Exhibit 907

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

CASE NO. 1:10-CV-24063-MORENO

MOTOROLA MOBILITY, INC.,	)
	)
Plaintiff / Counterclaim Defendant,	)
	)
v.	)
	)
MICROSOFT CORPORATION,	)
	)
Defendant / Counterclaim Plaintiff.	)
	)

REBUTTAL EXPERT REPORT OF DR. MARTIN E. KALISKI, Ph.D.
REGARDING THE VALIDITY OF U.S. PATENT NO. 5,764,899

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I.   INTRODUCTION

1.   I submitted a report on June 27, 2011, relating to the infringement of U.S. Patent No. 5,764,899 ("the '899 patent"; MOTM_24063_0017790-0017810) (the "Kaliski Initial '899 Report"). I submit this report in response to Microsoft's Expert Report on the validity of the '899 patent.

2.   I have been asked, for purposes of this report, to provide an overview of the prosecution history of the '899 patent, to provide an overview of the two reexaminations of the '899 patent, to provide an overview of the alleged invalidity references asserted by Dr. Stuart Stubblebine in his report of June 27, 2011 (the "Stubblebine Report"), to offer an opinion as to the validity of the '899 patent in light of the positions taken in Dr. Stubblebine's report, and to respond to the opinions set forth in Dr. Stubblebine's report. I incorporate my June 27, 2011 Kaliski Initial '899 Report by reference, including the disclosure of my qualifications and my understanding of the '899 patent.

3.   I have formed the opinions expressed in this report through my independent evaluation and analysis. The opinions contained in this report are my own. If called upon to testify in this matter, I have personal knowledge of the contents of this report and I can competently testify to the matters addressed in this Expert Report and the materials I relied upon in rendering my opinions. I may also rebut any testimony, reports, or opinions proffered by Microsoft's witnesses (expert or otherwise).

4.   The materials I have considered in formulating my opinions are set forth in Exhibit A to this report. I note that in preparing this report I have also relied upon my education and experience, and the knowledge that I have accumulated in the course of my over 35 years working with technology relating to the '899 patent. I reserve the right to supplement this list of materials considered.

5.   This report is based on information available to me at the time it is submitted. I reserve the right to continue my investigation and study, which may include a review of documents and information that recently have been produced or may be produced in the future, as well as deposition testimony from depositions for which final transcripts are not yet available or that may yet be taken in this case. Therefore, I expressly reserve the right to expand or modify my opinions as my investigation and study continues, and to supplement my opinions in response to any additional information that becomes available to me, any matters raised by Microsoft or opinions provided by its expert or experts, or in light of any relevant orders from the Court.

II.   UNDERSTANDING OF THE LAW

6.   I am not an attorney and do not expect to offer any opinions at trial regarding the law. However, I have been informed of certain legal principles relating to patent validity that I relied upon in reaching the opinions set forth in this report.

A.   Claim Construction

7.   I understand that claims of a patent must be interpreted in light of the claim language itself, the written description and figures in the patent (the "specification"), and the patent's prosecution history. I further understand that the terms used in patent claims are given their plain and ordinary meaning to one of ordinary skill in the art at the time of the invention, absent the teaching of a different meaning within the specification or the prosecution history.

8.   As the result of my education and experience, I believe that I understand how the asserted claims of the '899 patent would be understood by a person of ordinary skill in the art. I have applied this plain and ordinary meaning except as to terms construed by the parties and documented below.

B.   Proof Needed for Invalidity

9.   I understand that a patent is presumed to be valid. However, I also understand that a patent may be determined to be invalid by so-called "prior art," as described in 35 U.S.C. §§ 102 or 103, or for other reasons.

10.   I have been advised that establishing a patent or patent claim to be invalid requires proof by "clear and convincing evidence." I understand that "clear and convincing evidence" is such evidence that causes a trier of fact to be persuaded that the fact sought to be proved is substantially more likely than not to be true. Proving a fact by "clear and convincing" evidence is a higher burden than proving a fact by a "preponderance of the evidence" but lower than "beyond a reasonable doubt."

C.   Obviousness

11.   I have read 35 U.S.C. § 103(a), and have been advised of the requirements to prove obviousness of a patented invention under this statutory provision. The provisions of § 103(a) that I read provide that:

> *A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.*

12.   I understand that a claim may be invalid under § 103(a) if the matter described by a claim as a whole would have been obvious to a hypothetical person of ordinary skill in the art ("POSITA") in view of a prior art reference or in view of a combination of references at the time the claimed invention was made. Therefore, I understand that obviousness is determined from the perspective of a hypothetical POSITA and that the asserted claims of the patent should be read from the point of view of such a person at the time of the claimed invention. A hypothetical

POSITA is assumed to know and to have all relevant prior art in the field of endeavor – that, in this case, is networked communication systems.

13.   I also understand that an analysis of whether a claimed invention would have been obvious should be considered in light of the scope and content of the prior art, the differences (if any) between the prior art and the claimed invention, and the level of ordinary skill in the pertinent art involved. I also understand that a prior art reference should be viewed as a whole. I also understand that a prior art reference may teach away from a claimed combination.

14.   I have been informed that the United States Supreme Court recently clarified the legal principles of obviousness. I understand that in considering whether an invention for a claimed combination would have been obvious, I may assess whether there are apparent reasons to combine known elements in the prior art in the manner claimed in view of interrelated teachings of multiple prior art references, the effects of demands known to the design community or present in the market place, and/or the background knowledge possessed by a person having ordinary skill in the art. I also understand that the Supreme Court identified other principles that may be relied on in evaluating whether a claimed invention would have been obvious, and that these principles include the following:

- A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results;

- When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one, so that if a person of ordinary skill can implement a predictable variation, the variation is likely obvious;

- If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill;

- An explicit or implicit teaching, suggestion, or motivation to combine two prior art references to form the claimed combination may demonstrate

obviousness but proof of obviousness does not depend on or require showing a teaching, suggestion or motivation to combine;

- Market demand, rather than scientific literature, will drive design trends and may show obviousness;

- In determining whether the subject matter of a patent claim is obvious, neither the particular motivation or the avowed purpose of the patentee controls;

- One of the ways in which a patent's subject can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims;

- Any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed;

- "Common sense" teaches that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle;

- A person of ordinary skill in the art is also a person of ordinary creativity, and is not an automaton;

- A patent claim can be proved obvious by showing that the claimed combination of elements was "obvious to try," particularly when there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions such that a person of ordinary skill in the art would have good reason to pursue the known options within his or her technical grasp; and

- One should be cautious of using hindsight in evaluating whether a claimed invention would have been obvious.

15.   I also have been informed that in determining whether a claimed invention would have been obvious, one should consider, if present, certain "secondary considerations" such as commercial success of the claimed invention, long-felt but unfulfilled need for the claimed invention, and failures of others to come up with the claimed invention. I understand, however, that there must be a "nexus" between the claimed invention and the secondary consideration.

D.   35 U.S.C. § 112

1.   35 U.S.C. § 112, ¶1 – Written Description and Enablement

16.   I understand the written description and enablement requirements are set forth in

35 U.S.C. § 112, ¶1. This section provides:

> *The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. I understand that the legal standard for the enablement requirement is that the written description must be sufficient at the time the patent application was filed to enable one of ordinary skill in the art to make and use the claimed inventions. I understand that a specification is enabling even if it requires one of ordinary skill in the art to conduct some experimentation, but that level of experimentation cannot be unreasonable under the circumstances.*

17.   I understand that for a U.S. Patent to meet the written description disclosure

requirements for patentability, it must describe the claimed invention with reasonable clarity

such that a person of ordinary skill in the relevant art would understand that the inventor

possessed the claimed invention at the time the patent application was filed, or if claiming any

priority, at the time the priority application was filed. I have been informed that the test for

sufficiency of a written description is whether the disclosure clearly allows persons of ordinary

skill in the art to recognize that the inventor invented what is claimed. "Possession" means

possession as shown in the disclosure and requires an objective inquiry into the four corners of

the specification from the perspective of a person of ordinary skill in the art. The specification

need not describe word for word what is in the claims and original claims are part of the

specification.

18.   It is my understanding that to be enabling the specification should teach persons

of ordinary skill in the art how to make and use the claimed invention without undue

experimentation.   It is also my understanding that a reasonable amount of routine

experimentation required to practice a claimed invention does not preclude the specification from being enabling. It is further my understanding that the following factors can be considered in evaluating whether a disclosure requires undue experimentation, as opposed to a reasonable amount of routine experimentation:

- the quantity of experimentation necessary;
- the amount of direction or guidance presented;
- the presence or absence of working examples;
- the nature of the invention;
- the state of the prior art;
- the relative skill of those in the art;
- the predictability or unpredictability of the art; and
- the breadth of the claims.

19.   I have been informed that the omission of minor details about the claimed invention, or the process or manner of making and using the claimed invention, does not make the specification non-enabling. Disclosure of starting material or the conditions under which a process can be carried out is sufficient to be enabling and does not show that undue experimentation is required.

2.   35 U.S.C. § 112, ¶2 – Indefiniteness

20.   I also understand the definiteness requirement is set forth in 35 U.S.C. § 112, ¶2. This section provides:

> *The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

21.   I have been informed by counsel that a party arguing that a claim term is indefinite must show by that one skilled in the art would not understand the scope of the claim in which the term appears when read in light of the specification. The purpose of the definiteness

requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude. A claim is considered indefinite when it is not amenable to construction or is insolubly ambiguous, and is indefinite only if reasonable efforts at construction of the claim would prove futile. When a word of degree is used in a claim, it is not indefinite so long as the patent's specification provides some standard for measuring that degree.

22. I have been informed that the definiteness requirement does not compel absolute clarity. Because only claims not amenable to construction or insolubly ambiguous are indefinite, the definiteness of claim terms depends on whether those terms can be given any reasonable meaning. I have been further informed that a difficult issue of claim construction does not automatically result in a holding of indefiniteness. Specifically, if the meaning of a claim term is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, the claim may be sufficiently clear to avoid invalidity on indefiniteness grounds. It is important to note that an issued patent is entitled to a statutory presumption of validity. I have been instructed that when considering indefiniteness, general principles of claim construction apply.

III. CLAIM CONSTRUCTION

23. I understand that the parties dispute the meaning of a number of claim terms in the '899 patent, attached as Exhibit B, and have agreed that expert opinions would not be offered in connection with the proper construction for these disputed claim terms. Accordingly, I offer no opinions concerning the claim construction for the disputed terms in Exhibit B.

24. For terms not in dispute, I interpret them according to their plain and ordinary meaning to one of ordinary skill in the art at the time of the invention based on my knowledge, experience, the patent itself, and its prosecution history.

IV. RESPONSE TO DR. STUBBLEBINE'S OPINIONS REGARDING THE '899 PATENT

25.   I disagree with many of Dr. Stubblebine's statements regarding the '899 patent, the prosecution of the application that led to the '899 patent, and the reexaminations of the '899 patent. I address Dr. Stubblebine's statements and opinions below.

A.   The Specification Of The '899 Patent

26.   I disagree with Dr. Stubblebine's suggestion that the problems described in Cols. 1:16 – 2:14 of the patent all relate to the invention claimed in the '899 patent itself. The '899 patent is part of a family of patents, all of which have identical (or nearly identical specifications) with claims directed towards the several distinct inventions described in the specification of the '899 patent. Thus, some inventions described in the specification of the '899 patent are claimed in other patents. As the title of the patent makes clear, the '899 patent pertains to a "Method and Apparatus for Communicating an Optimized Reply." The claimed invention of the '899 patent saves bandwidth by reducing the amount of data transmitted between clients and communication servers, not between the communication server and host server. '899 patent, Col. 12:62-67.

B.   The Prosecution Of The '899 Patent

27.   As I stated in the Kaliski Initial '899 Report, U.S. Patent Application No. 08/574,737 ("the '737 application") was filed on December 19, 1995, as a continuation-in-part of Application No. 08/557,657, which was filed on November 13, 1995. The '737 application was filed with 21 total claims – 5 of those were independent claims. [MOTM-24063-0017641 to 789.]

28.   In a first office action, the examiner rejected 7 of the claims as anticipated by U.S. Patent No. 4,994,985, allowed 6 claims, and objected to 6 claims. [MOTM-24063-0017716

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through 720.] Various claims were rejected or objected to based on U.S. Patent No. 4,994,985 alone and/or in combination with 5,604,788. [*Id.*] The applicants then cancelled the rejected claims without prejudice and amended the claims that were objected to by rewriting them in independent form, including all limitations of the rejected base claims. [MOTM-24063-0017724 through 731.] The examiner allowed those claims, resulting in 12 issued claims. [MOTM-24063-0017737 through 38.]

