

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John C. Harvey *et al.*

Application No.: 08/485,507

Filed: June 7, 1995

For: SIGNAL PROCESSING APPARATUS AND
METHODS

Confirmation No.: 5691

Art Unit: 2467

Examiner: Michael J. Moore, Jr.

INFORMATION DISCLOSURE STATEMENT (IDS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Prosecution of this application has been continued after being suspended since 2005. This application was held in abeyance from examination by the Office pending final action in a corresponding so-called "A" application, U.S. Patent Application Serial No. 08/474,145 (issued as U.S. Patent 7,992,169 on August 2, 2011) as explained in the Supplemental Amendment filed April 11, 2011, in this application and in the Comments on Statement of Reasons for Allowance and Amendment under 37 CFR § 1.312 filed November 2, 2010 in the 08/474,145 application. During the suspension, applicant filed no additional Information Disclosure Statements in this application. However, additional Information Disclosure Statement were filed in Application Serial No. 08/474,145 and Applicants other copending "A" applications. This Information Disclosure Statement cites the references of record in Application Serial No. 08/474,145 and Applicants other "A" application, but are not yet of record in this application.

This application is a continuation of Application Serial No. 08/113,329 (issued as U.S. Patent 7,856,650 on December 21, 2010), which is a continuation of Application Serial No. 08/056,501 (which issued as U.S. Patent 5,335,277 on August 2, 1994), which is a continuation of Application Serial No. 07/849,226 (which issued as U.S. Patent 5,233,654 on August 3, 1993) with

PMC Exhibit 2016

is a continuation of Application Serial No. 07/096,096 (which issued as U.S. Patent 4,965,825 on October 23, 1990), which is a continuation-in-part of Application Serial No. 06/829,531 (which issued as U.S. Patent 7,704,725 on November 3, 1987), which in turn is a continuation of Application Serial No. 06/317,510 (which issued as U.S. Patent 4,694,490 on September 15, 1987). Numerous of Applicants' copending applications having the above priority claim (including this application) share a specification with application 07/096,096 and each of its descendent applications. Of these copending applications, Application Serial No. 08/480,060 issued as U.S. Patent 5,887,243 on March 23, 1999. On or subsequent to June 8, 2010, 53 of these co-pending patents have issued, including applications 08/113,329 and 08/487,397 discussed above. Another three applications have been allowed and the issue fee has been paid. Of note applications 008/470,571 (issued as U.S. Patent 7,734,251 on June 8, 2010) and 08/487,526 (issued as U.S. Patent 7,747,217 on June 29, 2010) each issued as patent after appeal to the Board of Patent Appeals and Interferences ("Board"). The decision in the '251 Application was issued on March 23, 2009, in Appeal 2007-1837 and a decision on rehearing was issued on June 24, 2009. The decision in the '526 Application was issued January 13, 2009, in Appeal 2007-2115.

Each of the seven patents issued prior to June 8, 2010 have been subject to one or more reexamination proceedings. These reexamination proceedings are summarized below and in the chart attached as Appendix A. U.S. Patent 4,694,490 underwent reexamination in Reexamination Control No. 90/006,800. The Examiner's rejections were appealed to the Board in Appeal 2008-0334. The Board issued a decision on June 30, 2008. A decision on rehearing was issued on December 18, 2008. Reexamination Certificate No. 4,694,490 C1 issued by the Board on June 23, 2009.

U.S. Patent 4,704,725 underwent reexamination in a merged proceeding of Reexamination Control Nos. 90/006,697 and 90/006,841. The Examiner's rejections were appealed to the Board in Appeal 2007-4044. The Board issued a decision on June 30, 2008. A decision on rehearing was issued by the Board on December 18, 2008. Reexamination Certificate No. 4,704,725 C1 issued on June 16, 2009.

