

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON WEB SERVICES, LLC,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner.

Case IPR2014-01527
Patent 5,887,243

Before KARL D. EASTHOM, TRENTON A. WARD, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner filed this Request for Rehearing (“Reh’g Req.” or “Rehearing Request”) asserting that the panel overlooked several issues in the Final Written Decision (Paper 42, “FWD”).

The applicable standard for a rehearing request is set forth in 37 C.F.R. § 42.71(d), which provides the following:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

For the reasons provided below, we *deny* Patent Owner’s request for rehearing.

II. DISCUSSION

A. Claim Construction Standard

The Final Written Decision issued on March 23, 2016,¹ exactly 17 years from the date of issuance of the ’243 patent, March 23, 1999. Patent Owner now argues, in its Rehearing Request, that we should adopt a claim construction standard pursuant to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* Reh’g Req. 4–5. Patent Owner does not

¹ The face of the Final Written Decision erroneously lists an “[e]ntered” date of March 23, 2014, a clerical error we hereby correct.

point to where in the record it previously urged the Board to adopt such a construction.

Patent Owner's Rehearing Request also does not show how any particular claim construction under *Phillips* would alter the outcome. We already determined in the Final Written Decision that "[t]he outcome in this case would not be altered under a . . . claim construction standard pursuant to *Phillips*." FWD 8; *see also* Dec. on Inst. 8 (citing *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) and stating that "claim terms are presumed to carry their ordinary and customary meaning as would be understood by one of ordinary skill in the art at the time of the invention").

B. Second Remote Signal Source

Patent Owner contends that the Board erroneously construed the "second remote source" of claim 13. Reh'g Req. 5–6. Patent Owner does not point to where the Board overlooked or misapprehended a previous argument by Patent Owner that the written description, which describes a remote keyboard, does not support a remote control device as a "second remote [signal] source." *See* Ex. 1003, 4:12; 4:28. Patent Owner also does not identify where the Board overlooked or misapprehended a previous argument by Patent Owner that a person of ordinary skill would not have recognized, pursuant to the plain meaning of a remote signal source, the well-known "remote" control device as disclosed in the prior art (*infra* note 2) and in the '243 patent.

Claim 13 refers to two remote sources: “[c] transmitting at least a portion of said data from said first remote data source to said receiver station” and “[d] transmitting from a second remote source to said receiver station a signal which controls said receiver station.” *See* FWD 6. The claim construction at issue applies to the second remote source, which requires transmitting a signal, as opposed to the first remote data source, which requires transmitting data. *See* FWD 6, 38–39, 59–60.

In the Final Written Decision, we adopted Petitioner’s contention that the term “remote” in the “second remote source” encompasses the “remote” controls disclosed in the prior art of record, based in part on a description of such remote controls (as a “remote keyboard”) in the background of the ’243 patent. *See* FWD 20–23.² These ubiquitous remote control devices, described in the ’243 patent and prior art at the time, constitute evidence of one plain meaning of the term “remote.” *See id.* For example, as part of our analysis of the “second remote source” with respect to the prior art, we found that “the ’243 patent . . . , consistent with the normal meaning of a ‘remote’ control device, does not preclude Summers’s “‘hand-held remote control device of any suitable known form.’” *See* FWD 59 (quoting Ex. 1010, 6:35–36).

² *See, e.g.*, FWD 23 (citing Ex.1036 ¶ 28 (noting that Reiter, Ex. 1025, 3:54–57, Summers, Ex. 1010, 6:35–40, and another prior art reference each refer to a “remote control” wireless device)); Ex. 1003, 3:40–44 (describing a “remote keyboard” in the vicinity of, and controlling, a television receiver).

In addition, we cited, for support, *Brookhill-Wilk 1, LLC v. Intuitive Surg., Inc.*, 334 F.3d 1294, 1297 (Fed. Cir. 2003) (construing “remote location” to encompass locations in the same room, and concluding that the lower court erred by construing “remote location” as “a location outside the operating room where the patient undergoing surgery is located”). *Brookhill-Wilk* did not involve the broadest reasonable construction standard, but nonetheless, the court construed “remote” consistent with our adoption of Petitioner’s construction; i.e., the term “remote” includes relatively local control with respect to the recited “second remote [signal] source.”