C.   The Reexamination Of The '899 Patent

29.   As I described in the Kaliski Initial '899 Report, on September 26, 2008, a third party requested reexamination of the '899 patent, filing reexamination request control no. 90/009,286 ("the '286 reexamination" or "first reexamination"). [*See generally* MOTM-24063-0014881 through 15458.] Although Dr. Stubblebine states that the PTO granted the first reexamination request for the '899 patent on September 26, 2008, that reexamination request was actually granted on December 12, 2008. [MOTM-24063-0014997 through 15011.] Claim 1 was confirmed with only a clarifying amendment, and new claims 13-18 were added to the patent. [MOTM-24063-0015447 through 15453.]

30.   I disagree with Dr. Stubblebine's statement that Motorola was incorrect in the '286 reexamination when it stated that Morgan does not teach or suggest that the document memory or the documents stored in the server are associated with users of a communication unit. As discussed below, Motorola's statements related to the fact that Morgan does not disclose an inbox associated with a particular email address.

31.   Dr. Stubblebine disagrees with the statement made by patent owners during the reexamination that "it is unclear in the Office's hypothetical why the computers 102 or 105 would provide document storage in addition to the document memory 203." [MS-MOTO_SDFLA_00000014174.] I agree with the patent owners that the Office's hypothetical is

unclear. Given the desire in Morgan for documents to be accessible at various points in the network there is not necessarily a need for those documents to be stored in a second location on the network (such as computers 102 or 105). Thus, to the extent computers 102 or 105 might provide document storage, there would be no reason to think that they would provide document storage that was duplicative of the storage in document memory 203. In fact, having two copies of the same document in Morgan would complicate the system, creating the risk that inconsistent annotations would be made, without an appropriate synchronization mechanism disclosed in the system. A more complex system would require additional resources and memory, and could consume more bandwidth, in contrast to the Morgan patent's objective.

32. Furthermore, Dr. Stubblebine ignores the first sentence of the paragraph he quotes in the reexamination, which states that "[f]irst, Morgan fails to teach or suggest that the office server 101 sends a request for a data unit to another server or any other computer during the document transmission mode." [MS-MOTO_SDFLA_00000014174.] The mere potential capability of computers 102 or 105 to act as servers in some instances does not mean that the original message would necessarily be stored there at the same time as it is saved on the server, or that those servers would include mailboxes or inboxes, especially in light of the storage disclosed in 203.

33. I agree with Motorola's statement that the "electronic messages" in Morgan are not "typical emails." [MS-MOTO_SDFLA_00000014327.] I understand that the Examiner stated that Morgan's electronic messages are emails and that the pending claims lacked any limitation on the scope of "email." [MS-MOTO_SDFLA_00000014373.] However, the Examiner also acknowledged that "the electronic messages of Morgan [are] different from the internet-based email interfaces that many of us use today." [MS-

MOTO_SDFLA_00000014373.] I understand the standards applied to claim construction during reexamination proceeding are different than those that may be applied by the court in this case. Specifically, I understand that in a reexamination, claims are given their broadest possible interpretation. This is consistent with my opinion that, contrary to the Examiner's statement that Morgan's messages are "email," one of skill in the art would have understood the plain and ordinary meaning of "email" in the context of the '899 patent to be different from the electronic documents described in Morgan.

34.   I disagree with Dr. Stubblebine's statements that "the server is holding email in an inbox while attempting to deliver email to wireless and wired clients" (citing Fig. 4, boxes 409, and 410 and Col. 5:25-6) and his suggestion that this inbox is the same as the "inbox" claimed in the '899 patent. Dr. Stubblebine goes on to say that the server (101) would need the "capability of accessing the data storage of a computer directly coupled to the server" and states that there is no evidence the examiner considered that scenario. Stubblebine Report at ¶ 57. As discussed in more detail below, I disagree that any storage in server 101 for outgoing mail would be any sort of inbox, let alone an inbox with the functionality described in the claims of the '899 patent. Accordingly, whether or not he did so, there would be no reason for the examiner to consider whether any such storage for outgoing messages would be an "inbox."

35.   In fact, in the first reexamination, the Examiner confirmed any "mailbox" disclosed in Morgan is not the same as the "inbox" claimed in the amended '899 patent claims. [MOTM-24063-0015452.]

36.   As discussed in the Kaliski Initial '899 Report, on March 7, 2010, a second reexamination was requested by a third party. [MOTM-24063-0015459 through 16829.] That

reexamination was assigned control no. 90/010,890 ("the '890 reexamination" or the "second reexamination"). [*See* MOTM-24063-0016689.]

37.   In the second reexamination, the third party cited RFC 1730 as an apparent attempt to address the elements that the Examiner found was missing in Morgan during the first reexamination. The third party that requested reexamination of the patent stated that "RFC 1730 outlines a fourth version of IMAP. IMAP allows a user to access and manipulate electronic mail messages on a server. These electronic messages are stored in message folders on the server called 'mailboxes'" (internal citations omitted). [MOTM-24063-0015471] The requester continued: "Each user of the system has a mailbox on the server, to which they can connect and retrieve their electronic mail messages…. Users of the system were able to create an additional mailbox named "outbox" on the message server if they so desired." [*Id.*] Nevertheless, On February 11, 2011, the examiner issued a non-final action confirming the patentability of claims 1, 3, and 13-18 and rejecting claim 4. [MOTM_24063_0024176.] The examiner stated that with respect to claim 1, neither Morgan nor any of the other art cited in the second reexamination teach a communication with a data transfer manager with various of the functions recited in the claims nor does any of the other art cited in the reexamination. [*See, e.g.*, MOTM_24063-0024179.] This statement was repeated in a June 30, 2011 final rejection (again confirming the patentability of claims 1, 3 and 13-18, while rejecting claim 4). [MOTM_24063_01864788-89.]

D.   The Level Of Ordinary Skill In The Art Of The '899 Patent

38.   I have reviewed Dr. Stubblebine's opinion regarding the level of ordinary skill in the art of the '899 patent. Although my opinion and Dr. Stubblebine's opinion regarding the level of skill appear somewhat similar, Dr. Stubblebine's definition of the level of ordinary skill in the art for the '899 patent is unnecessarily broad and undefined. For example, Dr. Stubblebine

does not explain what "industry experience" he believes would be sufficient to provide the "real-world experience" to supplement a technical degree.

39.   Accordingly, I stand by my opinion expressed in the Kaliski Initial '899 Report regarding the level of ordinary skill in the art of the '899 patent: a person of ordinary skill in the art of the '899 patent at the time of the invention (late 1995) would have had a Bachelor's or equivalent degree in computer science, electrical engineering, or the equivalent education and/or experience, plus approximately two years' experience with networked communication systems, including email systems.

V.   OVERVIEW OF THE REFERENCES RELIED ON BY MICROSOFT

40.   I have reviewed the prior art identified by Microsoft as allegedly invalidating the '899 patent, as discussed in Dr. Stubblebine's Report. In addition to these materials, I have also reviewed the material set forth in Exhibit A.

A.   U.S. Patent No. 5,239,466 ("Morgan")

41.   In particular, I have reviewed the Morgan patent, which was cited by Dr. Stubblebine as a reference against claims 1 and 14-18 when combined with other references. I understand that Motorola is no longer asserted claim 14 against Microsoft. Accordingly, I express no opinion regarding its validity or the opinions expressed by Dr. Stubblebine in that regard. I note that the patentability of the asserted claims in view of Morgan has been confirmed in both the first and second reexaminations.

42.   The application that issued as the Morgan patent was filed on October 4, 1990; it issued on August 24, 1993. The Morgan patent relates generally to a "system for selectively routing and merging independent annotations to a document at remote locations." Morgan patent, Title. As described in the Abstract of the Morgan patent:

A personal communicating computer (112) (FIG. 1) remains in contact, via a wireless network, with an office server (101). Documents from various sources can be transmitted to the personal communicating computer (112) using this network. Upon receipt, such documents can be accessed and utilized in a variety of ways. In particular, such documents can be annotated in a variety of ways, and those annotations forwarded on to other destinations for appropriate review and handling.

The documents described in the Morgan patent are typical office-type documents that a worker would annotate by hand. *See, e.g.*, Morgan patent, Col. 7:3-10.

43.   In order to facilitate this document sharing and annotation capability, a document stored on an office server is sent to a user. *See* Morgan patent, Col. 8:10-35. A user can create an annotation to that document then transmit that annotation with a reference to the original document and an accompanying message specifying the intended destination. *See id.* at Cols. 4:7-9, 8:10-34. The office server combines the annotation information with the original document that it stored, and then uses the stored message as part of a transmission to send to another user.

44.   Although email was well-known in 1993, Morgan does not disclose "email" or even suggest that email could be used within its communication network. The Morgan patent explains:

> The actions that can be taken with respect to a particular document are, of course, widely varying. A word processing document could be entered…. A spreadsheet document could be similarly opened….
>
> Of particular interest here is an ability to annotate the document with one or more annotations. Such annotations are intended here to be very much akin to the notes placed by a business person on tangible visual messages in his or her office environment, such as notes scribbled on a document. Such tangible notes are typically intended for review and action by others, and to facilitate this, the tangible item itself, along with the personally inscribed annotation, makes its way to such other individuals for appropriate action.

Morgan patent, Col. 7:11-20.

45.   Furthermore, the Morgan patent does not disclose a user's "inbox," or "reply data." Instead, as described above, it focuses on a system for distributing updates and annotations to shared documents over a network by notifying users that a document has been directed to them and is waiting at the server, and then providing that document to them at their remote machines, along with any relevant annotation information.

B.   U.S. Patent No. 5,819,274 ("Jackson")

46.   I have reviewed the Jackson patent, which was cited by Dr. Stubblebine as a reference against claims 1 and 14-18, when combined with the cc:Mail reference.[1]

47.   The application that issued as the Jackson patent was filed on June 6, 1997, as a continuation of an application filed on December 16, 1994. The Jackson patent issued on October 6, 1998, and was assigned to XcelleNet, Inc. The Jackson patent relates generally to a system and method for automatically distributing information, such as forms or documents, between data processing devices in a network (called nodes). *See, e.g.*, Col. 1:16-19, 2:61 – 3:7. For example, as discussed in the Jackson patent:

> According to the invention, information is automatically shared among a plurality of remote/mobile data processing nodes which are temporarily and intermittently linked to a data processing server by designing an information form and placing the information form on the server. The form is identified as being shareable, and an associated form distribution list is assigned to the form in order to identify users corresponding to first remote/mobile nodes. Remote/mobile communication links are established to the first remote/mobile nodes, and the form is transferred to the first remote/mobile nodes. The remote/mobile communications links are then disconnected from the first remote/mobile nodes.

Col. 3:8-19. In the system described in the Jackson patent, "[e]ach node 116 preferably runs a node software program in [the] background, … which operates in conjunction with the remote/mobile server 110. The node software initiates or responds to communications sessions,

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[1]   As discussed above in paragraph 41, I understand that Motorola is no longer asserting claim 14 in this case. Accordingly, I offer no opinion with respect to its infringement and/or validity.

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supports interactive remote console sessions, relays node status information to the server 110, and relays command line level instructions to the node operating system." *Id.* at Col. 6:44-50. Using the software installed at the remote node, "[t]he data may be viewed in the context of the form in which it was entered, and may be printed." *Id*. at Col. 2:47-49.

48.   The system described in the Jackson patent is a platform for distributing information via shared forms, which reside on, and are transferred from, a central server. Email is not disclosed. An exemplary Jackson "form" is reproduced below:

Jackson patent at FIG. 10. This "form" provides a user with a document that can be formatted and can have information input (e.g., "HIN" or a "Last" and "First" name).

49.   Using this system, a user can complete an "Instance" of a form, which can then be transferred to a server for later distribution. This process is described in Figure 5, reproduced below:

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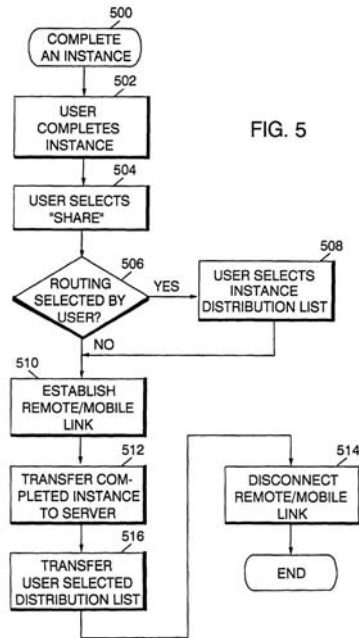
FIG. 5

Specifically, once form data is filled out (e.g., for a patient), that completed form can be transferred to the server. *See* Jackson patent, FIG. 5 (512).

