

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Owner:	Affinity Labs of Texas, LLC	§	Group Art Unit:	3992
Reexamination Control No:	95/001,281	§		
Filed:	December 15, 2009	§	Examiner:	Colin M. LaRose
For:	U.S. Patent No. 7,634,228	§	Atty. Dkt. No.:	AFF.004B7US

Mail Stop: *Inter Partes* Reexam  
Attn: Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR REHEARING**

Patent Owner submits this Request For Rehearing in response to the Board’s June 30, 2014 Decision on Appeal in the above-identified reexamination proceeding. Under 37 C.F.R. § 41.79, a “request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the Board’s opinion reflecting its decision.” In this case, the Decision overlooks that 1) an earlier Board decision found that the ‘228 Patent was entitled to the March 2000 priority date; and 2) the Office has already ruled that this panel is estopped from considering claims 3 and 22-30.

Date of Deposit: <u>July 29, 2014</u> I hereby certify under 37 C.F.R. § 1.8 this correspondence is being deposited <b>via EFS</b> on the date indicated above.  _____ /timothy g newman/ Timothy G. Newman
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**I. The Board Has Already Decided That The ‘228 Patent Is Entitled To The March 28, 2000 Filing Date**

This panel found that the ‘228 Patent was not entitled to the filing date of its parent. Decision at 9-10. However, in the related reexamination of U.S. Patent No. 7,486,926<sup>1</sup> the current Examiner had made the same rejection – that the claim language “to communicate data to a different electronic device that has an associated display to allow the different electronic device to present a selectable representation of the particular selectable icon on the associated display, and to begin playing the particular audio file at the portable audio file player in connection with a user selecting the selectable representation from the associated display” was not supported by the specification.

The Board reversed the Examiner:

We agree with [Affinity] that the cited disclosures in the specification of the ‘812 application provide sufficient written description support for the disputed claim limitation recited in independent claims 1 and 11 of the ‘926 patent ... the cited disclosures in both the ‘926 patent and the ‘812 application reasonably convey to one with ordinary skill in the art that *[Affinity] possessed the ability to transfer data from a portable audio player to a different electronic device, which in turn allowed the different electronic device to present a selectable representation of an audio file on a display associated therewith, when the ‘812 application was filed ...* Accordingly, the Examiner erred in finding that independent claims 1 and 11 of the ‘926 patent are not entitled to the benefit date of the ‘812 application – March 28, 2000.

Decision on Request for Rehearing dated February 15, 2013 at 7 (emphasis added) (Exhibit A).

The Examiner accepted that this holding applies full force to the ‘228 Patent:

In both [claim 1 of the ‘228 Patent and claim 1 of the ‘926 Patent], data is communicated from a portable device to a different electronic device so that a selectable interface item (i.e., “soft button” in the ‘228 patent, and “selectable representation” in the ‘926 patent) is displayed on the display of

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<sup>1</sup> Control No. 95/001,263, noted by this panel in the Decision at 4.

the different electronic device. When the interface item is selected, a media or audio file associated with the item is played by the portable device.

...

In view of the Board's finding that "the '812 application reasonably convey[s] to one of ordinary skill in the art that Appellant possessed the ability to transfer data from a portable audio player to a different electronic device, which in turn allowed the different electronic device to present a selectable representation of an audio file on a display associated therewith" for claims of the '926 patent, the claims of the '228 patent are likewise supported by the '812 application under 35 U.S.C. § 112, first paragraph.

For this reason, the claims of the '228 patent are entitled to the priority date of 28 March 2000.

Examiner's Answer mailed February 6, 2014, '228 Patent ex parte reexamination (Exhibit B) at 6-7.

The companion ex parte reexamination of the current '228 Patent thus resulted in a Reexamination Certificate confirming the patentability of claims 1-21, determining that claims 22 and 24-31 are patentable as amended, canceling claim 23, and determining that new claims 31-40 are patentable.

Thus the Board has already determined that subject matter at issue in the '228 Patent is entitled to a March 28, 2000 priority date. Ohmura and empeg<sup>2</sup> therefore do not qualify as prior art, such that no rejections remain.

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<sup>2</sup> empeg bears a copyright notice of "2000," which hardly establishes that it was published before March 28, 2000.

**II. The Office Has Already Ruled That This Panel May Not Consider Claims 3 And 22-30**

The Office decided in this reexamination, in July 2013, that the estoppel provisions of pre-AIA 35 U.S.C. § 317(b) apply, so that “[a]ny rejection in this reexamination proceeding which is presently applied against any of claims 3 and 22-30 of the ‘228 Patent ... **will not be further maintained by the Office.**” Decision on Petition mailed July 19, 2013 (underline and bold in original) at 1.

The Decision on Petition “referred [this proceeding] to the Central Reexamination Unit for further action pursuant to this decision.” *Id* at 6. Patent Owner is not aware of any action in response to that referral, nor did this panel act on Patent Owner’s Request for Remand (Exhibit C) filed April 29, 2014.

As expressed in that Request, Patent Owner continues to believe that the best course is for this matter to be remanded to the Examiner to ensure consistency. For example, the Examiner recently adopted a definition of “portable” that may be relevant to this case. Exhibit B at 8-10. Absent such a remand, however, it is clear that this panel cannot act with respect to claims 3 and 22-30.<sup>3</sup>

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<sup>3</sup> The ‘228 Patent is being asserted against Ford Motor Co., as noted in the Request for Remand. The District Court in that case has issued another order construing the ‘228 Patent that may be relevant. See Exhibit C.

**III. The '228 Patent Is Entitled To The Filing Date Of Its Parent For Additional Reasons**

**A. The Office found written support during an earlier prosecution for viewing the name on the associated device**

U.S. Patent No. 7,324,833 also claims priority to the '812 application, and shares an identical specification with that application and with the '228 Patent. The '833 patent was filed 36 months before the '228 Patent. Not surprisingly, the Office examined the '833 patent first, and initially took the position that claims to “a portable electronic device displaying a graphical interface item comprising a name associated with an audio file wherein the portable electronic device is communicatively coupled to a different electronic device and the portable electronic device communicates a representation of the graphical interface item to the different electronic device for display on said different electronic device” was not disclosed in the specification: “There is no mention of transmitting the associated name information to the different electronic device and subsequently displaying the information on the different electronic device.” Office Action mailed August 16, 2007 at 2 (Exhibit D).

After Patent Owner identified where the written description was, the Office reversed itself and found that the claims as written were supported. Examiner Interview Summary dated October 4, 2007 (Exhibit E). The original Examiner of the '228 Patent was explicitly apprised of the pendency of the '833 patent twice – once when a Terminal Disclaimer was filed, and again during an interview. *See* Terminal Disclaimer of November 18, 2008 and Interview Summary of December 9 and 15, 2008. Both of these notices occurred before the Examiner issued an action during prosecution of the '228 Patent. And when he did issue his first action, the Examiner never raised a §112(1) issue with the claims. Clearly then, the Examiner agreed that the claims were supported by the specification. *Goldenberg v. Cytogen*, 373 F.3d 1158, 1167 (Fed. Cir.

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