

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	§	
	§	
David A. Monroe	§	Group Art Unit: 2622
	§	
Serial No.: 10/336,470	§	Examiner: Joseph R. Pokrzywa
	§	
Filed: January 3, 2003	§	
	§	
For: APPARATUS FOR CAPTURING,	§	
CONVERTING AND	§	
TRANSMITTING A VISUAL	§	
IMAGE SIGNAL VIA A DIGITAL	§	
TRANSMISSION SYSTEM	§	

AFFIDAVIT OF DAVID A. MONROE UNDER 37 CFR 1.131

David A. Monroe, being duly sworn, states as follows:

1. I am over 21 years of age and am competent to make this declaration.
2. I am the named inventor of the applications for patent, U.S. Serial Nos. 10/326,503 and 10/338,470, each of which have an effective filing date of January 12, 1998.
3. During the prosecution of these applications I have become aware of a number of patents and publications which may be relevant to the scope of my invention. These patents and publications (the "131 Prior Art") have an effective prior art date which is earlier than my filing date but later than the date of the invention in each of the respective applications.
4. Some, but not all of the 131 Prior Art has been cited by the Examiner during prosecution of each of the subject applications. However, in the interest of thoroughness I desire to disclose all of the 131 Prior Art known to me at this time. The relevant 131 Prior Art is as follows:

<u>Patent/Publication</u>	<u>Earliest Effective Date</u>	<u>Cited by Examiner</u>
U.S. Pat. No. 5,546,194	March 23, 1994	SN 10/336,470
U.S. Pat. No. 5,550,654	May 13, 1994	SN 10/336,470
U.S. Pat. No. 5,689,300	November 18, 1997	SN 10/336,470
U.S. Pat. No. 5,754,227	September 28, 1994	NOT CITED

U.S. Pat. No. 5,854,694	October 17, 1995	NOT CITED
U.S. Pat. No. 5,893,037	December 9, 1994	NOT CITED
U.S. Pat. No. 5,517,683	January 18, 1995	NOT CITED
U.S. Pat. No. 5,711,013	January 18, 1995	NOT CITED
U.S. Pat. No. 5,666,159	April 24, 1995	SN 10/336,470
U.S. Pat. No. 5,793,416	December 29, 1995	SN 10/326,503
U.S. Pat. No. 5,825,408	March 18, 1994	SN 10/326,503
U.S. Pat. No. 5,893,037	December 9, 1994	SN 10/326,503
U.S. Pat. No. 5,929,901	October 6, 1997	NOT CITED
U.S. Pat. No. 5,995,041	December 30, 1996	SN 10/336,470
U.S. Pat. No. 5,969,750	September 4, 1996	SN 10/326,503
U.S. Pat. No. 6,072,600	January 30, 1996	SN 10/336,470
U.S. Pat. No. 5,806,005	May 10, 1996	SN 10/326,503
U.S. Pat. No. 5,864,766	August 13, 1996	NOT CITED
U.S. Pat. No. 6,043,839	January 12, 1998	NOT CITED
U.S. Pat. No. 6,085,112	November 7, 1996	NOT CITED
U.S. Pat. No. 6,111,863	December 29, 1995	SN 10/326,503
U.S. Pat. No. 6,122,526	April 24, 1997	NOT CITED
PCT Publication WO 97/26744	July 24, 1997	SN 10/326,503
U.S. Pat. No. 6,181,954	January 12, 1998	SN 10/326,503
U.S. Pat. No. 6,452,626	October 6, 1997	NOT CITED

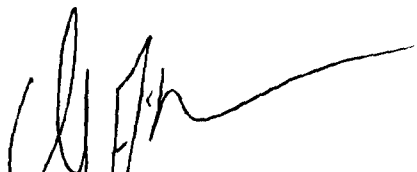
5. The earliest effective date of any of the 131 Prior Art is March 18, 1994. My invention date for each of the inventions shown and described in the subject applications is more than one year earlier than the earliest effective date of any of the 131 Prior Art, namely, earlier than March 18, 1993. This is supported by the schematic drawings Exhibits 10 and 11, that are dated earlier than March 18, 1993, and by the design renderings and sketches contained in Exhibits 7, 8, and 9, all of which are dated earlier than March 18, 1993.
6. During the period from the date of the inventions to the filing date of January 12, 1998 I was diligent in pursuing the invention and did not abandon the inventions. During this period the invention conceived and shown in Exhibits 6-16 was continually refined and revised, primarily in an effort to achieve a viable commercial product that met all the requirements of the inventions while at the same time being feasible. Commercial success demanded meeting both acceptable performance criteria and financial (cost) criteria.
7. I began working with the concept of sending image data over transmission systems as early as 1983. In 1983 I developed the "PhotoPhone™", a pioneering desktop device ultimately was extensively used and thrived as an early "tele-radiology" system for the transmission of medical X-Ray images, see Exhibit 1.
8. In 1985 I started a company called PhotoTelesis that focused on extending the PhotoPhone to specific Government applications. In 1986 I extended this desktop technology to enable transmission over radio circuits, including cellular. This was done by the addition of a cellular/radio interface circuit board called "CIS", see Exhibit 2. On May 26, 1986, a press release was released that discussed several new products that were announced at the Armed Forces Communication and Electronics Associations in Washington, D.C. The Com-RIT™ product included the CIS board and provided image transmission from a desktop unit over mobile telephones and portable satellite terminals, see Exhibit 3.
9. Over the next several years, I developed several Remote Image Transceivers or R.I.T.'s for the United States Military, see Exhibit 4, and as shown and described in the 1987 Business Plan of my company PhotoTelesis, see Exhibit 5. In 1989 I conceived the circuitry for a concept model R.I.T. which could be handheld, see Exhibit 6. Over the next several years I continued to develop the handheld R.I.T. while continuing to work on, develop and build the military R.I.T. systems such as those shown in the 1986 Business Plan, Exhibit 5. Evidence of this continuing effort is the design concept drawings of Exhibits 7 and 8, dated 1990. Additional concepts were generated during 1991 (Exhibit 9). In addition, in 1991, the first detailed schematic was generated (Exhibit 10), which would permit a prototype circuit to be built.

