

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the *Inter Partes* Review of:

Trial Number: To Be Assigned

U.S. Patent No. 8,191,091

Filed: June 7, 1995

Issued: May 29, 2012

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Title: Signal Processing Apparatus and Methods Panel: To Be Assigned

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**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. 8,191,091
UNDER 35 U.S.C. § 311 AND 37 C.F.R. § 42.100**

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Apple Inc. (“Apple”) requests *inter partes* review (“IPR”) of Claims 13-16, 18, 20-21, 23-24, 26-27, and 30 (“the Challenged Claims”) of U.S. Patent No. 8,191,091 (“the ’091 patent”) (Ex. 1003).

In 1981, the named inventors of the ’091 patent filed U.S. Patent Appl. No. 06/317,510, which issued as U.S. Patent No. 4,694,490 (“the ’490 patent”) to Personalized Media Communications, LLC (“PMC”). Ex. 1009 at 1. In 1987, PMC filed a continuation-in-part of that application, U.S. Patent Appl. No. 07/096,096, which discarded the original 22-column specification filed in 1981 and substituted a new specification that spanned over 300 columns. Ex. 1003 at 1. In the months leading up to June 8, 1995, PMC filed 328 virtually identical continuations from that 1987 application, with an estimated 10,000 to 20,000 claims. Ex. 1010; Ex. 1033 at 2 (stating applicants had “hundred[s] of applications, containing over ten thousand claims”). The ’091 patent is just one of the patents that issued from that flurry of activity.

During prosecution of the ’091 patent, PMC deluged the Examiner with references. Ex. 1031 at 11; Ex. 1003 at 1-33. While the Examiner may have performed to his “best ability,” he recognized that his review was limited “[i]n view of the unusually large number of references” and “the time and resources available.” Ex. 1031 at 11.

I. IDENTIFICATION OF CHALLENGE – 37 C.F.R. § 42.104(B)

A. 37 C.F.R. § 42.104(b)(1): Claims for Which IPR Is Requested

Apple requests IPR of the Challenged Claims of the '091 patent.

B. 37 C.F.R. § 42.104(b)(2): The Specific Art and Statutory Ground(s) on Which the Challenge Is Based

IPR of the Challenged Claims is requested in view of the prior art listed below. In the district court, PMC has asserted the Challenged Claims are entitled to a September 11, 1987 priority date. Ex. 1019 at 6. For purposes of this IPR only, Apple assumes the September 11, 1987 priority date.

- U.S. Patent No. 4,613,901 to Klein Gilhousen et al. (“Gilhousen”) (Ex. 1004), filed May 27, 1983 and issued September 23, 1986. Gilhousen is prior art under 35 U.S.C. § 102(a).¹
- U.S. Patent No. 4,736,422 to Arthur Mason (“Mason”) (Ex. 1005), filed July 2, 1984 and issued April 5, 1988. Mason is prior art under 35 U.S.C. § 102(e).
- U.S. Patent No. 4,712,239 to William Frezza et al. (“Frezza”) (Ex. 1006), filed June 16, 1986 and issued December 8, 1987. Frezza is prior art under 35 U.S.C. § 102(e).
- U.S. Patent No. 4,503,462 to Gordon Kelly et al. (“Kelly”) (Ex. 1007), filed October 16, 1981 and issued March 5, 1985. Kelly is prior art under 35 U.S.C. § 102(b).
- U.S. Patent No. 4,484,217 to Robert Block et al. (“Block”) (Ex. 1008), filed May 11, 1982 and issued November 20, 1984. Block is prior art under 35 U.S.C. § 102(b).

¹ Cites to 35 U.S.C. §§ 102 and 103 are to the pre-AIA version applicable here.

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