMailed03-11-11.pdf	66770 094aaaf83f685c934be3185de237ee43542bde01	yes	12
Multipart Description/PDF files in .zip description					
Document Description			Start	End	
Amendment/Req. Reconsideration-After Non-Final Reject			1	1	
Claims			2	7	
Applicant Arguments/Remarks Made in an Amendment			8	12	
Warnings:					
Information:					
2	Extension of Time	08_3MthEOT.pdf	316002 ab3e6dce7c00ee217aa08701dcd9c18780f603fe	no	2
Warnings:					
Information:					
3	Fee Worksheet (SB06)	fee-info.pdf	30328 f1a1f1be74475a0c036f5b840a28e02121d975995	no	2
Warnings:					
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Total Files Size (in bytes):			413100		
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>					

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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 12/324,122	Filing Date 11/26/2008	<input type="checkbox"/> To be Mailed
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APPLICATION AS FILED – PART I			OTHER THAN SMALL ENTITY			
	(Column 1)	(Column 2)	SMALL ENTITY <input checked="" type="checkbox"/>	OR		
FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)	RATE (\$)	FEE (\$)
<input type="checkbox"/> BASIC FEE <small>(37 CFR 1.16(a), (b), or (c))</small>	N/A	N/A	N/A		N/A	
<input type="checkbox"/> SEARCH FEE <small>(37 CFR 1.16(k), (j), or (m))</small>	N/A	N/A	N/A		N/A	
<input type="checkbox"/> EXAMINATION FEE <small>(37 CFR 1.16(o), (p), or (q))</small>	N/A	N/A	N/A		N/A	
TOTAL CLAIMS <small>(37 CFR 1.16(j))</small>	minus 20 =	*	X \$ =	OR	X \$ =	
INDEPENDENT CLAIMS <small>(37 CFR 1.16(h))</small>	minus 3 =	*	X \$ =		X \$ =	
<input type="checkbox"/> APPLICATION SIZE FEE <small>(37 CFR 1.16(s))</small>	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).					
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT <small>(37 CFR 1.16(j))</small>						
			TOTAL		TOTAL	

* If the difference in column 1 is less than zero, enter "0" in column 2.

APPLICATION AS AMENDED – PART II					OTHER THAN SMALL ENTITY			
	(Column 1)	(Column 2)	(Column 3)					
AMENDMENT	09/09/2011	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)
	Total <small>(37 CFR 1.16(i))</small>	* 12	Minus ** 20	= 0	X \$26 =	0	OR	X \$ =
	Independent <small>(37 CFR 1.16(h))</small>	* 3	Minus *** 3	= 0	X \$110 =	0	OR	X \$ =
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>						OR	
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>						OR	
					TOTAL ADD'L FEE	0	OR	TOTAL ADD'L FEE

	(Column 1)	(Column 2)	(Column 3)					
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)
	Total <small>(37 CFR 1.16(i))</small>	*	Minus **	=	X \$ =		OR	X \$ =
	Independent <small>(37 CFR 1.16(h))</small>	*	Minus ***	=	X \$ =		OR	X \$ =
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>						OR	
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>						OR	
					TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
 ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
 *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
 The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

Legal Instrument Examiner:
/KAREN VESTAL/

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963.3819 9036

22235 7590 03/11/2011
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

LEBASSI, AMANUEL

ART UNIT PAPER NUMBER

2617

NOTIFICATION DATE DELIVERY MODE

03/11/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@mhdpatents.com

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 2-14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Maggenti et al. US 20020061762.

Regarding claim 2, Keating discloses a communication system for transmitting, receiving, confirming receipt, and responding to an electronic message (**see abstract - selecting a group of mobile stations to participate in the wireless group call and causing an invitation message to be transmitted to the group of mobile stations**). Keating discloses a predetermined network of participants, wherein each participant has a similarly equipped PC or PDA/cell phone that includes a CPU and a touch screen display a CPU and memory (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**). Keating disclose a data transmission means that facilitates the transmission of electronic files between said PCs and said

Art Unit: 2617

PDA/cell phones in different locations (**paragraph [0020] where wireless data controller controls transmission of data therefore a data transmission means that facilitates the transmission of electronic files**). Keating discloses a sender PC or PDA/cell phone and at least one recipient PC or PDA/cell phone for each electronic message (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list therefore a sender PC or PDA/cell phone and at least one recipient PC or PDA**).

Keating discloses a forced message alert software application program loaded on each participating PC or PDA/cell phone (**paragraph [0025] where an alert message is queued in the mobile stations therefore a message alert software application program**). Keating discloses an alert message but is silent on disclosing 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 PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains containing a response list and requires requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone; means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message ~ alert and which recipient PCs or PDA/cell

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phones have not automatically acknowledged the forced message alert; means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

Maggenti teaches 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 PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains containing a response list and requires requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone (**paragraph [0120] and [0129] where an alert message is transmitted and upon receiving the request where the communication device acknowledges the response**). Maggenti teaches means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert (**paragraph [0141] where communication devices confirm the invitation by sending acknowledgements therefore list of**

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recipients have or not automatically acknowledged the forced message alert). Maggenti teaches means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert (**paragraph [0129] where the alert is resend therefore periodically resending said forced message alert to said recipient**) and means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded (**paragraph [0153] where server responds by resending the lost message response**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Maggenti, thereby determining participants in a net within a group communication network as taught by Maggenti (**paragraph [0004]**).

Regarding claim 3, Maggenti teaches wherein the forced message alert software application program on the recipient PC or PDA/cell phone includes: means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone (**paragraph [0120] and [0129]**). Maggenti teaches means for controlling of the recipient PC or PDA/cell phone upon transmitting

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said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display (**paragraph [0141]**) and means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PC or PDA/cell phone and means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted (**paragraph [0153]**).

Regarding claim 4, Keating discloses wherein said data transmission means is TCP/IP or another communications protocol (paragraph [0020] - **Internet Protocol (IP)**).

Regarding claim 5, Keating discloses wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program (**paragraph [0027]**).

Regarding claim 6, Keating discloses wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**see Fig. 2**).

Regarding claim 7, Keating discloses A method of sending a forced message alert to one or more recipient PCs or PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PC or PDA/cell phone is tracked, said method comprising the steps of: accessing a forced message alert software application program on a sender PC or PDA/cell phone **paragraph [0025] where an alert message is queued in the mobile stations therefore a forced message alert software application program**). Keating discloses creating the forced message alert on said sender PC or PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message (**paragraph [0022]**). Keating discloses designating one or more recipient PCs or PDA/cell phones in the communication network (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list**). Keating discloses electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones (**paragraph [0022]**). Keating discloses receiving automatic acknowledgements

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from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert **(see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones)**. Keating discloses periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt **(see Fig. 2)**. Keating discloses receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response that can only be cleared by manually selecting and transmitting a response to the manual response list **(paragraph [0028] where the message is cleared)**.

Keating is silent providing a manual response list on the display of the recipient PC or PDA/cell phone. Maggenti teaches providing a manual response list on the display of the recipient PC or PDA/cell phone **(paragraph [0011]** where the communication device sends a response to the message within a predetermined time period).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Maggenti,

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thereby determining participants in a net within a group communication network as taught by Maggenti (**paragraph [0004]**).

Regarding claim 8, Keating discloses wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on which are similarly equipped**).

Regarding claim 9, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program (**paragraph [0027]**).

Regarding claim 10, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**paragraph [0027]**).

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3. Claim 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Dalton et al. US 20040192365.

Regarding claim 11, Keating discloses a method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program (**paragraph [0027] where Keating discloses where a message is sent to inform the mobile stations that the group call is set to begin**), said method comprising the steps of: receiving an electronically transmitted electronic message (**Fig. 2 step 34 where message is received after being transmitted**). Keating discloses identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone (abstract where **an invitation message to be transmitted to the group of mobile stations**). Keating discloses transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the

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voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone (**see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones**) and transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone (**paragraph [0028] where a message is responded**). Keating discloses displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone (**see Fig. 2 step 36 where list of responsive participants is displayed upon request**) and providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message (**see Fig. 2 step 43 where group members allow communication therefore automatically acknowledged receipt of a forced alert message**).

Keating is silent their response to the forced alert message. . However, Dalton teaches responses to the forced message alert (**paragraph [0014] where each active mobile device responds to the predetermined message and performs a specific function related to the predetermined message**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Dalton, thereby integrating plurality of mobile devices as taught by Dalton (**paragraph [0001]**).

Regarding claim 12, Keating discloses wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**).

Regarding claim 13, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program (**paragraph [0027] where the message is displayed on the participating mobile phones**).

Regarding claim 14, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone(**see Fig. 2**).

Conclusion

1. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amanuel Lebassi, whose telephone number is (571) 270-5303. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached at (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Amanuel Lebassi
/A. L./
3/01/2011

/HUY PHAN/
Primary Examiner, Art Unit 2617

Notice of References Cited	Application/Control No. 12/324,122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.	
	Examiner AMANUEL LEBASSI	Art Unit 2617	Page 1 of 1

U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A US-2004/0082352	04-2004	Keating et al.	455/519
*	B US-2002/0061762	05-2002	Maggenti et al.	455/519
*	C US-2004/0192365	09-2004	Dalton et al.	455/517
	D US-			
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
	K US-			
	L US-			
	M US-			

FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

NON-PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)				
	U				
	V				
	W				
	X				

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Index of Claims *1232412 2*	Application/Control No. 12324122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.
	Examiner AMANUEL LEBASSI	Art Unit 2617

✓	Rejected
=	Allowed

-	Cancelled
÷	Restricted

N	Non-Elected
I	Interference

A	Appeal
O	Objected

Claims renumbered in the same order as presented by applicant
 CPA
 T.D.
 R.1.47

CLAIM		DATE							
Final	Original	09/09/2010	02/23/2011						
	1	✓	-						
	2	✓	✓						
	3	✓	✓						
	4	✓	✓						
	5	✓	✓						
	6	✓	✓						
	7	✓	✓						
	8	✓	✓						
	9	✓	✓						
	10	✓	✓						
	11	✓	✓						
	12	✓	✓						
	13	✓	✓						
	14	✓	✓						

Search Notes *1232412 2*	Application/Control No. 12324122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.
	Examiner AMANUEL LEBASSI	Art Unit 2617

SEARCHED			
Class	Subclass	Date	Examiner
455	41.1, 416, 518, 519	9/9/2010	AL

SEARCH NOTES		
Search Notes	Date	Examiner
Inventor Search	9/9/2010	AL

INTERFERENCE SEARCH			
Class	Subclass	Date	Examiner

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EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S49	1	"20040082352".pn.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 14:42
S50	1	(forced near3 (message alert software))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:28
S51	71	(forced near3 (alert))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:28
S52	1496	(alert) with (participat \$3 PDA)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:29
S53	2	S51 and S52	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:29
S54	7748	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:32
S55	7340	(alert) with (((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:32

S56	7748	(alert) with (participat\$3 (((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:33
S57	20	S51 and S56	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:33
S58	3	S57 and (ACK or Acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:34
S59	18128	(alert\$4) same (participat\$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:35
S60	2480	S59 and (ACK or Acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:35
S61	5	S59 and automatic (ACK or Acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:36
S62	5	S59 and (automatic (ACK or Acknowledge))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:36
S63	7	(forced near3 (alert \$4)) same (participat\$3 (((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:37