50. Instances of a form may also be distributed amongst nodes, as described in Figures 6A and 6B, reproduced below:
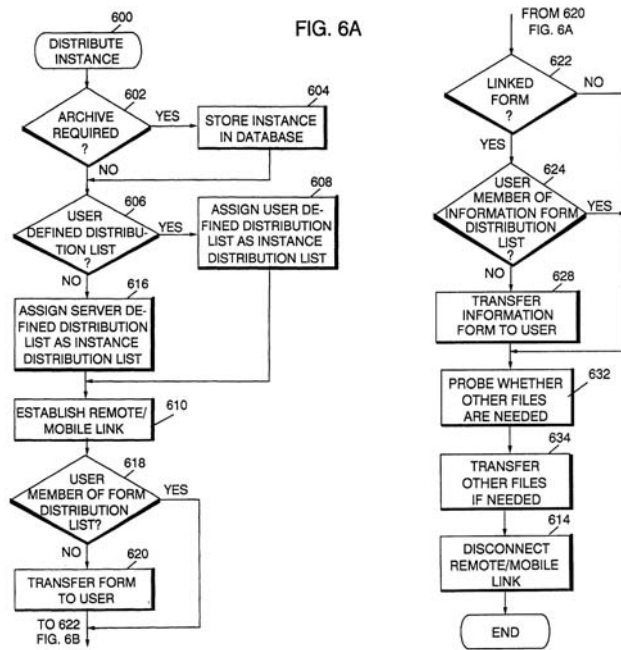
FIG. 6A
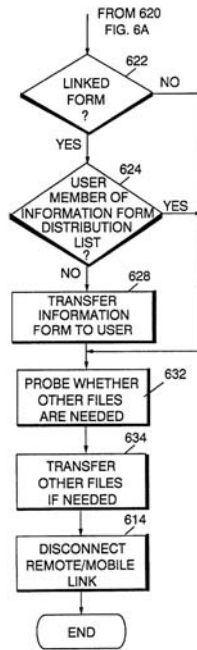
FIG. 6B

As shown in these figures, forms can be sent to various user groups using "distribution lists,"
which dictate which form should be distributed to a particular user (via his node). *See* Jackson
patent, FIG. 6A (606, 608, 616, 620), FIG. 6B (624, 628).

      51.   Finally, using the system disclosed in the Jackson patent, a user can choose to
modify a previously created (and distributed form), using the system's software. This software is
programmed to accept modifications from a user, transfer these modifications to the server, then
distribute modifications to the appropriate user list automatically. *See, e.g.*, Jackson patent, Col.
10:14-49. Figure 8 of the patent outlines the steps performed by the software to distribute these
changes to the appropriate distribution list of end nodes:

FIG. 8

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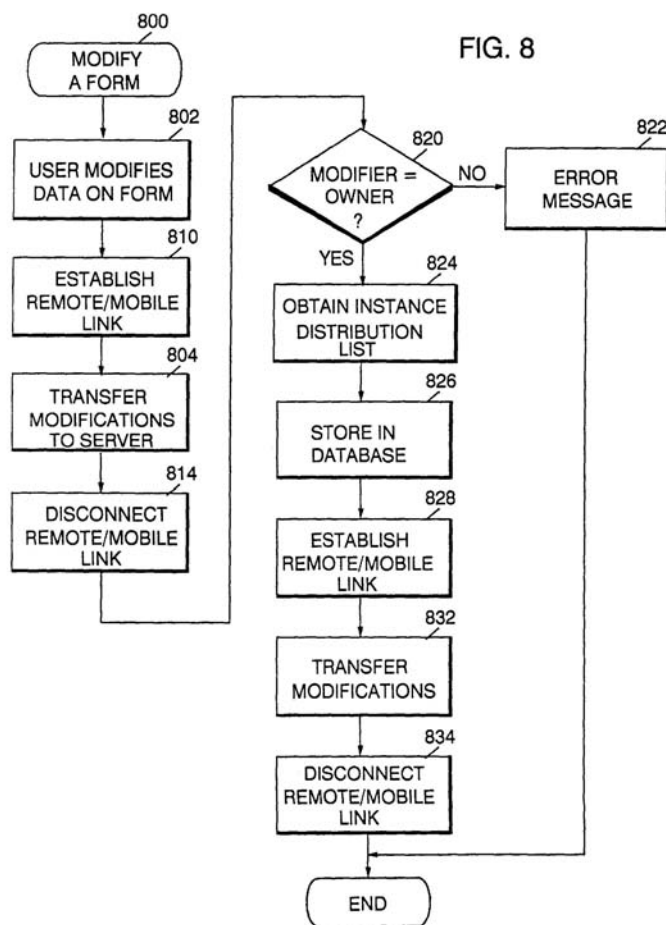
52.   Importantly, the Jackson patent makes clear that only the modifications should be transferred to the distribution list. *See* Col. 10:44-45 ("It will be understood that preferably only the modifications are transferred rather than the entire form.").

53.   Like the art cited during the reexaminations of the '899 patent, including the Morgan patent, the Jackson patent does not disclose "email," a user's "inbox," or "reply data." Instead, it focuses on a system for distributing updates to shared documents over a network.

C.   cc:Mail Plain & Simple ("cc:Mail")

54.   I have reviewed the cc:Mail reference, which was cited by Dr. Stubblebine as rendering claims 1 and 14-18 of the '899 patent obvious when combined with the Morgan and/or the Jackson patents.[2]

55.   The cc:Mail reference describes a traditional email system. The reference states that "cc:Mail is one of the most popular electronic mail (e-mail) systems. … This book covers the basics of addressing, sending, receiving, and managing messages using cc:Mail for Windows, as well as many advanced features that let you quickly and easily harness the power of your electronic mailbox." [MS-MOTO_SDFLA_00000228461.] As discussed below, I do not consider the reference to disclose anything other than a standard reply email message.

56.   The cc:Mail reference describes a post office where email is stored for a number of mailboxes. Each mailbox is intended for a particular user and contains an inbox and folders, such as a sent mail folder. There is no "bandwidth optimization" or "optimized reply" process described or suggested in cc:Mail, nor is any need for that optimization described. In fact, as shown below, cc:Mail suggests the opposite – original email text can be modified when drafting a reply email, showing that no optimization is being performed:

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[2]   As discussed above in paragraph 41, I understand that Motorola is no longer asserting claim 14 in this case. Accordingly, I offer no opinion with respect to its infringement and/or validity.
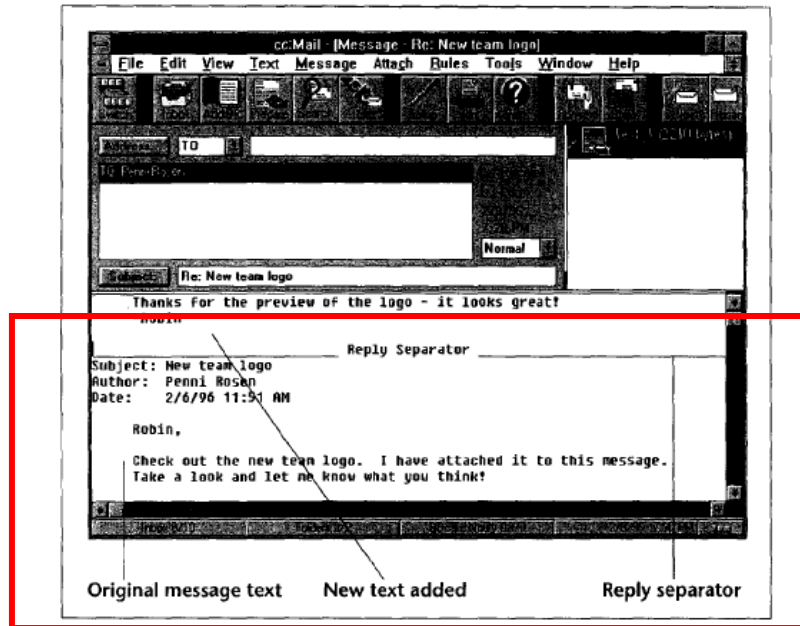
FIGURE 3.9: *A reply message with reply separator*

Type your reply in the space above the reply separator. Press the ↓ key to edit the original message text. When you have finished your reply, click on the Send SmartIcon or select Message ➤ Send to send the message.

[MS-MOTO_SDFLA_00000228501 ("Press the ↓ key to edit the original message text.".]

57.   Furthermore, cc:Mail does not describe storing one user's email in a mailbox and then using a message identifier to pass that original message to another user when a reply or forward is sent. Instead, cc:Mail describes sending the original data as either part of the message itself, or as an attachment to that email. [MS-MOTO_SDFLA_00000228499-504] Nowhere in the cc:Mail reference is the problem of bandwidth savings addressed or solved.

VI.   RESPONSE TO DR. STUBBLEBINE'S OPINIONS REGARDING THE VALIDITY OF THE '899 PATENT

58.   I disagree with many of Dr. Stubblebine's statements regarding the alleged invalidity of the '899 patent, based on both alleged prior art and 35 U.S.C. § 112. I address Dr. Stubblebine's statements and opinions below.

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A.   The Morgan Patent

1.   The Morgan Patent in combination with cc:Mail does not render claims 1 or 15-18 obvious

59.   Dr. Stubblebine concludes that the Morgan patent in combination with cc:Mail and the ordinary skill in the art render claims 1 and 15-18 obvious. *See* Stubblebine Report at ¶ 88. I disagree.

60.   Dr. Stubblebine provides no meaningful support for his conclusion that a person of ordinary skill would have combined the various elements he identifies in the various references to produce the invention claimed in the '899 patent. Instead, Dr. Stubblebine states in conclusory terms that both Morgan and cc:Mail are from the field of electronic communications between data processing systems and that they both relate to transmissions and receipts of electronic messages. Stubblebine Report at ¶ 95.

61.   Dr. Stubblebine concludes without any analysis that it would have been within the knowledge of a person of ordinary skill in the art to combine the email structure and post office in cc:Mail with Morgan's system of computing deltas, and that doing so would have resulted in the invention claimed in the '899 patent to provide predictable results. As set forth below, I disagree.

62.   First, the field of use defined by Dr. Stubblebine is too broad. On the one hand, the Morgan patent discloses a system for distributing annotated documents within a network via a server. On the other hand, cc:Mail describes a traditional email client application that can execute on a Windows computer. This software enables a user to send a receive email. This does not mean that a person of ordinary skill in the art would have combined them in 1995.

63.   Second, combination of these two systems in the manner suggested by Dr. Stubblebine would not solve any problems that the two references seek to solve. The Morgan

reference discloses a system and method for distributing annotated documents – the addition of traditional email functionality (like that disclosed in cc:Mail) would not provide for easier distribution of data. In fact, the requirement that user inboxes be added, along with the required software to manage those inboxes would complicate the system.

64.   As an initial matter, in the second reexamination of the '899 patent, the examiner has issued a non-final action confirming the patentability of claims 1 and 13-18 over Morgan in combination with RFC 1730 and various other art (recently followed-up with a final rejection including the same analysis, including confirmation of claims 1 and 13-18). The Examiner confirmed that neither Morgan nor any other reference cited in the reexamination teach the following configuration:

> [A] communication server, in communication with the communication unit, comprising a data transfer manager operable for receiving an optimized reply comprising a first data unit identifier and further data….

> [and] a host server, in communication with the communication server, comprising a store for storing the first data unit and being operable for, in response to a request for the first data unit by the communication server, forwarding the first data unit to the communication server.

[MOTM_24063_0024179.]

65.   The cc:Mail reference does not disclose any of the missing elements of Morgan. Like RFC 1730, which was cited in the second reexamination, it describes basic email software, which includes inbox and outbox functionality and email management capabilities. Importantly, however, the inbox described in cc:Mail does not have all the functionality of the "inbox" described in the claims of the '899 patent. As I describe above, only standard email and reply emails are described by cc:Mail – cc:Mail does not disclose any optimized replies.[3]

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[3]   Although cc:Mail provides the user with the option to manually decide whether or not to include the text of the received email in the reply email (*see* MS-MOTO_SDFLA_00000228500), this does not imply optimization. As discussed above, if the original text is not ignored, it becomes part of the message itself.

