

EXHIBIT 6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: Prager, et al.

Patent No.: 6,768,999

Filed: June 26, 2001

Title: ENTERPRISE, STREAM-BASED,
INFORMATION MANAGEMENT
SYSTEM

REQUEST FOR INTER PARTES
REEXAMINATION OF U.S. PATENT
6,725,999 UNDER 35 U.S.C. § 311 AND
37 C.F.R. §§ 1.913, 1.915

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

**REQUEST FOR *INTER PARTES* REEXAMINATION OF U.S. PATENT
6,768,999**

TABLE OF CONTENTS

TABLE OF CONTENTS 2

TABLE OF EXHIBITS..... 4

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

REQUEST FOR *INTER PARTES* REEXAMINATION OF..... 5

I. REQUIREMENTS FOR INTER PARTES REEXAMINATION UNDER 37 C.F.R. § 1.915 6

 A. 37 C.F.R. § 1.915 (B)(3): STATEMENT POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY 6

 B. 37 C.F.R. § 1.915 (B)(4): COPY OF EVERY PATENT OR PRINTED PUBLICATION RELIED UPON TO PRESENT AN SNQ 7

 C. 37 C.F.R. § 1.915 (B)(5): COPY OF THE ENTIRE PATENT FOR WHICH REEXAMINATION IS REQUESTED 8

 D. 37 C.F.R. § 1.915 (B)(6): CERTIFICATION THAT A COPY OF THE REQUEST HAS BEEN SERVED IN ITS ENTIRETY ON THE PATENT OWNER..... 8

 E. 37 C.F.R. § 1.915 (A): FEE FOR REQUESTING REEXAMINATION 8

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 ‘999 PATENT AND ITS PROSECUTION HISTORY 9

 A. SUMMARY OF THE DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS OF THE ‘999 PATENT 9

 B. SUMMARY OF THE PROSECUTION HISTORY 10

V. CLAIM CONSTRUCTION 10

 A. STANDARD..... 10

 B. CLAIM TERMS 12

1.	DOCUMENT OBJECT MODELS . . . HAVING A CONSISTENT STRUCTURE	12
VI.	PRIORITY OF THE '999 PATENT	13
VII.	STATEMENT OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY	14
A.	FREEMAN ANTICIPATES CLAIM 1	15
1.	CLAIM 1	16
B.	MANDER ANTICIPATES CLAIM 1	19
1.	CLAIM 1	21
VIII.	CONCLUSION	23

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. 6,006,227 (“Freeman”)
PA-B	U.S. Patent No. 6,243,724 (“Mander”)

B. RELEVANT PATENT MATERIALS (PAT)

PAT-A	U.S. Patent No. 6,768,999 (“the ‘999 patent”)
PAT-B	File Wrapper for the ‘999 Patent
PAT-C	File Wrapper for the ‘227 Patent

C. CLAIM CHARTS (CC)

CC-A	Claim Chart showing claim 1 is anticipated by U.S. Patent No. 6,006,227 (“Freeman”)
CC-B	Claim Chart showing claim 1 is anticipated by U.S. Patent No. 6,243,724 (“Mander”)

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.
OTH-C	Mirror Worlds’ Objections And Responses To Apple’s First Set Of Interrogatories (Nos. 1-17) in <i>Mirror Worlds, LLC v. Apple Inc.</i> , Civil Action No. 6:-08-CV-88 (E.D. Tex), served March 24, 2009.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventors: Prager, et al.

Patent No.: 6,768,999

Filed: June 26, 2001

Title: ENTERPRISE, STREAM-BASED,
INFORMATION MANAGEMENT
SYSTEM

REQUEST FOR INTER PARTES
REEXAMINATION OF U.S. PATENT
6,725,999 UNDER 35 U.S.C. § 311 AND
37 C.F.R. §§ 1.913, 1.915

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

**REQUEST FOR *INTER PARTES* REEXAMINATION OF
U.S. PATENT 6,768,999**

Dear Sir:

Third Party Requester and Real Party in Interest, Apple Computer, Inc., hereby respectfully requests reexamination pursuant to 35 U.S.C. §§ 311 *et seq.* and 37 C.F.R. § 1.902 *et seq.* of Claim 1 of U.S. Patent No. 6,768,999 (“the ‘999 patent”) filed June 26, 2001 and issued July 27, 2004 to Randy Prager, 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 ‘999 patent is enforceable¹ and by asserting the SNQ herein, Requester specifically asserts that Claim 1 of

¹ As alleged by Patent Owner in the below defined Underlying Litigation, and as required by 37 C.F.R. § 1.510(a), the ‘999 patent is still within its period of enforceability for reexamination purposes, to the extent that the ‘999 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.

the '999 patent is in fact not patentable, and as such, the U.S. Patent and Trademark Office (the "Office") should reexamine and find Claim 1 unpatentable and cancel Claim 1 of the '999 patent, rendering Claim 1 of the '999 patent null, void and otherwise unenforceable.

