

EXHIBIT 4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: Freeman, et al.

Patent No.: 6,638,313

Filed: September 17, 1999

Title: Document Stream Operating System

REQUEST FOR EX PARTE REEXAMINATION
OF U.S. PATENT 6,638,313 UNDER
35 U.S.C. §§ 302-307 AND
37 C.F.R. § 1.510

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

REQUEST FOR *EX PARTE* REEXAMINATION OF U.S. PATENT 6,638,313

TABLE OF CONTENTS

| | |
|---|-----------|
| LIST OF EXHIBITS | 4 |
| A. PRIOR ART (PA)..... | 4 |
| B. RELEVANT PATENT MATERIALS (PAT) | 4 |
| C. CLAIM CHARTS (CC) | 4 |
| D. OTHER DOCUMENTS (OTH) | 4 |
| I. REQUIREMENTS FOR EX PARTE REEXAMINATION UNDER 37 C.F.R. § 1.510..... | 6 |
| A. 37 C.F.R. § 1.510 (B)(1) AND (B)(2): STATEMENT POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY | 6 |
| B. 37 C.F.R. § 1.510 (B)(3): COPY OF EVERY PATENT OR PRINTED PUBLICATION RELIED UPON TO PRESENT AN SNQ | 7 |
| C. 37 C.F.R. § 1.510 (B)(4): COPY OF THE ENTIRE PATENT FOR WHICH REEXAMINATION IS REQUESTED | 7 |
| D. 37 C.F.R. § 1.510 (B)(5): CERTIFICATION THAT A COPY OF THE REQUEST HAS BEEN SERVED IN ITS ENTIRETY ON THE PATENT OWNER..... | 7 |
| E. 37 C.F.R. § 1.510 (A): FEE FOR REQUESTING REEXAMINATION | 7 |
| II. RELATED CO-PENDING LITIGATION REQUIRES TREATMENT WITH SPECIAL DISPATCH AND PRIORITY OVER ALL OTHER CASES..... | 8 |
| III. RELATED REEXAMINATION PROCEEDINGS | 8 |
| IV. OVERVIEW OF THE ‘313 PATENT AND ITS PROSECUTION HISTORY . | 8 |
| A. SUMMARY OF THE DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS OF THE '313 PATENT..... | 8 |
| B. SUMMARY OF THE FILE HISTORY | 11 |
| V. CLAIM CONSTRUCTION | 12 |
| A. STANDARD..... | 12 |
| B. CLAIM TERMS..... | 13 |
| 1. MAIN STREAM..... | 14 |
| 2. SUBSTREAM | 15 |
| 3. LIVE SUBSTREAM..... | 16 |
| 4. SUBSTREAM THAT PERSISTS | 16 |

| | | |
|-------------|--|-----------|
| 5. | ASSOCIATING TIME-BASED INDICATORS WITH THE DOCUMENTS RECEIVED..... | 17 |
| 6. | AUTOMATICALLY ARCHIVING..... | 17 |
| 7. | RECEDING, FORESHORTENED STACK OF PARTLY OVERLAPPING DOCUMENTS..... | 18 |
| 8. | OPERATING SYSTEM UTILIZING SUBSYSTEMS FROM ANOTHER OPERATING SYSTEM..... | 19 |
| 9. | APPLICATION OF 35 U.S.C. § 112(6)..... | 20 |
| VI. | STATEMENT OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY | 20 |
| A. | CLAIMS 1, 2, 3, 4, 9, 10 AND 11 ARE RENDERED OBVIOUS BY MANDER IN VIEW OF RETROSPECT UNDER 35 U.S.C. § 103 | 23 |
| 1. | A PERSON OF ORDINARY SKILL IN THE ART WOULD BE MOTIVATED TO COMBINE MANDER AND RETROSPECT..... | 25 |
| 2. | CLAIM 1 | 27 |
| 3. | CLAIM 2 | 33 |
| 4. | CLAIM 3 | 34 |
| 5. | CLAIM 4 | 34 |
| 6. | CLAIM 9 | 35 |
| 7. | CLAIM 10 | 40 |
| 8. | CLAIM 11 | 40 |
| B. | CLAIMS 1 2, 3, 9, 10 AND 11 ARE RENDERED OBVIOUS BY LUCAS IN VIEW OF MAGELLAN UNDER 35 U.S.C. § 103..... | 42 |
| 1. | A PERSON OF ORDINARY SKILL IN THE ART WOULD BE MOTIVATED TO COMBINE LUCAS AND MAGELLAN | 44 |
| 2. | CLAIM 1 | 45 |
| 3. | CLAIM 2 | 50 |
| 4. | CLAIM 3 | 50 |
| 5. | CLAIM 9 | 51 |
| 6. | CLAIM 10 | 54 |
| 7. | CLAIM 11 | 55 |
| VII. | CONCLUSION | 56 |

TABLE OF EXHIBITS

LIST OF EXHIBITS

The exhibits to the present Request are arranged in four groups: prior art (“PA”), relevant patent prosecution file history, patents, and claim dependency relationships (“PAT”), claim charts (“CC”), and other (“OTH”).

A. PRIOR ART (PA)

| | |
|---------|--|
| PA-SB08 | USPTO Form SB/08 |
| PA-A | U.S. Patent No. 6,243,724 (“Mander”) |
| PA-B | Retrospect User’s Guide, version 3 first edition, Dantz Development Corp., 1989-1995. (“Retrospect”) |
| PA-C | U.S. Patent No. 5,499,330 (“Lucas”) |
| PA-D | Magellan Explorer’s Guide (1989) (“Magellan Explorer’s Guide”) |
| PA-E | Using Lotus Magellan (1989) (“Using Lotus Magellan”) |

B. RELEVANT PATENT MATERIALS (PAT)

| | |
|-------|---|
| PAT-A | U.S. Patent No. 6,638,313 (the ‘313 patent) |
| PAT-B | File Wrapper for the ‘313 Patent |
| PAT-C | File Wrapper for the ‘227 Patent |

C. CLAIM CHARTS (CC)

| | |
|------|--|
| CC-A | Claim Chart showing claims 1, 2, 3, 4, 9, 10 and 11 are rendered obvious by U.S. Patent No. 6,243,724 (“Mander”) in view of Retrospect User’s Guide (“Retrospect”) |
| CC-B | Claim Chart showing claims 1, 2, 3, 9, 10 and 11 are rendered obvious by U.S. Patent No. 5,499,330 (“Lucas”) in view of Lotus Magellan (as described in Using Lotus Magellan (“Using Lotus Magellan”) and Magellan Explorer’s Guide (“Magellan Explorer’s Guide”)) |

D. OTHER DOCUMENTS (OTH)

| | |
|-------|--|
| OTH-A | Complaint in <i>Mirror Worlds, LLC vs. Apple Inc.</i> , Civil Action No. 6:-08-CV-88 (E.D. Tex) filed March 14, 2008. |
| OTH-B | Mirror Worlds’ Disclosure of Asserted Claims and Preliminary Infringement Contention Under Patent Rule 3-1 and Disclosures Under Patent Rule 3-2 in <i>Mirror Worlds, LLC v. Apple Inc.</i> , Civil Action No. 6:-08-CV-88 (E.D. Tex) filed August 15, 2008. |

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REQUEST FOR *EX PARTE* REEXAMINATION OF U.S. PATENT 6,638,313

Dear Sir:

Third Party Requester, Apple Inc., hereby respectfully requests reexamination pursuant to 35 U.S.C. §§ 302-307, 37 C.F.R. § 1.510, of claims 1, 2, 3, 4, 9, 10 and 11 of U.S. Patent No. 6,638,313 (“the ‘313 patent”) filed September 17, 1999 and issued October 28, 2003 to Eric Freeman, et al. (Exhibit PAT-A). Reexamination is requested in view of the substantial new questions of patentability (“SNQ”) presented below. Requester reserves all rights and defenses available including, without limitation, defenses as to invalidity and unenforceability. By simply filing this Request in compliance with the Patent Rules, Requester does not represent, agree or concur that the ‘313 patent is enforceable¹ and by asserting the SNQ herein, Requester specifically asserts that claims 1, 2, 3, 4, 9, 10 and 11 of the ‘313 patent are in fact not patentable and as such the U.S. Patent and Trademark Office (the “Office”) should

¹ As alleged by Patent Owner in the below defined Underlying Litigation, and as required by 37 C.F.R. § 1.510(a), the ‘313 patent is still within its period of enforceability for reexamination purposes, to the extent that the ‘313 patent has not lapsed for failure to pay maintenance fees, has not been the subject of any Terminal Disclaimer, and has not yet been held unenforceable in a court of competent jurisdiction.

reexamine and find claims 1, 2, 3, 4, 9, 10 and 11 unpatentable and cancel claims 1, 2, 3, 4, 9, 10 and 11 of the '313 patent, rendering claims 1, 2, 3, 4, 9, 10 and 11 of the '313 patent null, void and otherwise unenforceable.

I. REQUIREMENTS FOR EX PARTE REEXAMINATION UNDER 37 C.F.R. § 1.510

Requester satisfies each requirement for *ex parte* reexamination of the '313 patent.

A. 37 C.F.R. § 1.510 (B)(1) AND (B)(2): STATEMENT POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY

A statement pointing out each substantial new question of patentability based on the cited patents and printed publication, and a detailed explanation of the pertinence and manner of applying the patents and printed publications to claims 1, 2, 3, 4, 9, 10 and 11 of the '313 patent is presented below in accordance with 37 C.F.R. § 1.510 (b)(1) and (b)(2).

1. Mander in view of Retrospect renders obvious claims 1, 2, 3, 4, 9, 10 and 11.

Requestor respectfully submits that claims 1, 2, 3, 4, 9, 10 and 11 of the '313 patent are obvious over Mander in view of Retrospect. The references were not discussed or applied either by the Examiner or the Applicants during the original prosecution and raise a substantial new question of patentability with respect to the claims of the '313 patent because the combination is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered the combination pertinent to deciding the question of patentability of the requested claims. Furthermore, Mander in view of Retrospect teaches every element of the claims, including those noted by the Examiner to be most responsible for allowance of the claims. A claim chart setting forth the pertinency and manner of applying Mander in view of Retrospect to these claims is submitted herewith as Exhibit CC-A.

2. Lucas in view of Lotus Magellan (as described in Using Lotus Magellan and Magellan Explorer's Guide) renders obvious claims 1, 2, 3, 9, 10 and 11.

Requestor respectfully submits that claims 1, 2, 3, 9, 10 and 11 of the '313 patent are obvious over Lucas in view of Lotus Magellan. The references were not discussed or applied either by the Examiner or the Applicants during the original prosecution and raise a substantial new question of patentability with respect to the claims of the '313 patent because the combination is not cumulative of any art previously of record and its teachings are such that a reasonable examiner would have considered the combination pertinent to

deciding the question of patentability of the requested claims. Furthermore, Lucas in view of Lotus Magellan teaches every element of the claims, including those noted by the Examiner to be most responsible for allowance of the claims. A claim chart setting forth the pertinency and manner of applying Mander in view of Retrospect to these claims is submitted herewith as Exhibit CC-B.

B. 37 C.F.R. § 1.510 (B)(3): COPY OF EVERY PATENT OR PRINTED PUBLICATION RELIED UPON TO PRESENT AN SNQ

A copy of every patent or printed publication relied upon to present an SNQ is submitted herein, pursuant to 37 C.F.R. §1.510(b)(3), at Exhibits PA-A through PA-E. Citation of which may be found on the accompanying Form PTO-SB/08 at Exhibit PTO-SB/08. Each of these cited prior art publications constitutes effective prior art as to the claims of the '313 patent under 35 U.S.C. § 102 and 35 U.S.C. § 103.

C. 37 C.F.R. § 1.510 (B)(4): COPY OF THE ENTIRE PATENT FOR WHICH REEXAMINATION IS REQUESTED

A full copy of the '313 patent is submitted herein at Exhibit PAT-A and its corresponding file history, including a terminal disclaimer, is submitted at PAT-B in accordance with 37 C.F.R. § 1.510(b)(4).

D. 37 C.F.R. § 1.510 (B)(5): CERTIFICATION THAT A COPY OF THE REQUEST HAS BEEN SERVED IN ITS ENTIRETY ON THE PATENT OWNER

A copy of this request has been served in its entirety on the Patent Owner in accordance with 37 C.F.R. § 1.510(b)(5) at the following address:

RICHARD S. MILNER
COOPER AND DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

E. 37 C.F.R. § 1.510 (A): FEE FOR REQUESTING REEXAMINATION

In accordance with 37 C.F.R. § 1.510(a), a credit card authorization to cover the fee for reexamination of \$2,520.00 is submitted with this request. If this authorization is missing or defective please charge the Fee to the Novak Druce and Quigg Deposit Account No. 14-1437.

II. RELATED CO-PENDING LITIGATION REQUIRES TREATMENT WITH SPECIAL DISPATCH AND PRIORITY OVER ALL OTHER CASES

The '313 patent is presently the subject of litigation, *Mirror Worlds, LLC v. Apple, Inc.*, Civil Action No. 6:08-CV-88 (E.D. Tex.), filed March 14, 2008 (“the Pending Litigation”). See Complaint filed March 14, 2008 at Exhibit OTH-A. Pursuant to 35 U.S.C. § 305, requester respectfully urges that this Request be granted and reexamination conducted not only with “**special dispatch**,” but also with “**priority over all other cases**” in accordance with MPEP § 2261, due to the ongoing nature of the underlying litigation.

III. RELATED REEXAMINATION PROCEEDINGS

Requester is concurrently submitting a request for an *ex parte* reexamination of U.S. Patent No. 6,006,227 (“the ‘227 patent”), from which the ‘313 patent claims priority. Requester is also concurrently submitting requests for *inter partes* reexaminations of U.S. Patent No. 6,725,427 (“the ‘427 Patent”) and U.S. Patent No. 6,768,999 (“the ‘999 Patent”). The ‘427 Patent is a division of the ‘313 patent. The ‘999 patent is a continuation-in-part of the ‘313 patent.