Accordingly, a user's inbox (stored on the mailbox server) does not provide email data that can be recombined with reply data for transmission to a user other than the user associated with that inbox by allowing replica replies to be constructed.

66. Dr. Stubblebine attempts to rely on cc:Mail for the same reason RFC 1730 was cited in the second reexamination. As the Examiner in that reexamination has recognized, however, a reference that simply teaches email and an inbox is not sufficient – even in combination with the disclosure of the Morgan patent – to render the claims of the '899 patent obvious, because the "combination" of these two disparate references fails to disclose each and every limitation of the claims. And as discussed in greater detail below, I do no believe that one of ordinary skill in the art would combining these references in the first place. There was, for example, no problem in either the cc:Mail or Morgan systems that would be solved by making the combination identified by Dr. Stubblebine. Each system included its own way of routing information and no common sense solution would result from combining these references, nor would the combination yield a predictable result. Dr. Stubblebine fails to identify any design incentives or market forces that would prompt one of skill in the art to modify Morgan to provide the email capabilities found in cc:Mail in the 1995 timeframe. Furthermore, Dr. Stubblebine points to no explicit teaching, suggestion or motivation to combine the teachings of the Morgan and cc:Mail references in the way he suggests.

(a)   **Claim 1: "A system for communicating reply data with a communication unit comprising"**

67. I understand that Microsoft construes this phrase to mean "a system for transmitting or receiving the reply email composed on the communication unit before optimization." I further understand that Motorola contends that element is not a limitation of the claim but that, if it is, it should be accorded its plain and ordinary meaning.

68.   Under either parties' construction, I disagree that this element is disclosed in the Morgan patent and/or the cc:Mail reference. Neither the Morgan patent, nor cc:Mail describe a communication unit that sends or receives an optimized reply email composed on a device before sending. Indeed, Dr. Stubblebine has not pointed to any portion of either the Morgan or cc:Mail reference that teaches this limitation under his interpretation of Microsoft's construction or Motorola's construction.

69.   Arguing that the preamble is disclosed in Morgan in combination with cc:Mail and the knowledge of skill in the art, Dr. Stubblebine states that one would understand that the "personal communication computer 112 could take a received email that was very small and create an annotated document that was slightly larger. This annotated document [of Morgan] might be sent as an email message." Stubblebine Report at ¶ 101. I disagree with Dr. Stubblebine's conclusion that the annotated document might be sent as an email message.

70.   First, as discussed below, I disagree that Morgan discloses email. Nothing in Morgan suggests sending the annotated document as an email. Rather than an email, Morgan describes sending the document itself to end users. *See, e.g.*, Morgan patent, Col. 4:65-68 ("If access to the intended destination by the wireline network is available (407), the server transmits **the document (408)** via that network to the intended destination."). The documents disclosed in Morgan are not emails. And I disagree that the ability to start with a very small received email and create a slightly larger annotated document means that the documents may be sent as emails.

71.   Morgan also describes sending annotations or edits, along with a separate accompanying message containing information about the destination of the document. *See, e.g.*, Morgan patent, Col. 9:15-21. Dr. Stubblebine has identified no reason to send the annotated document described in the Morgan patent as an email because Morgan already describes an

accompanying message associated with the document that contains, *inter alia*, destination information. Email is unnecessary. And if the annotated document was to be sent as an email, Dr. Stubblebine provides no analysis as to how this message or email would be handled by the system, including what would happen to the separate message containing destination information that Morgan discloses.

      (b)   Claim 1: "a communication server, in communication with a the communication unit, comprising a data transfer manager operable for receiving an optimized reply comprising a first data unit identifier and further data"

72.   During the second reexamination of the '899 patent, the examiner stated that neither Morgan nor any of the other prior art under consideration teaches the configuration described in this claim limitation. [MS-MOTO_SDFLA_00000014600.] As I described above, the RFC 1730 reference was included in this reexamination request for the same reason as Microsoft attempts to use cc:Mail here – to teach an inbox (and email, generally). Accordingly, it is my opinion that consideration of cc:Mail here adds nothing to the Examiner's prior analysis of this limitation.

73.   Dr. Stubblebine states that Morgan in combination with knowledge of ordinary skill in the art and cc:Mail disclose a server comprising a data transfer manager. *See* Stubblebine Report at ¶¶ 108-114. More specifically, he states that the computer 201 of Morgan is the data transfer manager. *Id.* at ¶ 109. I disagree. While it is possible that computer 201 could direct data traffic between components of the system, the claims of the '899 patent require that the "data transfer manager" receive "an optimized reply." As discussed above, neither Morgan nor cc:Mail disclose optimized replies. Accordingly, whether or not computer 201 of Morgan can regulate data transmitted in a network, nothing in Morgan describes a data transfer manager

component of computer 201, as claimed. Nor is a "data transfer manager," when given its plain and ordinary meaning, even inherently disclosed in Morgan.

74. Dr. Stubblebine further states that Morgan in combination with knowledge of one of ordinary skill and cc:Mail teach forming a replica reply from the further data and a first data unit corresponding to the first data unit identifier. *See* Stubblebine Report at ¶¶ 116-119. Once again, I disagree. The first data unit in the claims is data that is provided from an inbox of the user of the originating email. As discussed in more detail below, Morgan does not teach an inbox. Nor does Morgan teach using one user's dedicated document storage as a source of a document and/or message that is sent to another user. Finally, the Morgan patent does not disclose creation of a "replica reply" email.

(c)   Claim 1: "wherein the store comprises an inbox of a user"

75. Dr. Stubblebine states that Morgan teaches an inbox by disclosing "the personal communication computer (112) can become aware the server (101) has a message intended for its reception." Stubblebine Report at ¶ 93. Dr. Stubblebine further states that one of skill in the art would not have understood that "server (101) has a message" inherently requires that the server (101) stores the message in memory, which is then available for retrieval by the communication unit. Dr. Stubblebine argues that, therefore, Morgan shows the mailbox of the server (101) is associated with a personal computer. I disagree. The mere fact that the server has a message to be sent does not mean that the server has an inbox. In fact, any storage of an outgoing message in the server (101) is distinct from the inbox claimed in the '899 patent. And a single outgoing message in a queue for sending would be in temporary memory, not mailbox storage. Further, an "inbox" collects a user's <u>received</u> emails – not its <u>outgoing</u> emails. Storage of a message in a location that is specifically associated with a given user's received emails is not necessarily an inbox. In addition, the claimed inbox must forward the first data unit to the

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communication server. Here, the "inbox" Dr. Stubblebine proposes is part of the same program or process as the communication server, and would not store the document after it is sent. Accordingly, the document would not be available in the "inbox" later when it needs to be retrieved to construct an annotated document. The server could store documents in a variety of different ways – including not using email at all (which I do not believe Morgan discloses).

76. In support of his argument that Morgan discloses a mailbox in the post office context, Dr. Stubblebine cites as support a declaration filed by John Friend on behalf of Motorola that relates to the understanding of mailbox by a person of ordinary skill: "new email arriving at the server based upon an email address could be accessed remotely." [MS-MOTO_SDFLA_ 0000014457.] Dr. Friend recognized that in the context of the reexamination, however, he must consider the broadest reasonable sense of the word "mailbox." [MOTM_24063_0023308.] This approach differs from how one of skill in the art would understand claim terms in the context of litigation. Further, even under this broad definition of mailbox, Morgan does not disclose this element. Morgan discloses providing a notification to a user that a document is available – when the device is connected to the server, the document will be collected and stored. *See, e.g.,* Morgan patent, FIG. 5 (502, 503). There is no disclosure of email arriving at a server based on an email address.

(d) Claim 1: "forming a replica reply"

77. It is my understanding from the claim language of the '899 patent that a replica reply is a replica of the full reply email. Thus, I understand the plain and ordinary meaning of this phrase to mean forming a replica reply email.

78. I am informed that the term "email" is construed by Motorola to have its plain and ordinary meaning or alternatively, to mean "electronic mail." I understand that Microsoft's construction of "email" is "A message, transmitted to a mailbox, having text and header

information used for transmitting the text. The header information includes at least the recipient mailbox address and the author address and may include other message attributes such as subject, date, and priority level."

79.   It is my opinion that if the plain and ordinary meaning of "email" is applied to the term, as Motorola proposes, Morgan does not teach email. As discussed above, I understand that the breadth of claims is interpreted more broadly in front of PTO during a reexamination proceeding. Hence, the Examiner's initial statement that electronic message in Morgan is email does not control here. Indeed, as discussed above, the Examiner later recognized that the system for distributing electronic documents in Morgan is different than the email configuration claimed in claim 1 of the '899 patent. This is consistent with my understanding of the Morgan patent.

80.   I also disagree with Dr. Stubblebine that the Morgan reference discloses "email" under Microsoft's proposed construction. *See* Stubblebine Report at ¶ 95. Microsoft's definition requires that a message include text and header information used to transmit the text. Morgan does not teach sending a single message containing both the substantive text and the destination information, nor does Morgan disclose a "header." In Morgan, information about where to send the document is part of a separate message. The fact that those two messages are transmitted together does not make the destination information part of the substantive textual message. *See* '899 Patent, FIG. 10 (step 1004). Nothing in Morgan suggests that the separate message is a header.

81.   Dr. Stubblebine also argues that "messages in Morgan have destination addresses prior to being transmitted." *See* Stubblebine Report at ¶ 95. As stated above, I disagree that the transmission in Morgan includes an email destination address. The claims of the '899 patent

require that the communication server "form[] a replica reply" – this is email, which is not disclosed by Morgan.

        (e)   **Claim 1: "a host server, in communication with the communication server, comprising a store for storing the first data unit and being operable for, in response to a request for the first data unit by the communication server, forwarding the first data unit to the communication server"**

82.   During the second reexamination of the '899 patent, the examiner stated that neither Morgan nor any of the other prior art under consideration teaches the configuration described in this claim limitation. [MS-MOTO_SDFLA_00000014600.] As I described above, the RFC 1730 reference was included in this reexamination request in an attempt to provide the elements that the Examiner found were missing in the Morgan patent during the first reexamination. Dr. Stubblebine attempts to do the same thing here, but with the cc:Mail reference instead. Specifically, Dr. Stubblebine attempts to find the disclosure of an inbox (and traditional email), in conjunction with reply emails to invalidate the claims of the '899 patent. But because cc:Mail provides only traditional reply emails (and does not disclose a dual-server arrangement for preparing replica reply email), cc:Mail adds nothing to the Examiner's analysis of this limitation that RFC 1730 did not already provide.

83.   I have been informed that the parties disagree about the proper construction of "host server" and "forwarding."

84.   I am informed that the phrase "a host server, in communication with the communication server" is construed by Motorola to mean "A computer or a program that operates as an e-mail post office, which can exchange data with the communication server." I understand that Microsoft has taken the position that this term means "The host server and the communication server are separate processing devices (e.g., computers) transmitting to or receiving from each other over a network."

85.   Dr. Stubblebine states that one of ordinary skill would understand that computer 102 is a host server that communicates with server 101 via local area network 104. *See* Stubblebine Report at ¶ 125. He goes on to state that it would be obvious to position the post office functionality of server 101 on a separate processing device such as computer 102. *See id.* at ¶ 126. First, I disagree that Morgan discloses that server 101 has "post office functionality." The office server in the Morgan patent is different from a post office server – indeed, it has no email functionality whatsoever. Further, even assuming that server 101 has "post office functionality," I disagree that it would have been obvious to position that functionality on a separate process, program, or processing device.

86.   Dr. Stubblebine suggests that the mere capability of office server 101 to access data storage of other computers means that means that it would have been obvious to one of skill in the art to divide up server 101 into two pieces- a communication server and a host server. *See, e.g.*, Stubblebine Report at ¶ 126. Again, I disagree. Dr. Stubblebine has identified no reason, such as efficiency or cost savings, why one of skill in the art would have sought to do so. And he has not provided any specific detail as to how such a change would be effectuated. This is especially true in light of the fact that creating the host server as a separate process, program, or device would result in the need for additional communication (between the new host and communication server) for server 101 to access the original message.

87.   Dr. Stubblebine goes on to say that since the host server can transmit to a communication server, one of skill in the art would have understood that a post office on computer 102 could have sent the server 101 an email containing the original document when a replica reply is formed. *See* Stubblebine Report ¶ 134. I disagree. Nothing in Morgan or

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cc:Mail suggests that the original document should be retrieved from a location other than the office server, nor does it disclose sending an annotated document via email.

