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95/001,261	11/13/2009	7139761

CONFIRMATION NO. 5286
ASSIGNMENT NOTICE

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Date Mailed: 11/18/2009

NOTICE OF ASSIGNMENT OF *INTER PARTES* REEXAMINATION REQUEST

The above-identified request for *inter partes* reexamination has been assigned to Art Unit 3992. All future correspondence in this proceeding should be identified by the control number listed above and directed to: Mail Stop Inter Partes Reexam, Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.

A copy of this Notice is being sent to the latest attorney or agent of record in the patent file or, if none is of record, to all owners of record. (See 37 CFR 1.33(c).) If the addressee is not, or does not represent, the current owner, he or she is required to forward all communications regarding this proceeding to the current owner(s)

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Attorney Docket No. 309101-203

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent No. 7,139,761)
)
) Examiner: Not Yet Assigned
Filed: December 10, 2003)
) Art Unit: Not Yet Assigned
Issued: November 21, 2006)
) Customer No.: 58249
For: DYNAMIC ASSOCIATION OF)
ELECTRONICALLY STORED)
INFORMATION WITH ITERATIVE)
WORKFLOW CHANGES)
)
Requester: Facebook, Inc.)

Mail Stop *Inter Partes* Reexamination
Commissioner for Patents
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Alexandria, VA 22313-1450

**REQUEST FOR *INTER PARTES* REEXAMINATION
UNDER 35 U.S.C. §§ 311 ET SEQ. AND 37 CFR § 1.902 ET SEQ.**

Dear Sir or Madam:

Pursuant to 35 U.S.C. §§ 311 *et seq.* and 37 C.F.R. § 1.902 *et seq.*, the undersigned, on behalf of Facebook, Inc., hereby requests an *inter partes* reexamination of claims 1-16, 21, 23-26, 29, 31-34 of U.S. Patent No. 7,139,761 (the “’761 patent”) to Michael McKibben et al. A copy of the ’761 patent is attached as **Exhibit A**. The ’761 patent issued on November 21, 2006 from an application filed in the United States on December 10, 2003.

The ’761 patent is currently involved in a pending *ex parte* reexamination proceeding (Control No. 90/010,591), assigned to Examiner Deandra M. Hughes. In the event the PTO grants the present Request, the Requester respectfully requests that the two reexaminations be merged so both can proceed expeditiously.

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

Pursuant to 37 C.F.R. §§ 1.913 and 1.915, each requirement for *Inter Partes* Reexamination of the '761 patent is satisfied. The application for the '761 patent was filed on December 10, 2003. As a patent issuing from an original application filed after November 29, 1999, the '761 patent qualifies for *Inter Partes* Reexamination. See 37 C.F.R. § 1.913.

A. Payment of Fees – 37 C.F.R. § 1.915(a)

The Requester authorizes the Patent and Trademark Office to charge the Deposit Account 50-1283 associated with the Customer Number listed on the face of this Request for the fees set forth in 37 C.F.R. § 1.20(c)(2).

B. Identification of Claims for *Inter Partes* Reexamination – 37 C.F.R. § 1.915(b)(1)

Facebook requests *inter partes* reexamination of claims 1-16, 21, 23-26, 29, 31-34 of the '761 patent. Detailed explanations of the pertinence and manner of applying the prior art references to each claim for which reexamination is requested may be found below under Section VII, beginning on page 27.

C. Citation of Prior Art Presented – 37 C.F.R. § 1.915(b)(2)

PTO Form SB/08a, filed concurrently herewith, identifies the patents and printed publications upon which this Request is based. A complete copy of each listed patent and printed publication is included herewith. This Request for reexamination is based on the following patents and printed publications:

Exhibit B: Christopher K. Hess & Roy H. Campbell, *A Context File System for Ubiquitous Computing Environments*, published by the Department of Computer Science, University of Illinois at Urbana-Champaign, July 2002 (“Hess”)

Exhibit C: U.S. Patent No. 6,430,575 B1 to J. Paul Dourish et al. entitled “Collaborative Document Management System with Customizable Filing Structures that are Mutually Intelligible,” issued on August 6, 2002 from an application filed in the United States on September 10, 1999 (“Dourish”)