IV. OVERVIEW OF THE ‘313 PATENT AND ITS PROSECUTION HISTORY

A. SUMMARY OF THE DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS OF THE ‘313 PATENT

The ‘313 patent is generally directed to an operating system in which documents are stored in chronologically ordered “streams” instead of in the familiar hierarchical folder structure typical of many operating systems. See, e.g., ‘313 patent at Abstract; 4:9-13. This is done so that the location and nature of file storage is transparent to the user. See, e.g., ‘313 patent at Abstract; 1:26-28 (“conventional operating systems require the user to invent pointless names for files and to construction organizational hierarchies that quickly become obsolete.”). The ‘313 patent states that the operating system also allows for information to be organized as needed (instead of at the time the document is created), and for large groups of related documents to be summarized concisely for the user. ‘313 patent at Abstract. The ‘313 patent also contemplates that archiving of documents is automatic. ‘313 patent at Abstract.

The preferred embodiment of the '313 patent is a computer storage system for storing files in a "time-ordered sequence" or "stream." '313 patent at 4:9-13. Every document created by or sent to a person or entity's computer is stored in the "main stream," so that the main stream serves "as a diary of a person or entity's electronic life." '313 patent at 4:9-13. The system also utilizes substreams, which contain subsets of the documents found in the mainstream. '313 patent at 5:5-23. Documents within the main stream and substreams are organized according to when the documents were created. '313 patent at 5:57-6:11. Documents in the main stream and substreams may be sorted according to the documents' chronological indicators. '313 patent at 3:1-16; 5:57-6:11. For example, a document that is considered a working document may be associated with the "present" chronological indicator if the document is identified by a timestamp that shows the document has been worked with recently. '313 patent at 5:58-6:1. Likewise older documents may be associated with the "past" chronological indicator if they have an older timestamp, and documents with the "past" chronological indicator may also be archived. '313 patent at 5:61-64. Similarly, documents having a timestamp with a future date may be associated with the "future" chronological indicator. '313 patent at 6:3-6:11. In this way, the system of the preferred embodiment maintains a time ordered sequence of stored files.

The '313 patent also describes user interface features to be used in conjunction with the storage system described above. For example, Figure 1 shows an embodiment in which the user interface is "based on a visual representation of the stream metaphor":

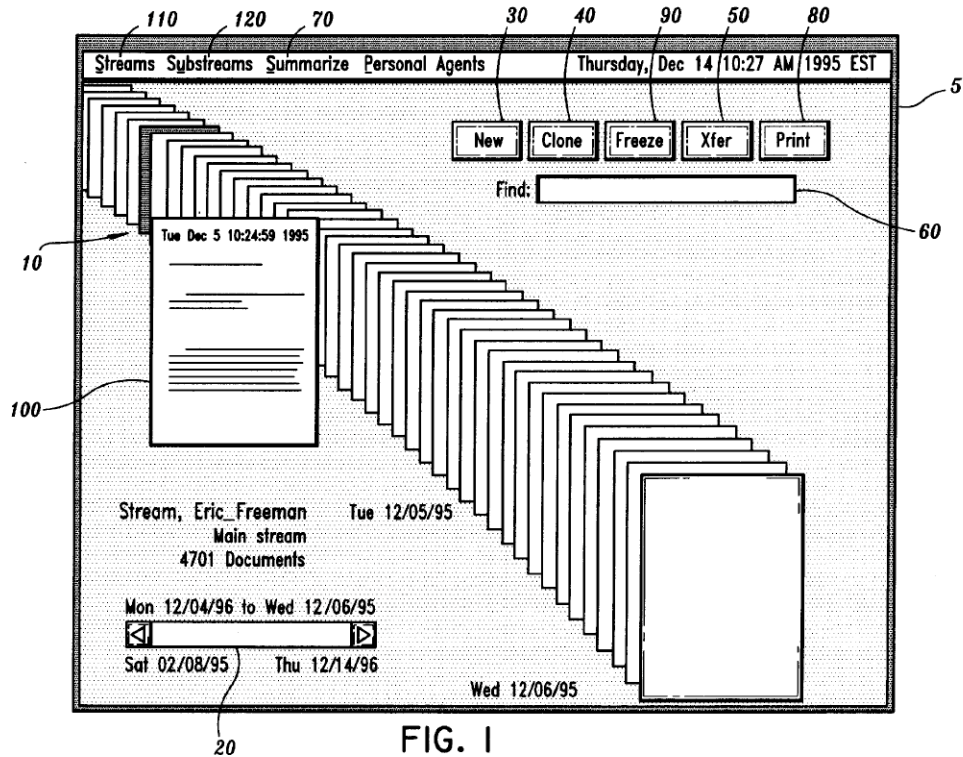


FIG. 1

The '313 patent at Figure 1, 6:35-41. In this embodiment, a receding foreshortened stack of document representations is displayed, and "users can slide the mouse pointer 10 over the document representations to 'glance' at each document by calling up the more detailed document representation labeled 100 in Fig. 1." Freeman at Figure 1, 6:30-36; 7:64-8:10.

As issued, the '313 patent has a total of 11 claims. Requester is seeking reexamination of claims 1, 2, 3, 4, 9, 10 and 11, which are being asserted by Patent Owner in co-pending litigation. Of those claims, claims 1 and 9 are independent claims and the remaining claims are dependent.

Independent claim 1 recites:

1. A method of utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system, comprising:

receiving documents from diverse applications in formats that are specific to the respective applications and differ as between at least some of said applications;

automatically associating time-based indicators with the documents received in the receiving step from the diverse applications;

automatically archiving the received documents;

automatically creating glance views that are abbreviated versions of respective ones of said documents;

selectively displaying at least some of said documents as a receding, foreshortened stack of partly overlapping documents so that only a part of each of said documents in the displayed stack, after the first document in the stack, is visible to the user;

said displaying further including displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display the glance view of the document in the stack that is currently touched by the cursor or pointer, without requiring clicking on the document; and

utilizing, in said document stream operating system, subsystems from said at least one other operating system for operations including writing documents to storage media, interrupt handling and input/output.

Independent claim 9 recites:

9. A method of automatically archiving documents received from diverse applications in different formats such that the archived documents can be searched for documents meeting selected criteria, comprising:

receiving documents from diverse applications in formats that are specific to the respective applications and differ as between at least some of said applications;

automatically associating time-based indicators with the documents received in the receiving step from the diverse applications;

automatically archiving the received documents together with said time-based indicators;

selectively displaying at least some of said documents as a receding, foreshortened stack of partly overlapping documents so that only a part of each of said documents in the displayed stack, after the first document in the stack, is visible to the user; and

said displaying further including displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display a glance view of the document in the stack that is currently touched by the cursor or pointer, wherein said glance view is an abbreviated version of the documents.

B. SUMMARY OF THE FILE HISTORY

The '313 patent is a continuation of U.S. Patent 6,006,227. The application that led the '313 patent was filed on 9/17/1999 and was assigned to an Examiner different from than

the one who had examined the application that led to the ‘227 patent. Unlike the ‘227 patent, the ‘313 patent was allowed after very brief examination.

The first and only Office Action was based on a double patenting rejection. PAT-B, Pros. His., paper 5, Office Action, 1/3/2003, pp. 2-6. In response, the applicant filed a terminal disclaimer and made minor amendments to the specification requested in the first Office Action. PAT-B, Pros. His., paper 6, Amendment, 1/29/2003, p. 2, paper 7, Terminal Disclaimer, 1/29/2003. Prior to any further formal action being taken by the Examiner, the applicant fax-filed a further Amendment. This Amendment cancelled two claims and made minor amendments to remove trademarked terms from two others, and was made without any remarks except the statement that “the application should now be in condition for allowance.” PAT-B, Pros. His., paper 8, Amendment, 4/7/2003, p. 2.

The Examiner then issued a Notice of Allowance, apparently in response to the filing of the terminal disclaimer and/or the removal of the trademarked terms from the claims. PAT-B, Pros. His., paper 7, Terminal Disclaimer, filed 1/28/03; paper 9, Notice of Allowability, mailed 4/7/03.

After allowance, the applicant filed an Information Disclosure Statement disclosing the Mander reference to the Patent Office for the first time. PAT-B, Pros. His., paper 11, Information Disclosure Statement, 6/21/2003. In response, the Examiner initialed the reference on the IDS and issued a supplemental Notice of Allowance without any comment. PAT-B, Pros. His., paper 12, Supplemental Notice of Allowability, 1/29/2003.

V. CLAIM CONSTRUCTION

A. STANDARD

Requester notes that the ‘313 patent, for which reexamination is requested, is asserted in *Mirror Worlds, LLC v. Apple Inc.*, Civil Action No. 6:-08-CV-88 (E.D. Tex). For purposes of this Request, the claim terms are presented by the Requester in accordance with 37 C.F.R § 1.555(b) and MPEP § 2111. Specifically, each term of the claims is to be given its “broadest reasonable construction” consistent with the specification. MPEP § 2111; *In re Trans Texas Holding Corp.*, No. 2006-1599, -1600, p.14 (Fed. Cir. August 22, 2007) (citing *In re Yamamoto*, 227 F.2d 1569, 1571 (Fed. Cir. 1984)). As the Federal Circuit noted in *Trans Texas*, the Office has traditionally applied this standard during reexamination and does not interpret claims as a court would interpret claims. MPEP §

2111. The Office is not bound by any prior district court claim construction. *Trans Texas*, No.2006-1599 at 14, 19. Rather:

the PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.

In re Morris, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997). The rationale underlying the "broadest reasonable construction" standard is that it reduces the possibility that a claim, after issue or certificate of reexamination, will be interpreted more broadly than is justified. 37 C.F.R § 1.555(b), MPEP § 2111.

Because the standards of claim interpretation used in the courts in patent litigation are different from the claim interpretation standards used in the Office in claim examination proceedings (including reexamination), any claim interpretations submitted herein for the purpose of demonstrating an SNQ are neither binding upon litigants in any litigation related to the '313 patent nor do such claim interpretations necessarily correspond to the construction of claims under the legal standards that are mandated to be used by the courts in litigation. *See* 35 U.S.C. § 314; *see also* MPEP § 2286 II (determination of an SNQ is made independently of a court's decision on validity because of different standards of proof and claim interpretation employed by the District Courts and the Office); *see also In re Trans Texas Holding Corp.*, No. 2006-1599, -1600, p.14 (Fed. Cir. August 22, 2007); *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Accordingly, the interpretation and/or construction of the claims in the '313 patent presented either implicitly or explicitly herein should not be viewed as constituting, in whole or in part, Requester's own interpretation and/or construction of such claims, but instead, should be viewed as constituting an interpretation and/or construction of such claims that is consistent with the broadest reasonable construction of the claim language and/or with Patent Owner's own view of the claims in the co-pending litigation. In fact, Requester expressly reserves the right to present its own interpretation of such claims at a later time, which interpretation may differ, in whole or in part, from that presented herein.

B. CLAIM TERMS

In considering the patentability of the claims of the '313 patent, the Requester has applied certain claim constructions presented by the Patent Owner during prosecution of the

'313 patent and on claim constructions derived from statements which indicate the Patent Owner's interpretation of the claim terms as a basis for its allegations of infringement in the co-pending litigation. *See* Mirror Worlds' Disclosure of Asserted Claims and Preliminary Infringement Contention Under Patent Rule 3-1 and Disclosures Under Patent Rule 3-2 in *Mirror Worlds, LLC v. Apple Inc.*, Civil Action No. 6:-08-CV-88 (E.D. Tex) filed August 15, 2008, OTH-B.

Requester presents these constructions for the convenience of the Office and does not agree that these interpretations are in fact the broadest reasonable interpretation of the presented terms. However, because they reflect Patent Owner's views as to the scope of the claims – including as Patent Owner seeks to enforce those claims in litigation – Requester submits the claim terms presented below should be construed no narrower than presented herein for purposes of this proceeding.

1. MAIN STREAM

During prosecution of the '227 patent, from which the '313 patent claims priority, the Patent Owner explained that “[a] ‘main stream’ is a type of stream which receives every data unit,” or “document,” “received by (external) or generated by (internal) the computer system.” PAT-C, Pros. His., paper 18, Response to Non-Final Rejection, 5/7/99, p.11. Patent Owner also explained that this data unit, or document, “must be included in the main stream.” PAT-C, Pros. His., paper 18, Amendment Under 37 C.F.R. § 1.115 In Response to November 3, 1998 Office Action, 5/3/99, p.16; *see also* '313 Patent at 4:11-13.

In the concurrent litigation, however, Patent Owner has accused products of having a “main stream” if the products include an index of files on a computer. Specifically, Patent Owner accuses Requester's product SPOTLIGHT of having a “main stream” because SPOTLIGHT “indexes your hard drive.” OTH-B, Attachment C-1, p. 50 (citing Attachment A-1, pg. 3, 6-7). Patent Owner further notes that “[t]he Spotlight Store is a file system-level database that holds all of the meta-data attributes about the files, as well as an index of their contents, on a file system. As each file is created, copied, updated, or deleted, Spotlight will ensure that both the content index and the meta-data store entries for that file are updated.” OTH-B, Attachment C-1, p. 50 (citing Attachment A-1, pg. 3, 6-7).

As demonstrated by its own application of the “main stream” limitation, Patent Owner believes that the broadest reasonable construction of “main stream” would encompass either a collection of documents or a collection of information about documents,

such as an index. As will be established by the arguments presented below, applying this broadest reasonable construction of the “main stream” limitation, main streams were well known in the art at the time of Patent Owner’s alleged invention.

2. SUBSTREAM

Likewise, the nature and character of what can be considered a “substream” is dependent on the nature and character of the “main stream.” During prosecution of the ‘227 patent, Patent Owner argued that “[a] ‘substream’ is a type of stream having one or more data units only from the main stream.” PAT-C, Pros. His., paper 18, Response to Non-Final Rejection, 5/7/99, p. 11. Patent Owner also took the position that that substreams “allow a user to determine the data units of direct interest while also maintaining the data unit in the main stream of the computer system.” PAT-C, Pros. His., paper 18, Amendment Under 37 C.F.R. § 1.115 In Response to November 3, 1998 Office Action, 6/3/99, p. 16-17.

