Exhibit 904

B. The Office has Interpreted Host Server *Mailbox* Inconsistent with the Specification.

The Office has not considered that the term *mailbox* is a term of art in an email/post office context. *Mailbox* conveys meaning to those of ordinary skill in the art as a term of art in the context of email/post office systems. The current Office interpretation is inconsistent with the understanding of the term in the art, as evidenced by the specification of the '899 Patent and as supported by declaration evidence submitted herewith from one skilled on the relevant art, Mr. John L. Friend.

II.   PROPER INTERPRETATION OF HOST SERVER *MAILBOX* (CLAIM 1)

A. According Proper Patentable Weight to *Mailbox*

It is well established that each word of every claim must be given weight. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well established that while the PTO is to give claim language its broadest "reasonable" interpretation, this does not mean that the PTO can completely ignore the understanding that the artisan would have of the terminology "mailbox" obtained in light of the specification so as to ascribe a completely different and unknown meaning thereto. See In re Cortright, 165 F.3d 1353, 1358, 49 USPQ 2d 1464, 1467 (Fed. Cir. 1999). ("Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one those skilled in the art would reach.") and In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976) citing In re Royka, 490 F.2d 981, 984, 180 USPQ 580, 582-83 (CCPA 1974)

As noted above, the claim term *mailbox* has not been given patentable weight since it is interpreted no different from *store*. Moreover, there is no indication that *mailbox* has been accorded an interpretation in light of the specification, consistent with an interpretation that

one of skill in the art would reach. It is this two-part process, properly performed, that

circumscribes the broadest linguistically **possible** interpretation (i.e., based solely on the

claims alone) to that which is *__reasonable__* in view of the technical context of the

specification.[2]

It is respectfully submitted that *mailbox* must be accorded patentable weight, and the

weight given to *mailbox* must be from the perspective of one of skill in the art, in view of the

specification. As *mailbox* has not been so interpreted, Patent Holder respectfully submits that

the rejection of claim 1 under 35 U.S.C. §103 is improper.

Further, in light of the proper interpretation of this feature, detailed next, from the

perspective of one of skill in the art, in view of the specification, the rejection of claim 1

under 35 U.S.C. §103 must be withdrawn.

B. *Mailbox* is a Term of Art, Used Consistently as Such in the Specification.

During examination, as well as reexamination claims must be interpreted as broadly

as their terms reasonably allow. This means that the words of the claim must be given their

plain meaning unless the plain meaning is <u>inconsistent with the specification</u>. *In re Zletz*, 893

F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (emphasis added)

The ordinary and customary meaning of a term may be evidenced by a variety of

sources, including "the words of the claims themselves, **the remainder of the specification,**

the prosecution history, **and extrinsic evidence concerning** relevant scientific principles, the

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[2] The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications **not solely on the basis of the claim language,** but upon giving claims their broadest reasonable construction "**in light of the specification as it would be interpreted by one of ordinary skill in the art.**" *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

meaning of technical terms, and the state of the art." *Phillips v. AWH Corp.*, 415 F.3d at

1314, 75 USPQ2d at 1327.

Next the declaration of Mr. John L Friend (Exhibit A) is discussed relative to the

proper interpretation of *mailbox*. The interpretation of Mr. Fried considers the consistent use

of the term in the specification, and the well known meaning in the art at the time of filing of

the '899 Patent.

1. Declaration Evidence Submitted Under 37 C.F.R. § 1.132

Declaration evidence is submitted herewith under 37 C.F.R. § 1.132, attached as

Exhibit A. Mr. John L. Friend, as described in the declaration and as further supplemented

by his attached curriculum vitae (Exhibit A-5), is one skilled in the art to which the '899

Patent pertains. Mr. Friend is an expert in the technical fields of user data communications

and interfaces.

Exhibit A provides the meaning of *mailbox* to Mr. Friend in the context of the '899

Patent, and as widely used in the art at the time of the invention.

Patent Holder respectfully requests that the Examiner enter the declarations of Mr.

Friend on the record and consider the same. The necessary showing of good and sufficient

reasons for entry is provided hereafter pursuant to 37 C.F.R. § 1.116(e).

Patent Holder respectfully submits that the declaration evidence was necessitated, in

part, by the inconsistent interpretation of *mailbox* by the Office and the need for the Patent

Holder to refute this interpretation with factual evidence to advance prosecution. It is noted

that the submitted declarations on claim meaning are coextensive in scope to the discussion

of the previous response. As such, these declaration present issues already of record, and

familiar to the Office. The entry of this evidentiary testimony will serve to advance the

prosecution of this reexamination, and present the outstanding issues in the best form for any

subsequent appeal.

Accordingly, Patent Holder respectfully submits that the declaration of Mr. Friend be

entered and considered.