I. REQUIREMENTS FOR INTER PARTES REEXAMINATION UNDER 37 C.F.R. § 1.915

Requester satisfies each requirement for *inter partes* reexamination of the '999 patent.

A. 37 C.F.R. § 1.915 (B)(3): STATEMENT POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY

A statement pointing out each SNQ based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to Claim 1 of the '999 patent is presented below in accordance with 37 C.F.R. § 1.915 (b)(3).

1. Freeman anticipates Claim 1

Requester respectfully submits that claim 1 of the '999 patent is anticipated by Freeman. The reference was not discussed or applied either by the Examiner or the Applicants during the original prosecution and raises a substantial new question of patentability with respect to claim 1 of the '999 patent because the reference is not cumulative of any art previously discussed or applied, 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, Freeman teaches every element of the claims, including "the particular combination of a DOM stream display in card format (browse cards) within pop-up windows (glance views) in response to the passing-over of a cursor," which was noted by the Examiner to be most responsible for allowance of the claims. Specifically, Freeman teaches that

[i]n one embodiment of the present invention 'browse cards' 100 are employed so that when the user touches a document in the stream-display with the cursor, a browse card appears. The purpose of the browse card is to help the user identify a document by providing the user some idea of the document's contents in a small window. The content of browse cards is an abbreviated version of a document which as been compressed into an micro-document like an index card. In one embodiment, the browse card creation operation does header stripping so that the browse card displays the first non-trivial words in a document. In another embodiment, complex

analysis is performed on the document contents so that ‘most important’ words, pictures and/or sounds are presented.

Freeman at 7:54-8:10. A claim chart setting forth the pertinency and manner of applying Freeman to claim 1 is submitted herewith as Exhibit CC-A.

2. Mander anticipates Claim 1

Requester respectfully submits that claim 1 of the ‘999 patent is anticipated by Mander. The reference was not discussed or applied either by the Examiner or the Applicants during the original prosecution and raises a substantial new question of patentability with respect to claim 1 of the ‘999 patent because the reference is not cumulative of any art previously discussed or applied, 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 teaches every element of the claim, including “the particular combination of a DOM stream display in card format (browse cards) within pop-up windows (glance views) in response to the passing-over of a cursor,” which was noted by the Examiner to be most responsible for allowance of the claims. Specifically, Mander teaches that

each document in the pile represented by the graphical representation may be a miniature of the first page of the actual document or an icon of the document type, a set of keywords related to the document or a set of attributes relating to the document. In this manner, the first page of the document serves as a proxy (indicia) indicating the content of the document, thereby providing the user with information concerning what the representation represents (i.e. what is contained within the document).

Mander at 7:1-12. A claim chart setting forth the pertinency and manner of applying Mander to claim 1 is submitted herewith as Exhibit CC-B.

B. 37 C.F.R. § 1.915 (B)(4): 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. §1.915(b)(4), as Exhibit PA-A and PA-B, citation of which may be found on the accompanying Form PTO-SB/08 at Exhibit PTO-SB/08. The cited prior art publications constitute effective prior art as to the claims of the ‘999 patent under 35 U.S.C. § 102.

C. 37 C.F.R. § 1.915 (B)(5): COPY OF THE ENTIRE PATENT FOR WHICH REEXAMINATION IS REQUESTED

A full copy of the '999 patent is submitted herein as Exhibit PAT-A and its corresponding file history is submitted as Exhibit PAT-B in accordance with 37 C.F.R. § 1.915(b)(5).

D. 37 C.F.R. § 1.915 (B)(6): 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. § 1.915(b)(6) at the following address:

COOPER AND DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

E. 37 C.F.R. § 1.915 (A): FEE FOR REQUESTING REEXAMINATION

In accordance with 37 C.F.R. § 1.915(a), a credit card authorization to cover the fee for reexamination of \$8,800.00 is attached. 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 '999 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”) and U.S. Patent No. 6,638,313 (“the ‘313 patent”), which claims priority to the ‘227 patent. The ‘999 patent is a continuation-in-part of the ‘313 patent. Requester is also concurrently submitting requests for *inter partes*

reexaminations of U.S. Patent No. 6,725,427 (“the ‘427 Patent”), which is a division of the ‘313 patent.