Brookhill-Wilk held that “[t]he overall limitation ‘remote location beyond a range of direct manual contact’ as used in the claims must be construed to encompass all locations where the surgeon is beyond direct physical contact with a patient, including locations within the operating room.” *Id.* at 1304. This construction is consistent with a plain meaning of “remote” that includes “locations that are separated by intervals greater than usual.”³ Therefore, *Brookhill-Wilk* supports virtually the same construction that we applied here, because a typical prior art remote control device allowed a user or operator to control receiver equipment at distances greater

³ *Brookhill-Wilk* “construe[d] the term ‘remote location’ to encompass not just locations that are ‘far apart or ‘distant,’ but also those locations that are merely ‘separated by intervals greater than usual.’ . . . These locations need not be outside the operating room.” *Id.* at 1302.

than an arm's length—which at the time of the invention, were distances “separated by intervals greater than usual,” *id.*,—i.e., otherwise a user would have had to control the receiver manually (within an arm's length). *See supra* note 2; FWD 23 (discussing wireless devices as remote control devices).

Brookhill-Wilk also requires a patentee to “express a manifest exclusion or restriction limiting the claim term,” from one of several plain meanings encompassed by the patent. *Id.* at 1301. Furthermore, “where the written description otherwise supports the broader interpretation, ‘we are constrained to follow the language of the claims’ and to give the claim term its full breadth of ordinary meaning as understood by persons skilled in the relevant art.” *Id.* at 1301–02 (citing *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed.Cir.2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001)).

Analogous to the remote operating surgeons involved in *Brookhill-Wilk*, 334 F.3d at 1302–04, the '243 patent shows that the term “remote [signal] source” embraces two ordinary and normal meanings: one encompassing a remote control device or remote keyboard that sends signals, the other encompassing a relatively far away source that may send signals and/or data. The cited prior art to Reiter and Summers coalesces with the '243 patent to support the former plain meaning. *See* note 2. In its Request for Rehearing, Patent Owner contends that the “remote keyboard” reference in the '243 patent applies only to prior art instead of the disclosed invention. *See* Reh'g Req. 6. Patent Owner characterizes *In re Abbott*

Diabetes Care Inc., 696 F.3d 1142, 1148 (Fed. Cir. 2012) as reversing [a claim] construction because “the Board improperly relied on language in its patents that was directed . . . to prior art devices.” *Id.*

Patent Owner’s characterization overstates the holding and thrust of *Abbott*. In *Abbot*, the court reversed the Board’s claim construction that included sensors with wires based on several factors, including the following: 1) “the specification contains *only disparaging* remarks with respect to the external cables and wires of the prior-art sensors,” 2) “*the claims themselves* suggest connectivity without the inclusion of cables or wires,” and 3) “*the primary purpose* of the invention was to provide ‘a small, compact device that can operate the sensor and provide signals to an analyzer without substantially restricting the movements and activities of the patient.’” *Abbott*, 696 F.3d 1149 (emphases added).

Other factors existed in *Abbott*, but not one of the factors exist here. Regarding the first factor listed above, the ’243 patent does not disparage prior art remote control devices as a signal source for any reason, implicitly or explicitly, let alone because they were not remote enough (i.e., not far enough away from the receiver station). Regarding the second listed point, Patent Owner contends that construing “remote” in the context of a prior art remote keyboard, or remote control device, effectively ignores the word “source” in the claim term “remote source.” Reh’g Req. 5–6. Patent Owner also contends we construed “remote” as a noun instead of as an adjective. *Id.* at 5. These arguments do not show an overlooked matter. In the context of the ’243 patent, a remote control device or remote keyboard *is a remote*

source. Such a remote control device sends a wireless signal—i.e., it is a source of the signal that it sends. Based on the '243 patent's discussion of the remote keyboard in the prior art, and the broad recitation of a remote source as a "second remote source" that sends a signal for control, the Patentee embraced the remote keyboard or known remote control devices as a type of source for the "second remote source."

In other words, claim 13 requires that the second remote source transmit a control signal: "transmitting from a second remote source to said receiver station a signal which controls said receiver station to select and process an instruct signal." Patent Owner ignores the broad claim language and the disclosure of a remote control device that tracks claim 13, and essentially argues that an implicit geographical limitation exists as to how remote the second source must be from the receiver station. But neither claim 13, nor the '243 patent disclosure, specify any degree of remoteness for a second remote source, and Patent Owner also does not specify a clear degree of required remoteness in its arguments.