S65	1	(automatic\$5 acknowledg\$3 receipt) and (forced alert message)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S66	1	(automatic\$5 acknowledg\$3) and (forced alert message)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S67	1	(automatic\$5 acknowledg\$3) and (forced alert)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S68	1	(automatic\$5 near2 acknowledg\$3) and (forced alert)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S69	1	(automatic\$5 near2 acknowledg\$3) and (forced near2 alert)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:39
S70	1	(automatic\$5 near2 acknowledg\$3) and (forced near2 alert\$4)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:39
S71	324	(automatic\$5 near2 acknowledg\$3) and (alert\$4)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:39
S72	48	S71 and S59	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 17:40
S73	46	S72 and S60	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 17:40

S74	20	"455"/\$.cls. and S73	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 18:04
S75	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 14:37
S76	1704	(alert near2 message) with (voice or text)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 15:04
S77	3	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:04
S78	24	(alert) with (participat \$3 near4 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05
S79	76	(alert\$3) same (participat\$3 near4 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05
S80	5	S76 and S78	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05
S81	21	S76 and S79	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05

S82	2	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S81	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 15:20
S83	22	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S79	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 15:58
S84	151	(alert near2 message) with (acknowledge or ACK)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 16:20
S85	0	S84 and (participat\$3 near4 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 16:21
S86	100	S84 and ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 16:22
S87	78	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S86	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 16:22
S88	24	"455"/\$.cls. and S87	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 16:23
S89	10	periodic\$4 with (resend \$3 or re-send\$3 or retransmit\$4) with alert	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:00
S90	2	S84 and S89	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:00

S91	0	S89 same (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:01
S92	2	S89 and (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:01
S93	79	periodic\$4 same (resend\$3 or re-send\$3 or retransmit\$4) same alert\$3	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:02
S94	12	S93 same (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:02
S95	10	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S94	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:02
S96	647	(periodic\$4 same (resend\$3 or re-send\$3 or retransmit\$4)) and alert\$3	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:04
S97	229	S96 and (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:04
S98	168	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S97	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:04
S99	40	"455"/\$.cls. and S98	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:05

S100	1	"20020061762".pn. and (respon\$4 with participant\$3)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/23 16:22
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2/ 23/ 2011 5:32:17 PM

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Malcolm K. Beyer, Jr.)	
)	
Serial No.: 12/324,122)	Confirmation No: 9036
)	
Filed: November 26, 2008)	Group Art Unit: 2617
)	
Entitled: METHOD OF UTILIZING)	Examiner: LEBASSI, Amanuel
FORCED ALERTS FOR)	
INTERACTIVE REMOTE)	
COMMUNICATIONS)	
_____)	

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

December 17, 2010
Filed Electronically

RESPONSE AND AMENDMENT

Dear Sir:

In response to the Office Action dated September 20, 2010, please amend the above referenced patent application as follows and consider the remarks below. This Response is believed to be timely. However, in the event that any further extension of time is required, please consider this a request therefor. The Commissioner is authorized to charge any additional fees due or credit any overpayment to Deposit Account 13-1130.

Please amend the claims as shown on pages 2-7.

Remarks begin on page 8.

CLAIM AMENDMENTS

Please amend the claims (~~striketrough~~ indicating deletion and underline indicating insertion) as follows:

1. (Cancelled)

2. (Currently Amended) 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 PC or 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 PCs and said PDA/cell phones in different locations;

a sender PC or PDA/cell phone and at least one recipient PC or PDA/cell phone for each electronic message; and

a forced message alert software application program loaded on each participating PC or PDA/cell phone [.] ;

~~The system as in claim 1, wherein the forced message alert software application program on the sender PC or 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 PC or PDA/cell phone to the recipient PC or PDA/cell phone, ~~wherein~~ said forced message alert software packet ~~contains~~ containing a response list and ~~requires~~ requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or

PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone;

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message ~~azler~~ alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

3. (Currently Amended) The system as in claim 1 2 , wherein the forced message alert software application program on the recipient PC or PDA/cell phone includes:

means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone;

means for controlling of the recipient PC or PDA/cell phone upon transmitting said automatic acknowledgment and ~~causes~~ causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message ~~to be~~ being periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and ~~transmits~~ transmitting said manual response to the sender PC or PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or ~~stops~~ stopping the repeating voice message and ~~clears~~ clearing the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted.

4. (Currently Amended) The system as in claim ~~1~~ 2, wherein said data transmission means is TCP/IP or another communications protocol.

5. (Currently Amended) The system as in claim ~~1~~ 2, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

6. (Currently Amended) The system as in claim ~~1~~ 2, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

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

accessing a forced message alert software application program on a sender PC or PDA/cell phone;

creating the forced message alert on said sender PC or 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 PCs or PDA/cell phones in the communication network;

electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones;

receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert;

periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone; and

providing a manual response list on the display of the recipient PC or PDA/cell phone;

clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response that can only be cleared by manually selecting and transmitting a response to the manual response list.

8. (Original) The method as in claim 7, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

9. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

11. (Currently Amended) A method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message;

identifying said electronic message as a forced message alert, wherein said forced message alert ~~consists~~ comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone; and

transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone;

displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone; and

providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.

12. (Original) The method as in claim 11, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

13. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone

REMARKS

The Office Action mailed September 20, 2010 has been received and reviewed. By the present Response and Amendment, Claim 1 is canceled, Claims 2-7 and 11 have been amended and claims 2-14 remain. No new matter is introduced.

Claim Rejections – 35 USC § 102

The Examiner's rejection of Claims 1, 4 and 6 under 35 U.S.C. § 102(e) as being anticipated by Keating et al. (US 2004/0082352) is respectfully traversed. It is elementary patent law that to sustain a rejection based on anticipation, each and every element recited in the claims that are rejected must be present in the reference cited by the Examiner. Claim 1 has been canceled. Remaining claims 4 and 6 have been amended to depend from amended claim 2. The Keating *et al.* patent is very specific about being a system and method to develop accurate billing for Push To Talk (PTT) phones. The described technique sets up a group of mobile stations based on digital replies automatically received from the group of mobile stations. Applicant's invention is about sending commands to individuals using any communications means that require a manual response from the individual to whom the command was issued, in much the same manner that when a U.S. Marine issues a command and he demands a "Yes Sir" or "No Sir" response from the person to whom the command was issued. Additionally, there is no use of remote or automatically generated voice commands that demand a response being sent in Keating *et al.* The Keating *et al.* reference does not disclose a forced message alert software application program loaded on each participating PC or PDA/cell phone as required in amended independent claim 2 from which claims 4 and 6 depend. The system in the Keating *et al.* reference is completely different in purpose and methodology and in other words structure and

function. The purpose of the system in the Keating *et al.* reference is to enable accurate billing of multiple call participants in a wireless group. There is no discussion or suggestion in Keating *et al.* to provide a forced message alert which is described in Applicant's specification. The Examiner states in the rejection that "Keating *et al.* discloses a forced message alert software application program loaded on each participating PC in paragraph (0025)". A review of paragraph (0025) of the Keating *et al.* reference shows that the leader sends a message to a wireless data controller that requests a list of participants that have responded that want to participate in a group call. This is not the forced message alert as described in applicant's specification and recited in amended claim 2. In the Keating *et al.* reference if there is no response then the recipient is not added to the group. Applicant's forced message alert forces a recipient to respond with an appropriate predetermined response. Again, the whole purpose of the Keating *et al.* invention is to make sure that there is an accurate billing among the receipt members. See paragraph (0005) of Keating *et al.*; the Keating *et al.* reference does not anticipate amended claim 2 from which claims 4 and 6 depend and therefore claims 4 and 6 are allowable.

Claim Rejections – 35 U.S.C. § 103

The Examiner's rejection of Claims 2, 3 and 5 under 35 U.S.C. 103(a) as being unpatentable over Keating *et al.* (US 2004/0082352) in view of Esler *et al.* (US 2005/0241026) is respectfully traversed. As stated above, with respect to the Keating *et al.* reference, the structure, methodology, and purpose of the Keating *et al.* reference are completely different than those in Applicant's claimed invention. Applicant's Claim 2 has been amended to distinguish the forced message alert. Esler *et al.* shows a device and method for storing data message alerts on medical devices. The medical device can be interrogated with a programmer. The method in

Esler's patent is the reverse of Applicant's patent claims. In the Esler patent, the individuals automatically provide unsolicited data to a remote computer which periodically polls for health data. There is no command sent to the participant to manually respond. There is no voice command involved. The method may also include communicating the data message alert by the programmer in response to detecting the data message alert stored in a dedicated alert field of a medical device. It is difficult to understand how a person of ordinary skill in the art that deals with the communication network that has forced message alerts would even consider the combination of device and method disclosed in the Keating *et al.* reference in conjunction with the method disclosed in Esler *et al.* since the two methods and systems are completely different and offer no suggestion or motivation to arrive at Applicant's claimed invention. It is Applicant's position that even if one combined or attempted to combine the method and systems described in Keating *et al.* with the method and systems described in Esler *et al.*, one would not arrive at Applicant's claimed invention. Since the references even if combined do not provide a prima facie obviousness rejection of these claims, it is Applicant's position that these claims are allowable over the references cited by the examiner.

The Examiner's rejection of Claims 7 – 14 under 35 U.S.C. § 103(a) as being unpatentable over Keating *et al.* (US 2004/0082352) in view of Dalton *et al.* (US 2004/0192365) is respectfully traversed. Applicant hereby asserts the arguments made above as to why Keating *et al.* is not an appropriate reference with respect to Applicant's claimed invention and claims 7 through 14. Applicant's claim 7 has been amended to include the steps of providing a manual response list on the display of the recipient PC/PDA and providing that clearing of the receiver's display screen in order to get the alert to cease can only be cleared by manually selecting and transmitting a response to the manual response list. Additionally, there is no use of remote or

automatically generated voice commands that demand a response being sent in Dalton *et al.* The steps are not taught or suggested in the references when viewed together cited by the Examiner. Dalton *et al.* shows a communications system and method that includes a data concentrator computer and a gateway device that allows direct communication between first and second mobile data acquisition devices. Again, it is Applicant's position that even if the method and reference device shown in Keating *et al.* were somehow to be combined with the system and method shown in Dalton *et al.*, Applicant's claimed invention cannot result based on the amendments to claim 7. Therefore, the Examiner has failed to present a prima facie case of obviousness under 35 U.S.C. § 103 with respect to claim 7. Therefore, it is Applicant's position that claims 7-14 are allowable over the art of record.

Claim 1 is canceled. Claims 2 through 14 are believed allowable over the art record for the reasons stated above.

CONCLUSION

In view of the amendments submitted herein and the above comments, it is believed that all grounds of rejection are overcome and that the application has now been placed in full condition for allowance. Accordingly, Applicant earnestly solicits early and favorable action. Should there be any further questions or reservations, the Examiner is urged to telephone Applicant's undersigned attorney at (954) 763-3303.