IV. OVERVIEW OF THE ‘999 PATENT AND ITS PROSECUTION HISTORY

A. SUMMARY OF THE DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS OF THE ‘999 PATENT

The ‘999 patent issued on July 27, 2004 to inventors Prager and Sparago. The ‘999 patent is a continuation-in-part of U.S. Patent No. 6,638,313 (issued on October 29, 2003), which is in turn a continuation of U.S. Patent 6,006,227 (issued on December 21, 1999).

The ‘999 patent is generally directed to a computer system for managing information. In contrast to traditional information management systems which “store and retrieve documents on the basis of attributes such as the name and storage location of a document,” the ‘999 patent describes an approach that relies “primarily on an intuitive, time-associated way of dealing with information.” ‘999 patent at 1:45-65. Its system is “stream-based in that it creates time-ordered streams of information items or assets, beginning with the oldest and continuing through current and on to future items.” ‘999 patent at 1:65-2:1.

The preferred embodiment of the ‘999 patent includes a document object model (DOM) that “can be thought of as a document shell of the information asset (IA) that contains, anon [sic] other items, a thumbnails of the information asset, permission rights, and metadata.” ‘999 patent at 5:10-14. The DOM is stored on a desktop computer or a server and is stored either independently or with a copy of the IA. ‘999 patent at 5:14-17. The system also generates “browse cards” or “glance views” that provide information about the underlying IA and are used to represent the IA graphically to a user. ‘999 patent at 12:63-13:6. The “browse cards” or “glance views” are displayed in a time ordered stream to users. ‘999 patent at 13:13-30. When the mouse pointer passes over the “browse card” or “glance view,” the full “browse card” or “glance view” is displayed and allows the client to perform actions on the “browse card” or “glance view” for which they have the proper permission. ‘999 patent at 13:31-42.

As issued, the ‘999 patent has only 1 claim, which reads:

A method of operating an enterprise information management system comprising at least one server and a number of personal computers selectively communicating with each other comprising:

creating document object models comprising selected information from and about information assets of diverse types, created by diverse software, said document object models having a consistent structure;

displaying browse cards related to respective ones of the information assets in a time-ordered stream, together with glance views related to the document object models of the respective displayed documents, said glance views being displayed essentially in real time in response to passing a cursor over respective ones of the browse cards.

Requester submits that the '999 was improperly allowed in view of the fact that the Freeman patent, to which the '999 improperly claims priority, as well as the Mander patent, each anticipate all the limitations of Claim 1 of the '999 patent.

B. SUMMARY OF THE PROSECUTION HISTORY

The '999 patent is a continuation-in-part of U.S. Patent No. 6,638,313, which is a continuation of U.S. Patent No. 6,006,227. The application that led to the '999 patent was filed on 6/26/2001. Unlike the '227 patent, the '999 patent was allowed after very brief examination.

Prior to any formal action by the Examiner, the Applicants filed two Information Disclosure Statements. PAT-B, Pros. His., papers 5 & 6, 5/8/2003 & 7/21/2003. Without ever issuing an Office Action, the Examiner issued a Notice of Allowability for the only pending claim. The Examiner noted that many of the claim elements were well-known in the art, but that "the particular combination of a DOM stream display in card format (browse cards) within pop-up windows (glance views) in response to the passing-over of a cursor is neither anticipated nor suggested by the prior art." PAT-B, Pros. His., paper 7, 3/10/2004, p. 2.

V. CLAIM CONSTRUCTION

A. STANDARD

Requester notes that the '999 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 '999 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 '999 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 '999 patent, the Requester has applied certain claim constructions presented by the Patent Owner during prosecution of patents related to the '999 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 that the claim terms presented below should be construed no narrower than presented herein for purposes of this proceeding.

1. DOCUMENT OBJECT MODELS . . . HAVING A CONSISTENT STRUCTURE

In the concurrent litigation, Patent Owner has construed the "document object model . . . having a consistent structure" limitation as covering the linking of data units according to the chronological indicators to generate one or more streams of data units in a stream-based operating system. For instance, in the concurrent litigation, Patent Owner has alleged that Requester's product APPLE COMPUTERS WITH COVER FLOW AND SPOTLIGHT meet the "document object models . . . having a consistent structure" limitation for exactly the same reasons that Requester's products meet the limitations of claim 1 of the '227 patent relating to the organization of data units by including them in a main stream according to the timestamp associated with that data unit. OTH-B, Attachment D-1, p. 54 (alleging that Requester's products meet the "document object models . . . having a consistent structure" limitation solely by cross-referencing allegations that Requester's products meet the limitations of claim 1 of the '227 patent)(citing Attachment A-1, pg. 1-7). This is consistent with the '999 patent's description of document object models as containing timestamps that govern where the

