



REEXAM
PATENT
A

ATTORNEY DOCKET: 52090.000411

PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Reexamination Of:)	
)	
Patent Number)	5,335,277
)	Group Art Unit: 3992
Control Number:)	90/006,563
)	90/006,698
)	Examiner: HARVEY, David E.
Filing Date:)	March 14, 2003
)	July 7, 2003
)	
Confirmation Number:)	7085

Mail Stop Appeal Brief - Patent
Central Reexamination Unit
Office of Patent Legal Administration
United States Patent & Trademark
Randolph Building
401 Dulany Street
Alexandria, VA 22314

APPEAL BRIEF

In accordance with 37 C.F.R. § 41.37, appellant submits this appeal brief in the above captioned application. Appellant appeals the final rejection of claims 2, 4, 6, 7, 10-15, 17-20, 22, 23, 27, 28, 30, 32, 33, 35, 38, 41, 42, 44-52, 55 and 56 set forth in the Office Action mailed March 16, 2006 (the "Office Action"). A Notice of Appeal was filed in accordance with 37 C.F.R. § 41.31 on June 16, 2006. Attached hereto is a check for \$500.00 covering the fee set forth in 37 C.F.R. 41.20(b)(2). Any additional fees that may be due but are not attached may be charged to Deposit Account No. 50-0206.

08/22/2006 MSALDANA 00000001 90006698
01 FC:1402 500.00 OP

Real Party In Interest

The real party in interest is the Patent Owner, Personalized Media Communications, LLC ("PMC") having a place of business at 708 Third Ave., New York, New York, 10017.

Related Appeals And Interferences

U.S. Patent 5,335,277 issued from application Ser. No. 56,501, filed May 3, 1993. Application Ser. No. 56,501 is a continuation of Ser. No. 849,226, filed March 10, 1992, Pat. No. 5,233,654, which is a continuation of Ser. No. 588,126, filed September 25, 1990, Pat. No. 5,109,414, which is a continuation of Ser. No. 96,096, filed September 11, 1987, Pat. No. 4,965,825, which is a continuation-in-part of Ser. No. 829,531, filed February 14, 1986, Pat. No. 4,704,725, which is a continuation of Ser. No. 317,510, filed November 3, 1981, Pat. No. 4,694,490.

U.S. Patent No. 5,335,277 is part of a chain of patents that includes additional issued patents and various pending applications. Application Ser. No. 113,329, filed August 30, 1993, which remains pending, is a continuation of application Ser. No. 56,501. Various applications claim priority to Application Ser. No. 113,329, including application Ser. No. 470,571, filed June 6, 1995; application Ser. No. 487,526, filed June 7, 1995; and application Ser. No. 480,060, filed June 7, 1995, now Pat. No. 5,887,243.

Each of appellant's seven related patents are involved in reexamination proceedings. The reexamination proceedings pending against appellant's related issued patents are as follows:

Pat. No. 4,694,490	Control No. 90/006,800,
Pat. No. 4,704,725	Control Nos. 90/006,697 and 90/006,841
Pat. No. 4,965,825	Control No. 90/006,536,
Pat. No. 5,109,414	Control No. 90/006,838,
Pat. No. 5,233,654	Control Nos. 90/006,606, 90/006,703 and 90/006,839, and
Pat. No. 5,887,243	Control No. 90/006,688.

The above applications and patents have been involved in the following appeals and judicial proceedings.

Pat. Nos. 4,965,825; 5,109,414 and 5,335,277 were asserted in the U.S. District Court, Eastern District of Virginia in *Personalized Mass Media Corp. v. The Weather Channel, Inc. et al.*, Doc. No. 2:95cv242. The case was settled prior to any substantive decision by the Court, although one procedural decision was published at 899 F.Supp. 239 (E.D.Va. 1995).