Respectfully submitted,

s/ Barry L. Haley
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Electronic Acknowledgement Receipt

EFS ID:	9059437
Application Number:	12324122
International Application Number:	
Confirmation Number:	9036
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Customer Number:	22235
Filer:	Barry Lee Haley/Amy Allen
Filer Authorized By:	Barry Lee Haley
Attorney Docket Number:	10963.3819
Receipt Date:	17-DEC-2010
Filing Date:	26-NOV-2008
Time Stamp:	11:08:29
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		05_RespToOAMailed09-20-10.pdf	63928 0e8c749d22c36b948ecc0f3c8f173bcfe5004523	yes	12

Multipart Description/PDF files in .zip description			
Document Description		Start	End
Amendment/Req. Reconsideration-After Non-Final Reject		1	1
Claims		2	7
Applicant Arguments/Remarks Made in an Amendment		8	12

Warnings:

Information:

Total Files Size (in bytes):	63928
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 12/324,122	Filing Date 11/26/2008	<input type="checkbox"/> To be Mailed
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APPLICATION AS FILED – PART I			OTHER THAN SMALL ENTITY				
	(Column 1)	(Column 2)	SMALL ENTITY <input checked="" type="checkbox"/>	OR			
FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)	OR	RATE (\$)	FEE (\$)
<input type="checkbox"/> BASIC FEE <small>(37 CFR 1.16(a), (b), or (c))</small>	N/A	N/A	N/A			N/A	
<input type="checkbox"/> SEARCH FEE <small>(37 CFR 1.16(k), (l), or (m))</small>	N/A	N/A	N/A			N/A	
<input type="checkbox"/> EXAMINATION FEE <small>(37 CFR 1.16(o), (p), or (q))</small>	N/A	N/A	N/A			N/A	
TOTAL CLAIMS <small>(37 CFR 1.16(i))</small>	minus 20 =	*	X \$ =		OR	X \$ =	
INDEPENDENT CLAIMS <small>(37 CFR 1.16(h))</small>	minus 3 =	*	X \$ =			X \$ =	
<input type="checkbox"/> APPLICATION SIZE FEE <small>(37 CFR 1.16(s))</small>	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).						
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT <small>(37 CFR 1.16(j))</small>							
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL			TOTAL	

APPLICATION AS AMENDED – PART II					OTHER THAN SMALL ENTITY				
	(Column 1)	(Column 2)	(Column 3)						
AMENDMENT	12/17/2010	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	OR	RATE (\$)	ADDITIONAL FEE (\$)
	Total <small>(37 CFR 1.16(i))</small>	* 13	Minus ** 20	= 0	X \$26 =	0	OR	X \$ =	
	Independent <small>(37 CFR 1.16(h))</small>	* 3	Minus *** 3	= 0	X \$110 =	0	OR	X \$ =	
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>								
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>						OR		
					TOTAL ADD'L FEE	0	OR	TOTAL ADD'L FEE	

	(Column 1)	(Column 2)	(Column 3)						
AMENDMENT	Total <small>(37 CFR 1.16(i))</small>	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	OR	RATE (\$)	ADDITIONAL FEE (\$)
	*	Minus	**	=	X \$ =		OR	X \$ =	
	Independent <small>(37 CFR 1.16(h))</small>	*	Minus	***	X \$ =		OR	X \$ =	
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>								
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>						OR		
					TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
 ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
 *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
 The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

Legal Instrument Examiner:
/STANLEY JORDAN/

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/324,122	11/26/2008	Malcolm K. Beyer JR.	10963.3819	9036
22235	7590	09/20/2010	EXAMINER	
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A. 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316			LEBASSI, AMANUEL	
			ART UNIT	PAPER NUMBER
			2617	
			NOTIFICATION DATE	DELIVERY MODE
			09/20/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@mhdpatents.com

Office Action Summary	Application No. 12/324,122	Applicant(s) BEYER, MALCOLM K.	
	Examiner AMANUEL LEBASSI	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 November 2008.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 November 2008 is/are: a) accepted or b) objected to by the Examiner.
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 4 and 6 are rejected under 35 U.S.C. 102(e) as being unpatentable by Keating et al. US 20040082352.

Regarding claim 1, Keating discloses A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message (**see abstract - selecting a group of mobile stations to participate in the wireless group call and causing an invitation message to be transmitted to the group of mobile stations**). Keating discloses a predetermined network of participants, wherein each participant has a similarly equipped PC or PDA/cell phone that includes a CPU and a touch screen display a CPU and memory (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**). Keating discloses a data transmission means that facilitates the transmission of electronic files between said PCs and said PDA/cell phones in different locations (**paragraph [0020] where wireless data controller controls transmission of data therefore a data transmission means that facilitates the transmission of electronic files**). Keating discloses a sender PC or PDA/cell phone and at least one recipient PC or

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PDA/cell phone for each electronic message (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list therefore a sender PC or PDA/cell phone and at least one recipient PC or PDA).**

Keating discloses a forced message alert software application program loaded on each participating PC or PDA/cell phone (**paragraph [0025] where an alert message is queued in the mobile stations therefore** a message alert software application program).

Regarding claim 4, Keating discloses wherein said data transmission means is TCP/IP or another communications protocol (paragraph [0020] - **Internet Protocol (IP)).**

Regarding claim 6, Keating discloses wherein the response list that is transmitted Within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**see Fig. 2).**

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Esler et al. US 20050241026.

Regarding claim 2, the combination of above discloses wherein the forced message alert software application program on the sender PC or 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 PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains a response list and requires the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone; means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the

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forced message alert; means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded (see above).

Regarding claim 3, Keating modified by Esler discloses wherein the forced message alert software application program on the recipient PC or PDA/cell phone: means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone (**paragraph [0027] where Keating discloses where a message is sent to inform the mobile stations that the group call is set to begin**). Keating modified by Esler discloses means for controlling of the recipient PC or PDA/cell phone upon transmitting said automatic acknowledgment and causes, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message to be periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display (**paragraph [0027] where the message is displayed on the participating mobile phones**). Keating modified by Esler discloses means for

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allowing a manual response to be manually selected from the response list or manually recorded and transmits said manual response to the sender PC or PDA/cell phone (**paragraph [0027]**) and means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stops the repeating voice message and clears the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted (**paragraph [0028] where the message is cleared**).

Regarding claim 5, Keating modified by Esler discloses wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program (**paragraph [0027]**).

3. Claim 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Dalton et al. US 20040192365.

Regarding claim 7, Keating discloses a method of sending a forced message alert to one or more recipient PCs or PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PC or PDA/cell phone is tracked, said method comprising the steps of: accessing a forced message alert software application program on a sender PC or PDA/cell phone (**paragraph**

[0025] where an alert message is queued in the mobile stations therefore a forced message alert software application program). Keating discloses creating the forced message alert on said sender PC or PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message (**paragraph [0022]**). Keating discloses designating one or more recipient PCs or PDA/cell phones in the communication network (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list**). Keating discloses electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones (**paragraph [0022]**). Keating discloses receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert (**see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones**). Keating discloses periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt (**see Fig. 2**). Keating discloses receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing

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the receiver's display screen or causing the repeating voice alert to cease upon selecting a response (**paragraph [0028] where the message is cleared**).

Keating is silent responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response. However, Dalton teaches responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response (**paragraph [0014] where each active mobile device responds to the predetermined message and performs a specific function related to the predetermined message**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Dalton, thereby **integrating plurality of mobile devices as taught by Dalton (paragraph [0001])**.

Regarding claim 8, Keating discloses herein each PC or PDA]cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on which are similarly equipped**).

Regarding claim 9, Keating modified by Dalton discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program (**paragraph [0027]**).

Regarding claim 10, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**paragraph [0027]**).

Regarding claim 11, Keating discloses a method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program (**paragraph [0027] where Keating discloses where a message is sent to inform the mobile stations that the group call is set to begin**), said method comprising the steps of: receiving an electronically transmitted electronic message (**Fig. 2 step 34 where message is received after being transmitted**). Keating discloses identifying said electronic message as a forced message alert, wherein said forced message alert consists of a voice or text message and a forced message alert

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application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone (abstract where **an invitation message to be transmitted to the group of mobile stations**). Keating discloses transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone (**see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones**) and transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone (**paragraph [0028] where a message is responded**). Keating discloses displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone (**see Fig. 2 step 36 where list of responsive participants is displayed upon request**) and providing a list of the recipient PC or PDA/cell phones have automatically

acknowledged receipt of a forced alert message (**see Fig. 2 step 43 where group members allow communication therefore automatically acknowledged receipt of a forced alert message**).

Keating is silent their response to the forced alert message. . However, Dalton teaches responses to the forced message alert (**paragraph [0014] where each active mobile device responds to the predetermined message and performs a specific function related to the predetermined message**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Dalton, thereby **integrating plurality of mobile devices as taught by Dalton (paragraph [0001])**.

Regarding claim 12, Keating discloses wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**).

Regarding claim 13, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program

(paragraph [0027] where the message is displayed on the participating mobile phones).

Regarding claim 14, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone **(see Fig. 2)**.

Conclusion

1. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amanuel Lebassi, whose telephone number is (571) 270-5303. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached at (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Art Unit: 2617

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

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Amanuel Lebassi

/A. L/
09092010

/NICK CORSARO/

Supervisory Patent Examiner, Art Unit 2617

Notice of References Cited	Application/Control No. 12/324,122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.	
	Examiner AMANUEL LEBASSI	Art Unit 2617	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2004/0082352	04-2004	Keating et al.	455/519
*	B	US-2005/0241026	10-2005	Esler et al.	D24/100
*	C	US-2004/0192365	09-2004	Dalton et al.	455/517
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
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	K	US-			
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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		12324122	
	Filing Date		2008-11-26	
	First Named Inventor	Malcolm K. Beyer JR.		
	Art Unit			
	Examiner Name			
	Attorney Docket Number		10963.3819	

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Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	
	1	7031728		2006-04-18	Beyer, Jr.		

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Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	
	1	20080076410		2008-03-27	Beyer		
	2	20060199612		2006-09-07	Beyer, JR. et al.		

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		12324122	12324122 - GAU: 2617	
	Filing Date		2008-11-26		
	First Named Inventor	Malcolm K. Beyer JR.			
	Art Unit				
	Examiner Name				
	Attorney Docket Number		10963.3819		

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
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Examiner Signature	/Amanuel Lebassi/	Date Considered	09/09/2010
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¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	9425	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 17:09
L2	9425	(message alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 17:09
L3	9425	(message alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 17:17
L4	1	(message alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:17
L5	192	(message near2 software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:17
L6	26	(alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:17
L7	26	L6	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:18

L8	5	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	NEAR	ON	2010/09/09 17:19
L9	1	(message near2 software) and L8	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:19
L10	5	(alert\$3) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	NEAR	ON	2010/09/09 17:22
L11	0	(buzz\$3) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	NEAR	ON	2010/09/09 17:22
L12	0	(message alert software) same mobiles	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:25
L13	1	(message alert software) with ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:26
L14	1	(message alert software) same((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27

L15	1	(message alert software) and ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L16	3756	(message near2 software) and ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L17	659	(message near2 software) same((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L18	0	(alrt software) same ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L19	9	(alert software) same ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:28
L20	1	forced message alert software application	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:32
L21	1	message alert software application	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:32


L22	14	message alert application	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:33
S1	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/08 19:27
S2	12	(Malcolm near3 Beyer). in.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:02
S3	2	11/612,830	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:03
S4	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:03
S5	1	S2 and forced alert	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:25
S6	5	S2 and alert	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:25
S7	9	("6204844" "6662016" "6868337" "20030139150" "20030200259" "20040192331" "20040204070" "20040266456" "20060031927").pn.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 11:32
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S9	1413	(alert) with (participat \$3 PDA)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 12:03
S10	0	S9 same participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 12:04
S11	55	S9 same participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 12:04
S12	29	S9 with participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 12:04
S13	9425	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 12:25
S14	75	S13 with participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 12:26
S15	9425	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55
S16	75	S15 with participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55
S17	75	S16	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55

