

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC

Patent Owner

Case No. IPR2016-00755

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

**PATENT OWNER'S SUR-REPLY IN RESPONSE TO
PETITIONER'S PRELIMINARY REPLY ON PRIORITY DATE**

Pursuant to 37 C.F.R. §§ 42.22, 42.104, the Petition must show that the references relied upon were indeed “prior art” to the challenged claims. Petitioner did not even attempt to make a *prima facie* case that the ’091 Patent, which was a CIP, is not entitled to the 1981 priority date of the original parent application cited in the priority claim on the face of the patent.

The situation is hardly different from *HP v. TPL* (IPR2013-00217), where HP argued, months after filing its petition, that the challenged patent should be held to the later priority date because the patentee was allegedly “estopped” from claiming an earlier priority date. “Decision,” 2013 WL 6514068 at *1 (P.T.A.B. Oct. 10, 2013). Since HP failed to “identify where in the Petition any of these ... arguments were made,” the PTAB “decline[d] to consider, for the first time, HP’s arguments and evidence related to the [earlier] effective filing date.” *Id.* at *2. Here, Petitioner’s new arguments and evidence on priority date should be rejected for the same reasons.

I. There Is No “Priority Date Disclaimer” Doctrine And The Prosecution History Does Not Evince “A Clear And Unmistakable Surrender” Of 1981 Priority for the Claims at Issue.

By picking and choosing among PMC’s statements made during an early stage of examination with respect to *then-pending* (but *later cancelled*) claims, Petitioner contends that PMC somehow “disclaimed” 1981 priority for the claims of the ’091 Patent (issued from App. No. 08/485,507 or “the ’507 Application”)

which were introduced years later. Petitioner could not cite a single controlling case recognizing such a doctrine of “priority date disclaimer.”

Even if a general doctrine of priority date disclaimer existed (it does not), Petitioner’s argument fails because the relied-upon statements fail to demonstrate “a clear and unmistakable surrender” of 1981 priority. *See Conoco v. EEI*, 460 F.3d 1349, 1364 (Fed. Cir. 2006) (“To invoke argument-based estoppel [of the scope of the claims] ... the prosecution history must evince ***a clear and unmistakable surrender*** of subject matter.”) (bracketed portion and emphasis added). And, even if they were misconstrued as “disclaimers” of priority, PMC’s statements would only be applicable to the *then-pending* claims—*all of which were cancelled* and replaced with significantly different claims that ultimately led to the claims at issue here. It is indisputable that priority is determined on a claim-by-claim basis, rather than applied wholesale to an entire application or patent. *See Tronzo v. Biomet*, 156 F.3d 1154, 1158 (Fed. Cir. 1998) (“For ***a claim*** in a later-filed application to be entitled to the filing date of an earlier application under 35 U.S.C. § 120, the earlier application must comply with the written description requirement ...”).

None of PMC’s statements that Petitioner relies upon can be interpreted as *unequivocal disclaimers of priority* in view of other affirmative assertions of 1981 priority that PMC made throughout prosecution. For example, upon initial filing

of the '507 Application, PMC amended the “Cross-Reference to Related Applications” to include a priority claim to the '490 Patent. Ex. 2017 at 2. In addition, both before and after the 1995 IDS and 1997 amendment that Apple cites, PMC made clear that its priority assertion extended back to the 1981-based '490 Patent. See Ex. 2015 at 1-2; Ex. 2016 at 1-2.

The cases cited by Petitioner involved different fact patterns that when contrasted with the present situation actually highlight the absence of any priority disclaimer by PMC. In *Bradford v. Conteyor N. Am.*, after successfully overcoming prior art rejections by denying that an earlier application disclosed a claimed feature, the patentee later sought to reverse course and assert priority to the earlier application. 603 F.3d 1262, 1269 (Fed. Cir. 2010). The prosecution statements that doomed the priority assertion in *Bradford* were not only unequivocal, but were *also directed to the very same claims*. *Id.* at 1269-70. That is not the case here. Further, the statements in *Bradford* were relied on by the PTO to allow the claims at issue—a clear benefit to the patentee. *Id.* That is not the case here. As for *Hakim v. Cannon Avent Group*, 479 F.3d 1313, 1315-16 (Fed. Cir. 2007) and *Springs Window Fashions v. Novo Industries*, 323 F.3d 989, 993-94 (Fed. Cir. 2003), those cases also involved clear and unmistakable disclaimers by the patentees, which is not the case here. They are also inapposite because they involve disclaimer of claim scope, not disclaimer of priority dates.

The only relevant support that Petitioner can cite (at pages 2-3) is a decision (Ex. 1048) on a related patent by the Board that cited no authority for “priority date disclaimer” and that is the subject of a pending Request for Rehearing. *See* Paper 43 (4/22/2016) in IPR2014-01527. With all due respect to the Board, the earlier decision should not be followed here because it was wrongly decided as a matter of law as pointed out in the still pending rehearing request.

Petitioner does not dispute that the alleged “disclaimer” statements by PMC were made years before the original version of the *claims at issue here* were introduced. In particular, PMC’s statement that “there could never have been a basis for claiming the ***present*** *subject matter* [in the 1981 applications]” (Ex. 1043 at 21 (emphasis added)) refers explicitly to *then-pending* claims 3-32 in 1997. That statement obviously did not apply to the new claims 33-63 introduced in 2011 which recited different limitations.

The early statements made by PMC were directed to claims 3-32 which each recited “*modifying a fashion* in which said receiver station locates [/ receives / identifies] said enabling information ...” That feature was not disclosed in the 1981 specification, which is why priority was asserted by PMC to 1987, not 1981. But claims 3-32 were canceled, and the new claims 33-63 which ultimately led to the claims challenged here *did not recite that feature* (“modifying a fashion ...”). In fact, Petitioner agrees that “the 1981 specification [only] describes

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