underlying information asset (i.e. data unit) is placed in a stream of documents. '999 patent at 6:37-50 (“Figs. 3 and 4 illustrate methods of creating document object models [“DOMs”] from information assets. ... At Step S305, agents specific to the disclosed embodiment of the system known as Scopeware 2.0 translate the IA into a DOM, i.e., create a DOM shell for the IA, with attributes as discussed in connection with FIG. 2. At step S306, Scopeware agents translate the IA modifications into an updated DOM and time-stamp the change so the new time-stamp becomes a part of the DOM and the modified IA can be placed in the stream of documents at a place reflecting the new time-stamp.”)

As demonstrated by its own application of “document object model . . . having a consistent structure,” Patent Owner believes that the broadest reasonable construction of the document object model limitation, like the “chronological indicator” limitation in the ‘227 patent, includes the means of linking of data units into a stream according to their timestamp. As will be established by the arguments presented below, applying this broadest reasonable construction of the “document object model” limitation, this limitation was well known in the art at the time of Patent Owner’s alleged invention, as was recognized by the Examiner in the Notice of Allowability.

VI. PRIORITY OF THE ‘999 PATENT

The ‘999 patent claims priority to the June 28, 1996 filing of the application that lead to the ‘227 patent. The Patent Owner initially relied on June 28, 1996 as the priority date for claim 1 of the ‘999 patent in the concurrent litigation. OTH-B, p. 5 (“The asserted claim of United States Patent No. 6,768,999 is entitled to a priority date of June 28, 1996.”). However, Patent Owner has recently taken the position that “the invention claimed in United States Patent No. 6,768,999 was conceived within the year prior to March 9, 2001, and constructively reduced to practice on June 26, 2001.” OTH-C, p. 5.

Patent Owner is not entitled to claim priority back to the ‘227 patent. Pursuant to 35 U.S.C. § 120, “[a]n application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States ... which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application,” if certain additional conditions are met. 35 U.S.C. § 120 (emphasis added). In other words, the statute requires that an application

seeking the benefit of priority to a prior application must share with that prior application at least one inventor named in the previously filed application. This statutory requirement is further codified in 37 C.F.R. § 1.78(a)(1), which clarifies that “[i]n order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application.” 37 C.F.R. § 1.78(a)(1) (emphasis added).

The requirement that a later-filed application share at least one inventor with a previously filed application in order to claim priority back to that application is not met by the ‘999 patent. The ‘227 patent to which the ‘999 patent claims priority names Eric Freeman and David H. Gelernter as inventors. Likewise, the ‘313 patent, of which the ‘999 patent is a continuation-in-part, names Eric Freeman and David H. Gelernter as inventors. In contrast, the ‘999 patent names only Randy Prager and Peter Sparago as inventors. There is no common inventor between the ‘227 or ‘313 patents and the ‘999 patent. Accordingly, under 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(1), claim 1 of the ‘999 patent is not entitled to any benefit from any prior application’s filing date.

VII. STATEMENT OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

The ‘999 patent was allowed with no rejections ever issued by the Examiner. As recognized by the Examiner during prosecution of the ‘999 patent, the concepts at the heart of the ‘999 patent were well-known in the art and were not novel at the time of the invention. As such, the Examiner made clear that the reason for allowing the ‘999 patent was not the Document Object Model (DOM), file navigation with thumbnail sketches, index cards, and pop-up windows elements described in the ‘999 patent, but rather, the specific combination of browse cards and glance views described therein:

A number of elements on the claim are well known in the art including the Document Object Model (DOM), file navigation with thumbnail sketches, index cards, pop-up windows...The particular combination of a DOM stream displayed in card format (browse cards) within pop-up windows (glance views) in response to the passing-over of a cursor is neither anticipated nor suggested by the prior art of record.

PAT-B, Pros. His., paper No. 7, Notice of Allowability, mailed 3/10/04.

