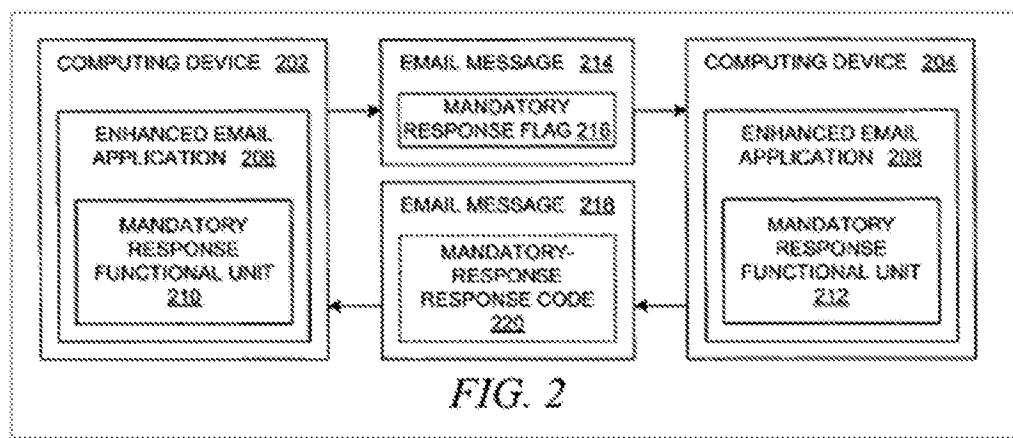


Kubala discloses the combination of an enhanced email application 208 and mandatory response functional unit 212 on a recipient computing device 204 (e.g., PDA), as illustrated in Figure 2 (reproduced below). (See Kubala, ¶¶33-36; see also Williams, ¶187.)



(Kubala, FIG. 2.)

Kubala also teaches or suggests the claimed functionality of “transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone.” In fact, 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.” (Kubala, ¶6.) Based on these teachings in Kubala, a POSA would have understood that the condition that causes the acknowledgement to be sent back to the sender is a configurable parameter, which could be set to occur when the sender’s email message is received at its intended destination or, in other words, as soon as it is received at the recipient’s device. (See Williams, ¶¶188-191.)

[2.2] 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;

In the Final Written Decision, the Board states that “Kubala teaches e-mail application 206 *taking control* of a PDA/cell phone” (*See Google*, IPR2018-01079, FWD at 52.):

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.

(*See id.*)

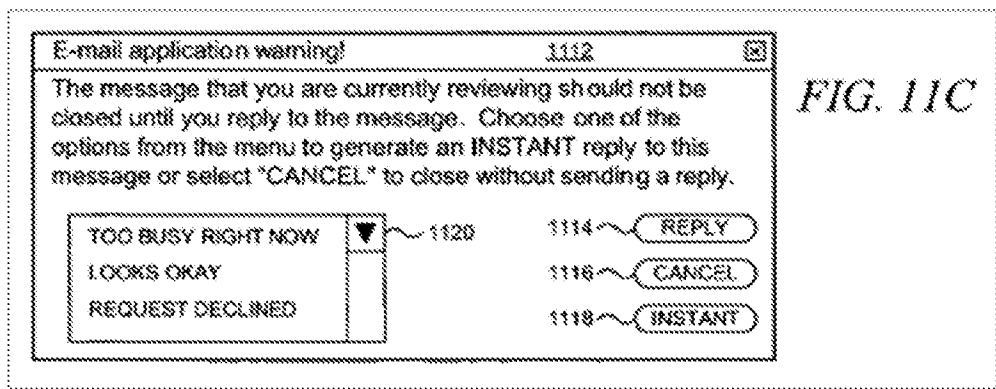
We note that a finding that Kubala teaches e-mail application 206 taking control of a PDA/cell phone would be further supported by Kubala’s disclosure that “the user must reply to the received e-mail in some manner *before the e-mail application will allow the user to perform some other action.*”

(*See id.* at 52-53 (emphasis in original); *see id.* at 51.)

Kubala teaches or suggests the structure and Kubala and Hammond disclose the claimed function of this limitation. Again, the structure for the recited “means for controlling. . .” is a

software application program on a PDA that performs the recited function. (*See supra* Section VI.H.) Like this structure, Kubala discloses the combination of an enhanced email application 208 and mandatory response functional unit 212 on a recipient computing device 204 (e.g., PDA). (Kubala, ¶¶33-36, FIG. 2; *see also* Williams, ¶¶192-193.)

