# EXHIBIT J

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC
Petitioner

v.

AGIS SOFTWARE DEVELOPMENT, LLC
Patent Owner

_____

Case IPR2018-01079
Patent 8,213,970

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**DECLARATION OF DAVID HILLIARD WILLIAMS IN SUPPORT OF PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,213,970**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Google 1003
U.S. Patent No. 8,213,970

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*e)*      *Claim 6*

134.    Kubala in view of Hammond discloses and/or renders obvious each and every limitation recited in claim 6. Claim 6 is reproduced below. The claim limitations have been labeled for ease of discussion.

> 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:

135.    The combination of Kubala and Hammond discloses the preamble, to the extent it is limiting. As set forth above, Kubala discloses a method for sending a forced message alert to one or more recipient PDA/cell phones within a predetermined communication network. (*See supra* claims [1.1], [1.3]; Kubala, ¶¶[0026]-[0027], FIG. 1A.) A POSA would have recognized that communication networks involving PDAs/cell phones were widespread, whether it was within a large carrier network, a group of users with a preexisting relationship (e.g. employees of a company), or a small, specific-function network such as a first responder incident management system. And as also set forth above, Hammond discloses the ability to track the receipt and response to forced message alerts. (*See supra* claim [1.7]; Hammond, Abstract, 2:11-18, 3:1-4:28, 5:20-35, 10:6-22, 6:56-8:45, FIG. 2.)

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

136.    As set forth above, Kubala discloses an enhanced email application that reads on this limitation. (*See supra* claim [1.4]; Kubala, ¶¶[0013], [0033]-[0036], FIG. 2.) It would have been well known to a POSA at the time of the patent filing that PDAs and cell phones could run applications. A POSA would further recognize thatmessaging-related application would necessitate being accessed by a sender as part of a messaging transaction. A POSA would also recognize that there were numerous email programs in existing prior to the earliest possible '970 priority date, and the POSA would recognize that such email programs could be readily enhanced by adding a forced message alert capability.

> [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;

137.    As set forth above, Kubala teaches or suggests creating the forced message alert on said sender PDA/cell phone by attaching a forced message alert application software packet to said voice or text message—as required by this limitation. (*See supra* claim [1.5]; Kubala, ¶¶[0032]-[0036], [0037]-[0041], [0054]-[0061], FIGS. 1A, 1B, 2-4.) A POSA would have recognized that appending or attaching information (e.g. packets) to email messages was well known. For

example, a message could be designated as "Urgent" or sent with a

Delivery/Return Receipt request. A POSA would have also recognized that voice-

messaging systems also attached packets or information to voice messages, with

"Urgent" and "Return Receipt requested" being examples.

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

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138.   As set forth above, Kubala teaches or suggests designating one or

more recipient PDA/cell phones in the communication network—as required by

this limitation. (*See supra* claim [1.5]; Kubala, ¶¶[0032]-[0036], [0037]-[0044],

[0054]-[0061], FIGS. 1A, 1B, 2-5.) A POSA would recognize that any messaging

application (besides a blanket broadcasting application) would necessitate

designating one or more recipient PDA/cell phones in the communications

network, to ensure both that the appropriate recipients received the message, and

inappropriate PDAs/cell phones did *not* receive the message.

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

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139.   As set forth above, Kubala teaches or suggests this claim feature. (*See*

*supra* claim [1.5]; Kubala, ¶¶[0032]-[0036], [0037]-[0044], [0054]-[0061], FIGS.

1A, 1B, 2-5.) As stated earlier, the ability to receive messages on PDA/cell phones

had been known in the art since at least as early as 1993 with the introduction of

the IBM Simon.