Pat. No. 5,335,277 was involved in the matter of *Certain Digital Satellite System (DDS) Receivers and Components Thereof* before the United States International Trade Commission (“Commission”), Investigation No. 337-TA-392. The Administrative Law Judge (“ALJ”) issued an “Initial Determination Granting Motion for Summary Determination of Invalidity of Claim 35 of the ‘277 Patent” on May 16, 1997. This determination was appealed to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”), which affirmed the Commission decision in a decision decided January 7, 1999. The ALJ issued “Initial and Recommended Determinations” on October 31, 1997. The Commission adopted certain of the ALJ’s findings and took no position on certain other issues in a “Notice Of Final Commission Determination Of No Violation Of Section 337 Of The Tariff Act Of 1930,” dated December 4, 1997. This determination was appealed to the Federal Circuit, which affirmed-in-part, reversed-in-part, vacated-in-part, and remanded in a decision decided November 24, 1998, and published at 161 F.3d 696, 48 U.S.P.Q.2d 1880. On remand, the complainant moved to terminate the investigation. The Commission issued a “Notice Of Commission Decision To Terminate The Investigation And To Vacate Portions Of The Initial Determination” on May 13, 1999.

Pat. Nos. 4,965,825; 5,109,414 and 5,335,277 were asserted in the U.S. District Court, Northern District of California in *Personalized Media Communications, LLC v. Thomson Consumer Electronics et al.*, Doc. No. C-96 20957 SW (EAI). The case was stayed during the Commission proceedings and was thereafter voluntarily dismissed by the plaintiffs. The Court issued no substantive decisions.

Each of the related issued patents with the exception of Pat. No. 4,704,725 is also asserted in the U.S. District Court, District of Delaware in *Pegasus Development Corp. v. DIRECTV Inc.*, Doc. No. CA 00-1020 (“Delaware Action”). Special Master Robert L. Harmon has issued a “Report And Recommendation Of Special Master Regarding Claim Construction.” On March 29, 2003, Special Master Harmon issued a letter clarifying his report. The Court has taken no further action in this case as it has been stayed pending the resolution of the reexamination proceedings.

Each of the issued patents has also been asserted in a suit pending in the U.S. District Court, Northern District of Georgia in the case styled *Personalized Media Communications, LLC v. Scientific-Atlanta, Inc. et al.*, Doc. No. 1:02-CV-824 (CAP) (“Atlanta Action”). The Court has issued an order construing the claims at issue that adopts with minor modifications the Special

Master's Report and Recommendation construing the claim term disputed in that litigation. The Court has taken no further action in this case as it has been stayed pending the resolution of the reexamination proceedings.

In pending Application Ser. No. 113,329, an appeal was noticed on August 20, 1996, and briefed September 13, 1996. Prosecution was reopened without consideration and the disputed rejection withdrawn in an Office action mailed October 10, 1997.

An appeal was noticed on September 20, 2004, in Application Ser. No. 470,571. An Appeal Brief was submitted on February 8, 2005. An Examiner's Answer was mailed on October 6, 2005. A Reply Brief was filed on December 6, 2005. On April 11, 2006, the Board issued an Order Returning Undocketed Appeal to Examiner. A Substitute Appeal Brief was filed April 26, 2006. A new Examiner's Answer was mailed on June 27, 2006. A new Reply Brief was filed on July 3, 2006. This appeal is awaiting docketing at the Board.

An appeal was noticed on October 7, 2004, in Application Ser. No. 487,526. An Appeal Brief was filed on March 7, 2005. An Examiner's Answer was mailed on January 31, 2006. A Reply Brief was filed on March 27, 2006. The Reply Brief was noted on June 23, 2006.

An appeal was noticed on October 18, 2005, and briefed December 19, 2005, in reexamination Control No. 90/006,800, regarding U.S. Patent 4,694,490. The Examiner's Answer was mailed July 21, 2006.

An appeal was noticed on October 24, 2005, and briefed December 27, 2005, in merged reexamination Control Nos. 90/006,697 and 90/006,841, regarding U.S. Patent 4,704,725. The Examiner's Answer was mailed April 21, 2006. A Reply Brief was filed June 21, 2006.

An appeal was noticed on May 30, 2006, and briefed June 30, 2006, in merged reexamination Control Nos. 90/006,606, 90/006,703, and 90/006,839, regarding U.S. Patent 5,233,654.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.