On the other hand, in the concurrent litigation, Patent Owner has accused products of having a “substream” if the accused product enables a query of an index, produces search results, or organizes files by content and/or attributes. OTH-B, Attachment C-1, p. 50 (citing Attachment A-1, pg. 3, 7). For instance, Patent Owner alleges that SPOTLIGHT includes a “substream” because SPOTLIGHT “constructs the appropriate query expression for the search, specifies the scope of the search, how the data is to be grouped when it is returned, and then executes the query.” OTH-B, Attachment A-1, pg. 3. Patent Owner also argues that because you can “use Spotlight to search for items on your computer,” SPOTLIGHT contains a substream. OTH-B, Attachment A-1, pg. 4. Furthermore, according to Patent Owner, because Smart Folders, a feature of SPOTLIGHT, “can organize files by their contents, as well by attributes that describe those contents and how they were created,” Smart Folders must also include a substream. OTH-B, Attachment A-1, pg. 4. In other words, a query of an index, search results, and files organized by content and/or attributes is a subset of the contents of the index, which Patent Owner maintains is a main stream in the concurrent litigation, and thus constitutes a “substream.”

As demonstrated by its own application of the “substream” limitation, Patent Owner believes that the broadest reasonable construction of “substream” would encompass either a subset of a collection of documents, or a subset of the contents of an index, such as a search query of an index, search results, a Smart Folder, or a list of files organized by content and/or attributes.. As will be established by the arguments presented below, applying this

broadest reasonable construction of the “substream” limitation, substreams were well known in the art at the time of Patent Owner’s alleged invention.

3. LIVE SUBSTREAM

“Substreams” may be “live” or “dynamically updated by the addition of new data units,” as argued by Patent Owner during prosecution. PAT-C, Pros. His., paper 18, Response to Non-Final Rejection, 5/7/99, p. 11. As argued by Patent Owner in the concurrent litigation, live substreams occur where a “folder is updated automatically as you change, add, and remove files.” OTH-B, Attachment C-1, p. 51 (citing Attachment A-1, pg. 7-8). Patent Owner additionally alleges that the accused products include a “live substream” if they can “help you organize and access information on your computer.” OTH-B, Attachment C-1, p. 51 (citing Attachment A-1, pg. 7-8).

As demonstrated by its own application of the “live substream” limitation, Patent Owner believes that the broadest reasonable construction of “live substream” would include saved searches or Smart Folders that dynamically collect new documents that meet certain criteria as they are added to the main stream. As will be established by the arguments presented below, applying this broadest reasonable construction of the “live substream” limitation, live substreams, including at least automatically updated file maintenance systems, were well known in the art at the time of Patent Owner’s alleged invention.

4. SUBSTREAM THAT PERSISTS

“Substreams” may persist unless selectively destroyed by a user. As argued by Patent Owner in the concurrent litigation, “substreams that persist” occur where a “folder is updated automatically as you change, add, and remove files.” OTH-B, Attachment C-1, p. 51 (citing Attachment A-1, pg. 7-8). Patent Owner additionally alleges that the accused products include a “substream that persists” if they can “help you organize and access information on your computer.” OTH-B, Attachment A-1, pg. 8. Patent Owner further alleges that “a user may delete a saved search or Smart Folder.”

As demonstrated by its own application of the “substream that persists” limitation, Patent Owner believes that the broadest reasonable construction of “substream that persists” would include dynamically updating the stream. As will be established by the arguments presented below, applying this broadest reasonable construction of the “substream that persists” limitation, persistent streams, including at least saved searches, Smart Folders and automatically updated file maintenance systems, were well known in the art at the time of

Patent Owner's alleged invention.

5. ASSOCIATING TIME-BASED INDICATORS WITH THE DOCUMENTS RECEIVED

In the concurrent litigation, Patent Owner alleges that the “time-based indicators” claimed in the ‘313 patent correspond to the “timestamp to identify” limitation of the ‘227 patent. OTH-B, Attachment C-1, p. 49 (citing Attachment B-1, pg. 29 (citing Attachment A-1, p. 6)).

During prosecution of the ‘227 patent, Patent Owner stated that “[a] ‘timestamp’ is a date/time used to uniquely identify each data unit.” PAT-C, Pros. His., paper 18, Response to Non-Final Rejection, 5/7/99, p. 11. In the concurrent litigation, Patent Owner argues that the accused products include a timestamp because an MDItem object in Requester’s product SPOTLIGHT “contains a dictionary of the various meta-data attributes of that file organized as unique keys, *which includes timestamp information.*” OTH-B, Attachment A-1, pg. 6 (emphasis added).

As demonstrated by its own application of the limitation of “time-based indicators,” Patent Owner believes that the broadest reasonable construction of “associating time-based indicators with the documents received” includes using a date/time to uniquely identify each data unit *or* indexing that data unit using an object containing meta-data attributes which include timestamp information. As will be established by the arguments presented below, applying this broadest reasonable construction, this limitation was well known in the art at the time of Patent Owner’s alleged invention.

6. AUTOMATICALLY ARCHIVING

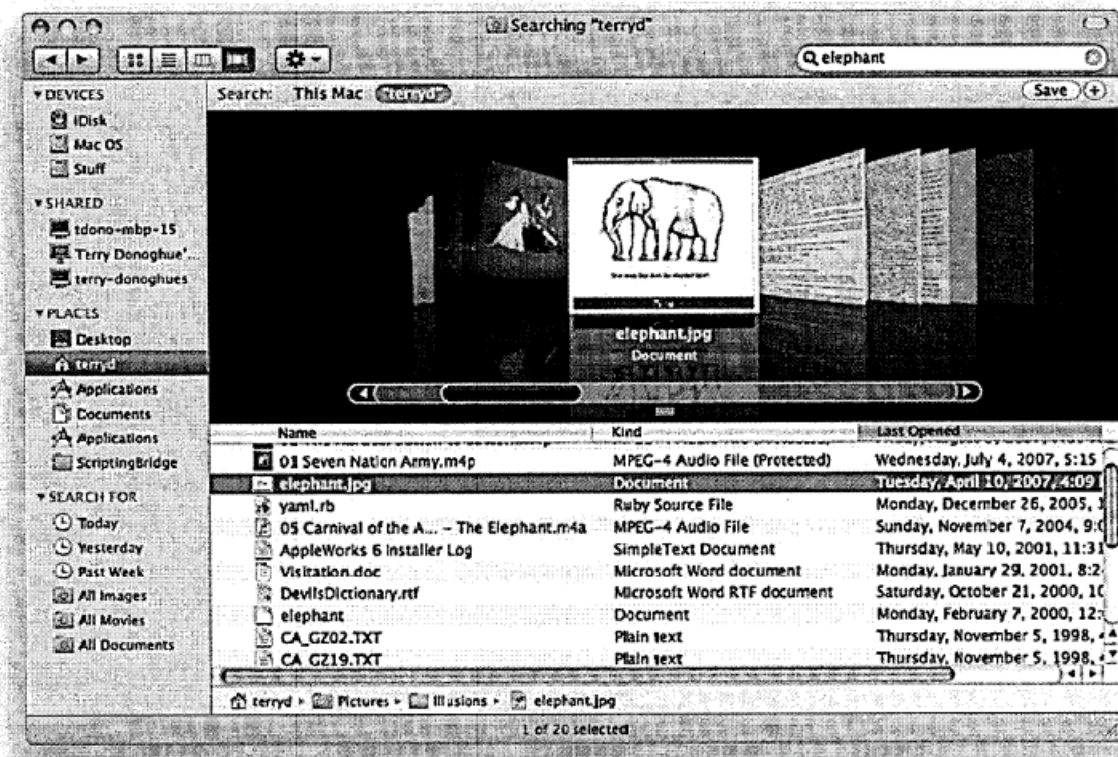
In the concurrent litigation, Patent Owner has construed “automatically archiving the received documents” as archival and back-up systems. For instance, in the concurrent litigation, Patent Owner has alleged that Requester’s product TIME MACHINE includes automatic archiving because “Time Machine is an application that automatically and transparently backs up the user’s files to a designated storage system.” OTH-B, Attachment C-1, p. 49 (citing Attachment B-1, pg. 29). Patent Owner further alleges that Requester’s product TIME MACHINE includes automatic archiving because “Time Machine is a breakthrough automatic backup” that “keeps an up-to-date copy of everything on your Mac.” OTH-B, Attachment C-1, p. 49 (citing Attachment B-1, pg. 29).

As demonstrated by its own application of “automatically archiving the received

documents,” Patent Owner does not distinguish between archiving and backup, and believes that the broadest reasonable construction of this limitation includes both archival and back-up. As will be established by the arguments presented below, applying this broadest reasonable construction of the “automatically archiving the received documents” limitation, this limitation was well known in the art at the time of Patent Owner’s alleged invention.

7. RECEDING, FORESHORTENED STACK OF PARTLY OVERLAPPING DOCUMENTS

In the concurrent litigation, Patent Owner has alleged that Requester’s product COVER FLOW includes a “receding, foreshortened stack of partly overlapping documents” because it includes the interface depicted below:



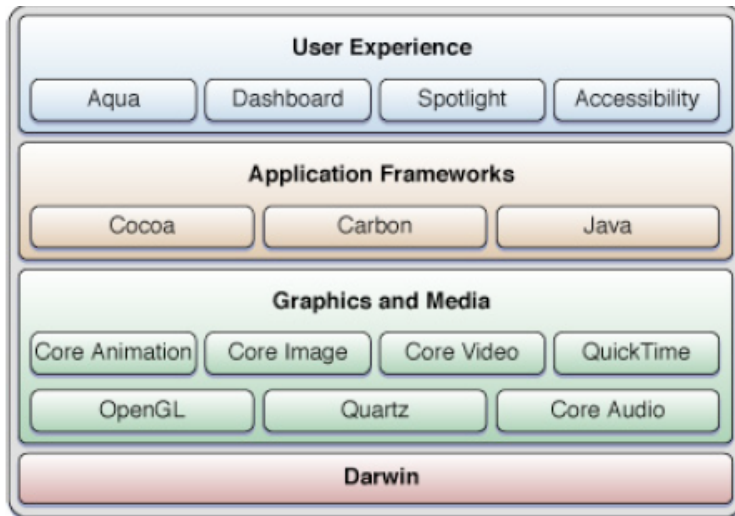
OTH-B, Attachment C-1, p. 50 (citing Attachment B-1, pg. 30 (citing Exhibit 25 as “displaying Cover Flow interface in which selected document representations are displayed as a receding, overlapping, foreshortened stack”).

As demonstrated by its own application of “receding, foreshortened stack of partly overlapping documents,” Patent Owner believes that the broadest reasonable construction of this limitation includes a three-dimensional representation of partly-overlapping icons of the same size. As will be established by the arguments presented below, applying this broadest reasonable construction, this limitation was well known in the art at the time of Patent

Owner’s alleged invention.

8. OPERATING SYSTEM UTILIZING SUBSYSTEMS FROM ANOTHER OPERATING SYSTEM

In the concurrent litigation, Patent Owner has construed the “utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system” and “utilizing, in said document stream operating system, subsystems from said at least one other operating system for operations including writing documents to storage media, interrupt handling and input/output” limitations as covering a computer system with multiple software layers, where the higher layers provide the user experience and the lower layers provide underlying functionality. For instance, in the concurrent litigation, Patent Owner has alleged that Requester’s product MAC OS X VERSION 10.5 LEOPARD meets the two operating systems requirements because it is a single operating system that includes multiple layers, including a core environment layer based in UNIX and a User Experience Layer:



OTH-B, Attachment C-1, p. 49-50 (citing Attachment B-1, pg. 27-29).

As demonstrated by its own application of “utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system” and “utilizing, in said document stream operating system, subsystems from said at least one other operating system for operations including writing documents to storage media, interrupt handling and input/output,” Patent Owner believes that the broadest reasonable construction of these limitations includes the use of a computer system with multiple software layers, including layers for core services and for user experience. As will be established by the arguments presented below, applying this broadest reasonable

construction, these limitations were well known in the art at the time of Patent Owner's alleged invention.

9. APPLICATION OF 35 U.S.C. § 112(6)

Patent Owner has taken the position in litigation that none of the claim limitations are means-plus-function limitations limited to their corresponding structure (or equivalents) under 35 U.S.C. § 112(6). Under the Patent Local Rules governing the underlying litigation, Patent Owner was required to identify in its Infringement Contentions "each element that [a party claiming patent infringement] contends is governed by 35 U.S.C. § 112(6)." E.D.T.X Patent Local Rule 3-1(c). Patent Owner did not identify any claim limitation as being governed by § 112(6). OTH-B, Attachment C-1. This demonstrates that Patent Owner believes that the broadest reasonable construction of the many "means" limitations is one where those limitations are treated as ordinary limitations, and are not limited to any corresponding structure.²

Accordingly, while Third Party Requester believes that many of the limitations in the '313 patent should be governed by 35 U.S.C. § 112(6), this Request applies the Patent Owner's position that the broadest reasonable constructions of the various "means for" elements are not limited by that section. Nonetheless, as shown in the discussion that follows, the prior art described in this request includes computer structure (algorithms and/or computer hardware) that performs the claimed functions.