Implicitly addressing the third factor, the primary purpose factor discussed in *Abbot*, Patent Owner contends that our construction "makes no sense for an invention which recites a distributed communication system." Reh'g Req. 5. To the contrary, claim 13 does not recite a "distributed communication system." Patent Owner also contends that "every embodiment" requires a "geographically remote source." *Id.* at 6. First, merely disclosing embodiments does not narrow a claim term, and even if it did, Patent Owner fails to explain how these embodiments apply to the

“second remote (signal) source.” Second, the recited term “remote” constitutes a generic term and the disclosed term “geographically remote” constitutes one subset of the generic term that claim 13 does not recite. *See* Reh’g Req. 6. This is consistent with the ’243 patent’s treatment of the term “remote” as a generic term that encompasses a remote keyboard (or remote control device) and a geographically remote source. Third, the Rehearing Request only identifies a single embodiment—the “Wall Street Week” embodiment, and fails to tie that to a second remote (signal) source. *Id.*

Regardless, these arguments track the arguments that *Brookhill-Wilk* dismissed:

Stating that the surgeon would always be in the operating room when performing traditional surgery does not foreclose the presence of the surgeon within the operating room when performing remote surgery. The statements from the description of the preferred embodiment are simply that—descriptions of a preferred embodiment that permits surgeons to operate from across the world. Those statements do not indicate that the invention can only be used in such a manner. Absent a clear disclaimer of particular subject matter, the fact that the inventor anticipated that the invention may be used in a particular manner does not limit the scope to that narrow context.

Brookhill-Wilk, 334 F.3d at 1302.

Nothing in claim 13 requires a “geographically remote” second remote source, and nothing in the ’243 patent indicates that the primary purpose of the invention is a system that requires some (unspecified) degree of remoteness for a second remote signal source. Claim 13 also fails to

specify from what entity the second remote source is remote, though it recites a receiver station and a first remote source.

As outlined in the Final Written Decision:

Relevant objectives of the invention include “combined medium programming” and “causing computers to generate and transmit programming, and for causing receiver apparatus to operate on the basis of programming and information received at widely separated times.” *Id.* at 6:40–52. The ’243 patent announces “great potential for combining the capacity of broadcast communications media to convey ideas with the capacity of computers to process and output user specific information.” *Id.* at 1:57–60. As an example, the [’243] Specification describes “[h]ereinafter” referring to “‘combined’ media” as “the new media” that results from, for example, the combination of “general information” for large audiences (e.g., stock market performance) from a television broadcaster with “information of specific relevance to each particular user” (e.g., “your stock portfolio went down”). *Id.* at 1:60–67.

FWD 14.

Patent Owner does not contend in its Rehearing Request that we overlooked argument or evidence that shows how reading the claimed “second remote source” on a remote control device cannot achieve most, if not all, of these objectives. Including within the scope of a second remote (signal) source a range of remoteness spanning from distances near the claimed receiver station to greater distances does not detract from any applicable objectives that somehow implicitly may be imputed as a limitation in claim 13.

Patent Owner argues that “the ’243 Patent, for example, describes remote stations as stations that are in ‘geographically separate locations.’”

PO Resp. 23 (citing Ex. 1003 at 221:50–53). In context, this description implies at most that the claimed “first remote data source” and “second remote source” as set forth in claim 13 may be geographically separate from each other. Also, a second remote source that includes a remote control device does not preclude geographically remote receiver stations, and claim 13 only recites and requires one “receiver station.”

A remote source sends a signal for control, according to claim 1, thereby providing “automatic wireless control of [the receiver station] from an undefined distance.” See FWD 22. Patent Owner does not challenge the finding in the Final Written Decision pointing out that “remote controls were ubiquitous” at the time of the invention, and the determination that “the ’243 patent does not exclude these ubiquitous remote controls from the ordinary meaning of ‘remote’ at the time of the invention.” See FWD 22 (citing Ex.1036 ¶ 28 (noting that Reiter, Ex. 1025, 3:54–57, Summers, Ex. 1010, 6:35–40, and other references refer to a “remote control”)); note 2.

Regarding Patent Owner’s argument that it supplied a construction through its expert that we did not adopt (see Reh’g Req. 5), typically, experts “cannot be used to prove ‘the proper or legal construction of any instrument of writing,’” *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S.Ct. 831, 841 (2015) (citing *Winans v. New York & Erie R. Co.*, 21 How. 88, 100–01 (1859)), and “in the actual interpretation of the patent the court proceeds upon its own responsibility, as an arbiter of the law, giving to the patent its true and final character and force,” *id.* (citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996)).