S18	21	S17 and "455"/\$.ccls.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55
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Index of Claims 	Application/Control No. 12324122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.
	Examiner AMANUEL LEBASSI	Art Unit 2617

✓	Rejected
=	Allowed


-	Cancelled
÷	Restricted

N	Non-Elected
I	Interference

A	Appeal
O	Objected

Claims renumbered in the same order as presented by applicant
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 R.1.47

CLAIM		DATE							
Final	Original	09/09/2010							
	1	✓							
	2	✓							
	3	✓							
	4	✓							
	5	✓							
	6	✓							
	7	✓							
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	9	✓							
	10	✓							
	11	✓							
	12	✓							
	13	✓							
	14	✓							

Search Notes 	Application/Control No. 12324122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.
	Examiner AMANUEL LEBASSI	Art Unit 2617

SEARCHED			
Class	Subclass	Date	Examiner
455	41.1, 416, 518, 519	9/9/2010	AL

SEARCH NOTES		
Search Notes	Date	Examiner
Inventor Search	9/9/2010	AL

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CONFIRMATION NO. 9036

SERIAL NUMBER 12/324,122	FILING or 371(c) DATE 11/26/2008	CLASS 455	GROUP ART UNIT 2617	ATTORNEY DOCKET NO. 10963.3819		
APPLICANTS Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;						
** CONTINUING DATA ***** This application is a CIP of 11/612,830 12/19/2006 which is a CIP of 11/308,648 04/17/2006 PAT 7,630,724 which is a CIP of 10/711,490 09/21/2004 PAT 7,031,728						
** FOREIGN APPLICATIONS *****						
** IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** ** SMALL ENTITY ** 12/08/2008						
Foreign Priority claimed <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No	35 USC 119(a-d) conditions met <input type="checkbox"/> Yes <input type="checkbox"/> No	<input type="checkbox"/> Met after Allowance Initials	STATE OR COUNTRY FL	SHEETS DRAWINGS 6	TOTAL CLAIMS 14	INDEPENDENT CLAIMS 3
Verified and Acknowledged <u>/AMANUEL LEBASSI/</u> Examiner's Signature						
ADDRESS MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A. 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316 UNITED STATES						
TITLE METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS						
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Table with 4 columns: APPLICATION NUMBER (12/324,122), FILING OR 371(C) DATE (11/26/2008), FIRST NAMED APPLICANT (Malcolm K. Beyer JR.), ATTY. DOCKET NO./TITLE (10963.3819)

CONFIRMATION NO. 9036

PUBLICATION NOTICE

22235
MALIN HALEY AND DIMAGGIO, PA
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316



Title:METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

Publication No.US-2009-0075685-A1
Publication Date:03/19/2009

NOTICE OF PUBLICATION OF APPLICATION

The above-identified application will be electronically published as a patent application publication pursuant to 37 CFR 1.211, et seq. The patent application publication number and publication date are set forth above.

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number		12324122	
	Filing Date		2008-11-26	
	First Named Inventor	Malcolm K. Beyer JR.		
	Art Unit			
	Examiner Name			
	Attorney Docket Number		10963.3819	

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	1	7031728		2006-04-18	Beyer, Jr.		

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	1	20080076410		2008-03-27	Beyer		
	2	20060199612		2006-09-07	Beyer, JR. et al.		

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Not for submission under 37 CFR 1.99)	Application Number	12324122
	Filing Date	2008-11-26
	First Named Inventor	Malcolm K. Beyer JR.
	Art Unit	
	Examiner Name	
	Attorney Docket Number	10963.3819

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1		<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

EXAMINER SIGNATURE

Examiner Signature	Date Considered
--------------------	-----------------

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**
(Not for submission under 37 CFR 1.99)

Application Number	12324122		
Filing Date	2008-11-26		
First Named Inventor	Malcolm K. Beyer JR.		
Art Unit			
Examiner Name			
Attorney Docket Number	10963.3819		

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

None

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/barry l haley/	Date (YYYY-MM-DD)	2009-02-19
Name/Print	Barry L. Haley	Registration Number	25,339

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Acknowledgement Receipt

EFS ID:	4820668
Application Number:	12324122
International Application Number:	
Confirmation Number:	9036
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcolm K. Beyer
Customer Number:	22235
Filer:	Barry Lee Haley
Filer Authorized By:	
Attorney Docket Number:	10963.3819
Receipt Date:	19-FEB-2009
Filing Date:	26-NOV-2008
Time Stamp:	13:24:27
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Information Disclosure Statement (IDS) Filed (SB/08)	3819lds.pdf	863891 <small>a6fab4ae304cfdaddb53502e4153941577 c7fdb</small>	no	4

Warnings:

Information:

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.



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Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 7 columns: APPLICATION NUMBER, FILING or 371(c) DATE, GRP ART UNIT, FIL FEE REC'D, ATTY. DOCKET NO, TOT CLAIMS, IND CLAIMS. Row 1: 12/324,122, 11/26/2008, 2617, 462, 10963.3819, 14, 3

CONFIRMATION NO. 9036

22235
MALIN HALEY AND DIMAGGIO, PA
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

FILING RECEIPT



Date Mailed: 12/10/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;

Power of Attorney:

Barry Haley--25339
Dale Di Maggio--31823
David Lhota--39275
Mark Bowen--39914

Domestic Priority data as claimed by applicant

This application is a CIP of 11/612,830 12/19/2006
which is a CIP of 11/308,648 04/17/2006
which is a CIP of 10/711,490 09/21/2004 PAT 7,031,728

Foreign Applications

If Required, Foreign Filing License Granted: 12/08/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US 12/324,122

Projected Publication Date: 03/19/2009

Non-Publication Request: No

Early Publication Request: No

** SMALL ENTITY **

Title

METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

Preliminary Class

455

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/324,122	11/26/2008	Malcolm K. Beyer JR.	10963.3819

CONFIRMATION NO. 9036

22235
MALIN HALEY AND DIMAGGIO, PA
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

NOTICE



Date Mailed: 12/10/2008

NOTICE OF INFORMAL APPLICATION

This application is considered to be informal since it does not comply with the regulations for the reason(s) indicated below. The period within to correct the informalities noted below and avoid abandonment is set in the accompanying Office action.

Items Required To Avoid Processing Delays:

The item(s) indicated below are also required and should be submitted with any reply to this notice to avoid further processing delays.

- Early Pre-grant Publication has been requested, however the early Pre-GRANT Publication Fee of **\$300** as required by 37 CFR 1.18(d) has not been paid. The application will be published as per the normal publication schedule.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76		Attorney Docket Number	10963.3819
		Application Number	
Title of Invention	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS		
The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76. This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.			

Secrecy Order 37 CFR 5.2

Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)

Applicant Information:

Applicant 1					<input type="button" value="Remove"/>
Applicant Authority <input checked="" type="radio"/> Inventor		<input type="radio"/> Legal Representative under 35 U.S.C. 117		<input type="radio"/> Party of Interest under 35 U.S.C. 118	
Prefix	Given Name	Middle Name	Family Name	Suffix	
	Malcom	K.	Beyer	Jr.	
Residence Information (Select One) <input checked="" type="radio"/> US Residency <input type="radio"/> Non US Residency <input type="radio"/> Active US Military Service					
City	Jupiter Inlet Colony	State/Province	FL	Country of Residence i	US
Citizenship under 37 CFR 1.41(b) i		US			
Mailing Address of Applicant:					
Address 1	92 Lighthouse Drive				
Address 2					
City	Jupiter Inlet Colony	State/Province	FL		
Postal Code	33469-3504	Countryⁱ	US		
All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the Add button.					<input type="button" value="Add"/>

Correspondence Information:

Enter either Customer Number or complete the Correspondence Information section below. For further information see 37 CFR 1.33(a).			
<input type="checkbox"/> An Address is being provided for the correspondence Information of this application.			
Customer Number	22235		
Email Address	info@mhdpatents.com	<input type="button" value="Add Email"/>	<input type="button" value="Remove Email"/>

Application Information:

Title of the Invention	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS		
Attorney Docket Number	10963.3819	Small Entity Status Claimed <input checked="" type="checkbox"/>	
Application Type	Nonprovisional		
Subject Matter	Utility		
Suggested Class (if any)		Sub Class (if any)	
Suggested Technology Center (if any)			
Total Number of Drawing Sheets (if any)		Suggested Figure for Publication (if any)	

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Application Data Sheet 37 CFR 1.76	Attorney Docket Number	10963.3819
	Application Number	
Title of Invention	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS	

Publication Information:

<input checked="" type="checkbox"/>	Request Early Publication (Fee required at time of Request 37 CFR 1.219)
<input type="checkbox"/>	Request Not to Publish. I hereby request that the attached application not be published under 35 U.S. C. 122(b) and certify that the invention disclosed in the attached application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

Representative Information:

Representative information should be provided for all practitioners having a power of attorney in the application. Providing this information in the Application Data Sheet does not constitute a power of attorney in the application (see 37 CFR 1.32). Enter either Customer Number or complete the Representative Name section below. If both sections are completed the Customer Number will be used for the Representative Information during processing.			
Please Select One:	<input checked="" type="radio"/> Customer Number	<input type="radio"/> US Patent Practitioner	<input type="radio"/> Limited Recognition (37 CFR 11.9)
Customer Number	22235		

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78(a)(2) or CFR 1.78(a)(4), and need not otherwise be made part of the specification.					
Prior Application Status	Pending		Remove		
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)		
	Continuation in part of	11612830	2006-12-19		
Prior Application Status	Pending		Remove		
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)		
11612830	Continuation in part of	11308648	2006-04-17		
Prior Application Status	Patented		Remove		
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)
11308648	Continuation in part of	10711490	2004-09-21	7031728	2006-04-18
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the Add button.					Add

Foreign Priority Information:

This section allows for the applicant to claim benefit of foreign priority and to identify any prior foreign application for which priority is not claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55(a).

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	10963.3819
	Application Number	
Title of Invention	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS	

			<input type="button" value="Remove"/>
Application Number	Country ⁱ	Parent Filing Date (YYYY-MM-DD)	Priority Claimed
			<input checked="" type="radio"/> Yes <input type="radio"/> No
Additional Foreign Priority Data may be generated within this form by selecting the Add button.			<input type="button" value="Add"/>

Assignee Information:

Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of Title 37 of the CFR to have an assignment recorded in the Office.				
Assignee 1				<input type="button" value="Remove"/>
If the Assignee is an Organization check here. <input type="checkbox"/>				
Prefix	Given Name	Middle Name	Family Name	Suffix
Mailing Address Information:				
Address 1				
Address 2				
City		State/Province		
Country ⁱ		Postal Code		
Phone Number		Fax Number		
Email Address				
Additional Assignee Data may be generated within this form by selecting the Add button.				<input type="button" value="Add"/>

Signature:

A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature.				
Signature	/barry l haley/		Date (YYYY-MM-DD)	2008-11-26
First Name	Barry L.	Last Name	Haley	Registration Number
				25339

This collection of information is required by 37 CFR 1.76. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 23 minutes to complete, including gathering, preparing, and submitting the completed application data sheet form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

BACKGROUND OF THE INVENTION

5 This application is a continuation-in-part of U.S. Patent Application Serial No. 11/612830 filed on December 19, 2006 which is a continuation-in-part of U.S. Patent Application Serial No. 11/308,648 filed April 17, 2006 which is a continuation-in-part of U.S. Patent Application Serial No. 10/711,490 now U.S. Patent No. 7,031,728.