VI. STATEMENT OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

The '313 patent is a continuation of U.S. Patent 6,006,227, and its allowance was conditioned on the filing of a terminal disclaimer. In view of the similarity of the subject

² Patent Owner's position reflects the near-total absence of structure in the specification. The specification states that one of its embodiments is "a computer program for organizing one or more data units" that can perform various functions, but it does not identify any specific algorithms or computer hardware. *See Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253-54 (Fed. Cir. 2005) ("WMS Gaming restricts computer-implemented means-plus-function terms to the algorithm disclosed in the specification") *citing WMS Gaming, Inc. v. Intern. Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999). For example, the '313 patent does not provide any structure for implementing a "main stream." While it describes a "main stream" functionally as "a time-ordered sequence" of "every document created by or sent to a person or entity's computer," it does not describe any algorithm and/or computer hardware that performs this function. '313 patent at 4:9-34. Similarly, while the '313 specification provides functional description of a "means for including each data unit according to the timestamp in the respective chronological indicator in the main stream," it does not describe any algorithm and/or computer hardware that performs this function. '313 patent at 3:1-3:36.

matter between the two patents, Requester notes that it is concurrently submitting a request for an *ex parte* reexamination of the '227 patent.

As noted above, the application that led the '313 patent was assigned to an Examiner different from than the one who had examined the '227 patent, and unlike the '227 patent, the '313 patent was allowed after a brief examination. There was no discussion during prosecution of any of the references that were central to the examination of the '227 patent. For example, the prosecution of the '313 patent included no mention of the 1994 Washington Post article by David Gelernter, entitled "The Cyber-Road Not Taken" (the "Gelernter Article"), despite the fact that the previous Examiner found that the application's concept of organizing a computer system around a "stream" of documents that serves "as a diary of a person or an entity's electronic life"—what the Examiner referred to as the "paradigm of 'lifestreams'"—had been described in the prior art Gelernter Article. '227 patent at 4:8-10; PAT-C, Pros. His., paper 4, Office Action dated 9/19/97, p.2 and p.3. Nor was their any discussion of the other art deemed significant by the previous examiner, including U.S. Patent No. 5,649,182 to Reitz, which the previous examiner recognized in his Notice of Allowability as disclosing a system that organized documents into a main stream according to timestamps,³ and that filtered or searched this main steam in order to generate substreams having particular attributes.⁴ PAT-C, Pros. His., paper 19, Notice of Allowability, 5/18/99 ("In particular, Reitz provides for the generation of subsets of the main stream of records organized by the timestamps and determined by attributes, which subsets correspond to persistent substreams").⁵

Instead, the first and only Office Action was based on a double patenting rejection. PAT-B, Pros. His., paper 5, Office Action, 1/3/2003, pp. 2-6. A terminal disclaimer was filed, and the Examiner then issued a Notice of Allowability. PAT-B, Pros. His., paper 7, Terminal Disclaimer, filed 1/28/03; paper 9, Notice of Allowability, mailed 4/7/03. The Notice of Allowability contains the Examiner's only discussion of the prior art, where the

³ See e.g. U.S. Patent No. 5,649,182 ("Reitz") at 1:47-52 (prior art describing "a processor operable to automatically organize the database records in a timeline sequence according to the calendar date associated with each of the database records").

⁴ See e.g. U.S. Patent No. 5,649,182 ("Reitz") at 2:30-35 ("selecting any number of filtering criteria such that only data messages having filtering identifiers in common with the selected filtering criteria are formed into a data message subset, and such that each of the data entries in the subset is sequentially organized by its associated calendar date.")

⁵ To be clear, Requestor is not asserting that these references raise a substantial new question of patentability in this Request.

Examiner states that the “closest prior art” is “U.S. Patent Number 6,523,048 to DeStefano.” PAT-B, Pros. His., paper 19, Notice of Allowability, 5/18/99, p. 2. The Examiner goes on to state that this reference “fails to disclose automatically associating time-based indicators with the documents,” and that it “does not disclose an operating system in which the location and nature of file storage is transparent to the user, for example, the storage of files is handled automatically and file name [*sic*] are only used if a user chooses to invent such names.” PAT-B, Pros. His., paper 19, Notice of Allowability, 5/18/99, p. 2.

However, both of the features the ‘313 Examiner notes as missing from the prior art were found by the ‘227 Examiner to be present in the prior art, particularly the Gelernter Article and Reitz. *See e.g.* Gelernter Article at C2 (“Nor do I want to organize my computer documents into files, nor be obliged to make up silly names every time I create documents ... In short, I want a ‘lifestream.’”)

Moreover, even putting that aside, what the Examiner saw as allowable in the ‘313 patent—associating time-based indicators with documents, and a file system where the location and nature of file storage could be made transparent to the user (so that documents could be accessed through a more intuitive user interface such as content or date based searching)—is clearly disclosed in the prior art that forms the basis of this request. For example, the Mander reference describes a graphical user interface based on “piles” of documents intended to solve problems of the traditional name and folder structure hierarchical filing mechanisms. *See* Mander at 1:66-2:60 (describing problems with traditional hierarchical filing systems). Mander’s graphically-represented “piles” of documents can be defined based on criteria, e.g. a pile of documents that are “from Richard Mander,” a pile of documents that are “dated April 19, 1991,” and a pile of documents containing certain text. Mander at 22:34-46 and 23:48-50. These piles can be generated and then updated automatically. Mander at 27:53-28:8; 35:14-17. Mander discloses that is done by generating an index of each document received or generated by the system. Mander at 5:42-6:4, 25:21-37, Fig. 15. This index can then be searched in order to generate the piles of documents that match the user-selected criteria. Mander at 24:4-26:65 (describing indexing process); *see also* Mander at 27:41-33:24 (describing subpiling processes and algorithms). Mander also discloses that each file has an associated timestamp and can be identified by sort and search algorithms based on that timestamp. *See e.g.*

Mander at 33:34-43. In short, Mander discloses both the time-based indicators and location-transparent file storage aspects of the '313 patent that the Examiner saw as rendering it allowable. As explained in more detail below, other prior art references cited herein do as well.

Claims 1, 2, 3, 4, 9, 10 and 11 of the '313 patent are rendered obvious under 35 U.S.C. § 103 by several different prior art references cited herein, which were not previously considered by the Examiner during the examination of the '313 patent application or which are discussed in a new light from the original prosecution of the '313 patent application. Claims 1, 2, 3, 4, 9, 10 and 11 of the '313 patent are set forth in detail in the attached claim charts (Exhibits CC-A and CC-B) that compares the limitations of the claims of the '313 patent to the pertinent prior art references. As the claim chart demonstrates, claims 1, 2, 3, 4, 9, 10 and 11 are unpatentable under 35 U.S.C. § 103 in view of the prior art references under any reasonable interpretation of the claims.

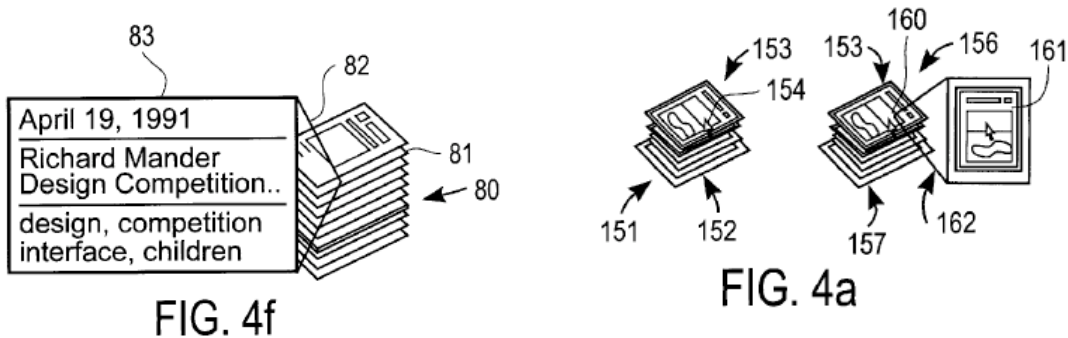
A. CLAIMS 1, 2, 3, 4, 9, 10 AND 11 ARE RENDERED OBVIOUS BY MANDER IN VIEW OF RETROSPECT UNDER 35 U.S.C. § 103

Mander was filed August 8, 1994 as a continuation of application No. 07/876,921 (filed on April 30, 1992) and published June 5, 2001. Therefore, Mander is prior art under 35 U.S.C. §102 and is asserted under 35 U.S.C. § 103. Although Mander was before the Examiner during the prosecution of the '313 patent, it was not applied. See PAT-B, paper 11, I.D.S., 6/27/03. Here, Mander is discussed in a new light from the original prosecution of the '313 patent application.

Mander discloses a system that indexes all files along with any metadata, and associates these files with folders called "piles." Mander at Fig. 15. Specifically, Mander discloses a system that organizes data units that are received by a computer system (e.g., electronic mail documents) or generated by a computer system (e.g., word processing documents). Mander at Abstract, 2:63-66, and 24:8-18. Each data unit in the system is stored in a filing system which includes indexed data information and the data units are placed into piles that may be further organized into one or more subpiles. Mander at 5:42 to 6:4, 25:21-37. The index stores information about the file that is useful in categorizing the file into a "pile" such as the frequency of each word's occurrence in a file. Mander at 24:34-42.

Just as in the '227 patent, each file is associated with a timestamp which is either selected by the system or by the user, and recorded in a date line field of the document or are recorded by the file system. Mander at 33:34-43. Documents may further be sorted into categories based on date. Mander at 23:39-51 and 33:35-36. One example of such a category is a label categorizing the documents in a pile. Mander discloses that piles are described by scripts and may be controlled by labels. The labels are existing controls or criteria that may be selected, and upon selection, control the functioning of a pile. Mander at 23:39-51; 33:35-36. For example, a user may choose to include only files created after a certain date. Mander at 22:34-46 and 23:48-50. Another example of a category based on date is a color coding scheme. Each data unit timestamped with an older date may be colored blue, while each data unit timestamped with a new date may be a brighter color. Mander at 33:42-62 (“the user selects the command ‘color by date’ . . .”). Another example is creating a pile based on date. Mander at 22:43-47 (“of the user selects the option of collecting items which are dated April 19, 1991 . . .”).

Mander also discloses a variety of visualization options for piles and the documents within them. Specifically, Mander discloses document views called “proxies.” Mander at 3:21-25. The proxies can be any number of different forms including a miniature representation of the document itself which can be paged through, or can be a sampling of the information in the document. See Mander at Fig. 4 for several different embodiments.



Mander is capable of seamless operation with an operating system, such as an Apple operating system. Mander at 36:56-37:4. Mander will utilize certain programs of the operating system to perform some of its functions. Mander is also capable of service in a networked environment. Mander at 8:14-16. Mander may be present on a client computer and rely on a network email server’s email program to generate email documents to be received and indexed by Mander. Mander at 8:22-24.

In short, Mander discloses the essential concepts (and more) of the '313 Patent – organizing and displaying documents in a computer system according to timestamps and/or pre-assigned chronological labels, and for automatically organizing new documents. Indeed, Mander anticipates, or at a minimum, renders obvious each of claims 1-4 and 9-11. A detailed application of the prior art to each element of the requested claims is presented in Exhibit CC-A and below.⁶

For purposes of this Request, Mander is analyzed in view of Retrospect. Retrospect is the name of commercial Macintosh software for automatic backup of files that was widely distributed in the 1990s. The 1995 Retrospect Users's Guide ("Retrospect") is a printed publication that is prior art under 35 U.S.C. §102(a) and (b) and is asserted under 35 U.S.C. § 103. Retrospect was not before the Examiner during the prosecution of the '227 patent.

**1. A PERSON OF ORDINARY SKILL IN THE ART WOULD BE
MOTIVATED TO COMBINE MANDER AND RETROSPECT**

Both Mander and Retrospect were designed to work with the Macintosh computers of the 1990s, and one of ordinary skill would be motivated to combine the file organization and user interface of Mander and the archiving functionality of Retrospect for several reasons.

**(a) COMBINING PRIOR ART ELEMENTS ACCORDING TO
KNOWN METHODS TO YIELD PREDICTABLE RESULTS**

MPEP § 2141.III states that "[e]xemplary rationales that may support a conclusion of obviousness include ... (A) Combining prior art elements according to known methods to yield predictable results." The combination of the prior art Macintosh file system in Mander in combination with prior art archiving software would have been obvious under this rationale. Retrospect was specifically designed to perform backups for Macintosh systems, and the entire manual describes how this is done. Retrospect at p. v ("Introducing Retrospect"), p. 3 ("Retrospect requires System 7.0 or later Apple System software"). Thus, application of Retrospect to perform backups of a Macintosh file system was a known prior art method with known results.

⁶ Although Requester has detailed the bases for invalidity of the identified claims of the '227 patent herein, Requester has also included additional citations to the disclosure in Mander in Exhibit CC-A to assist the Office.

Similarly, Mander was designed to work on a Macintosh computer's file system. Mander at 6:27-29 ("In the preferred embodiment of the present invention, the file system operates on a Macintosh computer of Apple Computer, Inc."). Thus, combining Retrospect with Mander's preferred embodiment would be a combination of prior art elements according to the known methods of using Retrospect with a Macintosh computer's file system. The result of the combination of Retrospect's backup techniques with the Macintosh file system would yield predictable results that are described in the Retrospect reference, including that the archival method of backup employed by Retrospect ensures that backed up files are not deleted or written over until instructed by the user. Retrospect at p. v.

(b) SUBSTITUTION OF ONE KNOWN ELEMENT FOR ANOTHER

One of ordinary skill in the art would be motivated to combine Mander with Retrospect as a substitution of one known element for another to obtain a predictable result. MPEP § 2141.III states that "[e]xemplary rationales that may support a conclusion of obviousness include ... (B) Simple substitution of one known element for another to obtain predictable results." The automatic archival backup method of Retrospect is a compatible alternative to the manual back-up of files that would be required in Mander. Indeed, there are predictable positive results associated with substituting an automatic archival backup for a manual backup, such as back up that does not require that the user attend the computer during the backup and that the archival method of back up ensures that backed up files are not deleted or written over until instructed by the user. Retrospect at p. v. Accordingly, one skilled in the art would be motivated to substitute the known automatic archival backup method of Retrospect for the known manual back-up method required in a system using Mander to obtain the predictable result of automated backups that ensure that files are maintained until the user elects to write over or delete them.