In any event, Dr. Russ’s testimony is conclusory: it fails to give a reason why an ordinarily skilled artisan would require a second remote signal source to be geographically remote, what that means in terms of a specified distance, and why a second remote signal source excludes a remote control device. *See* Ex. 2009 ¶ 79. Additionally, we considered testimony by both experts on the issue, and made the following observation: “Dr. Neuhauser and Petitioner also persuasively explain that Patent Owner’s assertion that Dr. Neuhauser supports the Patent Owner’s position takes Dr. Neuhauser’s testimony out of context. *See* Ex. 1036 ¶¶ 33–34 (explaining that Dr. Russ conflates alternative embodiments advanced by Dr. Neuhauser).” FWD 22.⁴

Patent Owner essentially defines a second remote source by where it is not located—i.e., not located within the boundaries of a receiver station—a receiver station “does not encompass local peripheral devices.” PO Resp. 26. Yet, the argument and record do not specify how to determine any claimed receiver station boundaries (such as an operating room as argued unpersuasively in *Brookhill-Wilk*). Depending on the boundaries and relative power of the source, a remote control device could operate from outside those boundaries. *See* FWD 59–60 (finding that “Summers’s remote control device includes ‘any suitable’ degree of power with which to facilitate varying degrees of remoteness”) (quoting Ex. 1010, 6:35–36)). In

⁴ Paragraphs 32–34 of Exhibit 1036 refer to Dr. Russ’s testimony at paragraph 83 of Exhibit 2009. We considered all cited testimony by both experts (and some that was not cited specifically for context).

Patent Owner's view, the power limits of a prior art remote control device itself somehow defines the boundaries of the claimed receiver station. Nothing in the '243 patent supports such a construction, and it lacks a meaningful line of demarcation for the boundaries of the receiver station.

Based on the foregoing discussion, we determine Patent Owner has not carried its burden of demonstrating that our Final Written Decision should be modified. *See* 37 C.F.R. § 42.71(d).

C. Priority

The prior art status of Reiter (filed May 28, 1985) under 35 U.S.C. §102(e) hinges on the effective priority date for the '243 patent with respect to claim 13. Petitioner contends that the earliest effective priority date for the '243 patent is September 11, 1987. Pet. 9. The '243 patent was filed as a CIP (continuation-in-part) application through a chain of continuing applications purportedly having a priority date of November 3, 1981—the filing date of the earliest-filed ancestor patent in the chain, U.S. Patent No. 4,694,490. *See* Ex. 1002 (“the '490 patent”). Patent Owner contends that the effective priority date of the '243 patent is “the November 3, 1981 filing date of the '490 [p]atent.” PO Resp. 8.

As set forth below, Patent Owner contends that we overlooked or misapprehended three central matters issues in determining that the '243 patent, a CIP, is not entitled to the earlier filing date of the '490 patent. *See* Reh'g Req. 3–4.

1. Mass Medium Program

Patent Owner contends that we improperly denied priority to the earlier filing date of the '490 patent, because we erroneously determined that Patent Owner impermissibly broadened the scope of the term “programming” as it appears in the '490 patent via an amendment to the '243 patent Specification.⁵ See Reh'g Req. 4, 13–15. In our Final Written Decision, we determined that the disclosed term “programming” in both patents relates to the claim 13 term “mass medium program.” FWD 33. The Rehearing Request notes that the two terms are different and contends that “the Board’s analysis focuses on the wrong term.” *Id.* at 14. Also alleging that our analysis improperly relies upon the Abstract of the '490 patent to determine the scope of “programming,” the Rehearing Request provides new citations to the '490 patent allegedly as describing “programming” in a different context than the Abstract (which we relied upon).⁶ See FWD 33

⁵ Reference to the '243 patent “Specification” indicates the “Specification” of the '243 patent being challenged in this *inter partes* review, whereas reference to the '490 patent “specification” refers to the specification of the '490 patent (which is not being challenged here).

⁶ The Rehearing Request contends that “in the timeframe in which this patent was examined, it was impermissible for the abstract to be used as a source for claim construction.” Reh'g Req. 14 (citing MPEP (Rev. 52, 1977) § 608.01(b)). Patent Owner also contends that we misconstrued the import of the earlier Abstract. See *id.* at 14–15. Accordingly, we address and rely on Patent Owner’s new citations to the '490 patent.