88.   I also disagree with Dr. Stubblebine's statement that one of skill in the art would understand that "the Post Office" on computer 102 could send to the server 101 the email containing the original document when a replica reply requiring the email containing the original document is formed on server 101. *See* Stubblebine Report ¶ 140. Dr. Stubblebine's opinion is hindsight – he uses the claims of the '899 patent to reach this conclusion and provides no other reason why one of skill in the art would do this. In 1995, one of skill in the art, in my opinion, would <u>not</u> have thought to send an email to one address using email stored in another user's inbox on a server, except in the context of simple mail forwarding. In fact, in 1995, email systems were simpler than today's networks. For example, the modularity and flexibility of servers today is different than the knowledge of one skilled in the art in 1995.

89.   In addition, Morgan does not teach storing the destination information on the server. Morgan states that "Upon receiving a document (401), the server stores the document (402) in its document memory (203 of FIG. 2) and then determines the intended destination(s) (403) of the document by considering the destination information provided by the originating party." '899 Patent, 4:17-21. Thus, Morgan demonstrates that this destination information is not part of the document (401) itself.

90.   I understand that Motorola is taking the position that the term "forwarding" should be construed according to its plain and ordinary meaning, or, alternatively, to mean "forwarding from one computer or program to another." I understand that Microsoft is taking the position that the term means "Sending [send, sends, sent] from one processing device (e.g., computer) to a separate processing device (e.g., computer)."

91.   Dr. Stubblebine states that "the Post Office on the computer 102 (one processing device) disclosed in cc:Mail could be used for storing the original document disclosed in Morgan. … [O]ne of ordinary skill in the art would understand that the Post Office on the computer 102 (one processing device) could send to the server 101 … the email containing the original document." Stubblebine Report at ¶ 140. Nothing in Morgan teaches this. In my opinion, without resorting to hindsight, it would not have been obvious to one of skill in the art to use computer 102 to store the document, since the reference already describes storing the document in server 101. As discussed above, storing the same document in more than one location would complicate the Morgan system and would not be a simple modification. Furthermore, none of the references suggest storing an email in a first user's inbox storage on a server to be retrieved to be sent to another person. The inbox disclosed in cc:Mail is not used for that purpose – because optimized reply emails are not disclosed of suggested in that reference.

92.   In my opinion, a person of skill in the art in 1995 would not have thought to store information being sent to one user in another user's inbox on a server. In 1995, data transmission and storage was particularly expensive. One of ordinary skill would have had no reason to modify Morgan (which had its own way of distributing annotations and updates to stored documents from a centralized server in an efficient manner) to create a separate server for storage for those documents. Adding more communication pathways to the document transmission process would only further complicate the system, potentially increasing bandwidth usage. Therefore, neither the Morgan patent nor the cc:Mail reference, either alone or in combination with the knowledge of ordinary skill in the art, disclose "forwarding" under either party's definition.

(f)   Claim 15: "the system of claim 1, wherein the first email sent to the communication unit includes a textual message and is accompanied by a file attachment"

93.   As discussed above with respect to claim 1, the parties disagree regarding the construction of the term "email."

94.   Dr. Stubblebine concludes that "[u]nder either definition of email, Morgan in combination with cc:Mail discloses this element." Stubblebine Report at ¶ 156. I disagree.

95.   Claim 15 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the Morgan patent with the cc:Mail reference, or that the Morgan patent in combination with the cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 15.

(g)   Claim 16: "the system of claim 1, and further wherein the communication server forwards the replica reply to an outbox of the mailbox of the user associated with the communication unit"

96.   Dr. Stubblebine states that cc:Mail discloses that the replica reply email of Morgan may be forwarded to a Message Log folder (outbox) of a user's mailbox. I disagree. Dr. Stubblebine has provided no support that the system disclosed in Morgan can be combined with cc:Mail to produce this result. Nothing in either reference discloses the transmission of a reconstructed replica reply message to an outbox. Nor does Morgan disclose transmitting any reconstructed message to a separate server.

97.   Claim 16 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the Morgan patent with the cc:Mail reference, or that the Morgan patent in combination with the

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cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 16.

      (h)   Claim 17: "the system of claim 1, wherein the mailbox of the user includes an inbox and an outbox, and further wherein the communication server is forwarded the first data unit from the inbox of the user associated with the communication unit, and the replica reply is forwarded to the outbox of the user associated with the communication unit"

98.   As discussed above with respect to claim 1, the parties disagree regarding the construction of the term "forwarded."

99.   Dr. Stubblebine concludes that "[u]nder Microsoft's construction of the term 'forwarded,' Morgan in combination with cc:Mail discloses this element." Stubblebine Report at ¶ 164. Dr. Stubblebine further concludes that "under Motorola's construction of the term 'forwarded,' this claim is also disclosed by Morgan in combination with cc:Mail." Stubblebine Report at ¶ 169. I disagree with both conclusions.

100.   Claim 17 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the Morgan patent with the cc:Mail reference, or that the Morgan patent in combination with the cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 17.

      (i)   Claim 18: "the system of claim 1, wherein the replica reply is stored in the mailbox such that both the first email and the replica reply are stored in the mailbox of the user associated with the communication unit"

101.   As discussed above with respect to claim 1, the parties disagree regarding the construction of the term "email."

102.   Dr. Stubblebine concludes that "under either definition of email, Morgan in combination with cc:Mail discloses this element." Stubblebine Report at ¶ 173. I disagree.

103. Claim 18 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the Morgan patent with the cc:Mail reference, or that the Morgan patent in combination with the cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 18.

B. The Jackson Patent In Combination with One of Ordinary Skill In The Art And cc: Mail Does Not Render Obvious Claims 1 and 15-18 Of The '899 Patent

104. As described above, the Jackson Patent does not disclose email, nor does it disclose anything related to optimizing reply email messages.

105. In his report, Dr. Stubblebine concludes that the Jackson patent, taken together with the knowledge of one of ordinary skill in the art and the disclosure of the cc:Mail reference, renders claims 1 and 15-18 of the '899 patent obvious. Dr. Stubblebine does not argue that any one reference contains each and every element of the asserted claims of the '899 patent, because each is missing at least one critical element of the claims. As a result, Dr. Stubblebine picks and chooses various elements from a number of references, and relies on the supposed knowledge of one of skill in the art, in an attempt to find a combination that he believes invalidates the asserted claims. For the reasons outlined below, I disagree with his conclusion.

106. And as discussed in greater detail below, I do not believe that one of ordinary skill in the art would combine these references in the first place. There was, for example, no problem in either the cc:Mail or Jackson systems that would be solved by making the combination identified by Dr. Stubblebine. Each system included its own way of delivering information to users and no common sense solution would result from combining these references, nor would the combination yield a predictable result. Dr. Stubblebine fails to identify any design incentives or market forces that would prompt one of skill in the art to modify Jackson to provide the email

capabilities found in cc:Mail in the 1995 timeframe. Furthermore, Dr. Stubblebine points to no explicit teaching, suggestion or motivation to combine the teachings of the Morgan and cc:Mail references in the way he suggests.

      (a)   Claim 1: "a system for communicating reply data with a communication unit comprising:"

107.   As discussed in my Kaliski Initial '899 Report, I understand that Motorola is taking the position that he preamble of Claim 1 is not limiting and should be construed according to its plain and ordinary meaning. I further understand that Microsoft believes that the preamble of Claim 1 is limiting and means "A system for transmitting or receiving the reply email formulated on the communication unit before optimization."

108.   Dr. Stubblebine concludes, based on Microsoft's interpretation, that the Jackson patent, in combination with the cc:Mail reference discloses this element. Stubblebine Report at ¶ 180. As an initial matter, I note that Dr. Stubblebine's comments about this alleged combination are conclusory. He does not say how this modification would be performed, what components would need to be added and how the device would operate.

109.   I agree that the Jackson patent discloses automatically sending information to various computers (or nodes) in a network. But this does not make the transmission of the information "reply data," as required by in the claim. Dr. Stubblebine cites to the discussion of FIG. 6 in the specification of the Jackson patent, pointing to steps 618 and 620 as supporting his conclusion that this element is disclosed in the patent. But even a cursory examination of the Jackson patent shows that this portion of the specification is discussing how a filled out form (or an "Instance," *see* Col. 3:21-22 ("An instance of a form is a form into which information or data has been entered.")) is distributed, not how **reply email** is communicated.

110.   According to the Jackson patent,

> Referring now to FIG. 5, operations for completing an instance of a form (Block 500 of FIG. 2) will now be described. It will be understood that these operations are performed similarly whether the instance is an instance of an information form or of a linked form.

Jackson Patent, Col. 8:58-62. Figure 5, which is reproduced below, discloses sending a completed "instance" of a form – not reply data. According to the patent, "[a]t Block 510, a remote/mobile link is established with the server and **the completed instance** is transferred to the server at Block 512." Jackson patent, Col. 9:20-22 (emphasis added).

FIG. 5
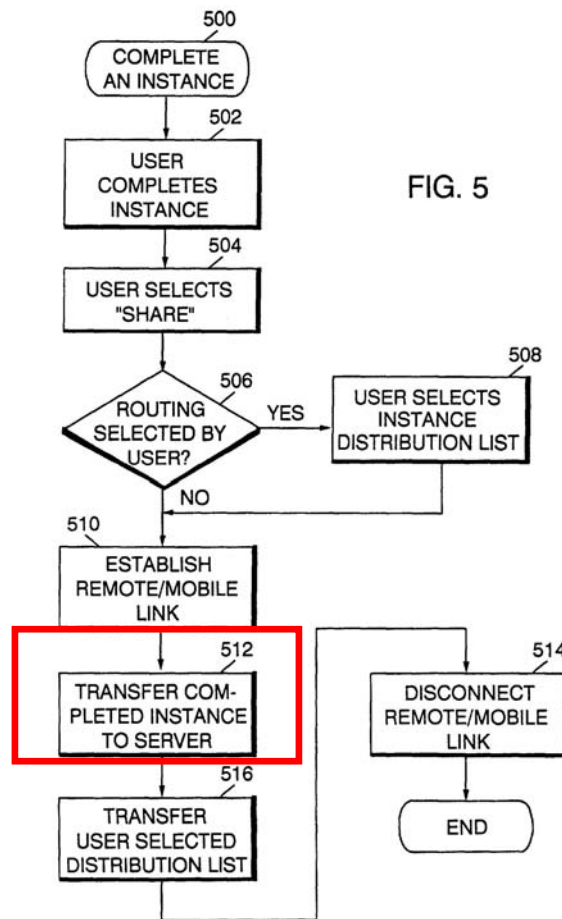
This is the entire filled-out form, not reply data.

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111.   The Jackson patent continues:

> Referring now to FIG. 6A-B, operations for distributing an instance of a form (Block 600 of FIG. 2) will now be described. It will be understood that these operations are performed to distribute instances of information forms to third remote/mobile nodes and instances of linked forms to the third remote/mobile nodes.