(c) USE OF KNOWN TECHNIQUE TO IMPROVE SIMILAR METHODS IN THE SAME WAY

MPEP § 2141.III states that "[e]xemplary rationales that may support a conclusion of obviousness include ... (C) Use of known technique to improve similar devices (methods, or products) in the same way." Once again, one of ordinary skill in the art would be motivated to use the known technique of Retrospect's automatic archival backup for the

Macintosh operating system with the similar system disclosed in Mander, in the same way. Design incentives would have prompted such a combination because it was well known that being able archive documents for later retrieval was desirable such as for backup/restore purposes, and also because it was well known that it was desirable to free expensive and scarce disk or memory space by archiving older files.

**(d) APPLYING A KNOWN TECHNIQUE TO A KNOWN DEVICE
READY FOR IMPROVEMENT**

MPEP § 2141.III states that “[e]xemplary rationales that may support a conclusion of obviousness include ... (D) Applying a known technique to a known device (method or product) ready for improvement to yield predictable results.” For the same reasons as above, one of ordinary skill in the art would be motivated to use the known technique of Retrospect’s automatic archival backup for the Macintosh operating system with the similar system disclosed in Mander. This is particularly true because Mander does not expressly disclose a method of archival or backup and would thus be ready for improvement. For example, with the ability to archive documents, users of the Mander system could keep seldom-used files at the same time as local hard drive or memory space is freed up; furthermore, reliability of the system described in Mander could be increased because archived documents can be retrieved in the event of a crash or failure.

In sum, based on the similarities between the two systems and the well-known nature of archiving systems at the time the ‘313 patent was filed, a person of ordinary skill in the art would have considered it obvious to implement the Mander system with the archiving methods disclosed in Retrospect.

2. CLAIM 1

1. A method of utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system, comprising:

As discussed above Section V.B (Claim Construction), the Patent Owner’s own application of “utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system” in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes the use of a computer system with multiple software layers, including layers for core services and for

user experience. Applying this broadest reasonable construction, Mander discloses an operating system that utilizes programs from other operating systems. Specifically, Mander discloses that the Piles invention can be used in conjunction with the Apple Operating System, including for example its file system. Mander at 24:8-18; 8:13-28; 15:34-60. Mander also contemplates that its document organizing operating system can utilize the Apple Operating System's Finder program to perform certain user experience functions, such as "standard window operations [that] are well known and are available in graphical user interfaces with windows, such as the Macintosh Finder from Apple Computer, Inc. of Cupertino, Calif." Mander at 15:34-60.

receiving documents from diverse applications in formats that are specific to the respective applications and differ as between at least some of said applications;

Mander discloses a filing system that receives documents created by diverse applications such as email, spreadsheets, digitized movies and text documents in formats specific to the respective applications, and differ between at least some of said applications. Mander at 8:14-28; 24:25-28; 22:24-27; 13:58-60; 36:30-32.

automatically associating time-based indicators with the documents received in the receiving step from the diverse applications;

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of "associating time-based indicators with the documents received" includes indexing a data unit using an object containing meta-data attributes which include timestamp information. Applying the broadest reasonable constructions of these terms, Mander discloses associating time-based indicators with the documents received by the system. Specifically, Mander discloses that the file system may select a timestamp for the document or the timestamp may be selected by a user and recorded in a date line field of the document. Mander at 33:34-43.

Mander further discloses that documents from diverse application are automatically associated with time-based indicators for any new document if the user instructs the system to carry out this step automatically. Mander at 28:5-12 ("It should be noted that step 803 could be performed automatically by the system for any new or modified document if the

user so instructs the computer system to perform this function automatically.”). Mander also discloses that this timestamp information is indexed and can be used to sort and list documents by date, as well as to generate a pile of documents “dated after a certain date.” *See, e.g.*, Mander at 33:34-63; 22:42-46; 23:48-50.

automatically archiving the received documents;

As discussed above Section V.B (Claim Construction), the Patent Owner’s own application of “automatically archiving the received documents” in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes archival and back-up systems. Applying the broadest reasonable construction of the “automatically archiving the received documents” limitation, this limitation was well known in the art at the time of Patent Owner’s alleged invention, including in Retrospect.

Retrospect discloses archiving software for archiving documents associated with a timestamp older than a specified time. Retrospect at pp. 151, 155. Because the archiving function is almost identical to a backup script, the archived file retains all the attributes of the original files. Retrospect at pp. 81-87, 98, 104. Further Retrospect also teaches retaining an alternative version of the documents by creating a catalog which indexes the archived files. Retrospect at pp. 21, 143.

automatically creating glance views that are abbreviated versions of respective ones of said documents;

Mander teaches that the system automatically creates glance views that are abbreviated versions of certain documents in a pile. For example, in one embodiment, Mander teaches glance views called proxies, which are “miniature[s] of the first page of the document that has been selected for browsing.” Mander at 9:54-10:1; 12:10-11. For example, Figure 4a of Mander discloses a “view cone 162 [that] points to or is connected on one side (the apex or smaller side) to the collection of documents” and “the other side of the viewing cone 162 shows a proxy 161 which is, in one embodiment, a miniature of the first page of the document which has been selected for browsing”:

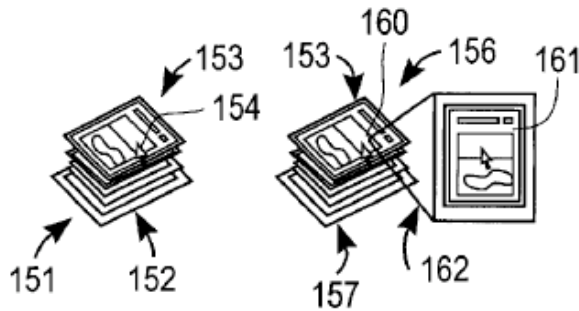


FIG. 4a

Mander at FIG. 4a.

Mander also teaches that a proxy can be generated by using the most characteristic words in the document and information from certain fields such as “To,” “Re,” and “Date.” Mander at 10:17-23; 10:33-35. For example, Figure 4f of Mander discloses a proxy that “conveys more information to the user in the case of a mail document than a miniature of the document which the user probably has not seen”:

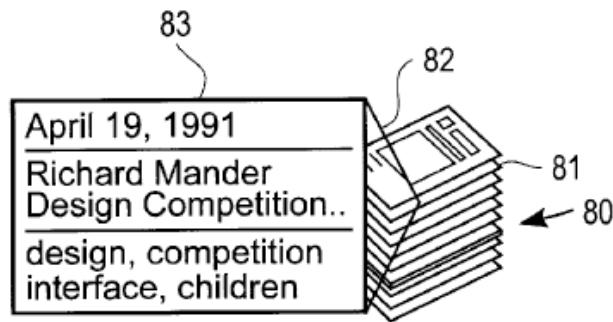


FIG. 4f

Mander at FIG. 4f.

selectively displaying at least some of said documents as a receding, foreshortened stack of partly overlapping documents so that only a part of each of said documents in the displayed stack, after the first document in the stack, is visible to the user;

As discussed above Section V.B (Claim Construction), the Patent Owner’s own application of “a receding, foreshortened stack of partly overlapping documents” in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes a three-dimensional representation of partly-overlapping icons of the same size. Applying the broadest reasonable construction of the “receding,

foreshortened stack of partly overlapping documents” limitation, this limitation is disclosed in Mander. Specifically, Mander discloses displaying documents in a three-dimensional stack of partly overlapping icons of the same side wherein only part of the documents below the top document in the stack is visible:

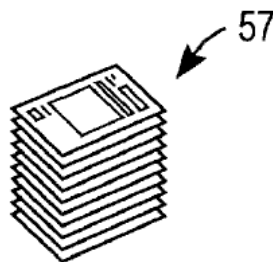


FIG. 2d

Mander at FIG. 2a-d.

Moreover, Mander is not the only reference that discloses the use of receding, foreshortened stacks to visually display files. The use of receding, foreshortened stacks to visually display files was well known in the art at the time of the ‘313 patent. As discussed below, the Lucas reference is another example of a reference that discloses the display of files as receding, foreshortened stacks. Indeed, to the extent that the Patent Owner argues that there is some sort of distinction between the piles depicted of Mander and the stacks (also called piles) disclosed in Lucas, it would have been known to one of ordinary skill in the art that the stream of Mander could be visually represented in other ways, including as depicted in Lucas.

said displaying further including displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display the glance view of the document in the stack that is currently touched by the cursor or pointer, without requiring clicking on the document; and

Mander discloses that when a cursor or pointer is positioned over a pile for a predetermined period of time the system displays a view cone with a proxy. Specifically, Mander discloses “[i]n other words, once the system has been instructed by the user to allow browsing of documents within a pile, the system displays the appropriate proxy for the selected document in the pile on demand by the user without waiting for a predetermined period of time. Once browsing has been invoked, the user may quickly scan

through the pile by moving the cursor up and down the pile; in this manner, each time the cursor comes to a representation of a document in the pile, the system displays the proxy for that document within the view cone 162.” Mander at 10:11-20; 9:54-10:1. Figure 16 shows a method for performing the operation of browsing a pile where a view cone is shown and a proxy of the selected document in the pile is displayed if the cursor remains pointed to a document for a predetermined period of time:

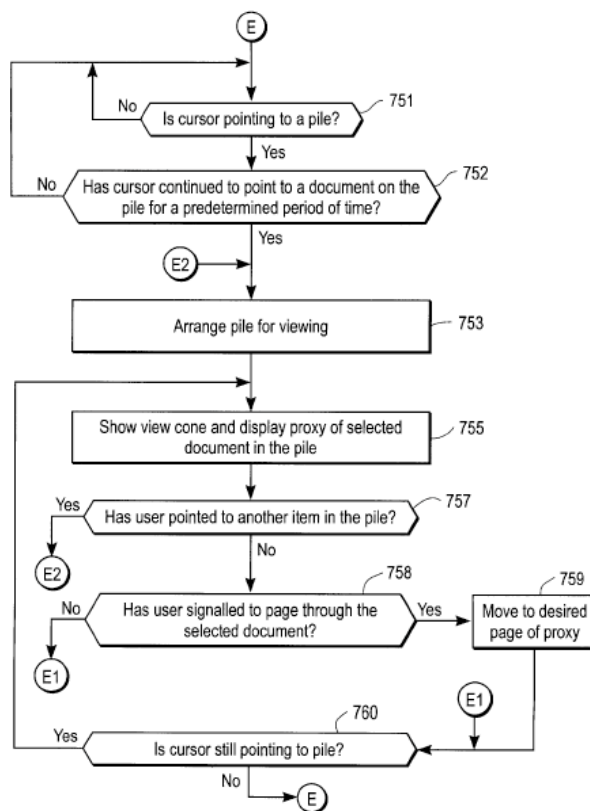


FIG. 16

Mander at FIG. 16; 26:66-27:40.

utilizing, in said document stream operating system, subsystems from said at least one other operating system for operations including writing documents to storage media, interrupt handling and input/output.

As discussed above Section V.B (Claim Construction), the Patent Owner’s own application of “utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system” in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes the use of a computer system with multiple software layers, including layers for core services and for

user experience. Applying this broadest reasonable construction, Mander discloses an operating system that utilizes subsystems from other operating systems. Specifically, Mander discloses that the Piles invention can be used in conjunction with the Apple Operating System. Mander at 24:8-18; 8:13-28; 15:34-60. For example, Mander discloses that programs from the operating system may be used along with the disclosed filing system for providing operations such as controlling input from a mouse and output to a display. Mander at 24:8-18; 8:13-28; 15:34-60. Additionally the operating system utilizes programs to receive documents over a network system, such as emails and therefore handling input/output. Mander at 24:8-18; 8:13-28; 15:34-60. Mander also contemplates that its document organizing operating system can utilize the Apple Operating System's Finder program to perform certain user experience functions, such as "standard window operations [that] are well known and are available in graphical user interfaces with windows, such as the Macintosh Finder from Apple Computer, Inc. of Cupertino, Calif." Mander at 15:34-60.

3. CLAIM 2

2. A method as in claim 1 including storing said documents as a main stream that is time-based and selectively generating a substream of documents that are a subset of the documents in the main stream matching selected criteria.

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of a "main stream" includes a collection of documents or a collection of information about documents, such as an index. Correspondingly, the broadest reasonable construction of "substream" includes a subset of a collection of documents, or a subset of the contents of an index, such as a search query of an index, search results, or a list of files organized by content and/or attributes. Applying the broadest reasonable constructions of these terms, Mander discloses a "main stream that is time-based." Specifically, Mander discloses software and a processor for generating an index of each data unit received or generated by the system. Mander at 5:42-6:4, 25:21-37, Fig. 15. Mander discloses that the file system may select a timestamp for the document or the timestamp may be selected by a user and recorded in a date line field of the document. Mander at 33:34-43. Mander also discloses that this timestamp information can be used to sort and list documents by date. Mander at 19:26-35; 19:66-20:14; 23:36-51; 33:34-43.

Mander also discloses one or more substreams, which are described as “piles” that contain only subsets of data units from the main stream. Mander at 8:47-55. According to Mander, “FIG. 18a shows a method of the present invention for creating subpiles from a pile or other selected set of documents (e.g. documents within a folder). This method would be invoked in various ways by the user or perhaps under system control automatically (e.g. as a result of a search where the user requests the search results pile to be processed into subpiles after the search).” Mander at 29:37-43. Mander also discloses that “the automatic filing into piles and subpiling and classification methods of the present invention are particularly useful in this mail/message environment. For example, the user may instruct the system to collect mail documents into a pile and then have the system create subpiles or search a pile of mail documents according to the invention and then create subpiles from documents found in the search.” Mander at 8:28-35.

4. CLAIM 3

3. A method as in claim 2 in which said generating a substream comprises generating a substream that persists unless selectively destroyed by a user.

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of a “substream that persists” includes persistent streams or streams that are dynamically updated, including at least saved searches, Smart Folders and automatically updated file maintenance systems. Applying the broadest reasonable constructions of these terms, Mander discloses a “substream that persists.” Specifically, Mander discloses the use of scripts that allow the user to “instruct[] the system to add documents to the pile on the basis of the pile’s modified script or the system” or “the system does so automatically after modifying the pile’s script.” Mander at 35:14-17; 27:53-28:8.