(citing Ex. 1002, Abstract); Reh’g Req. 14–15 (citing Ex. 1002, 3:51–55, 10:48–49).⁷

These newly-cited passages of the ’490 patent do not discuss the term “mass medium program.” Rather, one newly-cited passage refers to “provid[ing] techniques whereby automatically, single channel, single medium transmissions, television, radio, or other electronic transmissions, [which] may be recorded, [and] co[]ordinated in time with other programing previously transmitted and recorded.” Ex. 1002, 3:51–56; Reh’g Req. 15. The other newly-cited passage states that “[p]rogramming can also be manually delivered . . . on prerecorded video tapes and video discs.” Ex. 1002, 10:48–49); Reh’g Req. 15.

On the other hand, the later-filed ’243 patent states that “the term ‘programming’ refers to *everything* that is transmitted electronically to entertain, instruct or inform, including television, radio, broadcast print, and

⁷ The Patent Owner Response does not cite directly to these newly-cited passages in Exhibit 1002, although it does cite to Patent Owner’s declarant’s testimony, which in turn cites to the passages—amounting to an improper incorporation-by-reference under Rule 42.6 (a) (3). See PO Resp. 14 (citing Ex. 2009 ¶¶ 40–42). Ordinarily, this type of newly-cited evidence in a rehearing request fails to show an overlooked matter. See 37 C.F.R. § 42.71(d) (rehearing request must identify “the place where each matter was previously addressed”). Nevertheless, we consider the arguments by Patent Owner on this issue (and the disclaimer issue discussed below), as Patent Owner contends that addressing an issue not discussed in the Institution Decision (albeit raised by both parties in their briefs) for the first time in the Final Written Decision is unfair. See Reh’g Req. 6–7; *infra* Section II.C.3 (disclaimer issue).

computer programming as well as combined medium programming.” See Ex. 1003, 6:37–40 (emphasis added); FWD 33 (quoting and relying on a portion of this broad disclosure). These newly-cited passages do not upset the determination in the Final Written Decision that the later-filed ’243 patent disclosure is broader with respect to “programming” and “mass medium program” than the disclosure of the earlier-filed ’490 patent. See FWD 33.

The Rehearing Request alleges that the determination is “defective,” but fails to explain how the newly-cited passages show that the term “programming” has materially equal breadth in the two patents. See Reh’g Req. 13–15 (alleging five reasons why the determination is “defective” without addressing the central issue). The broad definition in the ’243 patent potentially includes not only “combined medium programming” and “computer programming,” it also includes “*everything* . . . electronically transmitted” (subject to the quoted qualifiers) at the time of filing of the ’243 patent (i.e., assuming for the sake of argument written description exists for “everything” so transmitted), whereas the earlier disclosure, in context, only includes “other electronic transmissions”—i.e., in context, those “other” transmissions that were similar to conventional “single channel, single medium,” “television” or “radio” transmissions at the time of filing of the ’490 patent. Compare Ex. 1002, 6:37–40, with Ex. 1003, 3:51–56, 10:48–49; see Pet. 11–13 (discussing similar differences in the two patent disclosures). Accordingly, it follows that “mass medium program,” which is a type of a program (or programming) including more than a single channel

or medium, necessarily also must encompass broader subject matter in the later-filed '243 patent relative to the earlier-filed '490 patent.⁸

Furthermore, as stated in the Final Written Decision, Patent Owner “fails to clarify whether or not the broader definition of ‘programming’ applies to the claim term “mass medium program” as recited in claim 13, and Patent Owner “does not dispute that ‘the 1981 [s]pecification [i.e., the '490 patent specification] describes the term ‘programming’ differently than the 1987 Specification.’” FWD 33 (quoting PO Resp. 13–14). In its Rehearing Request, notwithstanding its new citations to the '490 patent that refer to “programming,” Patent Owner not only fails to explain why the '490 patent supports the term “mass medium program” in the same material fashion as the '243 patent, Patent Owner implies that “programming” and “mass medium program” are not related. See Reh’g Req. at 14 (noting that the parties did not construe “programming” or “mass medium program” and contending that “the Board’s analysis focuses on the wrong term”).

