

Exhibit 903

document storage 203 into a mailbox. Patent Owner respectfully submits that there is nothing about Morgan's document or (in the Office's terminology) "payload data," that converts Morgan's document memory 203 into a mailbox as required by Claim 1.

Take an example where Morgan's original document is forwarded to multiple destinations. Morgan stores the document in memory 203, but he never indicates that the destination message is stored anywhere, never mind in memory 203. The memory 203 has no information about the recipient(s) to whom the document might have been forwarded. Claim 1, on the other hand, recites the mailbox "of a user of the communication unit" to which the email was sent. Morgan's memory 203 does not store the recipient(s) identities, and therefore is not storing any document in a recipient's mailbox.

Morgan makes clear that his memory 203 is not a mailbox in column 5. There (in lines 25-46), he discusses the failure of server 101 to send a document to an intended destination. At lines 45-46, he concludes by stating that the intended recipient "could then potentially take action to contact the originating party and seek a retransmission of the document." If Morgan's memory 203 stored the document in a mailbox of the recipient, then the intended recipient would not have to ask the originator to retransmit the document.

B. "a host server, in communication with the communication server"

The Office recognizes that, "[r]egarding the [claimed] host server, Morgan did not explicitly describe a second server in the office for providing mailbox storage." *Office Action, at page 5*. However, the Office states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to operate a distinct server for providing electronic message document storage instead of or in addition to document storage 203 in the Morgan system, since (1) Morgan explicitly taught that it can access the data storage of other computers in the office, either directly coupled or over the local area network; note column 3, lines 13-30, (2) Morgan explicitly taught that it could connect to other servers outside of the office, such as server 108, (3) regarding servers, Morgan states 'such a configuration, and the components thereof, are generally well understood in the art,' note column 2, lines 59-61; thus utilizing existing computers such as computers 102 or 105 as servers would not present any great technical difficulty" *Office Action at page 6*.

Patent Owner respectfully submits that points (1), (2), and (3) simply suggest that Morgan could be modified to include an additional server. However, the mere fact that a reference could be modified, or that the modification is within the capabilities of one of ordinary

skill in the art, does not render the resulting modification obvious. *M.P.E.P. § 2143.01(III)*. Patent Owner respectfully submits that reasons (1), (2), and (3), either alone or in combination, therefore fail to establish a *prima facie* case of obviousness.

The Office also provides the following fourth reason for modifying Morgan: “(4) as for the scope of this feature in the ‘899 patent, it is not important where the post office is located, as long as there is a clear signal path to the communication server; note the clear signal paths between computers 102 or 105 or server 108 and server 101 shown in Figure 1” *Office Action at page 6*. However, all words in a claim must be considered in judging the patentability of that claim against the prior art (*M.P.E.P. § 2143.03*). Claim 1 recites specifically that the mailbox is at the host server. Furthermore, the suggestion to modify Morgan and any expectation of success cannot come from the specification of the ‘899 patent. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Therefore, Patent Owner respectfully submits that the Office’s reason (4) is insufficient to establish a *prima facie* case of obviousness.

The Office further provides a fifth reason for modifying Morgan, stating that “it would have been obvious . . . to operate a distinct server for providing electronic message document storage instead of or in addition to document storage 203 in the Morgan system, since . . . (5) using an additional and/or dedicated server to provide electronic message document storage, instead of local document storage 203, may be justified and prove more efficient in a large office environment with large data transfer requirements.” *Office Action at page 6*. In response to Patent Owner’s previous argument that “the Office’s hypothetical would create duplicative storage that is wasteful,” the Office remarked that Patent Owner’s statement “is contrary to the principles of hierarchical storage.” *Office Action at page 21*. In particular, the Office states that “[i]n hierarchical storage, a smaller, faster, local memory may store data that is frequently used while a larger, slower, farther memory may have a greater amount of data available for access. Such a scenario is usually more efficient and often more economical than having one large memory available. The principles of hierarchical storage would certainly apply to utilizing a second server for providing mailbox storage in the Morgan system while the communication server keeps its local document memory.” *Office Action at page 21*. Patent Owner respectfully disagrees.

First, Morgan’s invention has a goal of *reducing* network traffic, so the Office’s hypothetical distributed storage runs contrary to Morgan’s invention. The Office has likewise not identified any evidence that a person of ordinary skill in the art at the time of the invention

would have applied such principles to an office document environment such as Morgan's. Second, the Office's leaves unexplained how the purported advantage of local memory storing data that is frequently used and remote memory storing larger amounts of data has relevance to Morgan's system. Morgan describes a system where a document is stored in the file server 101's document memory 203; some are "urgent" memos or memos "for your approval." *Morgan at col. 7, ll. 30-35*. The Office fails to provide evidence that these documents are frequently or infrequently used in Morgan's system, and likewise fails to explain why the artisan would move urgent documents to a slow, remote memory.

Patent Owner respectfully submits that the Office's rationale in an attempt to alter the principle of operation of the prior art, and therefore fails to establish a *prima facie* showing of obviousness. A person of ordinary skill in the art at the time of the invention would find no motivation to modify Morgan to store documents at a slow, remote location when they are already being stored in the server's document memory 203.

Regarding the Office's position that it would have been obvious "to operate a distinct server for providing electronic message document storage instead of . . . document storage 203 in the Morgan system, since . . . [doing so would] may have been well justified and proved more efficient in a large office environment with large data transfer requirements," Patent Owner disagrees. First, Morgan's system seems already to be a large office environment. Second, Morgan's goal is that "transmission resource requirements are minimized." *Morgan at col. 1, ll. 64-65*. In fact, the Office recognized this specific benefit in its rejection of Claim 8. *Office Action at page 11*. The Office's suggested modification to move the document storage 203 of Morgan to a server other than file server 101 would, contrary to the stated advantage of Morgan, increase the number of transmissions required to process communication of an annotation, where the transaction would require (1) the transmission of the annotation to the filer server 101, (2) transmission of a request for the original document to a server at computer 102 or 105 or server 108, (3) transmission of the original document from a server at computer 102 or 105 or server 108 to the filer server 101 for combination with the annotation, and (4) transmission of the combined original document and annotation to the intended recipient.

Thus, Patent Owner respectfully submits that it would not have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Morgan's communication system to duplicate or move document storage 203 to one of the computers 102/105 and operate them as servers. Patent Owner further submits that, even if the modification