5. CLAIM 4

4. A method as in claim 3 in which said generating a substream comprises generating a live substream that collects new documents that are added to said main stream and meet said criteria.

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of a “live substream” includes saved searches or Smart Folders that dynamically collect new documents that meet certain criteria as they are added to the main

stream. Applying the broadest reasonable constructions of these terms, Mander discloses a “live substream.” Specifically, Mander discloses the use of scripts that allow the user to “instruct[] the system to add documents to the pile on the basis of the pile’s modified script or the system” or “the system does so automatically after modifying the pile’s script.” Mander at 35:14-17; 27:53-28:8.

6. CLAIM 9

9. A method of automatically archiving documents received from diverse applications in different formats such that the archived documents can be searched for documents meeting selected criteria, comprising:

As discussed above Section V.B (Claim Construction), the Patent Owner’s own application of “automatically archiving received documents” in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes archival and back-up systems. Applying the broadest reasonable construction of the “automatically archiving received documents” limitation, this limitation was well known in the art at the time of Patent Owner’s alleged invention, including in Retrospect.

Retrospect discloses archiving software for archiving documents associated with a timestamp older than a specified time. Retrospect at pp. 151, 155. Because the archiving function is almost identical to a backup script, the archived file retains all the attributes of the original files. Retrospect at pp. 81-87, 98, 104. Further Retrospect also teaches retaining an alternative version of the documents by creating a catalog which indexes the archived files. Retrospect at pp. 21, 143. “The catalog, a file saved on [the user’s] hard disk, is an index of contents of the files on the backup media of a StorageSet,” and a user can restore files by searching through one or more StorageSets. Retrospect at pp. 21, 58. Notably, Retrospect also provides Browsers, which are powerful tools for viewing, selecting and manipulating files and folders on source and destination volumes; browser windows provide file management facilities similar to those in Finder, as well as additional features. Retrospect at p. 140.

receiving documents from diverse applications in formats that are specific to the respective applications and differ as between at least some of said applications;

Mander discloses a filing system that receives documents created by diverse applications such as email, spreadsheets, digitized movies and text documents in formats specific to the respective applications, and differ between at least some of said applications. Mander at 8:14-28; 24:25-28; 22:24-27; 13:58-60; 36:30-32.

automatically associating time-based indicators with the documents received in the receiving step from the diverse applications;

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of “associating time-based indicators with the documents received” includes using a date/time to uniquely identify each data unit or indexing a data unit using an object containing meta-data attributes which include timestamp information. Applying the broadest reasonable constructions of these terms, Mander discloses associating time-based indicators with the documents received by the system. Specifically, Mander discloses that the file system may select a timestamp for the document or the timestamp may be selected by a user and recorded in a date line field of the document. Mander at 33:34-43.

Mander further discloses that documents from diverse application are automatically associated with time-based indicators for any new document if the user instructs the system to carry out this step automatically. Mander at 28:5-12 (“It should be noted that step 803 could be performed automatically by the system for any new or modified document if the user so instructs the computer system to perform this function automatically.”). Mander also discloses that this timestamp information can be used to sort and list documents by date. For example the user may instruct that all documents dated after a certain date be added to a pile. Mander at 23:36-51.

automatically archiving the received documents together with said time-based indicators;

As discussed above Section V.B (Claim Construction), the Patent Owner’s own application of “automatically archiving the received documents” in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes archival and back-up systems. Applying the broadest reasonable construction of the “automatically archiving the received documents” limitation, this limitation was well known in the art at the time of Patent Owner’s alleged invention, including in Retrospect.

Retrospect discloses archiving software for archiving documents associated with a timestamp older than a specified time. Retrospect at pp. 151, 155. Because the archiving function is almost identical to a backup script, the archived file retains all the attributes of the original files. Retrospect at pp. 81-87, 98, 104. Further Retrospect also teaches retaining an alternative version of the documents by creating a catalog, which indexes the archived files. Retrospect at pp. 21, 143.

selectively displaying at least some of said documents as a receding, foreshortened stack of partly overlapping documents so that only a part of each of said documents in the displayed stack, after the first document in the stack, is visible to the user; and

As discussed above Section V.B (Claim Construction), the Patent Owner's own application of "a receding, foreshortened stack of partly overlapping documents" in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes a three-dimensional representation of partly-overlapping icons of the same size. Applying the broadest reasonable construction of the "receding, foreshortened stack of partly overlapping documents" limitation, this limitation is disclosed in Mander. Specifically, Mander discloses displaying documents in a three-dimensional stack of partly overlapping icons of the same size wherein only part of the documents below the top document in the stack is visible:

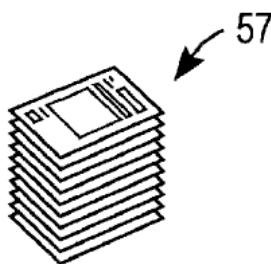


FIG. 2d

Mander at FIG. 2a-d.

said displaying further including displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display a glance view of the document in the stack that is currently touched by the

cursor or pointer, wherein said glance view is an abbreviated version of the documents.

Mander discloses that when a cursor or pointer is positioned over a pile for a predetermined period of time the system displays a view cone with a proxy. Specifically, Mander discloses “[i]n other words, once the system has been instructed by the user to allow browsing of documents within a pile, the system displays the appropriate proxy for the selected document in the pile on demand by the user without waiting for a predetermined period of time. Once browsing has been invoked, the user may quickly scan through the pile by moving the cursor up and down the pile; in this manner, each time the cursor comes to a representation of a document in the pile, the system displays the proxy for that document within the view cone 162.” Mander at 10:11-20; 9:54-10:1. Figure 16 shows a method for performing the operation of browsing a pile where a view cone is shown and a proxy of the selected document in the pile is displayed if the cursor remains pointed to a document for a predetermined period of time:

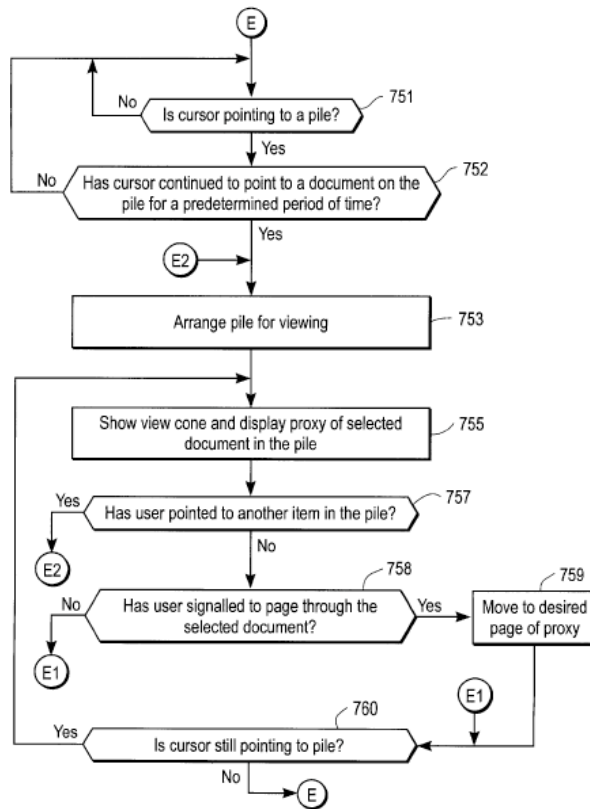


FIG. 16

Mander at FIG. 16; 26:66-27:40.

Mander further teaches that the system creates glance views that are abbreviated versions of certain documents in a pile. For example, in one embodiment, Mander teaches glance views called proxies, which are “miniature[s] of the first page of the document that has been selected for browsing.” Mander at 9:54-10:1; 12:10-11. For example, Figure 4a of Mander discloses a “view cone 162 [that] points to or is connected on one side (the apex or smaller side) to the collection of documents” and “the other side of the viewing cone 162 shows a proxy 161 which is, in one embodiment, a miniature of the first page of the document which has been selected for browsing”:

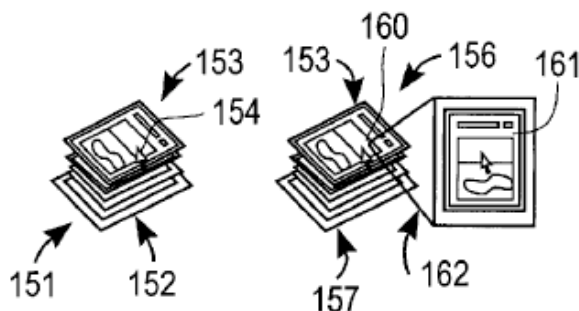


FIG. 4a

Mander at FIG. 4a.

Mander also teaches that a proxy can be generated by using the most characteristic words in the document and information from certain fields such as “To,” “Re,” and “Date.” Mander at 10:17-23; 10:33-35. For example, Figure 4f of Mander discloses a proxy that “conveys more information to the user in the case of a mail document than a miniature of the document which the user probably has not seen”:

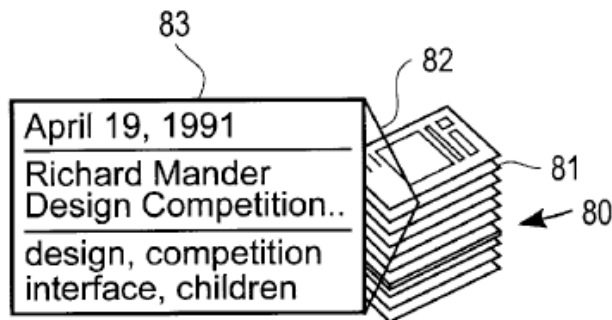


FIG. 4f

Mander at FIG. 4f.

7. CLAIM 10

10. A method as in claim 9, including utilizing subsystems from at least one other operating system for operations including writing documents to storage media and input/output in said archiving and displaying.

As discussed above Section V.B (Claim Construction), the Patent Owner's own application of "utilizing subsystems from at least one other operating system for operations including writing documents to storage media and input/output in said archiving and displaying" in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes the use of a computer system with multiple software layers, including layers for core services and for user experience. Applying this broadest reasonable construction, Mander discloses an operating system that utilizes subsystems from other operating systems. Specifically, Mander discloses that the piles invention can be used in conjunction with the Apple Operating System. Mander at 24:8-18; 8:13-28; 15:34-60. For example, Mander discloses that programs from the operating system may be used along with the disclosed filing system for providing operations such as controlling input from a mouse and output to a display. Mander at 24:8-18; 8:13-28; 15:34-60. Additionally the operating system utilizes programs to receive documents over a network system, such as emails and therefore handling input/output. Mander at 24:8-18; 8:13-28; 15:34-60. Mander also contemplates that its document organizing operating system can utilize the Apple Operating System's Finder program to perform certain user experience functions, such as "standard window operations [that] are well known and are available in graphical user interfaces with windows, such as the Macintosh Finder from Apple Computer, Inc. of Cupertino, Calif." Mander at 15:34-60.

8. CLAIM 11

11. A method as in claim 9 including selectively searching said archived documents for documents meeting selected criteria and generating and displaying a substream comprising documents identified in said searching, said substream being in time order and comprising documents in different formats matching respective different applications from which the documents originated.

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of “substream” includes a subset of a collection of documents or a query, search results, sub-folders or Smart Folders collection of information about documents, such as an index. Applying the broadest reasonable construction, Mander also discloses one or more substreams, which are described as “piles” that contain only subsets of data units from the main stream. Mander at 8:47-55. According to Mander, “FIG. 18a shows a method of the present invention for creating subpiles from a pile or other selected set of documents (e.g. documents within a folder). This method would be invoked in various ways by the user or perhaps under system control automatically (e.g. as a result of a search where the user requests the search results pile to be processed into subpiles after the search).” Mander at 29:37-43.

Mander also discloses that substreams or subpiles can be generated from a filing system that receives documents created by diverse applications such as email, spreadsheets, digitized movies and text documents in formats specific to the respective applications, and differ between at least some of said applications. Mander at 8:14-28; 24:25-28; 22:24-27; 13:58-60; 36:30-32.

Mander also discloses that substreams can be in time order based on timestamp information can be used to sort and list documents by date. For example the user may instruct that all documents dated after a certain date be added to a pile. Mander at 23:36-51. Mander also discloses “several command options which allow the user to view the pile in different ways and to order the contents of the pile in different ways and to select between those different ways in order to obtain different appearances of the pile or to otherwise reorganize the pile (e.g. create subpiles from a single original pile).” Mander at 19:66-20:14. As another example, “FIG. 20 shows a method for using color to assist in organizing information in a computer and to assist a user in understanding the content and organization of piles within the following system. This method begins in step 951 wherein the user selects a pile and then in step 953 selects a method of visualization such as the visualization window 551 shown in FIG. 13a. This causes the system, in step 955, and display the visualization window showing the pile within the window (or the user may have to move the pile into the window). Then in step 957, the user selects the command “order by date” and the system orders documents in the pile by the date of the document.” Mander at 19:26-35.

* * *

For the reasons set forth above and in Exhibit CC-A, the combination of Mander and Retrospect renders obvious each of 1, 2, 3, 4, 9, 10 and 11 of the '313 patent. Claims 1, 2, 3, 4, 9, 10 and 11 should be reexamined, rejected under 35 U.S.C. § 103, and canceled pursuant to this Request.

B. CLAIMS 1 2, 3, 9, 10 AND 11 ARE RENDERED OBVIOUS BY LUCAS IN VIEW OF MAGELLAN UNDER 35 U.S.C. § 103

Lucas (U.S. 5,499,330) was filed September 17, 1993. Therefore, Lucas is prior art under 35 U.S.C. §102 and is asserted under 35 U.S.C. § 103. Lucas was not before the Examiner during the prosecution of the '313 patent.