Jackson patent, Col. 9:26-31. Dr. Stubblebine relies on the first portion of this method in support of his conclusion that this element of the '899 patent is disclosed. (*See* Stubblebine Report at ¶ 180). But the portion of the Jackson patent relied upon by Dr. Stubblebine only discloses circumstance by which the original "form" will be sent to a user prior to sending a "linked form" or "other files" to that user. As shown below, nothing disclosed in Figures 6A or 6B suggests that reply email is being transmitted – only a "form" and/or "information "form."
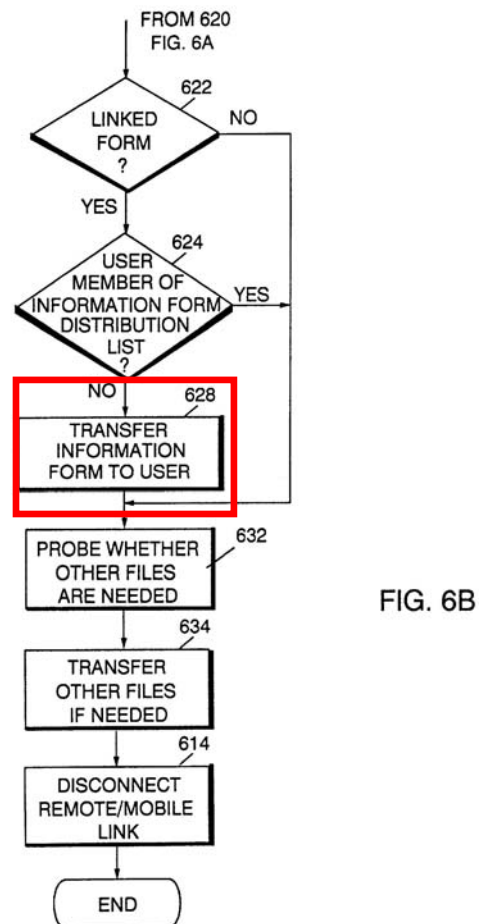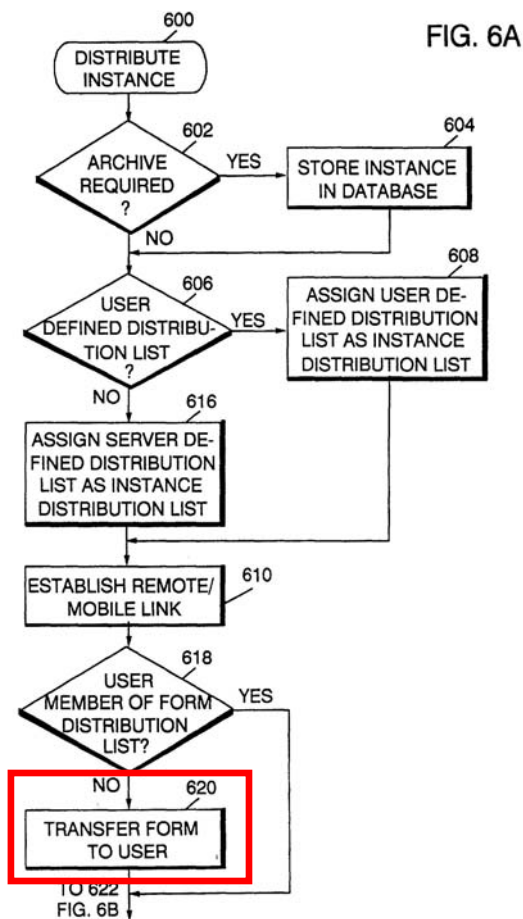
112.   Because I do not agree that sending either the "form" (Block 620) or the "information" (Block 628) alone is sending "communicating reply data with a communication unit," I disagree that this element is disclosed in the Jackson patent.

113.   Dr. Stubblebine next argues that to the extent the Jackson patent does not disclose this claim element, it would have been obvious for one of skill in the art to modify the system to do so. I disagree. Nowhere in the patent is the term "New Instance" data disclosed. Instead, the Jackson patent discloses distributing completed Instances (i.e., completed forms) to end users. Although the original form may be sent to a user, this does not mean that the system could necessarily be modified to re-create a "Completed form" at each node, based on the Original form and the new information input when creating the Instance. Dr. Stubblebine does not state how one of ordinary skill in the art would modify the Jackson system to accomplish such a change in functionality, nor does he disclose how the various nodes would process the form and Instance information to create a "Completed form." Nor does Dr. Stubblebine explain how the results of such a combination would be predicable to one of skill in the art.

114.   Finally, Dr. Stubblebine states that it would have been obvious for one of skill in the art to combine the system described in the Jackson patent with the cc:Mail reference. I disagree. Dr. Stubblebine provides no description of how one of ordinary skill in the art would combine these disparate systems, or why he or she would be motivated to do so. For example, Dr. Stubblebine does not describe how a Completed Instance would be distributed from a node to a server using the cc:Mail system and its addressing mechanism, nor why one of ordinary skill in the art would even want to do so, given the operation of the Jackson patent's "distribution list[s]." Indeed, further modification would be unnecessary. As discussed above, in my opinion, there is no teaching of suggestion in either Jackson or cc:Mail that would motivate one of

ordinary skill in the art to combine their teachings. And to the extent they were combined, I do not believe that any "results" suggested by Dr. Stubblebine would have been predictable.

115.   Dr. Stubblebine states that his analysis does not change if the court adopts Motorola's proposed construction. Again, I disagree. Under Motorola's proposed construction, the data that must be sent from one component to another must be email reply data. Because I disagree that the Jackson patent discloses email, and I disagree that the cc:Mail reference would be combined by one of skill in the art with the Jackson patent in the manner disclosed by Dr. Stubblebine, I disagree with his conclusion that this element of claim 1 is obvious.

(b)   Claim 1: "comprising a data transfer manager operable for receiving an optimized reply comprising a first data unit identifier and further data"

116.   Dr. Stubblebine concludes that this element is disclosed in the Jackson patent, when combined with the knowledge of one of ordinary skill in the art and cc:Mail. I disagree. The Jackson patent does not disclose a software component of the communication server that receives an optimized reply. According to the '899 patent, this optimized reply comprises a first data unit identifier (i.e., an identifier associated with a first email sent to the communication unit) and further data (i.e., a delta between the first email and the reply email). '899 patent, Reexamination Certificate at Col. 2:3-7. This is not disclosed in the Jackson patent.

117.   In support of his conclusion, Dr. Stubblebine points to "New Instance" data that is received by a server. *See* Stubblebine Report at ¶ 192. It is true that the various embodiments disclosed in the Jackson patent describe sending an Instance Form to the server. *See, e.g.* Jackson patent, Cols. 7:19-39, 7:49-64. But in each case, the Jackson patent discloses sending the entire form to the server. *See, e.g.*, Jackson patent, FIGs. 2-4. The patent does not disclose transmission of any "New Instance" data to the server from the remote node.

118.   Dr. Stubblebine further concludes that the Jackson patent discloses "a first unit identifier." *See* Stubblebine Report at ¶ 193. Arguing that a data identifier must be received by the server, Dr. Stubblebine makes improper assumptions about what must be included in any communication between a node the server. There is no requirement that a form being sent from a node to the server include such an identifier for the test of Block 618 to be performed. In fact, Dr. Stubblebine improperly describes the steps disclosed in FIG. 6A in reaching his conclusion. As described in the Jackson patent, the steps outlined in FIG. 6A relate to the distribution of an Instance – a completed form. *See* Jackson patent, Col. 3:21-22. As shown below, when an "Instance" is distributed, the form itself is transmitted to the server. *See* Jackson patent, FIG. 6A (620).
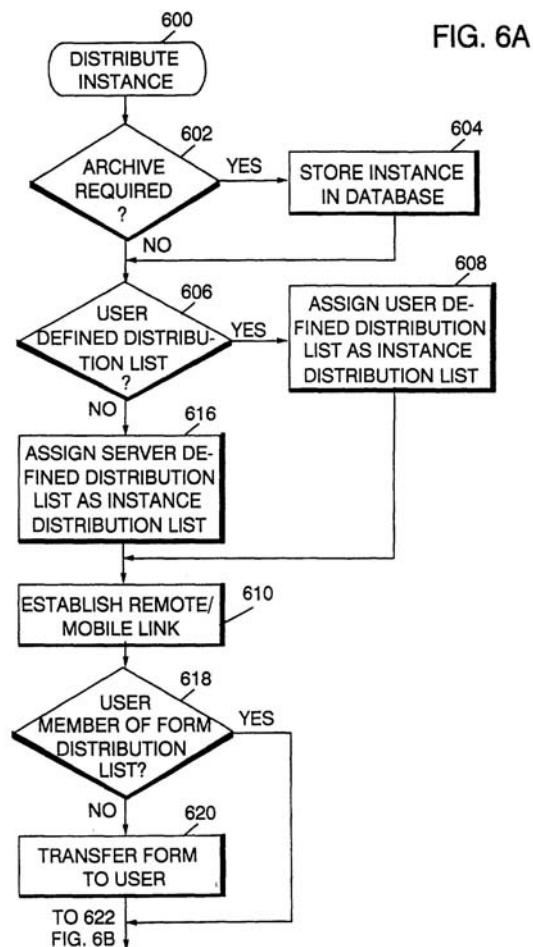
FIG. 6A

119.   In order to later route that Instance to the appropriate recipients, the server must

check for a distribution list. *See id.* at FIG. 6A (606). This does not require that a "first data unit

identifier" be included in the form. In fact, the Jackson patent describes the distribution list as

something that needs to be associated with the form itself – indeed, a distribution list identifier is

be used, rather than a form identifier. *See id.* at Col. 3:12-15 ("The form is identified as being

shareable, and an associated form distribution list is assigned to the form in order to identify

users corresponding to first remote/mobile nodes."). There is simply no requirement in the

Jackson patent system that a form identifier be used that would make this element inherently

present in the disclosure. Furthermore, Dr. Stubblebine argues that:

> One of ordinary skill of the art would understand that in order to make this
> determination, the New Instance must be accompanied by some reference to the
> original form. This is because the server must later retrieve the original form and
> distribute it along with the New Instance if the recipient does not already have the
> original form. If the server did not receive an identifier for the Original Form with
> the New Instance, it would be unable to determine which original form, if any, to
> send to the recipient of the new instance.

Stubblebine Report at ¶ 193. In my opinion, this statement amounts to a misstatement of what

the disclosure of the Jackson patent. Nowhere in the patent is there a description of the

transmission of both an original form AND a "New Instance." As described above, the

"Instance" that is distributed from the originator to the server is the form itself. *See* Jackson

patent, Col. 3:21-22. Once present at the server, the form data can be later distributed. *See*

Jackson patent, Col. 10:40-49. As discussed above, there is no requirement that an identifier be

included in that transmission. Accordingly, I do not agree that this element is disclosed in the

Jackson patent.

120.   Dr. Stubblebine further concludes that the Jackson patent in combination with the

cc:Mail reference discloses this element. *See* Stubblebine Report at ¶ 194. As discussed above, I

do not agree that one of ordinary skill in the art would combine the Jackson patent and the

cc:Mail reference. Because the email described in the Simple Mail Transfer Protocol ("SMTP") must be able to be routed and distributed across a wide variety of networks and computer systems, there needs to be a standardized way to identify email being sent and stored. Therefore, it is understandable that something like a "MESSAGE-ID" would be used. *See id.* This, however, does not mean that the closed network described in the Jackson patent requires such a standardized manner of identifying data. In fact, the Jackson patent discloses no such methodology – perhaps because its software could link forms and distribution lists via other means, such as the embedded distribution list example I presented previously.

121. Finally, Dr. Stubblebine concludes that software executing on the servers disclosed in the Jackson patent constitutes the "data transfer manger" required by the claims. I disagree. In his report, Dr. Stubblebine states that "the communication server manages the connection and disconnection of the remote/mobile link, and the receipt of the transfer of the completed instance, and instance distribution list." Stubblebine Report at ¶ 195. He concludes that "[t]he portion of the server that is doing this management is the data transfer manager." There is no disclosure in the Jackson patent that supports Dr. Stubblebine's conclusion – in fact, I believe the opposite to be true. Review of the portion of the specification describing Figure 5 in the Jackson patent describes various steps taken by the user using his remote node:

- "Upon completion of the information in the instance form, **the user selects a 'share' option at Block 504** …" Jackson patent, Col. 8:62-64.
- "At Block 506, **selection is made** as to whether the user or the server selects routing. In some cases, such as the distribution of an instance of a customer form, **the user may select a department or sales force group to which the instance will be distributed**." *Id.* at Col. 9:1-5.
- "Accordingly, **at Block 508, if the routing is selected by the user**, the user assigns an instance distribution list to the instance of the form to identify users corresponding to third remote/mobile nodes." *Id.* at Col. 8-11.
- "At Block 510, **a remote/mobile link is established** with the server and the completed instance is transferred to the server at Block 512. At Block 516, **if the**

user has selected a distribution list, then the instance distribution list is also transferred to the server. The remote/mobile link is then disconnected." *Id.* at Col. 21-25.

Therefore, it appears more likely to me that any "data transfer manager," to the extent one exists at all, is located on the remote user's node. At the very least, one cannot determine definitely that the data transfer manager is located on the server, as Dr. Stubblebine has done. Therefore, I disagree that this element is disclosed in the Jackson patent.