10 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.

15 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.

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

10 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
15 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
20 the recipient's cell phone or PC when sending the text or voice message.

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; (b) automatically transmit an acknowledgement of receipt from said recipient PCs and PDA/cell phones to the sender PCs or PDA/cell phones upon receipt of the forced message alert by the recipient PCs and PDA/cell phones; (c) periodically resend the message to the recipient PCs and PDA/cell phones that have not sent 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 acknowledgment; 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
5 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
10 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
15 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

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

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

5 Figure 2 shows the installation and set up of the forced message alert software on a communication network of cell phones, integrated PDA/cell phones, and PCs.

Figure 3A shows the first section of a flow chart showing a process of sending a forced message alert to one or more recipients as well as for ascertaining which recipients received the forced message alert and which recipients responded to the forced message alert.

10 Figure 3B shows the second section of a flow chart showing a process of sending a forced message alert to one or more recipients as well as for ascertaining which recipients received the forced message alert and which recipients responded to the forced message alert.

Figure 4 shows a flow chart showing a process of receiving a forced message alert as well as providing an acknowledgment of receipt and a response by the recipient.

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PREFERRED EMBODIMENT OF THE INVENTION

A communication system and method that joins participants in a communications network using personal computers ("PC") and handheld cell phones having integrated
5 personal digital assistant ("PDA/cell phone") with a forced message alert software application program that allows a participant to send a text or voice message to a group of people and force an automatic acknowledgment of receipt and a manual response.

Each PDA/cell phone described herein for the participant network has its own individual on/off power and can function just as any other cell phone. It can also function
10 with its PDA. To operate on the network, obviously the PDA/cell phone power switch has to be on. If the PDA/cell phone is completely turned off, then it is not part of the participating network and cannot send or receive any forced message alerts. In addition to its own on and off power switch, it has the forced message alert software application program that is activated manually when preparing to send a text or voice message or is activated automatically when
15 receiving a forced message alert from another PC or PDA/cell phone.

Each PC described herein is like any other contemporary PC, except that it has the forced message alert software application program installed on it. To operate on the network, obviously the PC must be on and have an active connection to the Internet or other digital transmission means. If the PC is completely turned off, then it is not part of the participating
20 network and cannot send or receive any forced message alerts. The forced message alert software application program on the PC is activated manually when preparing to send a text or

voice message or is activated automatically when receiving a forced message alert from another PC or PDA/cell phone.

The communication system also includes a server that acts as a forwarder for IP communications between any combination of PDA/cell phone users and/or PC based users.

5 Network participant location, identity and status messages are sent to the server by each user. The users are the network participants. Network participant entered tracks are also sent to the server. Because this data is of interest to all the network participants, the server forwards the data received from one participant to all other participants, thus providing the information necessary for all network participants to know the identity, location and status of all other
10 network participants. In addition, the server keeps all of the network participants updated on information kept in its databases, such as all of the participants' telephone numbers, E-mail addresses and other information necessary to carry on the communications described herein.

The server also acts as a forwarder of data addressed from one participant to one or more addressed participants, thus permitting the transmission of forced message alerts, other
15 text and voice 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.

20 Referring now to the drawings and, in particular, Figure 1a and 1b, a small handheld cellular phone 10 is shown that includes a PDA integrated in housing 12 that includes an

on/off power switch 19, a microphone 38, and an LCD display 16 that is also a touch screen system. The small area 16a is the navigation bar that depicts the telephone, GPS and other status data and the active software. Each cell phone includes a CPU and databases that store information useful in the communication network. With the touch screen 16, data can be

5 entered through the operator using a stylus 14 (or operator finger) by manipulatively directing the stylus 14 to literally touch display 16. Soft switches 16d displayed on the display 16 are likewise activated by using a stylus 14 and physically and manipulatively directing the stylus to literally touch display 16. The display x, y coordinates of the touched point are known by a CPU in the PDA section of the communication system in housing 12 that can coordinate

10 various information contained in the PDA relative to the x, y coordinate position on the display 16. Inside housing 12 is contained the conventional cellular phone elements including a modem, a CPU for use with a PDA and associated circuitry connected to speaker 24 and microphone 38. Conventional PDA/cellular phones are currently on sale and sold as a unit that can be used for cellular telephone calls and sending cellular SMS and TCP/IP or other

15 messages using the PDA's display 16 and CPU. The device 10 includes a pair of cellular phone hardware activating buttons 20 to turn the cellular phone on and 22 to turn the cellular phone off. Navigation pad actuator 18 is similar to a joy or force stick in that the actuator 18 manually provides movement commands that can be used by the PDA's software to move a cursor on display 16. Switches 26 and 28 are designed to quickly select an operator specified

20 network software program. Speaker 24 and microphone 38 are used for audio messages.

Switch 19 at the top left of device 10 is the power on and power off switch for the entire device.

The heart of the invention lies in the forced message alert software application program provided in each PC or PDA/cell phone. The forced message alert software application program is activated through use of a screen drawn soft switch or by clicking on an icon on the PC or PDA/cell phone display screen or when a forced message alert transmission is received by another PC or PDA/cell phone. The display 16 is mounted within the housing 12 as part of the PDA and the CPU (not shown). The internal CPU includes databases and software application programs that provide for a geographical map and georeferenced entities that are shown as display portion 16b that includes as part of the display various areas of interest in the particular local map section.

When looking at display 16, the software switches (soft switches) which appear at the very bottom of the display 16d are used to control by touch many of the software driven functions of the PDA/cell phone. The soft switches are activated through the operator's use of the navigation pad 18, or a small track ball, force stick or similar hardware display cursor pointing device. Alternatively, the operator may choose to activate the software switches by touching the screen with a stylus 14 (or finger) at the switches' 16d locations. When some of the software switches are activated, different software switches appear. The bar display 16d shows the software switches "ZM IN (zoom in)," "ZM OT (zoom out)," "CENT (center)" and "GRAB (pan/grab)" at the bottom of the screen. These software switches enable the operator to perform these functions. The "SWITH (switch)" software switch at the lower right causes a

matrix of layered software switches (soft switches) to appear above the bottom row of switches. Through use of the software switches, the operator can also manipulate the geographical map 16b or chart display. When looking at Figure 1a, display symbols depict permanent geographical locations and buildings are shown. For example, the police station is shown and, when the symbol is touched by the stylus or finger, the latitude and longitude of the symbol's location, as shown in display section 16c, is displayed at the bottom left of the screen. The bottom right side of display 16c is a multifunction inset area that can contain a variety of information including: a) a list of the communication link participants; b) a list of received messages; c) a map, aerial photograph or satellite image with an indication of the zoom and offset location of the main map display, which is indicated by a square that depicts the area actually displayed in the main geographical screen 16b; d) applicable status information; and e) a list of the communication net participants. Each participant user would have a device 10 shown in Figure 1a and 1b.

Also shown on the display screen 16, specifically the geographical display 16b, is a pair of different looking symbols 30 and 34, a small triangle and a small square, which are not labeled. These symbols 30 and 34 can represent communication net participants having cellular phones in the displayed geographical area that are part of the overall cellular phone communications net, each participant having the same device 10 used. The latitude and longitude of symbol 30 is associated within a database with a specific cell phone number and, if available, its IP address and E-mail address. The screen display 16b, which is a touch screen, provides x and y coordinates of the screen 16b to the CPU's software from a map in a

geographical database. The software has an algorithm that relates the x and y coordinates to latitude and longitude and can access a communications net participant's symbol or a fixed or movable entity's symbol as being the one closest to that point.

In order to initiate a telephone call to the PDA/cell phone user (communication net participant) represented by symbol (triangle) 30 at a specific latitude and longitude displayed on chart 16b, the operator touches the triangle 30 symbol with the stylus 14. The operator then touches a "call" software switch from a matrix of displayed soft switches that would overlay the display area 16c. Immediately, the PDA/cell phone will initiate a cellular telephone call to the PDA/cell phone user at the geographical location shown that represents symbol 30. A second PDA/cell phone user (communication net participant) is represented by symbol 34 which is a small square (but could be any shape or icon) to represent an individual cellular phone device in the display area. The ring 32 around symbol 30 indicates that the symbol 30 has been touched and that a telephone call can be initiated by touching the soft switch that says "call." When this is done, the telephone call is initiated. Other types of symbolic elements on the display 16 can indicate that a cellular phone call is in effect. Additionally, the operator can touch both symbol 34 and symbol 30 and can activate a conference call between the two cellular phones and users represented by symbols 30 and 34. Again, a symbolic ring around symbol 34 indicates that a call has been initiated.

Equally important, an operator/user with a PDA/cell phone call the police station or any other specific geographical facility displayed on the cell display map, including: buildings, locations of people, vehicles, facilities, restaurants, and the like, whose PDA/cell phone

numbers and, if available, E-mail addresses, IP addresses and their URLs are previously stored in the database, by touching a specific facility location on the map display using the stylus 14 and then touching the cellular phone call switch. As an example, the operator/user can touch and point to call a restaurant using a soft switch by touching the restaurant location
5 on the display with a stylus and then touching the call soft switch. The cellular phone will then call the restaurant. Thus, using the present invention, each participant can touch and point to call to one or more other net participants symbolically displayed on the map, each of whom has a device as shown in Figure 1a and can also point to call facilities and regular phone numbers that had been previously stored in the phone's database. Furthermore, this symbol
10 hooking and soft switch technique can be used to go to a fixed facility's website or to automatically enter the fixed facility's E-mail address in an e-mail.

Each PDA/cell phone user device is identified on the map display of the other participants users' phone devices by a display symbol that is generated on each user phone display to indicate each user's identity. Each symbol is placed at the correct geographical
15 location on the user display and is correlated with the map on the display. The operator of each PDA/cell phone device may also enter one or more other fixed entities (buildings, facilities, restaurants, police stations, etc.) and geo-referenced events such as fires, accidents, or other events into its database. This information can be likewise transmitted to all the other participants on the communications net. The map, fixed entities, events and PDA/cell phone
20 device communication net participants' latitude and longitude information is related to the "x" and "y" location on the touch screen display map by a mathematical correlation algorithm.

When the PDA/cell phone device user uses a stylus or finger to touch one or more of the symbols or a location displayed on the cellular phone map display, the system's software causes the status and latitude and longitude information concerning that symbol or location to be displayed. In order to hook a symbol or "track" such as another net participant which represents an entity on the geo-referenced map display, or a fixed geographical entity such as a restaurant, police station or a new entity observed by a cell phone user which is discussed below, the operator points at or near the location of a geo-referenced symbol appearing on the PDA/cell phone display that represents a specific track or specific participant or other entity. The hook application software determines that the stylus is pointed close to or at the location of the symbol and puts a circle, square or other indication around the symbol indicating that amplification information concerning the symbol is to be displayed and indicating that additional data or change in data can be made to the indicated symbol. The hook application code then sends a message to the display application code to display the net participant, facility or entity's amplifying data. The display application code retrieves the primary data and amplification data concerning the symbol or entity from the database and displays the information at the correct screen location. The operator can then read the amplification data that relates to that specific symbol at the specific location. The PDA/cell phone operator can also select soft switches on the touch screen display to change the primary data and amplification data. Furthermore, the operator can use a similar method of hooking and selecting to activate particular soft switches to take other actions which could include: making cellular phone calls, conference calls, 800 number calls; sending a free text message, operator

selected preformatted messages, photographs or videos to the hooked symbol; or to drop a entered symbol.

