UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner

Inter Partes Review Case No. IPR2023-00939
U.S. Patent No. 8,510,407

PETITIONER'S REQUEST FOR REHEARING BY THE DIRECTOR

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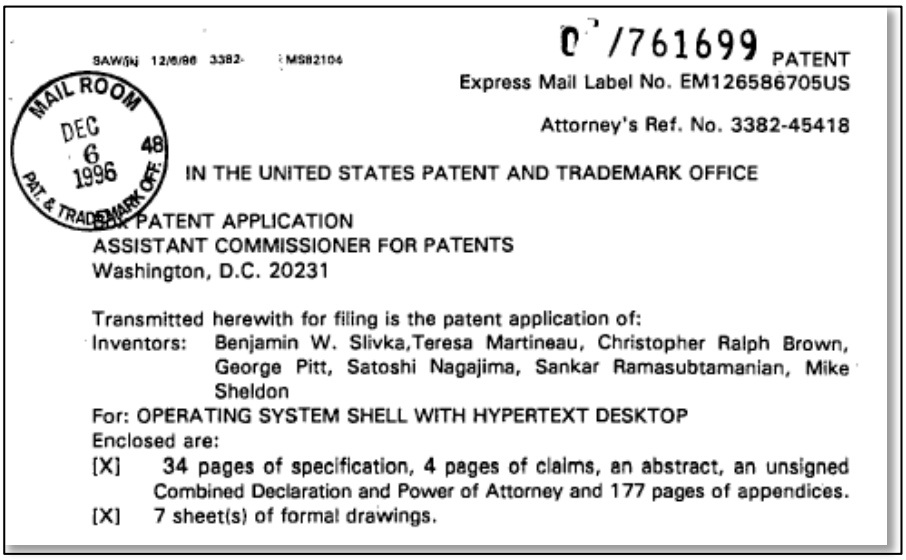
I. INTRODUCTION AND FACTUAL BACKGROUND

This case presents a question of first impression—whether a disclosure contained in appendices submitted with a patent application should be withdrawn from the public as prior art under 35 U.S.C. § 102(e) due to the prior art patent's alleged failure to properly incorporate those appendices by reference. It should not, particularly where the applicant's alleged failure did not impact (1) the public notice of those appendices, (2) *how* the public gained access to the appendices, or (3) *when* the public gained access to the appendices. Put simply, any negative consequences that result from a purportedly flawed prosecution process underlying a prior art patent should be imposed exclusively on the prior art patentee. The public should not also be punished by the USPTO withdrawing a prior art disclosure and allowing others to patent subject matter that had been previously submitted to the Office.

Petitioner advanced proposed grounds based on U.S. Patent No. 6,061,695 to Slivka, et al. ("Slivka Patent"), citing to the Slivka Patent and to appendices submitted with the application that issued as the Slivka Patent ("Slivka Appendices")—an application filed more than two years before the earliest priority date to which the Challenged Claims could be entitled. The appendices were submitted with the specification, claims, and drawings, indicating the applicant's intent for the Slivka Appendices to be a part of the Slivka Patent:



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION
ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Transmitted herewith for filing is the patent application of:
Inventors: Benjamin W. Slivka,Teresa Martineau, Christopher Ralph Brown, George Pitt, Satoshi Nagajima, Sankar Ramasubtamanian, Mike Sheldon
For: OPERATING SYSTEM SHELL WITH HYPERTEXT DESKTOP
Enclosed are:
[X] 34 pages of specification, 4 pages of claims, an abstract, an unsigned Combined Declaration and Power of Attorney and 177 pages of appendices.
[X] 7 sheet(s) of formal drawings.

Ex. 1005 (Slivka File History), 253. Further evincing the applicant's intent for the appendices to be part of the patent and putting the public on notice of the appendices, the Slivka Patent specification repeatedly describes the Slivka Appendices as "attached" to the patent. Relevant to the grounds advanced by Petitioner, the Slivka Appendices provide examples of HTML instructions that illustrate the concepts described in the Slivka Patent. Those appendices did not publish as part of the Slivka Patent due to Office procedural rules governing large appendices. Instead, they were made publicly available in the Slivka Patent's file history upon issuance.

Petitioner treated the Slivka Appendices as prior art pursuant to 35 U.S.C. § 102(e) as part of the "entire disclosure" of the Slivka Patent. *See* MPEP 2136.02 ("Under pre-AIA 35 U.S.C. 102(e), the entire disclosure of a U.S. patent . . . can be relied on to reject the claims."). It is undisputed that, if they are deemed properly incorporated by reference into the Slivka Patent, the Slivka Appendices are § 102(e)

prior art. It is also undisputed that, even if the Office finds that the applicant failed to properly incorporate them by reference, such a failure had no impact on the *timing* or *means* by which the Slivka Appendices were made available to the public.

The Board concluded that the Slivka Appendices are not prior art pursuant to § 102(e) because they were not properly incorporated by reference. Paper 12, 7 ("***Our determination is based on finding***[1] that Petitioner's challenge relies on appendices (Ex. 1005, 69–245) that were not published with the '695 patent (Ex. 1004). As discussed herein, we conclude, on the record before us, that ***Petitioner has insufficiently shown that the*** relied-upon ***appendices qualify as prior art*** under 35 U.S.C. § 102(e)[.]"). The Board's conclusion turns critically on the language used by the applicant to reference the Slivka Appendices. Rather than stating the appendices were "incorporated by reference[,]" the applicant repeatedly referred to the appendices as "attached" to the Slivka Patent. *Id*. at 9. From this, the Board concluded they had not been properly incorporated by reference. *Id*. at 9-10 (noting that, "[t]o incorporate material by reference, ***the host document must identify with detailed particularity what specific material it incorporates***[,]" and concluding the Slivka Appendices "were not incorporated by reference").

The policies underlying all implicated statutes and Office rules weigh against the Board's conclusion. There is no question that the applicant intended the Slivka

[1] All emphases added unless noted otherwise.

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