[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;

140.   As set forth above, the combination of Kubala and Hammond teaches

or suggests the features in this limitation. (*See supra* claims [1.5] and [1.7];

Kubala, ¶¶[0032]-[0036], [0037]-[0044], [0054]-[0061], FIGS. 1A, 1B, 2-5;

Hammond, Abstract, 2:11-18, 3:1-4:28, 5:20-35, 10:6-22, 6:56-8:45, FIG. 2.) A

POSA would have recognized that keeping track of which recipient PDA/cell

phones had or had not acknowledged receipt of the forced message would be a

simple database table update that would list the phone numbers the forced message

were sent, and updating that table when a receipt was received (with a "Yes",

and/or time stamp for example). It could easily also track when the forced message

had been sent, and thus easily determine how long it had been since the sending so

as to potentially resend the message if a certain period of time had elapsed.

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

141. As set forth above, the combination of Kubala and Hammond teaches or suggests the features in this limitation. (*See supra* claim [1.8]; Kubala, ¶¶[0033]-[0036], FIG. 2; Hammond, 2:47-50; *see also id.,* Abstract, 2:1-8, 4:21-28, 5:5-6:19, 6:66-7:63, 10:48-63, FIGS. 2, 3A, 3B, 4, 5A, 5B.) Periodic sending of alerts was well known in the art well before the '970 patent filing date, either through a scheduling process (e.g. 3:30pm, 3:45pm, 4:00pm), or a repeating time interval (e.g. every 15 minutes) until a goal (e.g. message receipt), deadline (e.g. 4:30pm), or number of repeats (e.g. 5) was reached.

> [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

142. Kubala discloses this limitation. For example, Kubala's Figure 2 illustrates that a sending PDA (e.g., computing device 202) may receive an email message 218 from a recipient PDA (e.g., computing device 204) in response to an email message 214 with a mandatory response flag 216. (*See* Kubala, ¶¶[0033]-[0036].)

*FIG. 2*
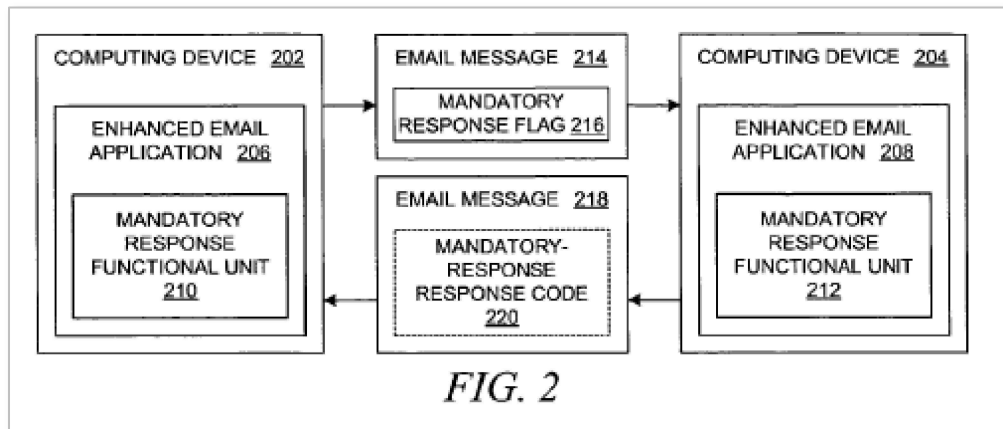
143.    The received email would have been displayed on computing device

202. (*See* Kubala, ¶¶[0028]-[0036], [0041], FIGS. 1A, 1B, 2.) The ability to send

and receive (and also display) email via a PDA/cell phone has been in place since

at least 1993 with the IBM Simon. (Google 1015, Hist. Mobile Phones, p. 7.)

> [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;

144.    As set forth above, Kubala teaches or suggests the features in this

limitation. (*See supra* claims [1.5] and [1.6]; Kubala, ¶¶[0009], [0033]-[0036],

[0040], [0041], [0047], [0054]-[0060], FIGS. 2, 8, 10, 11A, 11C.) The ability to

display a list on a PDA/cell phone is one of the earliest features of PDA, such as

the "list view" using a "list manager" on the Apple Newton in 1993. (Google 1016,

Apple, p. 5.) By the time of the '970 patent, a POSA would readily expect such list

manager-type capabilities to be available on any PDA/cell phone.