- Exhibit D:** European Patent Application EP 1 087 306 A2 to Laurence Hubert et al. entitled “Meta-Documents and Method of Managing Them,” filed on August 29, 2000 and published internationally on March 28, 2001 (“Hubert”)
- Exhibit E:** iManage, Inc., *iManage DeskSite 6.0 User Reference Manual*, 2001, Chapters 1-5 (“iManage”)
- Exhibit F:** U.S. Patent No. 6,236,994 B1 to Ronald M. Swartz et al., entitled “Method and Apparatus for the Integration of Information and Knowledge,” issued in the United States on May 22, 2001
- Exhibit G:** U.S. Patent No. 6,434,403 B1 to Michael R. Ausems et al. entitled “Personal Digital Assistant with Wireless Telephone,” issued on August 13, 2002 from an application filed in the United States on February 19, 1999 (“Ausems”)
- Exhibit H:** Microsoft Press, *Microsoft Computer Dictionary* (3d ed. 1997), pages 403-04, 462, 487, 505-506, 511-512 (“Microsoft”)
- Exhibit I:** U.S. Patent Application Pub. No. 2003/0120660 to L. Michael Maritzen entitled “Consumer-Centric Context-Aware Switching Model,” filed in the United States on December 7, 2001 and published on June 26, 2003 (“Maritzen”)

D. Listing of Substantial New Questions – 37 C.F.R. § 1.915(b)(3)

This Request is based upon the newly cited prior art documents identified on the accompanying Patent and Trademark Office Form SB/08a. None of these references were cited or considered during the original prosecution. Therefore, each raises a substantial new question of patentability (“SNQ”). Each of these prior art references constitutes effective prior art vis-à-vis claims 1-16, 21, 23-26, 29, 31-34 under 35 U.S.C. § 102 and/or 35 U.S.C. § 103. The detailed identification of each new SNQ is provided in Part VI, beginning at page 22. The SNQs presented by this Request are listed below:

No.	SNQs (Written as Proposed Rejections for the '761 Patent)
1	Whether claims 1-13, 16, 21, 23-26, 29, 31-34 are anticipated by Christopher K. Hess and Roy H. Campbell, <i>A Context File System for Ubiquitous Computing Environments</i> (July 2002) under 35 U.S.C. § 102(b).
2	Whether claims 1-15, 21, 23-26, 29, 31-34 are anticipated by U.S. Patent No. 6,430,575 B1 to J. Paul Dourish et al. under 35 U.S.C. § 102(b).
3	Whether claims 1-15, 21, 23-26, 29, 31-34 are anticipated by EP 1 087 306 A2 to Laurence Hubert et al. under 35 U.S.C. § 102(b).

No.	SNQs (Written as Proposed Rejections for the '761 Patent)
4	Whether claims 1-2, 4-15, 21, 23-26, 29, 32-34 are anticipated by iManage, Inc., <i>iManage DeskSite 6.0 User Reference Manual</i> , December 17, 2002, Chapters 1-5, under 35 U.S.C. § 102(b).
5	Whether claim 3 is anticipated by U.S. Patent No. 6,236,994 to Robert M. Swartz et al. under 35 U.S.C. § 102(b).
6	Whether claims 9-15, 21, 23-26, 31-34 are obvious over Hess in view of Microsoft Press, <i>Microsoft Computer Dictionary</i> , pages 462, 487, 505-06 (3d ed. 1997).
7	Whether claim 16 is obvious over any one of Dourish, Hubert or iManage in view of U.S. Patent No. 6,434,403 B1 to Michael R. Ausems.
8	Whether claim 31 is obvious over any one of Hess, Dourish or iManage in view of Microsoft Press, <i>Microsoft Computer Dictionary</i> , pages 403-04 (3d ed. 1997).
9	Whether claims 1-16, 21, 23-26, 29, 31-34 are obvious in view of the combination of Hess and Dourish.
10	Whether claims 1-15, 21, 23-26, 29, 31-34 are obvious over Hubert in view of U.S. Patent Appl. Pub. 2003/0120660 to L. Michael Maritzen.

Detailed explanations of the pertinence and manner of applying the prior art references to each claim for which reexamination is requested is set forth in this Request under Section VII, beginning on page 27.

E. Copy of Prior Art and Translations – 37 C.F.R. § 1.915(b)(4)

Copies of every patent and printed publication relied upon in this Request are included as Exhibits as required by 37 C.F.R. § 1.915(b)(4).