122. Finally, Dr. Stubblebine concludes that the Jackson patent, in combination with the cc:Mail reference, discloses a data transfer manager in the communication server. *See* Stubblebine Report at ¶¶ 196-198. I see no disclosure of a server-based data transfer manager in the cc:Mail reference identified by Dr. Stubblebine. While Chapter 3 of the cc:Mail reference does disclose methods for "creating and sending messages," there is no disclosure of either data transfer manger or an optimized reply. It is just as likely that any data transfer manager resides on the cc:Mail client application (running on a desktop computer) than the mailbox server. And, critically, there is no disclosure that the reply disclosed in the cc:Mail reference is anything other than a standard reply email (an email with the original email text included in the reply message. In fact, Figure 3.9 of the cc:Mail reference, reproduced below, shows what I believe is a standard reply email message, because the original message text can be edited ("Press the ↓ key to **edit the original message text**."):
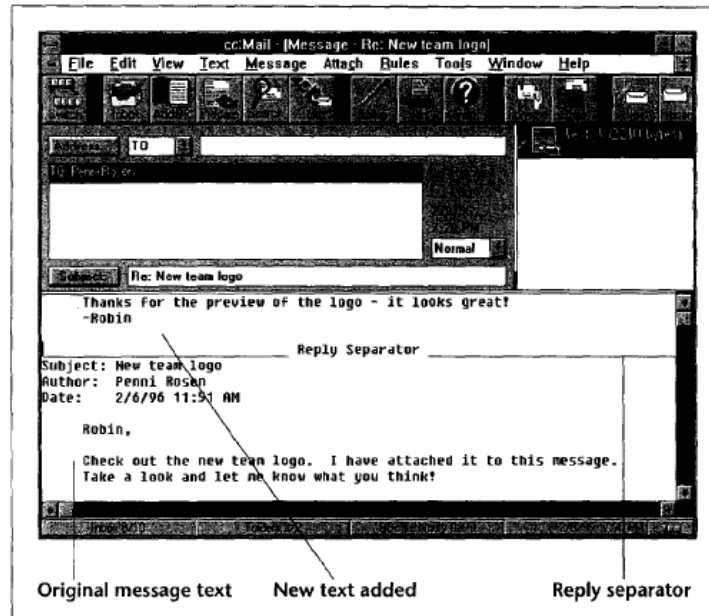
FIGURE 3.9: *A reply message with reply separator*

Type your reply in the space above the reply separator. Press the ↓
key to edit the original message text. When you have finished your
reply, click on the Send SmartIcon or select Message ➤ Send to send
the message.

[MS-MOTO_SDFLA_00000228501.] Accordingly, I disagree that cc:Mail – either alone or in

combination with the Jackson patent – discloses this element.

> **(c)** **Claim 1: "forming a replica reply from the further data and a first data unit corresponding to the first data unit identifier"**

123.   Dr. Stubblebine concludes that the Jackson patent, in combination with the skill of

a person of ordinary skill in the art and the cc:Mail reference, discloses this reference. *See*

Stubblebine Report at ¶¶ 200-202. Once again, I disagree.

124.   Dr. Stubblebine argues that a combination of the Jackson patent and the cc:Mail

reference "discloses forming a replica reply from the further data (delta between the Original

Form as an email and the Completed Form as an email, which is the New Instance computed

between the emails) and a first data unit (identifier of the Original Form as an email)

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corresponding to the first data unit identifier (identifier of the Original Form as an email)." *Id.* at ¶ 200. But the Jackson patent does not disclose email, and the portions of the specification that discuss Figure 6 that Dr. Stubblebine cites in support of this statement do not provide any support for his conclusion, either.

125.   As discussed above, the Jackson patent does not disclose the transmission of a "New Instance" from the originating node to the server, whereby the "New Instance" is new data added to a form. Instead, the patent discloses updating a form to create an Instance (FIG. 5 (500, 502)), transmitting that Instance to the server (FIG. 5 (512)), checking whether any new users were added to the distribution list (FIG. 6A (618)), and transmitting the original form to those users if they do not already have it (FIG. 6A (620)). The server never receives "further data" or "a first data unit identifier corresponding to the first data unit identifier," as required by the claims of the '899 patent. And Dr. Stubblebine does not provide any citation or support for his conclusion that a combination of references would make this element obvious. Instead, as discussed above, the Jackson patent discloses receipt of a form Instance (i.e., filled out form) by the server (FIG. 5 (512)), which is then transmitted to other users.

126.   Dr. Stubblebine states that this process of sending an original form along with "New Instance data" is disclosed "between blocks 610 and 614 in Figures 6A and 6B." Stubblebine Report at ¶ 200. But the only transfer of data disclosed in these Figures is the "transfer form to user," "transfer information form to user," and "transfer other files if needed" steps (Blocks 620, 628 and 634 of FIGs. 6A & 6B), none of which is a delta between an original email and an original email message, as required by the claims of the '899 patent.

127.   Dr. Stubblebine concludes by stating that one of ordinary skill in the art would find it obvious to combine the Jackson patent's use of Instance forms and cc:Mail's use of SMTP

to produce a "replica reply … created in an email format with same email headers as the reply email." Stubblebine Report at ¶ 201. To the extent Dr. Stubblebine's argument is anything other than a repetition of certain claim terms, this is conclusory hindsight. There is no disclosure in either reference of an optimized reply. Nor is there any reason that one would combine the Jackson patent and the cc:Mail reference to provide any type of reply data whatsoever. And if combined, Dr. Stubblebine has provided no detail regarding what results one of ordinary skill would anticipate, and whether those results would be predictable (or even possible). Accordingly, I disagree that this element is disclosed in the Jackson patent or the cc:Mail reference, taken alone or in combination with each other.

(d) Claim 1: "and forwarding the replica reply"

128. As discussed in my Kaliski Initial '899 Report, I understand that Motorola is taking the position that the term "forwarding" should be construed according to its plain and ordinary meaning, or, alternatively, to mean "forwarding from one computer or program to another." I further understand that Microsoft is taking the position that the term means "Sending [send, sends, sent] from one processing device (e.g., computer) to a separate processing device (e.g., computer)."

129. Dr. Stubblebine concludes that under Microsoft's or Motorola's proposed construction of the term, it would be obvious to combine the Jackson patent with the cc:Mail reference to meet this claim limitation. *See* Stubblebine Report at ¶¶ 204-206. Because I do not believe that a replica reply is ever created, as discussed above, I do no agree.

130. As described in the claims of the '899 patent, a replica reply is "a replica of the reply email." '899 patent, Reexamination Certificate at Col. 2:7-8. Neither the Jackson patent, nor the cc:Mail reference, either alone or in combination, disclose sending a "replica reply" anywhere, whether between two software applications or two computers. The Jackson patent

discloses sending either form data (e.g., FIG. 6A (620)), or the newly added data to other recipient nodes (e.g., FIG. 8 (832)). And the cc:Mail reference discloses traditional reply email (e.g., Fig. 3.9). Neither discloses creating a "replica reply" from a first data unit identifier and further data, then forwarding that data elsewhere. And I do not believe that one of ordinary skill would combine them – the Jackson patent explicitly recommends against creation of what would be a "replica reply": "It will be understood that preferably **only the modifications are transferred rather than the entire form**." Jackson patent, Col. 10:44-45 (emphasis added).

131.   Dr. Stubblebine's conclusion essentially turns these references on their heads. Because I do not believe it would be obvious to forward a replica reply, I disagree with his opinion that this claim element is disclosed.

(e)   Claim 1: "a host server, in communication with the communication server"

132.   As discussed in my Kaliski Initial '899 Report, I understand that the phrase "a host server, in communication with the communication server" is construed by Motorola to mean "A computer or a program that operates as an e-mail post office, which can exchange data with the communication server". I understand that Microsoft has taken the position that this term means "The host server and the communication server are separate processing devices (e.g., computers) transmitting to or receiving from each other over a network."

133.   Dr. Stubblebine concludes that the Jackson patent discloses this element under Microsoft's construction. *See* Stubblebine Report at ¶¶ 208-212. Although I do not necessarily agree with all citations that he provides in those paragraphs, I do agree that the Jackson patent does state that "[a]t Block 602, a determination is made at the server as to whether archive of the received information is required" and "[i]f yes, the instance information is stored in database 112 (FIG. 1) or in another database." Jackson patent, Col. 9:33-36.

134. Dr. Stubblebine further concludes that the cc:Mail reference discloses an "e-mail post office" and that "[o]ne of ordinary skill in the art would understand that the Post Office disclosed in cc:Mail for storing and sorting mail could be located on LAN file server 108 from Jackson." Stubblebine Report at ¶ 215. I do not agree with this statement. As discussed above, I do not agree that one of ordinary skill in the art would have any reason to combine the Jackson patent with the cc:Mail reference. There would be no reason to add an email server to the Jackson patent system – distribution lists already accomplished distribution of data. And Dr. Stubblebine provides no detail as to how one of ordinary skill in the art would combine these references, nor what he would expect the results to be. Accordingly, I disagree that cc:Mail in combination with the Jackson patent renders this claim element obvious.

135. Applying Motorola's proposed construction for this element, Dr. Stubblebine concludes that the Jackson patent, in combination with the cc:Mail reference, discloses this claim element. I disagree. As discussed earlier, I do no believe that the Jackson patent discloses email. Nor do I believe that it discloses "a computer or a program that operates as an e-mail post office," as one of ordinary skill in the art would understand that term. Rather, the Jackson patent discloses "a LAN file server 108 and a LAN database 112." Jackson patent, Col. 6:5-6. These servers were sufficient for performing all tasks described in the Jackson patent: storage of forms for distribution and archiving of data. There would be no reason to add an additional email post office to the Jackson system, as Dr. Stubblebine suggests. *See* Stubblebine Report at ¶ 217. Nor would there be any reason to employ "email" or "reply data" to distribute and archive the forms disclosed in the Jackson patent, as discussed in greater detail above. Dr. Stubblebine's conclusions in this regard are little more than conclusory hindsight, without any analysis as to why a person of ordinary skill would modify the Jackson patent to include email, how that

modification would be performed, and what results, if any, would be predictable. I do not believe it would have been obvious to do so.

(f) **Claim 1: "comprising a store for storing the first data unit"**

136. Dr. Stubblebine concludes that "[w]hen combined with cc:Mail, Jackson discloses this element." Stubblebine Report at ¶¶ 219-221. As discussed above, I do not agree that one of ordinary skill in the art would combine the Jackson patent with the cc:Mail reference. Accordingly, I disagree with Dr. Stubblebine's conclusion that this element is disclosed by the combination of these two references.

(g) **Claim 1: "and being operable for, in response to a request for the first data unit by the communication server, forwarding the first data unit to the communication server"**

137. As discussed above, I understand that Motorola is taking the position that the term "forwarding" should be construed according to its plain and ordinary meaning, or, alternatively, to mean "forwarding from one computer or program to another." I further understand that Microsoft is taking the position that the term means "Sending [send, sends, sent] from one processing device (e.g., computer) to a separate processing device (e.g., computer)."

138. Dr. Stubblebine concludes that "[u]nder Microsoft's definition, Jackson in combination with cc:Mail discloses this element." As discussed above, I disagree with Dr. Stubblebine's conclusory statement that the Jackson patent in combination with the cc:Mail reference would yield a system that distributed forms (and updates to forms) via email with optimized replies. There is simply no disclosure, either in the references themselves, or the Stubblebine Report, to support such a conclusion.

139. As discussed previously, I do not believe that either the Jackson patent or the cc:Mail reference disclose a "first data unit," or original email that is requested by the communication server and forwarded to that server following that request. Accordingly, I

disagree with Dr. Stubblebine's conclusion that this claim element is disclosed by the Jackson patent in combination with the cc:Mail reference.

(h)   **Claim 1: "wherein the store comprises an inbox of a user associated with the communication unit"**

140.   Dr. Stubblebine concludes that this element is disclosed by a combination of the Jackson patent and the cc:Mail reference. *See* Stubblebine Report at ¶¶ 225-226. As discussed above, I disagree that one of ordinary skill in the art would combine these references. Dr. Stubblebine has not provided any description of how a person of ordinary skill in the art would combine these references and what results, if any, would be predictable. Accordingly, I disagree that this claim element is disclosed by a combination of the Jackson patent and the cc:Mail reference, as stated by Dr. Stubblebine.

(i)   **Claim 1: "the first data unit is a first email sent to the communication unit and having an associated first data identifier"**

141.   As discussed in my Kaliski Initial '899 Report, I understand that the term "email" is construed by Motorola to have its plain and ordinary meaning or alternatively, to mean "electronic mail." I understand that Microsoft's construction of "email" is "A message, transmitted to a mailbox, having text and header information used for transmitting the text. The header information includes at least the recipient mailbox address and the author address and may include other message attributes such as subject, date, and priority level."

142.   Dr. Stubblebine concludes that the Jackson patent in combination with the cc:Mail reference discloses this element. *See* Stubblebine Report at ¶¶ 228-230. I disagree. As discussed above, the Jackson patent does not disclose email or the use of an identifier to describe a form (or an Instance of a form). And I do not agree that Dr. Stubblebine has provided any indication as to why a person of ordinary skill would combine the Jackson patent with the

cc:Mail reference, nor has he indicated how such a combination would be made. Each reference presumable identifies each form (Jackson patent) or email (cc:Mail) differently; Dr. Stubblebine has not provided any details regarding how information being passed between devices in the combined system would be routed and/or stored. Finally, he has not stated what the practical result of such a combination would be, or whether those results would be predictable. Therefore, I disagree that this element is disclosed by the combination of the Jackson patent and the cc:Mail reference, under either Motorola's or Microsoft's construction of the term "email."