U.S. Patent 4,965,825 underwent reexamination in Reexamination Control No. 90/006,536. The Examiner's rejections were appealed to the Board in Appeal 2008-4228. The Board issued a decision on December 19, 2008. A decision on rehearing was issued by the Board on May 22, 2009. Reexamination Certificate No. 4,965,825 C1 issued on November 10, 2009. Reexamination Certificate No. 4,965,825 C2 issued on October 26, 2010 as result of a second reexamination in Reexamination Control No. 90/010,709. A Notice of Intent to Issue Reexamination Certificate confirming the patentability of the claim under reexamination has been mailed in a third reexamination proceeding, Reexamination Control No. 90/011,274, regarding the '825 Patent.

U.S. Patent 5,109,414 underwent reexamination in Reexamination Control No. 90/006,838. The Examiner's rejections were appealed to the Board in Appeal 2008-4864. The Board issued a decision on January 7, 2009. Reexamination Certificate 5,109,414 C1 issued on August 4, 2009. Reexamination Certificate 5,109,414 C2 issued on June 7, 2010, as a result of a second reexamination in Reexamination Control No. 90/011,016. A third reexamination request for reexamination assigned Reexamination Control No. 90/011,744 was granted on September 2, 2011 and is currently pending.

U.S. Patent 5,233,654 underwent reexamination in a merged proceeding of Reexamination Control Nos. 90/006,606, 90/006,703 and 90/006,839. Reexamination Certificate 5,233,654 C1 issued February 17, 2009, as result of this proceeding.

U.S. Patent 5,335,277 is undergoing reexamination in a merged proceeding of Reexamination Control Nos. 90/006,563 and 90/006,698. The Examiner's rejections were appealed to the Board in Appeal 2009-6825. The Board issued a decision on January 19, 2010. A decision on rehearing was issued on September 27, 2010. An appeal of the Board's decision was taken to the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit"). The Court affirmed the Board's decision without opinion on October 13, 2011. A further reexamination request for reexamination assigned Reexamination Control No. 90/011,904 was granted on November 7, 2011, and is currently pending. Yet another request for reexamination of the '277 Patent, filed November 1,

2011, has been assigned Reexamination Control No. 90/011,992 but no determination on the request has yet been made.

U.S. Patent 5,887,243 underwent reexamination in Reexamination Control No. 90/006,688. The Examiner's rejections were appealed to the Board in Appeal 2008-4816. The Board issued a decision on March 5, 2009. A decision on rehearing was issued on June 1, 2009. Reexamination Certificate 5,887,243 C1 issued on October 13, 2009.

Applicants' issued patent have been asserted in several proceedings. U.S. Patents 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 ("Virginia Action"). 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). The procedural decision can be found in the Related Proceedings Appendices filed in each of the appeals to the Board listed above, for example, with the Appeal Brief filed February 22, 2007, in Reexamination Control No. 90/006,838.

U.S. Patent 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 ("ITC Investigation"). 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 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. The 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 1180. 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.). The ITC and Federal Circuit decisions can be found in the Related Proceedings Appendices filed in each of the appeals to the Board listed above, for example, with the Appeal Brief filed February 22, 2007, in Reexamination Control No. 90/006,838.

U.S. Patents 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 proceeding and was thereafter voluntarily dismissed by the plaintiffs. The Court issued no substantive decisions.

U.S. Patents 4,694,490, 4,965,825, 5,109,414, 5,233,654, 5,335,277 and 5,887,243 are 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 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 resolution of the reexamination proceedings. The Harmon Report can be found in the Related Proceedings Appendices filed in each of the appeals to the Board listed above, for example, with the Appeal Brief filed February 22, 2007, in Reexamination Control No. 90/006,838. Materials that are not prior art, but reflect the parties arguments related to the patents, can be found in the Information Disclosure Statement filed in the reexamination proceedings on October 28, 2005.

Each of the patents issued prior to June 8, 2010 were asserted 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 issued an order construing the claims at issue that adopts with minor modifications the Special Master’s Report and Recommendation construing the claim terms disputed in that litigation. The court has dismissed this case. The defendants have appealed the dismissal. A third-party has appealed a licensing issued unrelated to patentability or infringement The Markman Decisions can be found in

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.