F. Copy of U.S. Patent No. 7,139,761 – 37 C.F.R. § 1.915(b)(5)

Attached as **Exhibit A** is a copy of the '761 patent as required by 37 C.F.R. § 1.915(b)(5). To Requester's knowledge, the '761 patent is in force. The Requester is aware of no disclaimer, certificate of correction, or reexamination certificate. 37 C.F.R. § 1.915(b)(5).

G. Certification of Service on Patent Owner – 37 C.F.R. § 1.915(b)(6)

The undersigned certifies that a complete and entire copy of this Request for *Inter Partes* Reexamination and all supporting documents have been provided to the patent owner by serving the attorneys/agents of record at the Patent Office for the '761 patent:

KING AND SPALDING LLP
1700 Pennsylvania Ave, NW
Suite 200
Washington DC 20006

Eric D. Jorgenson
1457 King Road
Hinckley OH 44233

H. Certification That Estoppel Does Not Prohibit *Inter Partes* Reexamination – 37 C.F.R. § 1.915(b)(7)

Facebook hereby certifies that it is not prohibited under the provisions of 35 U.S.C. § 317 or 37 C.F.R. § 1.907 from filing this Request for *Inter Partes* reexamination. Neither Facebook nor those in privity with Facebook have previously requested *Inter Partes* reexamination of the '761 patent. 35 U.S.C. § 317(b); 37 C.F.R. § 1.907.

I. Statement Identifying Real Party in Interest – 37 C.F.R. § 1.915(b)(8)

Facebook, as the real party in interest, requests reexamination of the '761 patent in view of the SNQs explained in detail below. Facebook reserves all rights and defenses available including, without limitation, defenses as to invalidity and unenforceability. By filing this Request in compliance with the Patent Rules, Facebook does not represent, agree, or concur that the '761 patent is enforceable. Facebook specially asserts that the claims of the '761 patent are in fact not patentable and as such the Patent and Trademark Office should reexamine and find them unpatentable and cancel those claims, rendering them null, void, or otherwise unenforceable.

II. IDENTIFICATION AND STATUS OF PENDING LITIGATION INVOLVING THE '761 PATENT

The '761 patent is the subject of pending litigation; in particular:

- Leader Technologies, Inc. v. Facebook, Inc., No. 1:08-CV-00862 JJF, filed November 19, 2008 in the United States District Court for the District of Delaware. Facebook has

VIII. LIST OF EXHIBITS

The following is a list of exhibits filed with this Request:

- Exhibit A:** U.S. Patent No. 7,139,761 to Michael McKibben et al.
- Exhibit B:** Christopher K. Hess & Roy H. Campbell, *A Context File System for Ubiquitous Computing Environments*, Department of Computer Science, University of Illinois at Urbana-Champaign, July 2002
- Exhibit C:** U.S. Patent No. 6,430,575 B1 to J. Paul Dourish et al.
- Exhibit D:** European Patent Application EP 1 087 306 A2 to Laurence Hubert et al.
- Exhibit E:** *iManage DeskSite 6.0 User Reference Manual*, 2001, Chapters 1-5
- Exhibit F:** U.S. Patent No. 6,236,994 B1 to Ronald M. Swartz et al.
- Exhibit G:** U.S. Patent No. 6,434,403 B1 to Michael R. Ausems et al.
- Exhibit H:** Microsoft Press, *Microsoft Computer Dictionary* (3d ed. 1997), pages 403-04, 462, 487, 505-506, 511-512
- Exhibit I:** U.S. Patent Application Pub. No. 2003/0120660 to L. Michael Maritzen
- Exhibit J:** Affidavit of Christopher Butler, dated October 29, 2009

IX. CONCLUSION

The claims of the '761 patent are not patentable over the prior art cited in this Request. The prior art discloses, teaches or suggests the subject matter of the '761 patent in such a manner that SNQs are raised for each of claims 1-16, 21, 23-26, 29, 31-34. The Requester respectfully requests that the PTO grant this Request and return a first Office Action rejecting claims 1-16, 21, 23-26, 29 and 31-34 in accordance with the proposed rejections listed in Part I(D) starting at page 5 above, with special dispatch.

Dated: November 13, 2009

Respectfully submitted,

/Heidi L. Keefe/

Heidi L. Keefe

Reg. No. 40,673