(j)   Claim 1: "the reply data is reply email of the communication unit, the further data comprises a delta between the first email and the reply email, and the replica reply is a replica of the reply email"

143.   As discussed above, I understand that the term "email" is construed by Motorola to have its plain and ordinary meaning or alternatively, to mean "electronic mail." I understand that Microsoft's construction of "email" is "A message, transmitted to a mailbox, having text and header information used for transmitting the text. The header information includes at least the recipient mailbox address and the author address and may include other message attributes such as subject, date, and priority level."

144.   In his report, Dr. Stubblebine states that "Jackson discloses New Instance Data, Original Form, and the identifier of the Original Form." Stubblebine Report at ¶ 232. As stated previously, I disagree that the Jackson patent discloses either "New Instance Data" or an "identifier of the Original Form." Based in part on these improper assumptions, Dr. Stubblebine concludes that:

> [O]ne of ordinary skill in the art would understand that Jackson could be combined with cc:Mail, as described above, such that the replica reply email could be formed according to the electronic mail standard implemented by cc:Mail (i.e. RFC 822) and having the exact same email headers as the reply email. For example, the optimized reply could include information necessary to construct a reply email with the same headers as the reply email.

Stubblebine Report at ¶ 233. Although cc:Mail discloses email, including reply email, there is no disclosure in either the Jackson patent or cc:Mail of an "optimized reply" or a "replica reply," either alone or in combination. And as I stated previously, I do no believe that one of ordinary skill in the art would combine these references, nor do I believe that a combined system would provide that functionality. As stated previously, the system described in the Jackson patent was designed to distribute shared form data. Once uploaded to the server, the form could be distributed either wholesale, or updates/modifications could be distributed to users with the original form resident on their remote computers. *See, e.g.* Jackson patent, FIG. 8. There would be no need to create a "replica reply" at the server and distribute that. Indeed, the patent suggests otherwise: "It will be understood that preferably only the modifications are transferred rather than the entire form." *Id.* at Col. 10:44-45. And with respect to the cc:Mail reference, only standard reply email is disclosed – not "optimized reply" email. *See, e.g.*, [MS-MOTO_SDFLA_00000228501.] Accordingly, I disagree with Dr. Stubblebine that this claim element is disclosed by the Jackson patent in combination with the cc:Mail reference. My opinion does not change in this respect under either Microsoft's or Motorola's construction of the disputed claim terms.

> **(k)**   **Claim 15: "the system of claim 1, wherein the first email sent to the communication unit includes a textual message and is accompanied by a file attachment"**

145.   As discussed above with respect to claim 1, the parties disagree regarding the construction of the term "email."

146.   Dr. Stubblebine concludes that "[u]nder either definition of email, Jackson in combination with cc:Mail discloses this element." Stubblebine Report at ¶ 243. I disagree.

147.   Claim 15 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the

Jackson patent with the cc:Mail reference, or that the Jackson patent in combination with the cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 15.

> **(l)**   **Claim 16: "the system of claim 1, and further wherein the communication server forwards the replica reply to an outbox of the mailbox of the user associated with the communication unit"**

148.   Dr. Stubblebine concludes that this element is disclosed by "Jackson in combination with cc:Mail." Stubblebine Report at ¶ 249. I disagree.

149.   Claim 16 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the Jackson patent with the cc:Mail reference, or that the Jackson patent in combination with the cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 16.

> **(m)**   **Claim 17: "the system of claim 1, wherein the mailbox of the user includes an inbox and an outbox, and further wherein the communication server is forwarded the first data unit from the inbox of the user associated with the communication unit, and the replica reply is forwarded to the outbox of the user associated with the communication unit"**

150.   As discussed above with respect to claim 1, the parties disagree regarding the construction of the term "forwarded."

151.   Dr. Stubblebine concludes that "[u]nder Microsoft's construction of the term 'forwarded,' Jackson in combination with cc:Mail discloses this element." Stubblebine Report at ¶ 251. Dr. Stubblebine further concludes that "under Motorola's construction of the term 'forwarded,' this claim is also disclosed by Jackson in combination with cc:Mail." Stubblebine Report at ¶ 257. I disagree with both conclusions.

152.   Claim 17 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the Jackson patent with the cc:Mail reference, or that the Jackson patent in combination with the cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 17.

        (n)   **Claim 18: "the system of claim 1, wherein the replica reply is stored in the mailbox such that both the first email and the replica reply are stored in the mailbox of the user associated with the communication unit"**

153.   As discussed above with respect to claim 1, the parties disagree regarding the construction of the term "email."

154.   Dr. Stubblebine concludes that "under either definition of email, Jackson in combination with cc:Mail discloses this element." Stubblebine Report at ¶ 261. I disagree.

155.   Claim 18 depends from claim 1 of the '899 patent. Therefore, as described previously, because I do not believe that one of ordinary skill in the art would combine the Jackson patent with the cc:Mail reference, or that the Jackson patent in combination with the cc:Mail reference discloses all elements of independent claim 1, that same art cannot disclose all elements of dependent claim 18.

C.   35 U.S.C. § 112

1.   The Asserted Claims Comply With 35 U.S.C. § 112, ¶1

156.   I understand that the test for sufficiency of a written description is whether the disclosure clearly allows persons of ordinary skill in the art to recognize that the inventor invented what is claimed. The specification must describe the claimed invention with reasonable clarity such that a person of ordinary skill in the relevant art would understand that the inventor possessed the claimed invention at the time the patent application was filed.

157. I understand that to be enabling the specification should teach persons of ordinary skill in the art how to make and use the claimed invention without undue experimentation. It is also my understanding that a reasonable amount of routine experimentation required to practice a claimed invention does not preclude the specification from being enabling. It is further my understanding that the omission of minor details about the claimed invention, or the process or manner of making and using the claimed invention, does not make the specification non-enabling.

158. Dr. Stubblebine concludes that all asserted claims of the '899 patent are invalid for a lack of enablement and written description. I interpret Dr. Stubblebine's statement to be limited to a circumstance where the court finds the preamble to be a limitation and adopts Microsoft's construction. This is because under Motorola's construction, the preamble is not a limitation and the scope of the claim would be dictated by the body of the claim. And Dr. Stubblebine does not appear to opine that the '899 patent does not provide written description support for each claim limitation of the asserted claim. Moreover, it appears that Dr. Stubblebine also does not contest that the '899 patent specification does not enable a person of ordinary skill in the art to practice claims 1. I agree – the specification at, for example, Cols. 3:35-42, 11:48-61 and FIG. 9 clearly provides a description of the optimized reply of claim 1, including all of the claimed components and their functionality. Based upon at least this disclosure, I believe that under Motorola's construction, the inventors of the '899 patent were in possession of the optimized reply of claim 1 at the time of filing and that one of skill in the art could practice the claim without undue experimentation.

159. Under Microsoft's construction (which construes the preamble to mean "a system for transmitting or receiving the reply email composed on the communication unit before

optimization"), I am of the opinion that there is written description and enabling support for the invention. In my view, it was well within the knowledge of one of ordinary skill in the art to send a "normal" reply from a communication unit to a communication server. Indeed, the cc:Mail reference cited extensively by Microsoft did just that. And as stated above, there is written description and enabling support for the transmission of an optimized reply.

160. Despite this, Dr. Stubblebine appears to argue that the claim lacks written description and is not enabled because "there is no discussion of a communication unit that can send both the optimized reply and the 'normal reply.'" This makes no sense to me. In ¶ 262 of his Report, Dr. Stubblebine acknowledges that the specification of the '899 patent describes an optimized reply at Col. 3:35-42 and also describes a "normal" reply at Col. 11:48 – 12:8. According to the patent's specification, both the normal reply and the optimized reply can be sent by the same communication unit.

2. The Asserted Claims Comply With 35 U.S.C. § 112, ¶2

161. Dr. Stubblebine argues in passing that the '899 patent is invalid for indefiniteness. *See* Stubblebine Report at ¶ 5. But Dr. Stubblebine provides no further details as to which claims he believes are indefinite, nor which claim terms he believes are indefinite. Accordingly, I cannot respond to Dr. Stubblebine at this time, but reserve the right to do so should Dr. Stubblebine supplement his opinion with respect to indefiniteness.

VII. TRIAL EXHIBITS

162. I may rely on visual aids and demonstrative exhibits that demonstrate the bases for my opinions and that may assist me in explaining the bases for my opinions. These visual aids and demonstrative exhibits may include, for example, excerpts from the prior art, publications, deposition testimony and deposition exhibits, as well as charts, diagrams, videos and animated or computer-generated presentations.

163.   I have not yet prepared any exhibits for use at trial in support of the opinions expressed in this report, but I expect to do so in accordance with the Court's scheduling orders.

VIII.   SUPPLEMENTATION AND/OR AMENDMENT

164.   I reserve the right to supplement or to amend my opinions in response to opinions expressed by Microsoft's experts, or in light of any additional evidence, testimony, discovery or other information that may be provided to me after the date of this report. In addition, I expect that I may be asked to consider and testify about such issues that may be raised by the Microsoft's fact witnesses and experts at trial or in expert reports. In such case, it may be necessary for me to modify or supplement my opinions as a result of ongoing discovery or testimony at trial.

Dated: July 7, 2011

Martin Kaliski, Ph.D.

EXHIBIT A

List of Materials Considered by Martin Kaliski – '899 Patent

Expert Report of Stuart Stubblebine Regarding the Invalidity of Claims 1 and 14-18 of U.S.P.N. 5.764,899, and all exhibits and corresponding material (other than the "Third Party Bell Productions")

U.S. Patent No. 5,771,353

U.S. Patent No. 5,958,006

MOTM_24063_0014881-0015458

MOTM_24063_0015459-0016829

MOTM_24063_0017641-0017789

MOTM_24063_0017790-0017810

MOTM_24063_0022802-0024183

MOTM_24063_01863353-01864798

EXHIBIT B

CASE NO. 1:10-cv-24063-MORENO

	)
MOTOROLA MOBILITY, INC.,	)
	)
Plaintiff,	)
	)
vs.	)
	)
MICROSOFT CORPORATION,	)
	)
Defendant.	)
	)
	)

**DEFENDANT MICROSOFT CORPORATION'S DISCLOSURE OF
<u>PROPOSED CLAIM CONSTRUCTIONS</u>**

Defendant/Counter-Claimant Microsoft Corporation ("Microsoft") provides the following

proposed claim constructions for the claim limitations in the asserted patents that require

construction by the Court. The list of proposed claim constructions contained herein is based on

information reasonably available to Microsoft at this stage of the litigation. Microsoft reserves

the right to amend and supplement this list when and if additional information becomes

available. Microsoft further reserves the right to amend and supplement this list upon receipt of

Motorola's submission of the same.

Motorola Patent No. 5,764,899

Claim Term/ Identified By	Claims	Microsoft Proposed Construction	Motorola Proposed Construction
Microsoft proposed term: A system for communicating reply data with a communication unit comprising	1	The preamble is limiting. The term means "A system for transmitting or receiving the reply email composed on the communication unit before optimization."	The preamble is not limiting and should be construed according to its plain and ordinary meaning.
Microsoft proposed term: a host server, in communication with the communication server	1	The host server and the communication server are separate processing devices (e.g., computers) transmitting to or receiving from each other over a network.	A computer or a program that operates as an e-mail post office, which can exchange data with the communication server
Microsoft proposed term: email; e-mail	1, 15,18	A message, transmitted to a mailbox, having text and header information used for transmitting the text. The header information includes at least the recipient mailbox address and the author address and may include other message attributes such as subject, date, and priority level.	This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: "electronic mail"
Microsoft proposed term: "forwarding" / "forward" / "forwards" / "forwarded"	1, 14, 16, 17	Sending [send, sends, sent] from one processing device (e.g., computer) to a separate processing device (e.g., computer)	This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: "Forwarding from one computer or program to another"
Microsoft proposed term:	14	A comparison is made at the	This element requires no construction

Claim Term/ Identified By	Claims	Microsoft Proposed Construction	Motorola Proposed Construction
a determination is made whether to forward the optimized reply or a replica reply		communication server whether to forward the optimized reply or replica reply based on the known parameters of the target communication unit, such as whether the target is served by the same communication server, was an original addressee, or has deleted the original message.	and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: "the communication server decides whether to forward the optimized reply or the replica reply."