The claim limitation that provided the Examiner with this reason for allowance requires “displaying browse cards related to respective ones of the information assets in a

time-ordered stream, together with glance views related to the document object models of the respective displayed documents, said glance views being displayed essentially in real time in response to passing a cursor over respective ones of the browse cards.” As will be established by the arguments presented below, this limitation was well known in the art years prior to Patent Owner’s proper priority date. Patent Owner’s own ‘227 patent clearly discloses the “glance view in response to the passing-over of a cursor” limitation the Examiner noted as the basis for allowance. In addition, the Mander reference provides detailed disclosure of a stream of documents displayed in card format (browse cards) within pop-up windows (glance views) in response to the passing-over of a cursor. While the Mander reference was initialed by the Examiner without comment, there is no indication in the prosecution history that the Examiner was aware that Mander clearly disclosed the very combination— documents “displayed in card format (browse cards) within pop-up windows (glance views) in response to the passing-over of a cursor” —that the Examiner credited as the reason for allowance.

As set forth in detail below, Claim 1 of the ‘999 patent is fully anticipated under 35 U.S.C. § 102 by the prior art references cited herein, which are discussed in a new light from the original prosecution of the ‘999 patent application. Claim 1 of the ‘999 patent is set forth in detail in the attached claim charts (Exhibits CC-A and CC-B) that compare the limitations of Claim 1 of the ‘999 patent to the pertinent prior art references. As the claim charts demonstrate, Claim 1 is unpatentable under 35 U.S.C. § 102 in view of Freeman and in view of Mander under any reasonable interpretation of the claims.

A. FREEMAN ANTICIPATES CLAIM 1²

As noted above, the ‘227 patent names Freeman and Gelernter as inventors and was filed on June 28, 1996 and issued on December 21, 1999.

The ‘227 Patent (“Freeman”) is generally directed to an operating system in which documents are stored in chronologically ordered streams such that the location and nature of file storage is transparent to the user. *See, e.g.*, Freeman at Abstract.

Freeman 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”:

² 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 Freeman in Exhibit CC-A to assist the Office.

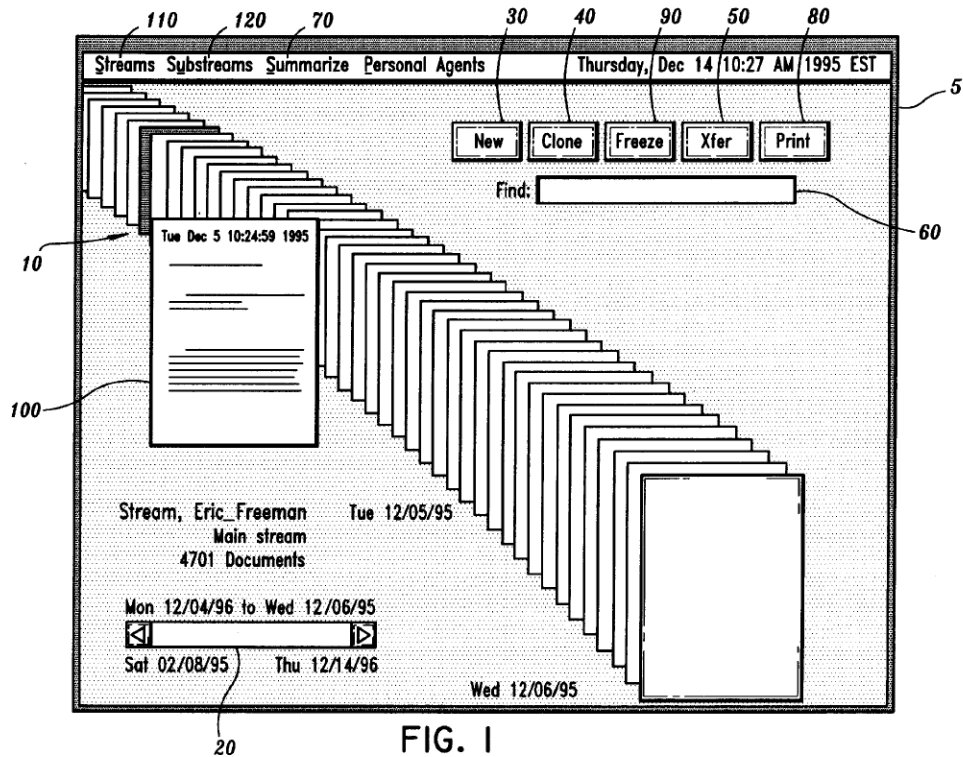


FIG. 1

Freeman at Figure 1, 6:30-36. 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; claim 25 (“means for selecting one or more of the document representations with a pointing device so that the data units represented by the selected document representations are further displayed with a second document representation comprising an alternative version of the content of the respective data unit.”).