[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 [sic] that can only be cleared by manually selecting and transmitting a response to the manual response list.

145.   As set forth above, Kubala teaches or suggests the features in this limitation. (Kubala, ¶¶[0033]-[0036], [0049], [0053], [0054], [0057], FIGS. 2, 8, 10, 11C.) A POSA would have recognized that it would have been a straightforward matter of programming to cause a software process to clear a display screen and/or terminate (after beginning on a repeating schedule) a voice alert upon a certain condition (e.g. a response input from the recipient) being entered into the device (and not before). A POSA would have recognized that PDAs/cell phones would have had the ability to generate sound alerts by the time of the earliest possible priority date of the '970 patent. These sound alerts would have included voice alerts.

146.   Specifically, Kubala discloses that a user can select a response from a menu of responses. (*See* Kubala, ¶[0057], FIG. 11C (reproduced below).)

*FIG. 11C*
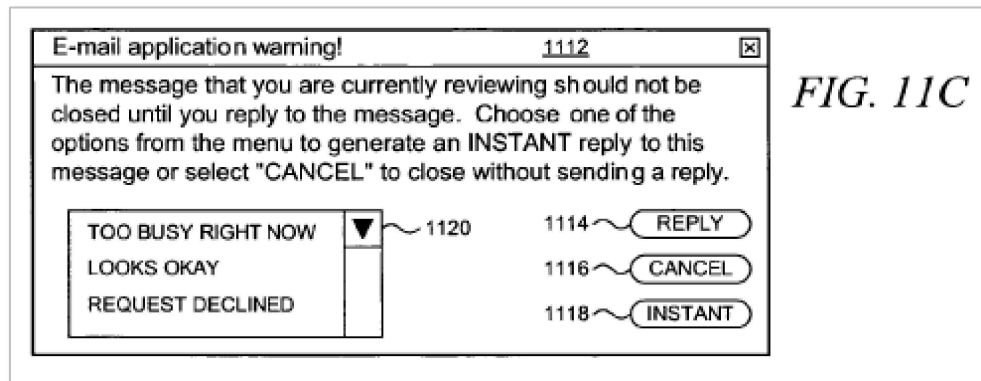
147.   After selecting a response from menu 1120, a user presses the "INSTANT" button 1118, which closes window 1112, thus *clearing* the recipient's cell phone display and generating a reply message. (*Id.*, ¶[0057].) Kubala explains:

> INSTANT" button 1118 **closes window 1112** and then **creates a reply e-mail message** with an automatically generated reply message in which the message body is predetermined or pre-configured; in this example, when "INSTANT" button 1118 is selected, the e-mail application determines which **menu item within menu 1120 has been selected by the user** as a quick response to the original e-mail message, thereby fulfilling the sender's request that the **recipient is required to provide a mandatory response**.

(*Id.*) 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." (*Id.*, ¶0009.) Thus, Kubala teaches or suggests this limitation. A POSA would have

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recognized that it would have been a straightforward matter of programming to

prevent a software process from proceeding further unless a certain condition (e.g.

a response input from the recipient) has been entered into the device.

*f)      Dependent Claim 7*

148.    Kubala discloses the limitation of dependent claim 7. The limitation

of claim 7 is reproduced below.

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.

149.    As set forth above, Kubala teaches or suggests the features of this

limitation. (*See supra* claims [1.1], [1.4]; Kubala, ¶¶[0026]-[0036], FIGS. 1A, 1B,

2.) A POSA would have recognized that it was well known at the time of the filing

that many types of PDA/cell phone applications would require a software program

to be loaded on it in order to work (versus assuming it would have the application

or specific set of capabilities designed into it at manufacture). Furthermore, a

POSA would have recognized that there were numerous email programs in

existence prior to the earliest possible priority date of the '970 patent that would

work on PDAs/cell phones, and thus serve as a platform for the forced message

response application. (Google 1017, Email, p. 1) In particular, the predetermined

network of participates is shown in Kubala's Figure 1A (reproduced below), which