Each known net participant has a PDA/cell phone number, IP address and, if available, E-mail address that is stored in each participant's device database.

5 Referring now to Figure 2, in order to set up a communication network that utilizes the forced message alert system, the forced message alert software application program must be installed on a plurality of PCs and/or PDA/cell phones. The application will provide for a forced alert message that can be designated for transmission according to several criteria: a.) A single PC and/or PDA/cell phone, b.) The list of users currently participating in the network,
10 and c.) A user or administrator predefined list of network participants.

A required response list which will be either preinstalled in the phone application software or sent with the forced message alert will be presented to the user operator upon receipt of the forced message. When the forced text or voice alert is received, the user operator is presented with the required response list. In order to clear the forced text message alert from
15 the user operator's PC or PDA/cell phone display, the user operator is required to select a reply from this list. If the alert is a voice message, the message keeps repeating at a defined rate until the user operator selects from the required response list. A military default response list would typically consist of choices such as, "will comply," will not comply," and "have complied." However, depending on the nature of the industry in which the users in the
20 communication network are in, this default response list could vary significantly.

The contact and identifying information for each PC and PDA/cell phone that is anticipated to be a member of the communication network and the default response list is loaded on to every member PC and PDA/cell phone in the preferred embodiment. This step makes sure the each user of the communication network has, in addition to the necessary software, the necessary information to send a forced message alert to any and every known member of the communication network. When operating in an open network mode where all that know the password can join the network, the default list is created or expanded as new members join.

Referring now to Figure 3A and Figure 3B, the process of sending a forced message alert from a PC or PDA/cell phone begins with a sender selecting the forced message alert software application program on a sender PC or PDA/cell phone. The sender can then select by said sender PC or PDA/cell phone to type a text message or record a voice message or select the text alert or voice alert from a list. Once the sender types a text message or records a voice message or selects a voice or text message on said PC or PDA/cell phone, the sender can then use a soft switch or selection from a list to send the forced alert to: a.) Another network participant, b.) The current PC or PDA/cell phone network participants or c.) A user or administrator predefined list of network participants. 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 then transmitted via TCP/IP or other digital transmission means to every PC or PDA/cell phone designated to receive the forced

message alert either directly or through a server whose function is to retransmit the messages to the correct users in the communications network.

After the forced message alert is transmitted, the sender PC or PDA/cell phone monitors for and receives electronic transmissions with acknowledgments of receipt from the
5 PCs or PDA/cell phones that have received the forced message alert. Then, the sender PC or PDA/cell phone provides an indication of which of the PC or PDA/cell phone that the forced message alert was sent to have acknowledged receipt and which of the PC or PDA/cell phone that the forced message alert was sent to have not acknowledged receipt on its display. The sender PC or PDA/cell phone will then periodically resend the forced message alert to the PC
10 or PDA/cell phone that have not acknowledged receipt.

The sender PC or PDA/cell phone also monitors for and receives electronic transmissions with manual responses to the forced message alert from the PC or PDA/cell phone that received the message. As these electronic transmissions with manual responses are received, the sender PC or PDA/cell phone displays an indication of the response from each
15 recipient cell phone, integrated PDA/cell phone and PC.

Referring now to Figure 4, the process of receiving, acknowledging and responding to a forced message alert from the sender PC or PDA/cell phone begins when an electronic transmission is received by a recipient PC or PDA/cell phone. When the electronic transmission is received by the recipient PC or PDA/cell phone, the recipient PC or PDA/cell
20 phone identifies the transmission as a forced message alert and the forced message alert software application program on the recipient PC or PDA/cell phone separates the text or

voice message and the forced message alert software packet. Immediately following the detection of the forced message alert, the forced message alert software application program on the recipient PC or PDA/cell phone prepares and electronically transmits an automatic acknowledgement of receipt to the sender PC or PDA/cell phone. However, if the recipient PC
5 or PDA/cell phone is powered off or is not able to receive electronic transmissions, the forced message alert is not received by the recipient PC or PDA/cell phone and no acknowledgment is transmitted. If no acknowledgement is received, the sender PC or PDA/cell phone continues to transmit the forced alert at a predefined rate until acknowledged.

After the acknowledgement of receipt is transmitted, the forced voice alert software
10 application program effectively takes control of the recipient PC or PDA/cell phone. If a text message was received, the forced voice alert software application program causes the text message and the response list to be shown on the display of the recipient PC or PDA/cell phone until a manual response is selected from the response list. Upon selection of the desired response, the forced alert text data is cleared from the recipient PC or PDA/cell phone display.
15 If a voice message was received, the forced voice alert software application program causes the voice message to be periodically repeated using the speakers of the recipient PC or PDA/cell phone while the response list is shown on the display. This voice message cannot be stopped from repeating until one of the entries on the response list is selected.

Once a response is selected or recorded and transmitted to the sender PC or PDA/cell
20 phone, the forced message alert software application program releases effective control of the

recipient PC or PDA/cell phone, clears the display, and or stops repeating the voice message and transmits the response to the force alert sender.

The instant invention has been shown and described herein in what is considered to be the most practical and preferred embodiment. It is recognized, however, that departures may
5 be made there from within the scope of the invention and that obvious modifications will occur to a person skilled in the art.

CLAIMS

What is claimed is:

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

5 a predetermined network of participants, wherein each participant has a similarly equipped PC or 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 PCs and said PDA/cell phones in different locations;

10 a sender PC or PDA/cell phone and at least one recipient PC or PDA/cell phone for each electronic message; and

a forced message alert software application program loaded on each participating PC or PDA/cell phone.

2. The system as in claim 1, wherein the forced message alert software application
15 program on the sender PC or 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 PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains a response list and requires the forced message alert software on said recipient PC or PDA/cell
20 phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone;

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient PCs
5 or PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

3. The system as in claim 1, wherein the forced message alert software application
10 program on the recipient PC or PDA/cell phone:

means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone;

means for controlling of the recipient PC or PDA/cell phone upon transmitting
15 said automatic acknowledgment and causes, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message to be periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmits said manual response to the sender PC or PDA/cell phone; and

5 means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stops the repeating voice message and clears the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted.

4. The system as in claim 1, wherein said data transmission means is TCP/IP or another communications protocol.

10 5. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

6. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the
15 specific forced message alert is created on the sender PC or PDA/cell phone.

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

20 accessing a forced message alert software application program on a sender PC or PDA/cell phone;

creating the forced message alert on said sender PC or 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 PCs or PDA/cell phones in the
5 communication network;

electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones;

receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell
10 phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert;

periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient PCs or
15 PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone; and

clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response.

8. The method as in claim 7, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert
20 software application program loaded on it.

9. The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

11. A method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message;

identifying said electronic message as a forced message alert, wherein said forced message alert consists of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of

the voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone; and

transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone;

displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone; and

providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.

12. The method as in claim 11, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

13. The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

ABSTRACT OF THE DISCLOSURE

The system and method having a specialized software application on a personal computer or a PDA/cell phone that that enables a participant to force an automatic acknowledgement and a manual response to a text or voice message from other participants

5 within the same network. Each participant's PC or 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 PC or PDA/cell phone to one or more recipient PCs and PDA/cell phones

10 within the communication network; (b) automatically transmit an acknowledgement of receipt to the sender PC or 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

15 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 PC or PDA/cell phone of the status and content the manual responses