1. CLAIM 1

1. A method of operating an enterprise information management system comprising at least one server and a number of personal computers selectively communicating with each other comprising:

Freeman discloses a method of operating an enterprise information management system comprising at least one server and a number of personal computers selectively communicating with each other, including at least one embodiment that “utilizes a machine-independent, client/server open architecture.” Specifically, Freeman discloses at least one embodiment that “utilizes a machine-independent, client/server open architecture” and an embodiment that is implemented in a client/server architecture over

the Internet. Freeman at 3:62-4:5; 6:8-13; *see also, e.g.*, Freeman at 2:49-61; 3:10-12; 14:17-21.

creating document object models comprising selected information from and about information assets of diverse types, created by diverse software, said document object models having a consistent structure;

As described in more detail in Section V.B above (Claim Construction), the broadest reasonable construction of “document object models . . . having a consistent structure” includes the means of linking of diverse data units into a stream according to their timestamp, such as through a chronological indicator. Applying this broadest reasonable construction, Freeman discloses “creating document object models . . . having a consistent structure” by disclosing “a method of organizing one or more data units is provided including the steps of: (1) receiving one or more data units, each of which is associated with one or more chronological indicators; and (2) linking each of the data units according to the chronological indicators to generate one or more streams of data units.” ‘227 patent at 3:14-24. The chronological indicators of Freeman comprise timestamps from and about the underlying data units (i.e. information assets) and have a consistent structure in that they consistently use timestamps to link data units of diverse types into streams.

Thus, under the broadest reasonable construction of the limitation, Freeman discloses “document object models . . . having a consistent structure.” Indeed, as described in Section V.B above, Patent Owner has alleged that Requester’s products meet the “document object models . . . having a consistent structure” limitation solely by cross-referencing allegations that Requester’s products meet the limitations of claim 1 of the ‘227 patent). OTH-B, Attachment D-1, p. 54. Freeman also discloses that the information assets are of diverse types such as “traditional text based files, electronic mail files, binary files, audio data, video data, and multimedia data.” Freeman at 14:33-36; *see also, e.g.*, Freeman at 4:16-21; 11:5-7; 11:8-9; 11:15-17; 11:27-29; 11:44-45; 12:3-6; 12:51-55; 12:62-64; claims 3, 17. Further, Freeman discloses that the information assets created by diverse software (e.g., “external applications are used to view and edit documents . . . for example, conventional UNIX application[s] such as emacs, xv, and ghostview” and “applications such as QUICKEN”). Freeman at 6:45-52; 12:31-37.

displaying browse cards related to respective ones of the information assets in a time-ordered stream, together with glance views related to the document object models of the respective displayed documents, said glance views being displayed essentially in real time in response to passing a cursor over respective ones of the browse cards.

Freeman discloses displaying browse cards related to respective ones of the information assets in a time-ordered stream:

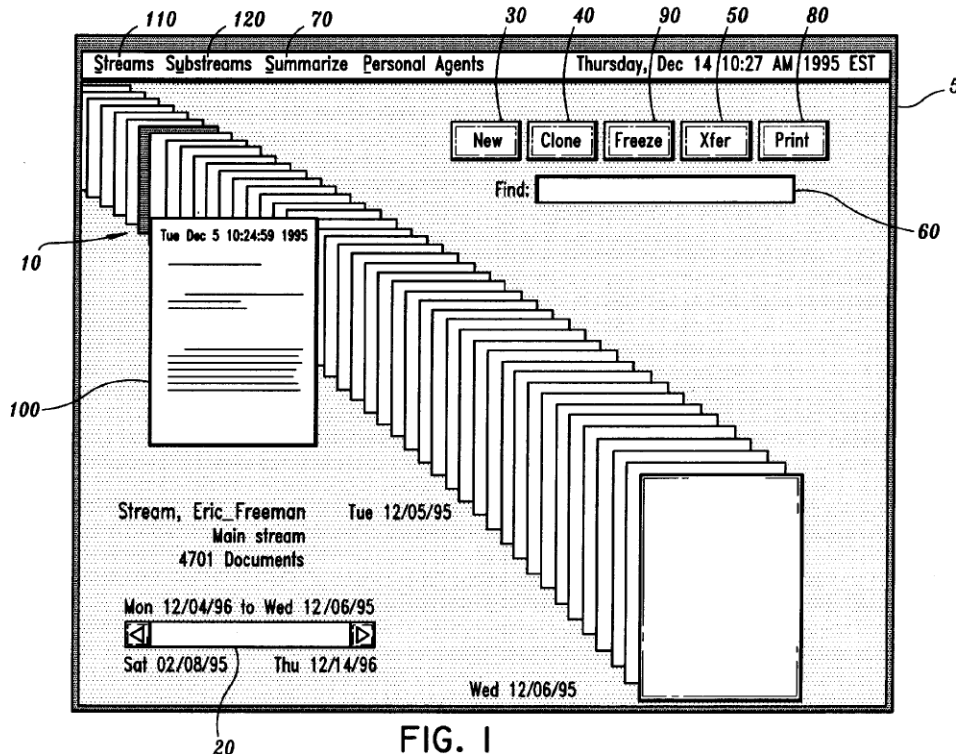


FIG. 1

Freeman at FIG. 1, 6:30-36; *see also*, e.g., Freeman at 7:54-8:10 (“In one embodiment of the present invention ‘browse cards’ 100 are employed so that when the user touches a document in the stream-display with the cursor, a browse card appears. The purpose of the browse card is to help the user identify a document by providing the user some idea of the document's contents in a small window. The content of browse cards is an abbreviated version of a document which as been compressed into an micro-document like an index card. In one embodiment, the browse card creation operation does header stripping so that the browse card displays the first non-trivial words in a document. In another embodiment, complex analysis is performed on the document contents so that ‘most important’ words, pictures and/or sounds are presented.”); claim 25.

Freeman further discloses glance views related to the document object models of the respective displayed documents, which glance views are displayed essentially in real

time in response to passing a cursor over respective ones of the browse cards. Specifically, Freeman discloses that, in the embodiment shown in Figure 1, “[u]sers can slide the mouse pointer 10 over the document representation to ‘glance’ at each document.” Freeman at FIG. 1; 6:30-36; *see also, e.g.*, Freeman at claim 25 (“means for selecting one or more of the document representations with a pointing device so that the data units represented by the selected document representations are further displayed with a second document representation comprising an alternative version of the content of the respective data unit”).

B. MANDER ANTICIPATES CLAIM 1³

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 ‘999 patent, it was not applied. Here, Mander is discussed in a new light from the original prosecution of the ‘999 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; 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.

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; 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

³ 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-B to assist the Office.

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. 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 (“the user selects the option of collecting items which are dated April 19, 1991 . . .”).

Just as in the ‘999 patent, document object models are created in the form of internal representations of each file. The internal representations contain vectors which are representative of the words contained in the file, as well as thumbnails for every non-system file on the computer. Mander at Abstract; 4:8-13; 11:54-60; 24:8-22. Such non-system files may include, but are not limited to, text documents, email documents, spreadsheets, digitized movies, and digitized sound. Mander at 8:14-28; 11:54-60; 22:24-27; 36:32-37; 36:54-55. Such diverse files may be created by diverse software. Mander at 10:55-61; 36:65-37:4. The method of indexing all files to form internal representations of each file provides for all document object models to have a consistent structure. Mander at 24:22-53.

Mander also discloses a variety of visualization options for piles and the documents within them. Not only does Mander disclose scripts which describe the contents and/or organization of a particular pile, but Mander also 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.

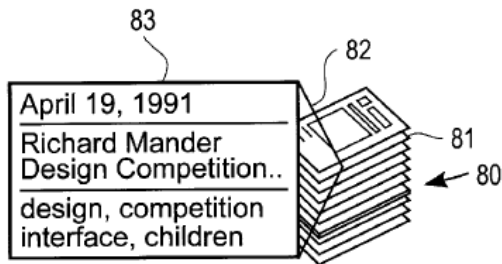


FIG. 4f

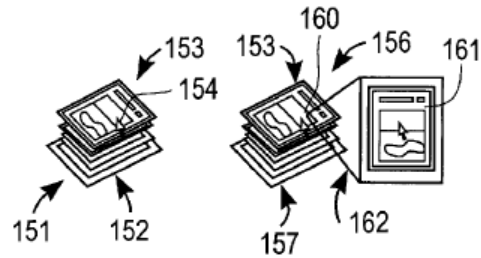


FIG. 4a

Further, Mander discloses displaying browse cards related to the diverse files in a time-ordered stream. Mander at Abstract; 33:34-36; FIGS. 2a, 2b, 2c and 2d. Additionally, the system displays glance views related to the document object models of the respective displayed documents in real time in response to passing a cursor over a particular browse card. Mander at 3:20-25; 7:1-12; 10:15-20.

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 of the '999 Patent- organizing and displaying files in a computer network system according to internal representation vectors, and allowing glance views of said files. Indeed, Mander anticipates claim 1 of the '999 patent. A detailed application of the prior art to each element of the requested claims is presented in Exhibit CC-B and below.