As we determined in the Final Written Decision, *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008), controls the outcome here. FWD 33 (citing *PowerOasis*, 522 F.3d at 1306–11 (an original specification does not support a claim that receives a broader interpretation

⁸ In a related case that involves a similar issue and the same respective 1981 and 1987 specifications, *Apple Inc. v. Personalized Media Commc’ns, LLC*, IPR2016-00755, slip. op. at 20, 26 (PTAB June 24, 2016) (Paper 7, Preliminary Response), Patent Owner contends that programming includes “digital television programming” (*id.* at 20) having “all digital content” or including “an **entire** digital signal transmission” (*id.* at 26).

based on later-filed new matter describing a term of the claim)). Contrary to Patent Owner's arguments, the Rehearing Request fails to distinguish *PowerOasis*. Reh'g Req. 15. Faced with Petitioner's prima facie evidence that claim 13 is not entitled to priority to the earlier-filed '490 patent (*see* Pet. 9–13 (citing Ex. 1005, 1043, 984–1044), *see infra* note 10), Patent Owner did not come forward and show with sufficient evidence or persuasive argument that the '490 patent supports the disputed term with materially the same breadth that the '243 patent supports it. *See* PO Resp. 13–14⁹; *PowerOasis*, 522 F.3d at 1305–06 (holding that the “district court . . . correctly placed the burden on [patentee] PowerOasis to come forward with evidence to prove entitlement to claim priority [from a CIP application] to an earlier filing date”). Of course, notwithstanding “shifting burden[s]” of “going forward with evidence” regarding priority, and assuming Patent Owner came forward with “sufficient evidence” or “persuasive argument,” *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008) (“the phrase ‘going forward with evidence’ . . . mean[s] both producing additional evidence and presenting persuasive argument”), the burden of showing unpatentability, including a lack of priority, remains with

⁹ Patent Owner's argument that “the Examiner [in the '243 patent Reexamination, *infra* note 10] subsequently dropped all rejections of claim 13 [after finding a lack of priority to the '490 patent] that relied on prior art references post-dating the 1981 priority date” does not mention that the Examiner ultimately deemed the issue moot because no intervening references were relied upon, as discussed below. *See* PO Resp. 13–14; FWD 32 (citing Ex. 1005, 139).

Petitioner. *See id.* at 1327–28 (discussing *PowerOasis*). Petitioner satisfies its burden of persuasion even if Patent Owner met its burden of going forward, because the weight of evidence shows that Patentee effectively broadened the scope of claim 13 relative the earlier-filed '490 patent.

Attempting to distinguish *Power Oasis*, Patent Owner contends that the finding of a lack of priority “flies in the face” of two prior reexamination decisions and fails to consider another reexamination decision. *See* Reh’g Req. 4, 15 (citing Ex. 1005,¹⁰ 56, Ex. 2003,¹¹ 20–21, Ex. 2006,¹² 13–16). Contrary to these arguments, the Final Written Decision does consider each reexamination proceeding. *See* FWD 3, 32–34 (citing and/or discussing Ex. 1005, 2003, 2006).

During the course of the instant trial, Petitioner persuasively argued, with respect to the 2010 reexamination decision (*see* Exhibit 2003, note 11), that the Board panel in that decision only determined that *conditional* priority existed—i.e., on the condition that Patent Owner limited the term

¹⁰ Patent Owner cites “Reexam No. 90/006,688,” which we interpret to be a citation to Exhibit 1005, 56. *See* Rehear. Req. 15. Exhibit 1005 contains the reexamination record for the '243 patent, including the Board’s “'243 patent Reexamination Decision,” *Ex Parte Personalized Media Commc’ns, LLC*, Appeal 2008-004816 (BPAI Mar. 5, 2009) (Reexam. Control. No. 90/006,688).

¹¹ *Ex Parte Personalized Media Commc’ns, LLC*, App. No. 2009-006825 (BPAI Jan. 19, 2010) (Reexam. Control Nos. 90/006,563 & 90/006,698, U.S. Pat. No. 5,335,277).

¹² *Ex Parte Personalized Media Commc’ns, LLC*, App. No. 2008-004228 (BPAI Dec. 6, 2008) (Reexam. Control No. 90/006,536, U.S. Pat. No. 4,965,825).