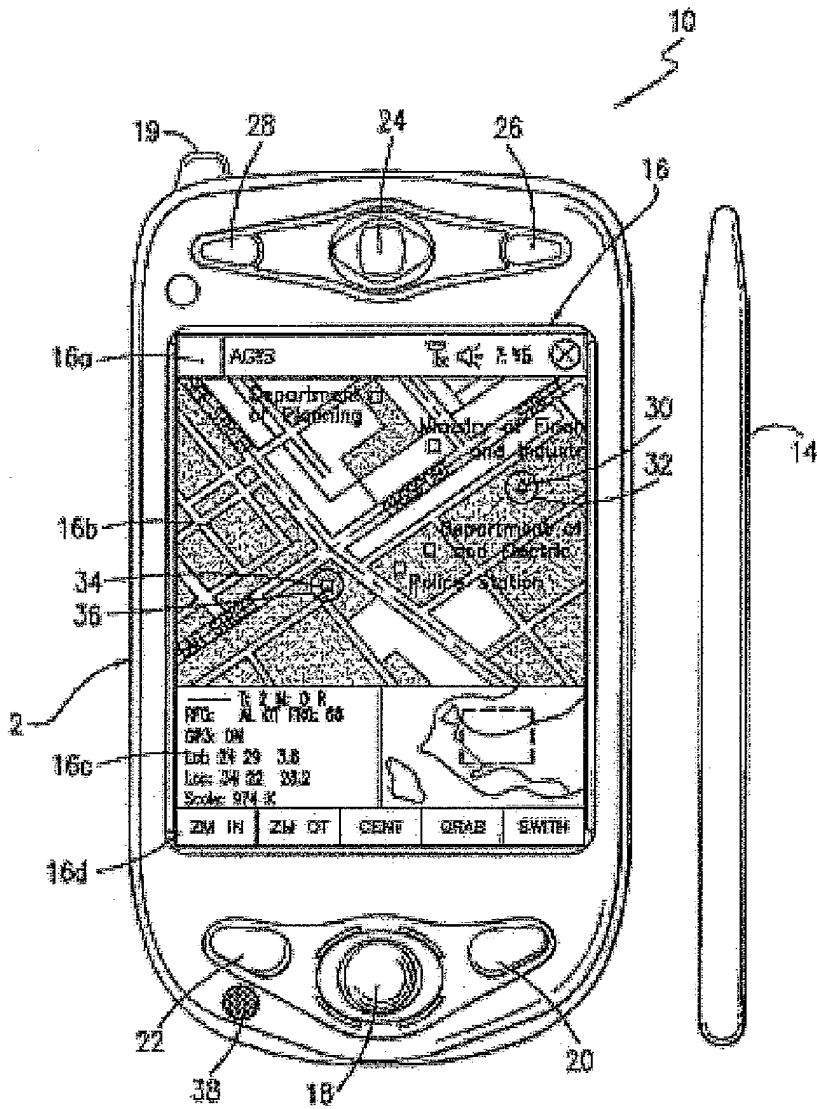


Fig 1a

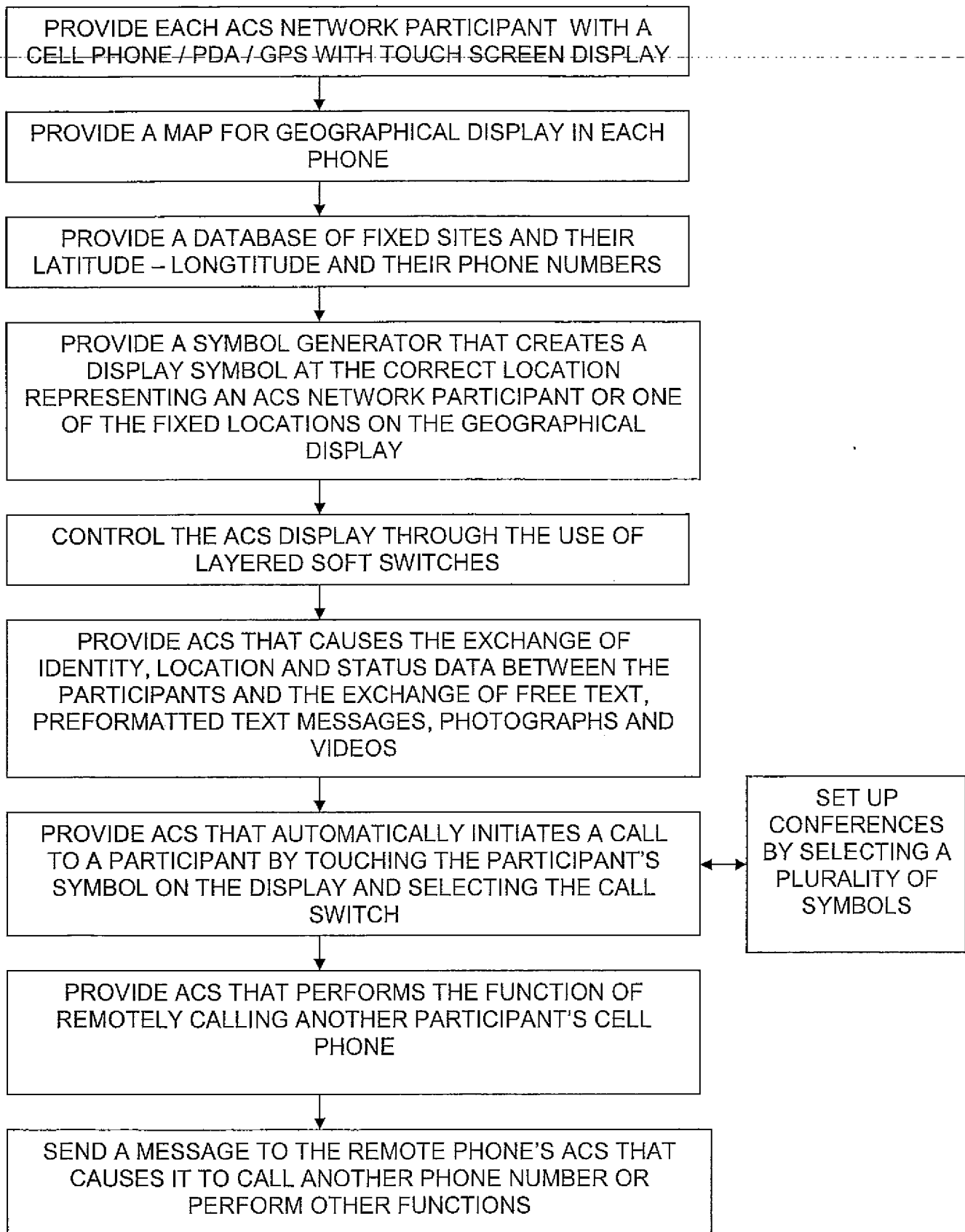


Fig 1b

Fig. 2

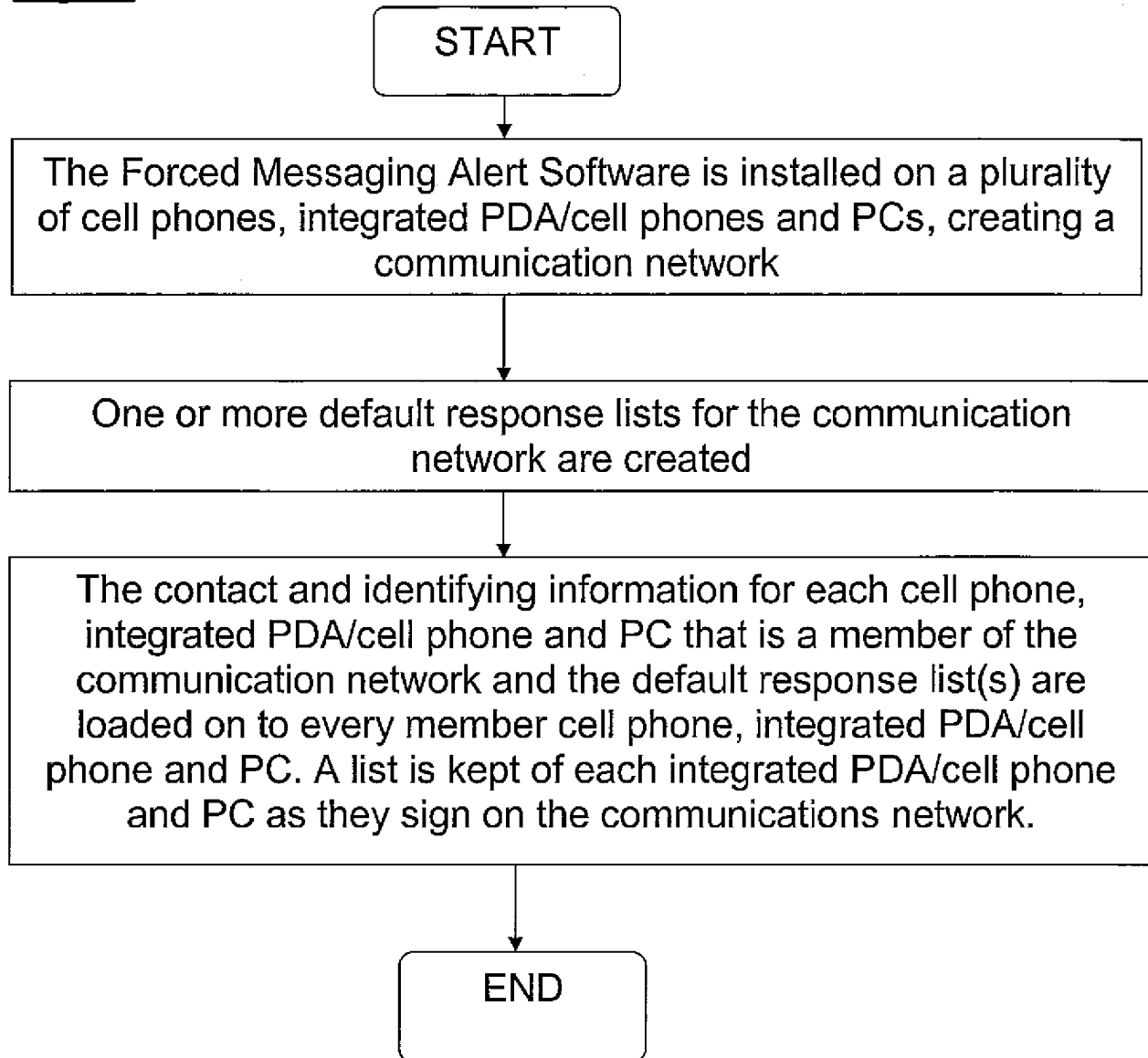
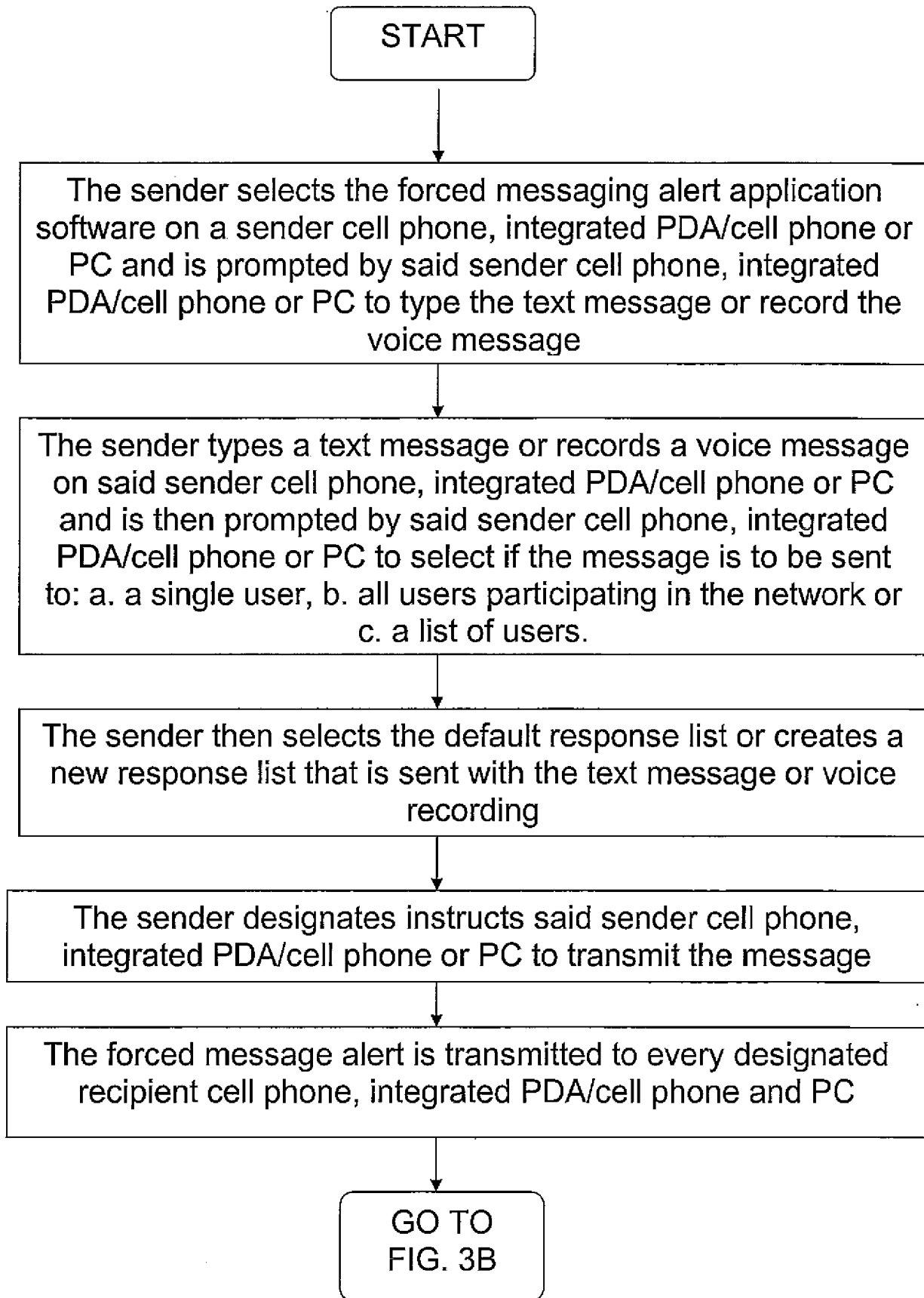