10. I perceived that a small, handheld image RIT was needed and in 1989 I conceived the circuit architecture for a concept model R.I.T. that could be handheld, see Exhibit 6. This design, although functionally viable, was in practice power hungry and slow in performance. Over the next several years I continued my efforts to develop the handheld R.I.T. while continuing to work on, develop and build the larger specialized tactical military R.I.T. systems such as those shown in the 1987 Business Plan, Exhibit 5. Evidence of this continuing effort are the design concept drawings generated in corroboration with an industrial designer shown in Exhibits 7 and 8, dated 1990. In addition, in 1991 I developed the enhanced architecture that enabled the first detailed schematic (Exhibit 10), which would permit a higher performance and low-power prototype circuit to be built.
11. In 1992, the first comprehensive circuit was completed for a handheld R.I.T., as shown in Exhibit 11. This circuit became Fig. 8 of U.S. Application No. 10/336,470. Continued work done in 1992 on a packaging modification that would be more desirable to Government Customers, as is shown in Exhibits 12 and 13. Some of the design concepts of the 1992 and earlier period were also included in the Government model as was shown in the Application. Compare, for example, Fig. 6 in the application to the 1992 concept drawings Exhibits 12 and 13.
12. Over the next several years, 1993-1997, Photo-Telesis became the standard R.I.T. for Government tactical image transmission. The tactical systems developed and commercialized by PhotoTelesis were employed by the U.S. Government in many systems. Many of the products developed and sold by PhotoTelesis followed the concepts shown and described in the 1987 Business Plan (Exhibit 5).
13. During this time, I continued to be interested in and continued to develop the concept of a true handheld R.I.T. product. In fact, I came up with a formal proposal of a handheld R.I.T. in 1995 and put together a concept proposal in November, 1995 (Exhibit 14), using secure radio transmission. Ultimately this project was never Government funded, I went on to fund and develop a commercially feasible handheld R.I.T. that was first publicly disclosed in late 1997 and first sold to the Government in 1998.
14. While the proposal shown in Exhibit 14 did not feature a cellular telephone compatible R.I.T., it was architecturally consistent and a development stepping-stone toward that goal. The final product incorporated my design concepts of 1993 and earlier, and did include cellular telephone compatibility. A first prototype of this product is embodied in physical Exhibit 15. Physical Exhibit 15, which was shown to the Examiner in charge of prosecution of each subject cases during an interview, is a prototype of the first commercial embodiment of the invention. This was completed in mid-1997 and was first publicly disclosed sometime early 1998. Photographs of this one-of-a-kind prototype are contained in this record as Exhibit 15.
15. The circuitry for supporting the product resulting from the 1995 proposal is provided in the schematics of Exhibit 16, which ultimately became Fig. 5 of Application No. 10/326,503.

16. The product based on the prototype (Exhibit 15 and Exhibit 16) was put into production and sold to the Government. One of the production units, Physical Exhibit 17 as is photographed in Exhibit 17, was demonstrated transmitting over cellular telephone to the Examiner.
17. As shown by the Exhibits attached hereto, I conceived the invention at least as early as March 18, 1993 and worked diligently in developing a commercially viable product culminating in the first commercial handheld R.I.T. in late 1997. This handheld R.I.T. used cellular telephone transmission technology, as evidenced by Exhibits 15-17 as first conceived and document as early as March 18, 1993, see Exhibits (6 -13).
18. The subject applications were timely filed, being within one year of the first public disclosure of the inventions, and in fact, prior to any public disclosure.
19. The above facts establish reduction to practice prior to the earliest effective dates of the 131 Prior Art, or as a minimum, establish conception of the invention prior to the earliest effective date of the 131 Prior Art coupled with due diligence from prior to this date to a subsequent reduction of practice culminating in the prototype of the commercial embodiment Exhibit 15 in mid-1997.

Further affiant sayeth naught.

Executed this 27<sup>th</sup> day of December, 2004, by:

  
\_\_\_\_\_  
David A. Monroe

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