Lucas discloses a system for displaying documents in three dimensions, particularly three-dimensional piles, to provide an “intuitively appealing” improvement over conventional user-interfaces where “folders or directories are used to organize files or documents into groups or hierarchies.” Lucas 1:14-40 at Figs. 5 & 3. Specifically, Lucas discloses a system that displays documents along a two-dimensional “strand” through a three-dimensional display space. Lucas at 1:55-61. The strand path is defined by a strand function that determines the shape of the three-dimensional display of documents. Lucas at 8:54-9:7. The strand mechanism can form any kind of continuous three-dimensional display of documents, including piles or documents “spiraling back to infinity.” Lucas at 8:46-9:7; Figs. 5 & 3.

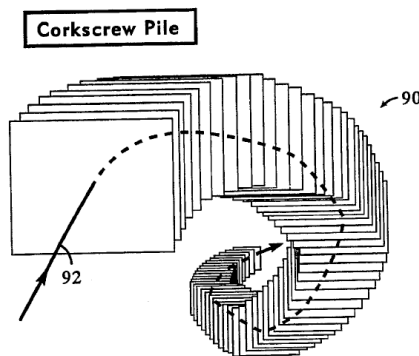


FIG. 5

Lucas also discloses a “pile and scroll tool” that allows a user to browse through a collection of documents displayed along a strand. Lucas at 10:43-51; Fig. 3. The pile and scroll tool allows the user to browse documents that are cycling through a U-shaped strand in response to input signals from a user-controlled mouse. Lucas at 10:61-11:17.

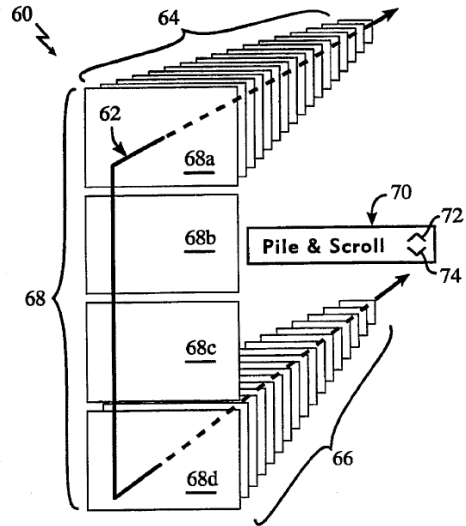


FIG. 3

Lucas describes using these piles as a generic tool able to present any type of collection of documents, including for example the output of a “FIND” command. Lucas at 9:7-14. The user interface described in Lucas is designed to work with “repositories” and “workspaces” of documents, which can be kept either in local storage or accessed over a computer network. Lucas at 7:40-67.

For purposes of this Request, Lucas is analyzed in view of Lotus’s Magellan software. Lotus’s Magellan was a software system first released in the 1980s by Lotus Development Corporation. Magellan was disclosed in, among others, “Using Lotus Magellan,” by David P. Gobel (Que Corporation, 1989) and “Lotus Magellan’s Explorer’s Guide,” by Lotus (Lotus Development Corporation, 1989). Therefore, Magellan is prior art under 35 U.S.C. §102 and is asserted under 35 U.S.C. § 103. Lotus’ Magellan was also not before the Examiner during the prosecution of the ‘313 patent.

Magellan discloses a system for indexing the entire contents of a computer system, including every word of every document in the system, and even allows indexing of networked storage. Using Lotus Magellan at 1-2. After indexing all of the files on a user’s system, Magellan allows searching the index to find documents satisfying user-defined search criteria. Using Lotus Magellan at *xi-xii*; Magellan Explorer’s Guide at 19. In addition to indexing the contents of the files, Magellan also indexes file metadata such as

name, path, time, size, and date. Magellan Explorer's Guide at 186.⁷ While Magellan had sophisticated indexing and searching capabilities, it did not have a graphical user interface.

**1. A PERSON OF ORDINARY SKILL IN THE ART WOULD BE
MOTIVATED TO COMBINE LUCAS AND MAGELLAN**

One of ordinary skill would be motivated to combine the display features of Lucas with the search and indexing features of Lotus' Magellan.

(a) SUBSTITUTION OF ONE KNOWN ELEMENT FOR ANOTHER

One of ordinary skill in the art would be motivated to combine Lucas with Magellan as a substitution of one known element for another to obtain a predictable result. MPEP § 2141.III states that "[e]xemplary rationales that may support a conclusion of obviousness include ... (B) Simple substitution of one known element for another to obtain predictable results." The user interface of Lucas is a compatible alternative to the user interface used by Magellan, including in particular because there are predictable positive results associated with substituting the Lucas user interface for a DOS-based user interface. Those predictable positive results include, among others, the positive results disclosed in Lucas, such as allowing users to "more easily manipulate documents in an environment like the real world of the desktop and to organize documents in a way that is intuitively appealing" and is "not based on artificial constructs imposed by the nature of computer storage of documents or two dimensional user interface designs." Lucas at 1:14-40. Accordingly, one skilled in the art would be motivated to substitute the known three-dimensional user interface of Lucas for the known DOS-based user interface of Magellan to obtain the predictable result of an enhanced user interface. This is particularly true because Lucas expressly contemplates the use of searches (which it describes using, for example, the FIND operation) to generate the content to be displayed. Lucas at 9:8-14.

**(b) APPLYING A KNOWN TECHNIQUE TO A KNOWN DEVICE
READY FOR IMPROVEMENT**

MPEP § 2141.III states that "[e]xemplary rationales that may support a conclusion of obviousness include ... (D) Applying a known technique to a known device (method or product) ready for improvement to yield predictable results." For the same reasons as

⁷ Although Requester has detailed the bases for invalidity of the identified claims of the '313 patent herein, Requester has also included additional citations to the disclosure in Lucas and Magellan in Exhibit CC-B to assist the Office.

above, one of ordinary skill in the art would be motivated to use the known technique of Lucas's user interface with search and archival features of Magellan. This is particularly true because Magellan does not disclose a three-dimensional user interface that allows users to "more easily manipulate documents in an environment like the real world of the desktop and to organize documents in a way that is intuitively appealing," as disclosed in Lucas, and would thus be ready for improvement.

(c) TEACHING, SUGGESTION OR MOTIVATION IN THE PRIOR ART

Finally, one of ordinary skill in the art would be motivated by the direct teaching of Lucas to combine it with Magellan. Lucas expressly contemplates the use of searches (which it describes using, for example, the FIND operation) to generate the content to be displayed. Lucas at 9:8-14. Magellan discloses a system for indexing the entire contents, including every word of every document, in a computer system and allowing the user to perform sophisticated searches to find documents satisfying user-defined search criteria. Using Lotus Magellan at 1-2; Using Lotus Magellan at *xi-xii*; Magellan Explorer's Guide at 19. One of ordinary skill in the art reading the disclosure of high-level search functionality in Lucas would be motivated by that teaching to identify known techniques for sophisticated searching and to combine those techniques with Lucas.

In sum, based on the capabilities of the two systems and the well-known nature of both user interface and searching systems at the time the '313 patent was filed, a person of ordinary skill in the art would have considered it obvious to implement the Lucas display technique with the searching system disclosed in Magellan.

2. CLAIM 1

1. A method of utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system, comprising:

Magellan discloses utilizing a document stream operating system that in turn utilizes subsystems from at least one other operating system, namely DOS. Magellan Explorer's Guide at back cover ("Systems Requirements: DOS versions 2.1 and higher").

receiving documents from diverse applications in formats that are specific to the respective applications and differ as between at least some of said applications;

Magellan discloses receiving documents from other computer systems, such as files received via removable disks or from other networked computers. Magellan Explorer's Guide at pg. 4 and 191. Lucas also contemplates that data units may be received from other computer systems or "repositories," including computers that are networked. Lucas at 7:58-8:2, 8:24-29, 18:30-42.

Magellan also discloses that the indexed documents may contain at least textual data. Magellan Explorer's Guide at pg. 186. Lucas contemplates that its technique can be used broadly for handling documents in a computer system, including documents that are typed, scanned, faxed or emailed. Lucas at 1:49-52, 14:28-35.

automatically associating time-based indicators with the documents received in the receiving step from the diverse applications;

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of "associating time-based indicators with the documents received" includes using a date/time to uniquely identify each data unit or indexing a data unit using an object containing meta-data attributes which include timestamp information. Applying the broadest reasonable constructions of these terms, the combination of Lucas and Magellan discloses associating time-based indicators with the documents received by the system. Specifically, Magellan discloses an index which identifies the time and date that each document was created or last modified. Magellan Explorer's Guide at pp. 29, 186, Using Lotus Magellan at pg. 36. In addition, Lucas contemplates that the files that it displays will include timestamp information. For example, Lucas discloses that "whenever a new document is scanned, faxed or sent through electronic mail, and then subsequently fetched to a workspace, the system will annotate that document to indicate that it has not been read" and "may staple an information sticker to the new document." Lucas at 19:42-67. In the case of scanned documents, Lucas contemplates that the scanned document will have an information sticker that includes the date on which the document was scanned. Lucas at 4:43-48. As another example, Lucas also contemplates the display of email messages that are sorted by timestamp. Lucas at 14:28-35.

automatically archiving the received documents;

As discussed above Section V.B (Claim Construction), the Patent Owner's own application of "automatically archiving the received documents" in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes archival and back-up systems. Applying the broadest reasonable construction of the "automatically archiving the received documents" limitation, this limitation was well known in the art at the time of Patent Owner's alleged invention, including in Magellan.

Magellan discloses a computer search program that organizes all data units, or documents as construed by Patent Owner, generated by a computer or received by a computer over a network in order to facilitate viewing and locating files. Magellan Explorer's Guide at pg. 4, 63, and 191. Magellan also describes archiving, as it "provides the file management tools you need to archive your data and remove any unnecessary files after finishing a project." Magellan Explorer's Guide at pg. 52, 57; Using Lotus Magellan at pp. 88-91.

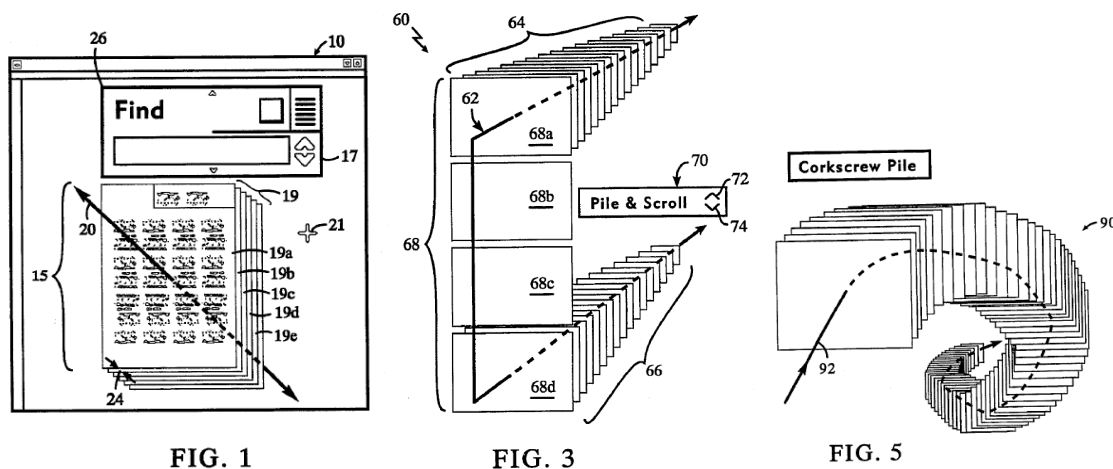
automatically creating glance views that are abbreviated versions of respective ones of said documents;

Magellan discloses a computer search program that organizes all data units, or documents as construed by Patent Owner, generated by a computer or received by a computer over a network in order to facilitate viewing and locating files. Magellan Explorer's Guide at pg. 4, 63, and 191. Lucas discloses that alternative versions of the content of files can be displayed, including through use of its document renderers, which draw a rectangle of the screen object associated with each document in a workspace and renders the interior of each screen object. Lucas at 5:42-57. Lucas also discloses that a user can clip a document so as to restrict the viewable area of the screen object associated with that document in a view; clipping a document makes it look smaller without changing its position on the Z axis. Lucas at 19:26-33.

selectively displaying at least some of said documents as a receding, foreshortened stack of partly overlapping documents so that only a part of each of said documents in the displayed stack, after the first document in the stack, is visible to the user;

Magellan discloses a computer search program that organizes all data units, or documents as construed by Patent Owner, generated by a computer or received by a computer over a network in order to facilitate viewing and locating files. Magellan Explorer's Guide at pg. 4, 63, and 191.

Lucas discloses the display of files as a receding foreshortened stack of partly overlapping documents where only a part of each of said documents in the displayed stack, after the first document in the stack, is visible to the user:



Lucas at FIGS. 1, 3, 5. Lucas further discloses that “in a preferred embodiment of a workspace, the workspace is wrapped at the edges giving a fish-eye lens effect, so that every screen object that is not invisible has at least some portion of its rectangle within the screen display no matter what its position in the three dimensional workspace.” Lucas at 5:14-22.

said displaying further including displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display the glance view of the document in the stack that is currently touched by the cursor or pointer, without requiring clicking on the document; and

Lucas further discloses displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display the glance view of the document in the stack that is currently touched by the cursor or pointer, without requiring clicking on the document. Specifically, Lucas discloses that

a track ball device may be used to manipulate the position of the mouse cursor. As the mouse cursor is moved toward the bottom of the screen, the screen object is dragged forward (towards the user) within the workspace. As

the mouse cursor is moved toward the upper left corner of the screen instead of forward, the screen object is pushed back within the workspace. Note that as the screen object on the display device is being moved, the virtual location of the corresponding document maintained in the world space of the workspace viewer is being changed accordingly. Thus one can either say that the screen object is being moved, or that the document is being moved, and have the same meaning.

Lucas at 6:63-7:12.

Lucas goes on to disclose that

as a document is pulled forward, the document is moved towards the user along the z axis of the three dimensional workspace. The perspective process translates this movement of the object towards the user into a screen representation of the screen object for the document. As a result, the screen object for the document grows in size in its two dimensional screen space representation. Conversely, when a document is pushed back, the screen object for the document is made smaller.

