Exhibit 5

to Defendant Uber Technologies, Inc.'s Motion to Dismiss U.S. Patent No. 8,213,970

Attorney Docket No. 2525.993REX0
Control No.: 90/014,507 (Re-exam of U.S. Patent No. 8,213,970)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. PATENT NO.:	8,213,970	ART UNIT:	3992
CONTROL NUMBER:	90/014,507	CONF. NO.:	6188
FILING DATE:	May 15, 2020	EXAMINER:	Kiss, Eric B.

TITLE: **METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS**

FILED ELECTRONICALLY

Mail Stop *Ex Parte* Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION OF DR. LOREN TERVEEN IN SUPPORT OF REPLY UNDER 37 C.F.R. 1.111 TO A NON-FINAL OFFICE ACTION

I, Loren G. Terveen, Ph.D., being duly sworn, hereby state as follows:

Background

1. I am a Professor and Distinguished McKnight University Professor of Computer Science and Engineering at the University of Minnesota. I hold a Ph.D. and Master of Science degree in Computer Sciences from University of Texas and a Bachelor of Arts degree in Computer Science, Mathematics, and History from the University of South Dakota. I have been associated with human-computer interaction, computing systems, and electronics industry as a designer and consultant and am a named inventor on 10 U.S. patents.

2. My skills and experience are in areas of information systems and processing, human-computer interactions, computing systems, location-based data and applications, graphical user interfaces. Specifically, I have:

conducted research regarding algorithm design, human-computer interaction, artificial intelligence, computing systems, and online communities;

taught courses in user interface design, implementation, and evaluation, collaborative and social computing, computer programming, GUI toolkits and implementation, and collaborative computing;

provided expert services, investigating both process and design technologies of various devices (graphical user interfaces), systems (interactive program guide systems, information processing, hypertext, inference, information search), products related to wireless tracking and geofencing; and

3. I am an inventor on a number of patents directed to wireless communication of location and tracking information, including a wireless myoelectric control apparatus and methods and system and method for selecting and displaying hyperlinked information resources.

4. Because of my background, training, and experience, I am qualified as an expert to opine on the patent under examination. A more detailed account of my work experience and other qualifications is listed in my Curriculum Vitae attached as **Exhibit A** to this declaration.

The '970 Patent and its Prosecution History

5. United States Patent No. 8,213,970 ("'970 Patent") is entitled "METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS" and issued on July 3, 2012. The '970 Patent, filed on November 26, 2008, was given Application No. 12/324,122. The '970 Patent includes on independent apparatus claim, four dependent apparatus claims, two independent method claims, and six dependent method claims.

6. I reviewed the prosecution history of the '970 Patent, inclusive of cited prior art, and expect to testify with respect to these documents to explain the subject matter and disclosures of this patent. The following sections contain a summary of this review.

7. An Office Action was issued by the PTO on September 20, 2010, in which the Examiner rejected claims 1 through 14. Claims 1, 4, and 6 were rejected under 35 U.S.C. §

102(e) as anticipated by Keating et al. US 20040082352. Claims 2, 3, and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. US20040082352 in view of Esler et al. US 20050241026. Claims 7 through 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Dalton et al. US20040192365.[1]

8. Applicant submitted an Amendment dated December 17, 2010, that amended claims 2-7, and 11 and canceled claim 1.[2]

9. An Office Action was issued by the PTO on March 11, 2011, in which the Examiner rejected claims 2 through 14. Claims 2 through 10 were 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. Claims 11 through 14 were 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.[3]

10. Applicant submitted an Amendment dated September 9, 2011, that amended claims 2, 3, 7, and 11.[4]

11. A Notice of Allowance was issued by the PTO on April 25, 2012 that allowed claims 2 through 14.[5]

The Level of Ordinary Skill in The Art

12. In my opinion, a person of ordinary skill in the art at the time of the claimed invention is someone with at least a bachelor's degree in computer science or computer engineering with one to two years of experience in the field of computer programming for

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[1] See '970 Patent Prosecution History, Office Action dated Sept. 20, 2010, pp. 2-12.
[2] *Id.*, Preliminary Amendment dated Dec. 17, 2010, pp. 8-12.
[3] *Id.*, Office Action dated March 11, 2011, pp. 2-13.
[4] *Id.*, Preliminary Amendment dated Sept. 9, 2011, pp. 8-12.
[5] *Id.* Notice of Allowance dated Apr. 25, 2012.

communications systems, or the equivalent education and work experience. Extensive experience and technical training might substitute for educational requirements, while advanced degrees might substitute for experience. At times, I will refer to a person of ordinary skill in the art as a "POSITA" or a "skilled artisan."

Rejection 1: The Combination of Kubala, Hammond, Johnson, and Pepe

13. I have reviewed the Office Action mailed on May 3, 2021. I understand that Claims 2 and 10-13 of U.S. Patent No. 8,213,970 (the "'970 Patent") are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application 2006/0218232 ("Kubala"), U.S. Patent No. 6,854,007 ("Hammond"), U.S. Patent No. 5,325,310 ("Johnson"), and U.S. Patent No. 5,742,905 ("Pepe"). I have reviewed the Kubala, Hammond, Johnson, and Pepe references.

14. I note that the portions relied upon in the asserted prior art are directed to email messages. I understand that Patent Owner, in its response to this Office Action, has expressly stated that the claims of the '970 patent do not cover email messages and that, the claimed forced message alerts, specifically, are not email messages. I understand that the Patent Owner has expressly stated that to the extent any parties have incorrectly interpreted forced message alerts to mean email messages, Patent Owner expressly disavows the claim scope for email messages as they would pertain to the claimed forced message alerts.

15. In my opinion, this disavowal of subject matter is particularly relevant to the Office Action because the Kubala reference concerns "email messages" and the Kubala embodiments relied upon in the Office Action are limited to "email messages." I understand that one of the Office's guiding principles is to provide "high quality patents" and to "optimize patent

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