



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Number	4,965,825)	Group Art Unit:	3992
Control Number:	90/006,536)	Examiner:	HARVEY, David E.
Filing Date:	February 4, 2003)		
Confirmation Number:	3222)		

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 1, 2 and 14-25 set forth in the Office Action mailed September 28, 2006 (the "Office Action"). A Notice of Appeal was filed in accordance with 37 C.F.R. § 41.31 on November 28, 2006. Commissioner is hereby authorized to charge undersigned's Deposit Account No. 50-0206 in the amount of \$500.00 to cover 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.

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I. 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.

II. RELATED APPEALS AND INTERFERENCES

U.S. Patent 4,965,825 issued from application Ser. No. 96,096, filed September 11, 1987, 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. 4,965,825 is part of a chain of patents that includes additional issued patents and various pending applications. U.S. Patent 5,335,277 issued from application Ser. No. 56,501, filed May 3, 1993, which 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. 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. 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,
Pat. No. 5,335,277	Control Nos. 90/006,653 and 90/006,703, 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

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