“programming” to the scope of the ’490 patent disclosure (albeit without deciding that scope). See Pet. Reply 8 (citing Ex. 2003, 21). For example, the Board panel reasoned that “[t]he fact that the later specification allegedly broadens the claim term [“programming’] is immaterial because the Appellant has adopted the earlier definition through the claim to priority.” Ex. 2003, 21. Rather than supporting Patent Owner, the finding of a “broader definition,” by the examiner that the Board noted in its 2010 reexamination decision (Ex. 2003, 21) supports Petitioner’s showing that priority to the ’490 patent cannot exist under the holding of *PowerOasis*. The Board in that prior reexamination decision did not disagree with the examiner’s finding in its 2010 reexamination decision, it only disagreed “with the Examiner’s reasoning.” Ex. 2003, 21. In other words, as indicated above, the Board conditioned the priority on the original relatively narrower disclosure in the ’490 patent, reasoning that even if the later-filed reexamined CIP patent provides a broader meaning to “programming,” this “evolved” scope would not show a lack of priority to the earlier-filed ’490 patent. See *id.*¹³ As we noted in the Final Written Decision, the Board’s reasoning in that 2010 reexamination decision does not account for the holding in *Power[]Oasis*. See FWD 33–34 (citing Ex. 2003, 20–21, Ex. 2006, 13–16).

¹³ The Board reasoned that the term “programming” would be restricted to the meaning found in the earlier-filed ’490 patent disclosure “plus any equivalents under the doctrine of equivalents.” *Id.*

As Petitioner also argued during the instant trial, contrary to Patent Owner's argument, the 2008 reexamination proceeding (*see* Exhibit 2006, note 12) lacks material relevance to this proceeding, because it involves a different patent with different claims and does not discuss "programming." *See* Ex. 2006, 15–16 (discussing support for claims 1, 20, and 22–25 of U.S. patent 4,965,825 with respect to the '490 patent); Pet. Reply 8. Finally, in the '243 patent Reexamination proceeding (*see* Ex. 1005, note 10), as discussed further below in the discussion of disclaimer, the Examiner deemed the issue of priority *moot* after first finding a lack of priority, *and the Board did not reach priority*, contrary to Patent Owner's characterizations in this trial. *See* FWD 31–32 (citing Ex. 1005, 139); Ex. 1005, 69 n.6, 139, 429, 1043, 984–1044 (cited by Pet. 9–10); *infra* Section II.C.3 (discussing Ex. 1005, 69 n.6 (the Board declining to reach priority because the Examiner deemed the issue moot due to the lack of intervening references)).

Based on the foregoing discussion, even considering Patent Owner's new arguments in light of Patent Owner's allegations of unfairness (*see* note 7), we determine Patent Owner has not carried its burden of demonstrating that our Final Written Decision should be modified. *See* 37 C.F.R. § 42.71(d).

2. Transmitting a Portion of Data in Response to a Query

Patent Owner contends that we erred in determining a lack of support in the earlier '490 patent specification for the following the claim phrase: "transmitting *at least a portion* of said data from said first remote data

source to said receiver station in response to said step of receiving said query, said receiver station *selecting and storing said transmitted at least a portion of said data*,” lacks original support in the ’490 patent specification. *See supra* claim 13 (emphasis added); Reh’g Req. 10–13.

Patent Owner’s Rehearing Request alleges that we failed to appreciate a disclosure of “**two** incoming transmissions that include data: the multi-challenge cable transmission and the telephone network-other-data-transfer-network.” Reh’g Req. 12. According to Patent Owner, this places the “single passage the Board did cite into proper context.” *Id.* (citing Ex. 2002, Fig. 1, Fig. 6C). Patent Owner’s arguments in its Rehearing Request are new. For the first time, Patent Owner includes annotations to a passage at column 19 of the ’490 patent that we relied upon in the Institution Decision and the Final Written Decision, demarcating how the (newly cited) two incoming transmissions correspond to different sentences in the relied-upon column 19 passage. *See* Reh’g Req. 12–13 (quoting and annotating Ex. 1002, 19:35–41). Patent Owner also argues, for the first time, that as to the first transmission (the cable transmission), “the stock data of interest is captured by comparison to identifiers reflecting the user’s particular portfolio.” *Id.* (citing Ex. 2002, 18:44–68).