2. The Host Server *Mailbox* in the context of the '899 Patent

A location of a server memory associated with a particular email address.

As noted in the declaration of Mr. Friend, the '899 Patent is directed to a system and

method of exchanging data between a mobile client and a host server (e.g., post office).[3] A

host server (240) includes mailboxes (246) to house email data of users shown in Figure 2 of

the '899 Patent, reproduced below. *See, e.g.,* '899 Patent, Figure 2.

FIG.2

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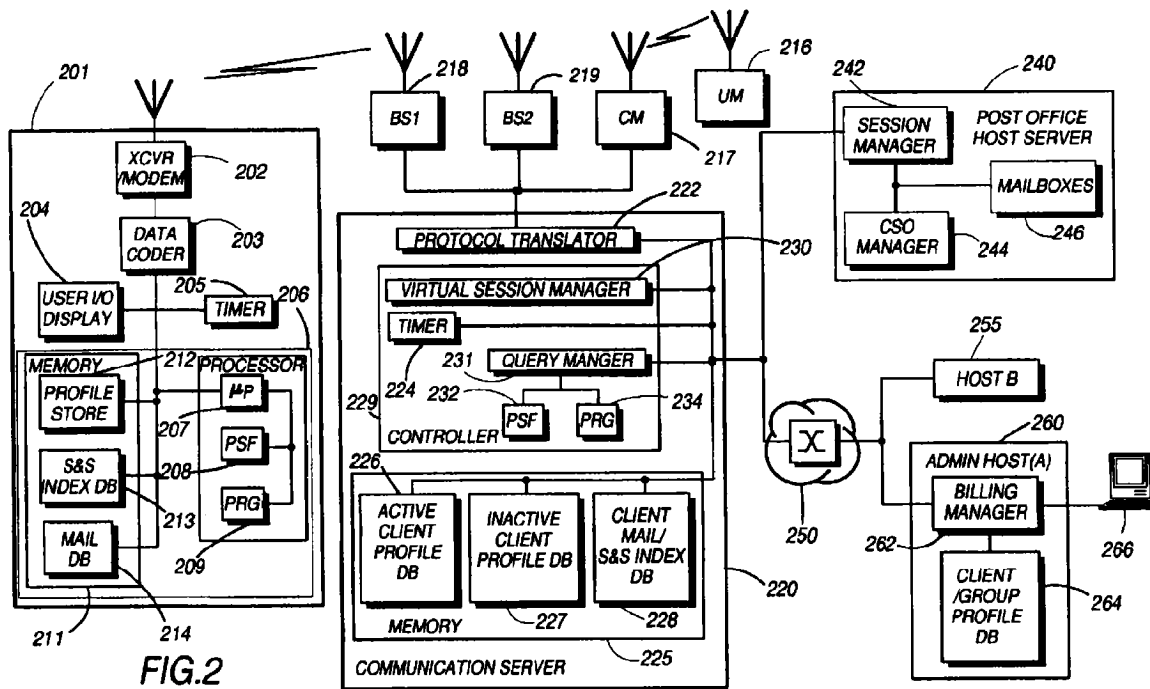
[3] *See, e.g.,* '899 Patent Figures 1-2; col. 1, ll. 58-67; and col. 3 ll. 3-15.

The architecture of the '899 Patent provides for the remote access of the mailboxes of server (240) from the communication device (211). The system supports multiple users, each having a mailbox (246) *See, e.g.,* '899 Patent, col. 6, ll. 3-17.

The procedure for accessing the host server (e.g., "post office") is shown in the flow chart of Figure 3 of the '899 Patent, reproduced below. *See, e.g.,* '899 Patent, Figure 3.
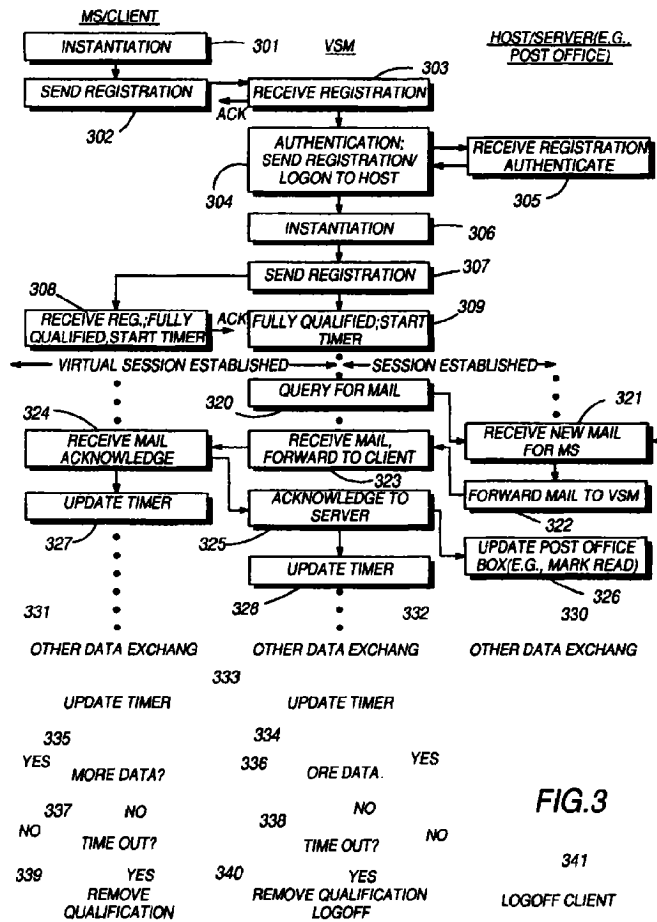