Fig. 3A



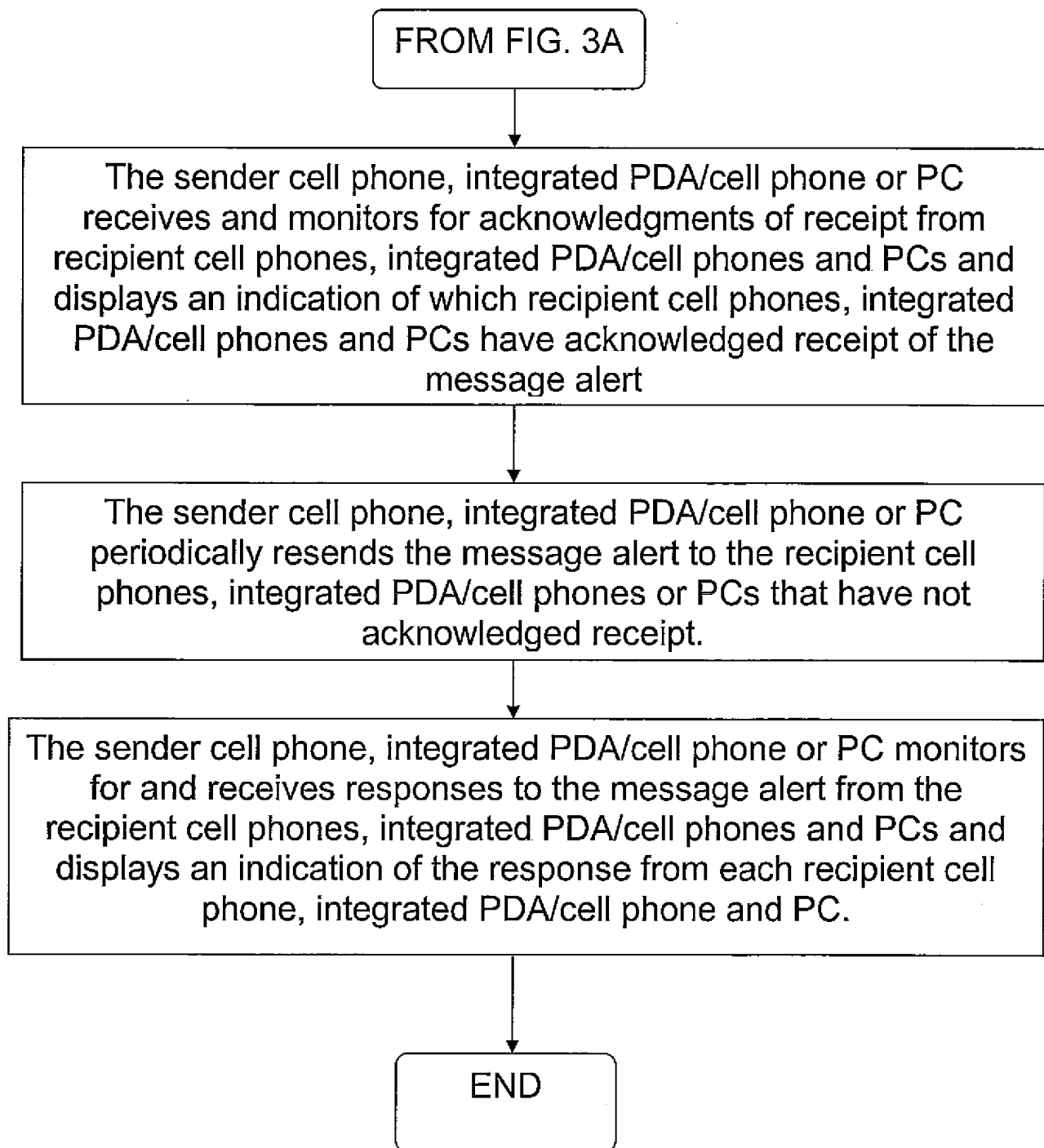
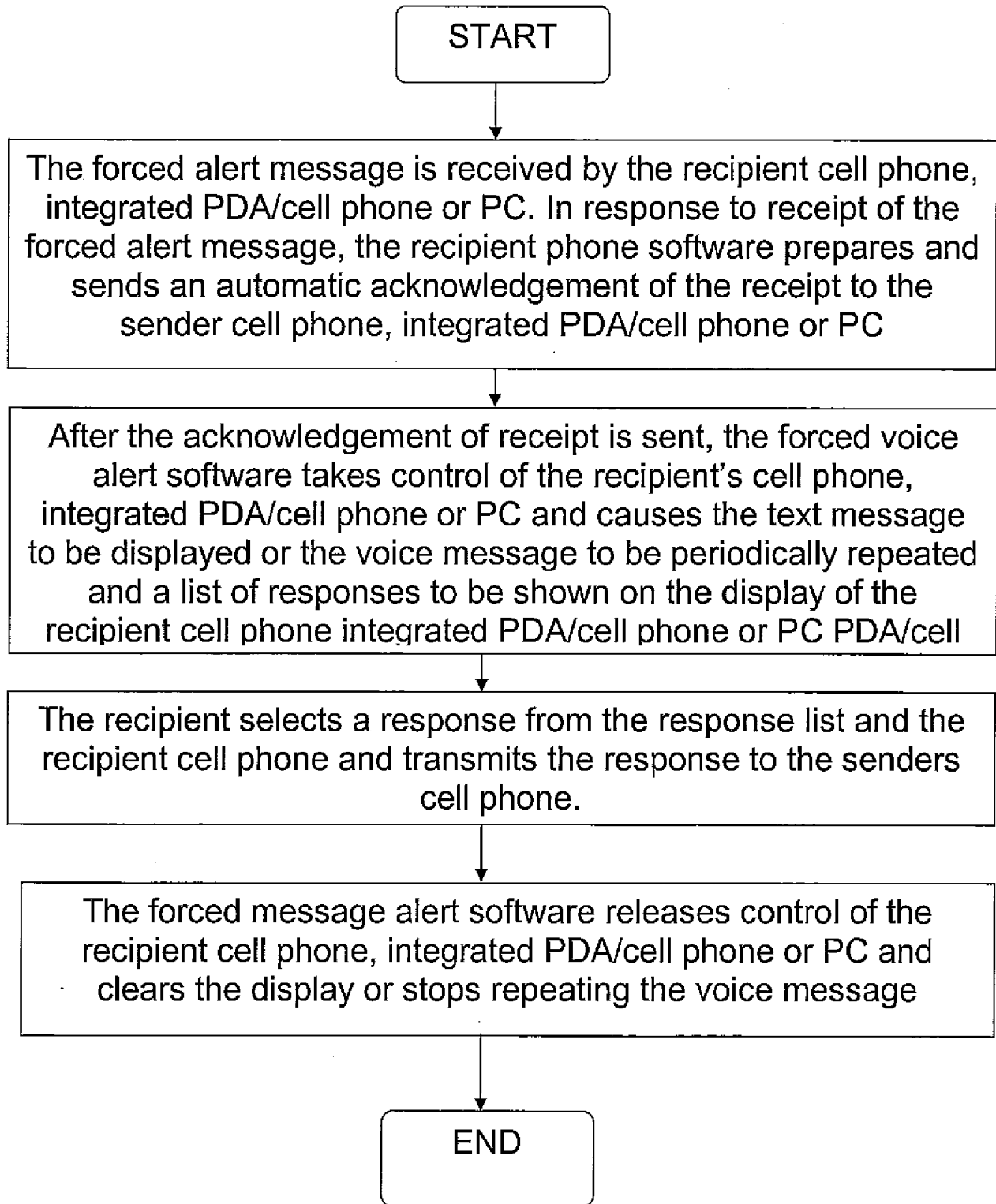


Fig. 4



DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION
(English Language Declaration)

Our File No.: 10963.3819

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: **METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS**, the specification of which (check one):

is attached hereto
 was filed on _____ as Serial No. _____ and was amended on _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability, as defined in Title 37, Code of Federal Regulations §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

<u>Prior Foreign Application(s)</u>		<u>Day/Month/Year</u>	<u>Priority Claimed</u>	
<u>Number</u>	<u>Country</u>		<u>Yes</u>	<u>No</u>

I hereby claim the benefit under Title 35, United States Code, Section 120, of any United States application(s) or PCT international application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations 1.56, which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Status</u>
11/612,830	December 19, 2006	
11/308,648	April 17, 2006	Pending
10/711,490	September 21, 2004	Issued (U.S. Patent No. 7,031,728)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY

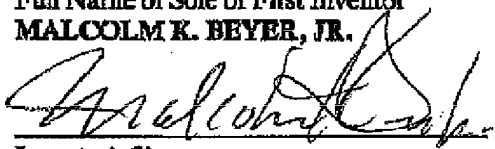
As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith along with any and all foreign applications filed and foreign patents issued therefrom.

Barry L. Haley, Registration No. 25,339
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Second Inventor's Signature Date

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F:\10893\fm\3819\declaration

Electronic Patent Application Fee Transmittal

Application Number:	
Filing Date:	
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcom K. Beyer, Jr.
Filer:	Barry Lee Haley
Attorney Docket Number:	10963.3819

Filed as Small Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Utility filing Fee (Electronic filing)	4011	1	82	82
Utility Search Fee	2111	1	270	270
Utility Examination Fee	2311	1	110	110

Pages:

Claims:

Miscellaneous-Filing:

Petition:

Patent-Appeals-and-Interference:

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				
Miscellaneous:				
Total in USD (\$)				462

Electronic Acknowledgement Receipt

EFS ID:	4362702
Application Number:	12324122
International Application Number:	
Confirmation Number:	9036
Title of Invention:	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
First Named Inventor/Applicant Name:	Malcom K. Beyer, Jr.
Customer Number:	22235
Filer:	Barry Lee Haley
Filer Authorized By:	
Attorney Docket Number:	10963.3819
Receipt Date:	26-NOV-2008
Filing Date:	
Time Stamp:	15:16:33
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$462
RAM confirmation Number	2080
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

File Listing:					
Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Application Data Sheet	3819Ads.pdf	1685926 b27df136d29b2f60ba1bea36a6cba31fa7e4b541	no	4
Warnings:					
Information:					
2		3819application.pdf	866380 810f2429d9d42bb1d2ced1228c2d0bdfec7ca132	yes	33
	Multipart Description/PDF files in .zip description				
	Document Description		Start	End	
	Specification		1	18	
	Claims		19	24	
	Abstract		25	25	
	Drawings-only black and white line drawings		26	31	
	Oath or Declaration filed		32	33	
Warnings:					
Information:					
3	Fee Worksheet (PTO-06)	fee-info.pdf	33183 03dceb97e3360ef3a08a09a4506746fe7683d6f7	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			2585489		

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Filing Date: 11/26/08

Approved for use through 7/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 12/324,122
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APPLICATION AS FILED – PART I			SMALL ENTITY		OTHER THAN SMALL ENTITY	
	(Column 1)	(Column 2)				
FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)	RATE (\$)	FEE (\$)
BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	82	N/A	
SEARCH FEE (37 CFR 1.16(k), (l), or (m))	N/A	N/A	N/A	270	N/A	
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	110	N/A	
TOTAL CLAIMS (37 CFR 1.16(j))	14	minus 20 =	x\$26		x\$52	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	3	minus 3 =	x\$110		x\$220	
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR					
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))			195		390	
			TOTAL	462	TOTAL	

* If the difference in column 1 is less than zero, enter "0" in column 2.

APPLICATION AS AMENDED – PART II					SMALL ENTITY		OTHER THAN SMALL ENTITY	
	(Column 1)	(Column 2)	(Column 3)					
AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)	ADDITIONAL FEE (\$)
Total (37 CFR 1.16(j))	*	Minus **	=	X =		X =		
Independent (37 CFR 1.16(h))	*	Minus ***	=	X =		X =		
Application Size Fee (37 CFR 1.16(s))								
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))				N/A		N/A		
				TOTAL ADD'T FEE		TOTAL ADD'T FEE		

APPLICATION AS AMENDED – PART II					SMALL ENTITY		OTHER THAN SMALL ENTITY	
	(Column 1)	(Column 2)	(Column 3)					
AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)	ADDITIONAL FEE (\$)
Total (37 CFR 1.16(j))	*	Minus **	=	X =		X =		
Independent (37 CFR 1.16(h))	*	Minus ***	=	X =		X =		
Application Size Fee (37 CFR 1.16(s))								
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))				N/A		N/A		
				TOTAL ADD'T FEE		TOTAL ADD'T FEE		

- * If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
 - ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
 - *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
- The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.