First, Kubala discloses the required function of “controlling . . . the recipient PDA/cell phone upon transmitting said automatic acknowledgment.” As discussed above, Kubala discloses various embodiments for requiring a response to an “e-mail message.” And Kubala explains that its disclosure is not limited to only emails; instead, according to Kubala, “an e-mail message comprise various types of electronic messages, e.g., text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages.” (Kubala, ¶32.) Each of the embodiments that Kubala explicitly discloses and suggests “represent[s] 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.*, ¶54.) In particular, Kubala discloses that “the user *must* reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” (*Id.*, ¶53.) As the Board noted, these disclosures satisfy the “controlling” limitation. (*Google*, IPR2018-01079, FWD at 52-53 (“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.*’”) (emphasis in original) (citing Kubala, ¶53); *see also* Williams, ¶194.)



(Kubala, FIG. 11C.)

Although the specific embodiment illustrated in Figure 11C shows that a user can “select ‘CANCEL’ to close without sending a reply,” Kubala also explicitly teaches that “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.” (Kubala, ¶9, FIG. 11C; *see also id.*, ¶55.) Moreover, Kubala also discloses that a recipient being required to respond to a mandatory-response message is a configurable feature. (*See id.*, ¶¶9, 54-55, 59-60.) For example, the recipient may be required to respond “when the recipient first reviews the e-mail message.” (*Id.*, ¶60; *see also* Williams, ¶195.)

Kubala’s Figure 11A (reproduced below) shows an example of alerting a user by displaying a warning message 1102 when an e-mail message that contains a mandatory request flag is received, and shows that the recipient “*must provide* a reply message in response to the original message.” (*Id.*, ¶54; *see also* Williams, ¶196.)

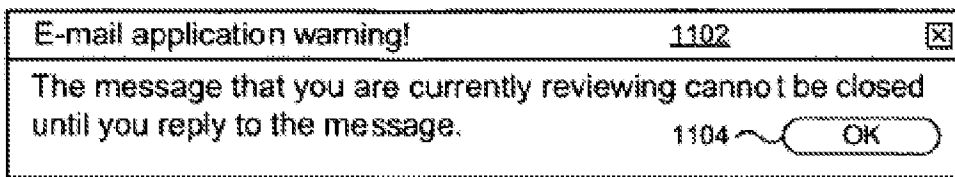
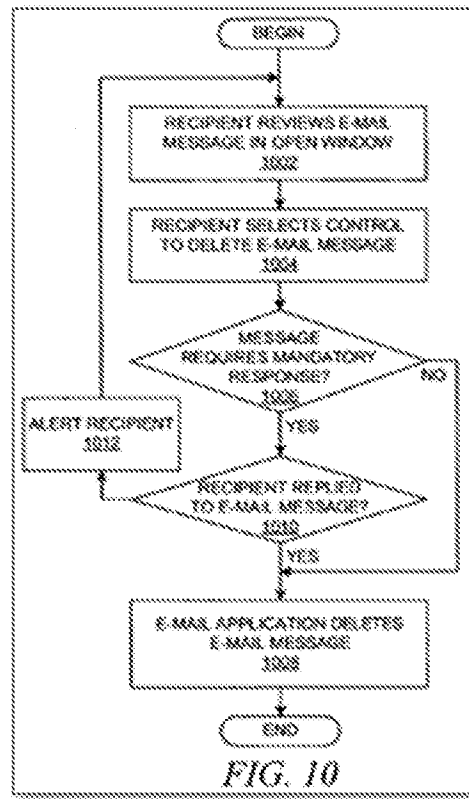


FIG. 11A

(Kubala, FIG. 11A.)

Second, Kubala teaches or suggests the claimed requirement of “causing, in cases where the force[d] 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.” As set forth above, Kubala explains that e-mail message 214 may be a **text** message or a **voicemail or audio** message. (Kubala, ¶32.) Kubala discloses that when a reply to an email message with an associated mandatory-response flag has not been made, the enhanced email application 208 loops back to alert the recipient via 1012, as illustrated in Figure 10 (reproduced below). The looping back at 1012 has the effect of resending the message—that can be a text or voice message—to the user until the user replies to the received message as required. (*See id.*, ¶53, FIG. 10.) Thus, Kubala teaches or suggests these claimed functions. (*See* Williams, ¶197.)



(Kubala, FIG. 10.)

To the extent that it is argued that Kubala does not teach this limitation, Hammond’s “system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed.” (Hammond, 2:47-50; *see also id.*, Abstract, 2:1-8, 4:21-28, 5:5-6:20, 6:66-7:63, 10:48-63, FIGS. 2, 3A, 3B, 4, 5A, 5B.) As explained above (*see* claim [1.7] and Section IX.A.1), a POSA would have been motivated to combine Kubala and Hammond. (Williams, ¶198.)

[2.3] 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 PDA/cell phone; and

Kubala discloses the structure and Kubala and Hammond disclose the claimed function of this limitation. The structure for this “means for . . .” limitation is a software application program on a PDA that performs the recited function. (*See supra* Section VI.I.) Like this structure, Kubala’s Figure 2 (reproduced below) shows that a receiving PDA (e.g., computing device 204) can receive

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