UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner

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

PETITIONER'S PRELIMINARY REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

Table of Contents

I. Petitioner Relies Exclusively on the Slivka Patent 1

II. Slivka's Appendices are Incorporated by the Slivka Patent 1

III. The Appendices Are Properly Part of the Slivka Patent 1

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

I. Petitioner Relies Exclusively on the Slivka Patent

Contrary to PO's mischaracterizations, the Slivka *patent* is the sole asserted §102(e) reference, and the Petition does not rely on Slivka's file history or its application. The Petition cites to the file history only because Slivka's appendices—not printed with the patent—are made available to the public in the file history.

II. Slivka's Appendices are Incorporated by the Slivka Patent

The incorporation of Slivka's appendices are evidenced by **(1)** clear and consistent references to the appendices throughout the specification (Ex. 1004, 6:41, 12:34-36, 15:32-33, 18:56-57, 64-65, 17:1-3, 22-24, 19:24-29), **(2)** the inclusion of the appendices with the originally filed application, stamped with the filing date (Ex. 1005, 69-245), and **(3)** Applicant expressly noting the incorporation of the appendices to the Examiner during prosecution of the Slivka patent (*Id.*, 254). Thus, it was made clear in multiple ways that the appendices were properly disclosed and incorporated at the time of filing and are thus part of the Slivka patent.

III. The Appendices Are Properly Part of the Slivka Patent

PO ignores that other types of appendices are allowed, mischaracterizes Slivka's appendices as "Computer Program Listings," and fails to engage with the policy rationale underlying §102(e). As PO acknowledges, at the time of the Slivka patent, the MPEP expressly acknowledged "Computer Program Listings" as a type

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

of disclosure that is part of the patent but is not printed with the patent. POPR, at 14, 25-26; Ex. 2008. Based on logistical challenges related to submitting such materials, the MPEP set forth specific procedures for submitting appendices in the form of Computer Program Listings. Ex. 1017, 42793. The PTO has since expanded the types of appendices with similar requirements. *See* MPEP 608.05 (imposing submission requirements for "Sequence Listing" and "Large Tables").

The MPEP recognizes (1) that the three expressly identified types of appendices are not exclusive, and (2) that all appendices are treated identically with respect to publication. *See* MPEP 1121 (noting "[a]ppendices, ***other than*** those containing 'Sequence Listings' . . . or 'Large Tables', are not printed if they are contained on pages located after the claims," and similarly noting that "'Computer Program Listing Appendices' . . . are not printed as part of the patent").

PO mischaracterizes Slivka's appendices as "Computer Program Listings," claiming they are not deemed part of the Slivka disclosure because the applicant did not comply with the MPEP's requirements for such appendices. POPR, at 14, 25-26. PO is wrong for at least two key reasons. First, Slivka's appendices are not "Computer Program Listings" at all. Indeed, only 24 of the 177 pages of appendices relate to computer code, and those pages are merely HTML *templates,* which do not rise to the level of a "computer program." The remaining 153 pages of appendices

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

are not directed toward any type of computer code at all, and instead comprise material such as textbook excerpts. POPR, at 13-14, 25-26; Ex. 1005, 69-245. Second, even if the "Computer Program Listings" requirements did apply to Slivka's appendices, PO cites no support for its assertion that failure to comply with such requirements results in the appendices being excluded from the patent disclosure.

The policy rationale underlying §102(e) also supports finding Slivka's appendices prior art. §102(e) dictates that prior art *disclosed* to the patent office before the priority date qualifies as prior art even if it does not become publicly available until later. 35 U.S.C. §102(e)(2); *Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 255-256, 86 S. Ct. 335, 15 L. Ed. 2d 304 (1965) (explaining that prior art for a §103 analysis is accorded the filing date because "[t]he delays of the patent office ought not to cut down the effect of what has been done.") (quoting *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, 46 S. Ct. 324, 70 L. Ed. 651 (1926)) (internal quotations omitted). Indeed, the MPEP specifies that "[u]nder 35 U.S.C. §102(e), **the entire disclosure** of a U.S. patent having an earlier filing date can be relied on to reject the claims." MPEP 2136.02 (emphasis added). Because Slivka's appendices were incorporated in the Slivka patent disclosure at the time of filing, it is proper for Petitioner to rely on the appendices as part of "the entire disclosure" of the Slivka patent as a §102(e) reference. *Id*.

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.

WHAT WILL YOU BUILD? | sales@docketalarm.com | 1-866-77-FASTCASE

fastcase® Smarter legal research.