1. CLAIM 1

1. A method of operating an enterprise information management system comprising at least one server and a number of personal computers selectively communicating with each other comprising:

Mander discloses a method of operating an enterprise information management system comprising at least one server and a number of personal computers, defined as "multiple computer systems, each with disclosed filing system, each having a graphical user interface which includes graphical representations of documents, and each of which is connected to a network server." Specifically, Mander discloses multiple computer

systems (e.g., “the user will not typically know the content of a mail message received from another computer user”), each with disclosed filing systems (e.g., “the filing system of the computer”), a graphical interface which includes graphical representations of documents (e.g., “graphical user interface which includes graphical representations of documents”), and each of which is connected to a network server (e.g., “network system or other electronic mail system”). Mander at 2:63-66; 3:31-36; 8:14-28. Mander further discloses a server (e.g., “electronic mail network”) and a number of personal computers selectively communicating with each other (e.g., “In the case of electronic mail, the user will not typically know the content of a mail message received from another computer user”). Mander at Abstract; 8:14-28.

creating document object models comprising selected information from and about information assets of diverse types, created by diverse software, said document object models having a consistent structure;

Mander discloses creating document object models having a consistent structure. Specifically, Mander discloses a “method ... for indexing documents” creating “internal representations” which contain “a vector which is representative of the words contained in the document” and thumbnails (e.g., “proxies which are shown within the view cone”) for “every document...in the system.” Mander at Abstract; 4:8-13; 11:54-60; 24:8-53. Additionally, Mander discloses that “[t]he methods employed in steps 703, 705, 707, 709 and 711 are known in the art and various ways of determining an internal (or content) representation of a document are available in the information retrieval art.” Mander at 26:20-26.

Mander discloses information assets of diverse types from diverse software such as “text documents,” “electronic mail documents,” “spreadsheets,” “digitized movies,” and “digitized sound.” Mander at 8:14-28, 11:54-60, 22:24-27, 36:32-37, and 36:54-55.

displaying browse cards related to respective ones of the information assets in a time-ordered stream, together with glance views related to the document object models of the respective displayed documents, said glance views being displayed essentially in real time in response to passing a cursor over respective ones of the browse cards.

Mander discloses displaying browse cards related to respective ones of the information assets (e.g., “[t]he method and apparatus include the creation of a pile

comprising a collection of documents and displaying a graphical representation of the collection of documents”) in a time-ordered stream (e.g., “[t]hen 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 Abstract; 33:34-36; FIGS. 2a, 2b, 2c and 2d.

Mander further discloses glance views (e.g., “a proxy”) related to the document object models of the respective displayed documents. Specifically, “each document in the pile represented by the graphical representation may be a miniature of the first page of the actual document or an icon of the document type, a set of keywords related to the document or a set of attributes relating to the document. In this manner, the first page of the document serves as a proxy (indicia) indicating the content of the document, thereby providing the user with information concerning what the representation represents (i.e. what is contained within the document).” Mander at 7:1-12.

The glance views (e.g., “proxies”) in Mander are displayed essentially in real time (e.g., “predetermined period of time” which may be significantly short) in response to passing a cursor over respective ones of the browse cards. Specifically, “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.” Mander at 3:20-25; 10:15-20.

VIII. CONCLUSION

The prior art document presented in the above Request is being presented in a new light pursuant to MPEP §2642 (II). The claims of the ‘999 patent are not patentable over the Freeman and Mander patents cited herein.

In view of the foregoing, it is respectfully submitted that a substantial new question of patentability of Claim 1 of Patent No. 6,768,999 has been raised by this Request. Accordingly, the Office is requested to grant this Request and to initiate reexamination with special dispatch. Claim 1 should be reexamined, rejected under 35 U.S.C. § 102, and canceled pursuant to this Request.

As an aid to the application of the presented prior art to Claim 1 of the ‘999 patent, corresponding claim charts are provided as 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.

NOVAK DRUCE + QUIGG, LLP
1000 Louisiana Ave.
53rd Floor
Houston, Texas 77002
P: 713-571-1500
F: 713-456-2836

Respectfully submitted,

/Tracy W. Druce/

Novak Druce & Quigg, LLP
Donald J. Quigg
Reg. No. 16,030
Tracy W. Druce
Reg. No. 35,493
James P. Murphy
Reg. No. 55,474
Brian K. McKnight
Reg. No. 59,914
Attorneys for Third Party Requester

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Request for *Inter Partes* 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:

COOPER AND DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

/Johanna Weir/

Johanna Weir