FIG.3

Figure 3 of the '899 Patent illustrates a post office access via a user agent (instantiation) by way of a communication server. New email is obtained by connecting the mobile client to a mailbox of the post office associated with the user. *See, e.g.,* '899 Patent Figure 3 (step 321, 324); and col. 7 ll. 14-21. At the time of the '899 Patent filing, and for at

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least a decade prior, post office mail handling was a known mechanism by which a client

device could remotely access a post office mailbox to access email associated with a user of

the client device. Indeed, the telecommunication community was moving toward

standardizing a protocol for accessing post office email from remote clients as early as

October 1984. *See* Exhibit A-1 Internet Engineering Task Force (IETF) "Post Office

Protocol" RFC 918. *See, Also e.g.*, Exhibits A-2 and A-4 , "Post Office Protocol Version 3"

RFC 1460, 1225 pages 1-2."

Figure 3 of the '899 Patent describes generic authorization and update procedures

consistent with the Post Office Protocol of the RFC 1460 and draft RFC 1225. *See, e.g.*,

Exhibits A-1 and A-2 "authorization state" and "update state"; and *See, e.g.*, '899 Patent

(steps 305, 326) Exhibits A-1 through A-4 are evidence of the well established meaning of

mailbox in the art at the time of the invention of the '899 Patent.

Furthermore, the term *email* is described throughout the '899 Patent consistent with

Mr. Friend's understanding of this term as used in the art. The definition of email and the use

of mailboxes in combination with email is well known in the art, at least since RFC 821

(Exhibit A-4) . In RFC 821, the Simple Mail Transfer Protocol, from August 1982, there is a

description of the process for sending an email from one user to another user's mailbox. This

involves addressing the email appropriately with the destination user's mailbox address and

then communicating with the SMTP server using the protocol in RFC 821. The SMTP server

would receive the email and, upon verifying that the target mailbox address was appropriate,

would add the email to the target mailbox. In the RCPT section of 4.1.1 in RFC 821, it

states: "When mail reaches its ultimate destination (the forward-path contains only a

destination mailbox), the receiver-SMTP inserts it into the destination mailbox in accordance

with its host mail conventions."

Accordingly, In 1995, when the '899 Patent was filed, a person of ordinary skill in the art would understand the claim term *mailbox* in the context of the email exchange/post office context (i.e., as described in the '899 Patent specification and prosecution history), in the broadest reasonable sense to define ___a location of a server memory associated with a particular email address___. In this way, new email arriving at the server based upon an email address could be accessed remotely from a mobile client by a user associated with the address as known in the art and as consistently described specification of the '899 Patent.[4]

3. Morgan Describes Storing Annotated Groupware Documents in a Memory

As noted above, the Office has interpreted the Patent Holder's claimed *mailbox* to correspond to memory (203) of <u>Morgan</u>. Yet, the interpretation of a host server *mailbox* as embracing general memory space of a workstation, is unreasonably broad. This is because the term *mailbox* as used in the context of the '899 Patent is inconsistent with such an interpretation, and the term *mailbox* is in fact a very well known term of art.[5]

All of the rejections of record rely upon the above noted improper interpretation of *mailbox*. As such, Patent Holder respectfully requests that the rejection of claim 1, and by virtue of dependency, claims 14, 15 and 18, be withdrawn.[6]

CONCLUSION

If the Examiner believes and additional formal matters need to be addressed in order to place this Patent in condition for a Notice of Intent to issue a Reexamination Certificate, Patent Holder respectfully requests the Examiner contact the undersigned, by telephone, to address such matters consistent with the special dispatch accorded this matter within the Office.

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[4] *See, e.g.,* '899 Patent, Figures 3 (steps 321, 324); col. 12 ll. 19-45.; and col. 1 ll. 36-67.
[5] *See* Exhibits A, and A-1 through A-4.
[6] The merits of claims 14, 15 and 18 are not discussed in view of the distinctions presented for base claim 1.