Lucas at 7:13-21. In addition, Lucas discloses that as the object moves toward the user screen and grows larger, a glance view of the document becomes visible to the user. Specifically, Lucas discloses that alternative versions of the content of files can be displayed, including through use of its document renderers, which draw a rectangle of the screen object associated with each document in a workspace and renders the interior of each screen object. Lucas at 5:42-57. Indeed, when a document is pulled towards the user by sliding a cursor or track ball without clicking on the document such that it “plastered against the workplace window and cannot be moved any closer” to the user, that alternative version of the file or glance view comes to the front of the workspace window. Lucas at 7:13-27.

utilizing, in said document stream operating system, subsystems from said at least one other operating system for operations including writing documents to storage media, interrupt handling and input/output.

Magellan discloses a document stream operating system that in turn utilizes subsystems from at least one other operating system, namely DOS, for operations including writing documents to storage media, interrupt handling and input/output. Magellan Explorer’s Guide at back cover (“Plus, Magellan offers a full complement of DOS utilities that allows you to copy, move, delete, back up and otherwise organize files as you choose.”).

3. CLAIM 2

2. A method as in claim 1 including storing said documents as a main stream that is time-based and selectively generating a substream of documents that are a subset of the documents in the main stream matching selected criteria.

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of a “main stream” includes a collection of documents or a collection of information about documents, such as an index. Correspondingly, the broadest reasonable construction of “substream” includes a subset of a collection of documents, or a subset of the contents of an index, such as a search query of an index, search results, or a list of files organized by content and/or attributes. Applying the broadest reasonable construction of these terms, Magellan is a program which creates a main stream as a main index of data units on a hard disk where said data units were generated by a computer or received by a computer over a network. Magellan Explorer’s Guide at pg. 19-20, 186, and 191. Further, when the main index is searched with Magellan’s Explore command, the results of the search create a substream, which lists the relevant subset of documents from the main index, or main stream. Magellan Explorer’s Guide at pg. 96-97 and 109. Similarly, Lucas contemplates the use of searches (the FIND operation) to create substreams or piles for display. Lucas at 9:8-14.

4. CLAIM 3

3. A method as in claim 2 in which said generating a substream comprises generating a substream that persists unless selectively destroyed by a user.

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of a “substream that persists” includes persistent streams or streams that are dynamically updated, including at least saved searches, Smart Folders and automatically updated file maintenance systems. Applying the broadest reasonable constructions of these terms, Magellan discloses using the Update command to maintain a persistent updated main stream and substreams. Magellan Explorer’s Guide at pg. 49. In addition, macros can be used to automatically update the index as a persistent stream. Magellan Explorer’s Guide at pg. 220, Using Lotus Magellan at pg. 216.

5. CLAIM 9

9. A method of automatically archiving documents received from diverse applications in different formats such that the archived documents can be searched for documents meeting selected criteria, comprising:

As discussed above Section V.B (Claim Construction), the Patent Owner's own application of "automatically archiving received documents" in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes archival and back-up systems. Applying the broadest reasonable construction of the "automatically archiving the received documents" limitation, this limitation was well known in the art at the time of Patent Owner's alleged invention, including in Magellan.

Magellan discloses a computer search program that organizes all data units, or documents as construed by Patent Owner, generated by a computer or received by a computer over a network in order to facilitate viewing and locating files. Magellan Explorer's Guide at pg. 4, 63, and 191. Magellan also "provides the file management tools you need to archive your data and remove any unnecessary files after finishing a project." Magellan Explorer's Guide at pg. 52, 57; Using Lotus Magellan at pp. 88-91.

receiving documents from diverse applications in formats that are specific to the respective applications and differ as between at least some of said applications;

Magellan discloses receiving documents from other computer systems, such as files received via removable disks or from other networked computers. Magellan Explorer's Guide at pg. 4 and 191. Lucas also contemplates that data units may be received from other computer systems or "repositories," including computers that are networked. Lucas at 7:58-8:2, 8:24-29, 18:30-42.

Magellan also discloses that the indexed documents may contain at least textual data. Magellan Explorer's Guide at pg. 186. Lucas contemplates that its technique can be used broadly for handling documents in a computer system, including documents that are typed, scanned, faxed or emailed. Lucas at 1:49-52, 14:28-31.

automatically associating time-based indicators with the documents received in the receiving step from the diverse applications;

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of “associating time-based indicators with the documents received” includes using a date/time to uniquely identify each data unit, or indexing a data unit using an object containing meta-data attributes which include timestamp information. Applying the broadest reasonable constructions of these terms, the combination of Lucas and Magellan discloses associating time-based indicators with the documents received by the system. Specifically, Magellan discloses an index which identifies the time and date that each document was created or last modified. Magellan Explorer’s Guide at pp. 29, 186, Using Lotus Magellan at pg. 36. In addition, Lucas contemplates that the files that it displays will include timestamp information. For example, Lucas discloses that “whenever a new document is scanned, faxed or sent through electronic mail, and then subsequently fetched to a workspace, the system will annotate that document to indicate that it has not been read” and “may staple an information sticker to the new document.” Lucas at 19:42-67. In the case of scanned documents, Lucas contemplates that the scanned document will have an information sticker that includes the date on which the document was scanned. Lucas at 4:46-48. As another example, Lucas also contemplates the display of email messages that are sorted by timestamp. Lucas at 14:28-35.

automatically archiving the received documents together with said time-based indicators;

As discussed above Section V.B (Claim Construction), the Patent Owner’s own application of “automatically archiving the received documents” in litigation demonstrates that Patent Owner believes that the broadest reasonable construction of this limitation includes archival and back-up systems. Applying the broadest reasonable construction of the “automatically archiving the received documents” limitation, this limitation was well known in the art at the time of Patent Owner’s alleged invention, including in Magellan.

Magellan “provides the file management tools you need to archive your data and remove any unnecessary files after finishing a project.” Magellan Explorer’s Guide at pg. 52, 57; Using Lotus Magellan at pp. 88-91.

selectively displaying at least some of said documents as a receding, foreshortened stack of partly overlapping documents so that only a part of each of said documents in

the displayed stack, after the first document in the stack, is visible to the user; and

Magellan discloses a computer search program that organizes all data units, or documents as construed by Patent Owner, generated by a computer or received by a computer over a network in order to facilitate viewing and locating files. Magellan Explorer's Guide at pg. 4, 63, and 191.

Lucas discloses the display of files as a receding foreshortened stack of partly overlapping documents where only a part of each of said documents in the displayed stack, after the first document in the stack, is visible to the user:

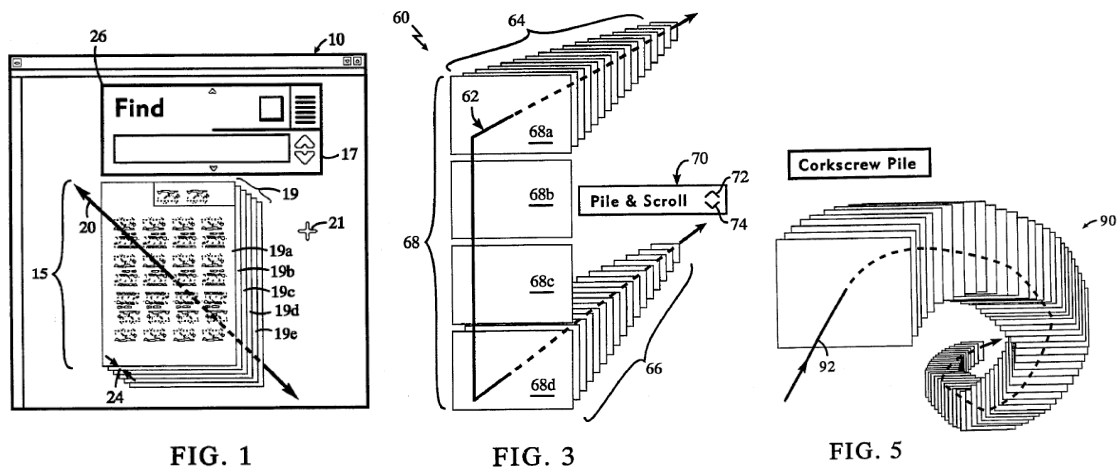


FIG. 1

FIG. 3

FIG. 5

Lucas at FIGS. 1, 3, 5. Lucas further discloses that “in a preferred embodiment of a workspace, the workspace is wrapped at the edges giving a fish-eye lens effect, so that every screen object that is not invisible has at least some portion of its rectangle within the screen display no matter what its position in the three dimensional workspace.” Lucas at 5:14-22.

said displaying further including displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display a glance view of the document in the stack that is currently touched by the cursor or pointer, wherein said glance view is an abbreviated version of the documents.

Lucas further discloses displaying a cursor or pointer and responding to a user sliding the cursor or pointer over said displayed stack to display the glance view of the document in the stack that is currently touched by the cursor or pointer, without requiring clicking on the document. Specifically, Lucas discloses “[a]s an alternative a track ball

device may be used to manipulate the position of the mouse cursor. As the mouse cursor is moved toward the bottom of the screen, the screen object is dragged forward (towards the user) within the workspace. As the mouse cursor is moved toward the upper left corner of the screen instead of forward, the screen object is pushed back within the workspace. Note that as the screen object on the display device is being moved, the virtual location of the corresponding document maintained in the world space of the workspace viewer is being changed accordingly. Thus one can either say that the screen object is being moved, or that the document is being moved, and have the same meaning.” Lucas at 6:63-7:12.

Lucas goes on to disclose that, “as a document is pulled forward, the document is moved towards the user along the z axis of the three dimensional workspace. The perspective process translates this movement of the object towards the user into a screen representation of the screen object for the document. As a result, the screen object for the document grows in size in its two dimensional screen space representation. Conversely, when a document is pushed back, the screen object for the document is made smaller.” Lucas at 7:13-21. In addition, Lucas discloses that, as the object moves toward the user screen and grows larger, a glance view of the document becomes visible to the user. Specifically, Lucas discloses that alternative versions of the content of files can be displayed, including through use of its document renderers, which draw a rectangle of the screen object associated with each document in a workspace and renders the interior of each screen object. Lucas at 5:42-57. Indeed, when a document is pulled towards the user by sliding a cursor or track ball without clicking on the document such that it “plastered against the workplace window and cannot be moved any closer” to the user, that alternative version of the file or glance view comes to the front of the workspace window.

6. CLAIM 10

10. A method as in claim 9, including utilizing subsystems from at least one other operating system for operations including writing documents to storage media and input/output in said archiving and displaying.

Magellan discloses a document stream operating system that in turn utilizes subsystems from at least one other operating system, namely DOS, for operations including writing documents to storage media, interrupt handling and input/output. Magellan Explorer’s Guide at back cover (“Plus, Magellan offers a full complement of DOS utilities

that allows you to copy, move, delete, back up and otherwise organize files as you choose.”).

7. CLAIM 11

11. A method as in claim 9 including selectively searching said archived documents for documents meeting selected criteria and generating and displaying a substream comprising documents identified in said searching, said substream being in time order and comprising documents in different formats matching respective different applications from which the documents originated.

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of “substream” includes a subset of a collection of documents or a query, search results, sub-folders or Smart Folders collection of information about documents, such as an index. Applying the broadest reasonable construction, when the main index is searched with Magellan’s Explore command, the results of the search create a substream, which lists the relevant subset of documents from the main index, or main stream. Magellan Explorer’s Guide at pg. 96-97 and 109. Similarly, Lucas contemplates the use of searches (the FIND operation) to create substreams or piles for display. Lucas at 9:8-14.

The combination of Magellan and Lucas also discloses that substreams can be generated from a filing system that receives documents created by diverse applications. Magellan also discloses that the indexed documents may contain at least textual data. Magellan Explorer’s Guide at pg. 186. Lucas contemplates that its technique can be used broadly for handling documents in a computer system, including documents that are typed, scanned, faxed or emailed. Lucas at 1:49-52, 14:28-31.

Magellan also discloses that substreams can be in time order based on timestamp information can be used to sort and list documents by date. For example, Magellan discloses an index which identifies the time and date that each document was created or last modified. Magellan Explorer’s Guide at pp. 29, 186, Using Lotus Magellan at pg. 36. Magellan also discloses a command T which is used to “select the Time/date option” where the user “want[s] to sort the files by the time and date they were created or last modified.” Magellan Explorer’s Guide at pg. 40, Using Lotus Magellan at pg. 70.

* * *

For the reasons set forth above and in Exhibit CC-B, the combination of Lucas and Magellan renders obvious each of 1, 2, 3, 9, 10 and 11 of the '313 patent. Claims 1, 2, 3, 9, 10 and 11 should be reexamined, rejected under 35 U.S.C. § 103, and canceled pursuant to this Request.

VII. CONCLUSION

The prior art documents presented in the above Request were either not previously considered by the Office or are now being presented in a new light pursuant to MPEP §2242 (II). The claims of the '313 patent are not patentable over the prior art documents cited herein. The prior art documents teach the subject matter of the '313 patent in a manner such that substantial new questions of patentability for all claims are raised by this Request.

In view of the foregoing, it is respectfully submitted that a substantial new question of patentability of Claims 1, 2, 3, 4, 9, 10 and 11 of Patent No. 6,638,313 has been raised by this Request. Accordingly, the Office is requested to grant this Request and to initiate reexamination with special dispatch. Claims 1, 2, 3, 4, 9, 10 and 11 should be reexamined, rejected under 35 U.S.C. §§ 102-103, and canceled pursuant to this Request.

As an aid to the application of the presented prior art to claims of the '313 patent, corresponding claim chart is provided at Exhibits CC-A and CC-B attached hereto.

Enclosed is a credit card authorization to cover the Fee for reexamination. If this authorization is missing or defective please charge the Fee to the Novak Druce Deposit Account No. 14-1437.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Request for *Ex Parte* Reexamination, together with all exhibits and attachments and supporting documentation, has been served via first class mail on the 23rd day of April 2009, upon the following:

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