Patent Owner fails to direct us to where it made these arguments in its Patent Owner Response, particularly with respect to the specific citation to column 18, or with respect to tying the two particular transmission types and citations to Figures 1 and 6C to the column 19 passage. *See* 37 C.F.R. § 42.71(d) (rehearing request must identify “the place where each matter

was previously addressed”). The Rehearing Request generally cites to the Patent Owner Response at pages 10 through 13. *See* Reh’g Req. 13. None of the particular arguments identified above appear on pages 10 through 13 of the Patent Owner Response. Page 13 thereof deals with a separate written description issue. The discussion at page 10 of the Patent Owner Response quotes and relies upon the same column 19 passage that the Preliminary Response, Institution Decision, Response, and Final Written Decision each quote and rely upon. Prelim. Resp. 12 (quoting Ex. 1002, 19:35–41); PO Resp. 10 (quoting same passage); Inst. Dec. 15 (quoting same passage); FWD 24 (quoting same passage and noting that Patent Owner relies on the same passage). The trial stage is too advanced to allow either party, as matter of fairness, due process, and expediency, to attempt to introduce new evidence and reorganize arguments around the central passage of the ’243 patent that has been at the heart of this particular priority issue throughout the trial.

Contrary to the citation in the Rehearing Request, pages 10 through 13 of the Patent Owner Response do not discuss or cite any figure or passage in the ’490 patent, other than the passage at column 19. We could not have misapprehended or overlooked an argument Patent Owner did not advance. Patent Owner has waived any reliance on these particular arguments newly raised in its Rehearing Request. *See* Paper 8, 3 (“The patent owner is cautioned that any arguments for patentability not raised in the response will

be deemed waived.”); 37 C.F.R. § 42.71(d) (“request must specifically identify . . . the place where each matter was previously”).

Patent Owner also argues that the basis for our error is in characterizing an embodiment in the ’490 patent specification as using a “transmitter that sends the stock data.” Reh’g Req. 11. Patent Owner argues that the passage we cited and relied upon says “**nothing** about a transmitter that sends the stock data.” Reh’g Req. 11. On the other hand, Patent Owner itself states that “the 1981 specification teaches a broadcast *transmission* (push model) for *distributing the day’s stock trade data* to a receiver.” Reh’g Req. 11 (emphasis added). Accordingly, Patent Owner’s point is not clear. A *transmission* model that distributes data necessarily must include some type of a *transmitter*.

Patent Owner also argues that the cited passage “also says **nothing** about a transmitter that ‘controls the data,’ whatever that means.” Reh’g Req. 11. Notwithstanding Patent Owner’s arguments, we explained in the Final Written Decision the central difference between what claim 13 requires and what the ’490 patent specification supports. FWD 25 (“In essence, in claim 13, the receiver’s query controls the portion of data transmitted to the receiver. In contrast, in the ’490 patent specification, the transmitter controls the data—its sends all the stock data for a given day, and the receiver then culls and records subscriber stock data from that transmitted data.”). Patent Owner fails to show that we overlooked or misapprehended a matter and mischaracterized this essential difference

between what claim 13 requires and what the '490 patent specification supports.

The Final Written Decision addresses Patent Owner's original arguments regarding the query embodiment (FWD 24–28), which Patent Owner refers to in its Rehearing Request as a “request-response embodiment where a query is submitted.” Reh'g Req. 13. Patent Owner relies on Dr. Russ's testimony about a “Viewdata type request-response system,” but fails to cite to where it argued in its Patent Owner Response that the '490 patent specification supports a Viewdata type request-response system that corresponds to support for claim 13. *See id.* We analyzed Dr. Russ's testimony, as cited in the Patent Owner Response. *See, e.g.*, FWD 26–27 (discussing PO Resp. 12 (citing Ex. 2009 ¶¶ 52, 58)). Although Dr. Russ cites to testimony by Dr. Neuhauser and each discuss Viewdata, Dr. Russ relies on a passage from Dr. Neuhauser's testimony about *Viewdata as disclosed in Ciciora*, a prior art reference, not the '490 patent specification. *See* Ex. 2009 ¶ 52 (quoting Ex. 10[01] ¶ 73). At the other cited paragraphs, Exhibit 2009, paragraphs 46–51, 53–58, cited by Patent Owner (Reh'g Req. 13), Dr. Russ does not mention Viewdata, and does not mention any specific figure in the '490 patent specification. Addressing Patent Owner's query theory, we determined that Patent Owner relied on “what was known” instead of what “the '490 patent applicants conveyed with reasonable clarity.” FWD 27.

In summary, Patent Owner failed to tie its current “Viewdata type request-response system” theory in a sufficiently clear fashion, if at all, to

the '490 patent in its Patent Owner Response, as it now argues, for the first time, in its Rehearing Request. *See* Reh'g. Req. 13. Stated another way, Patent Owner did not argue, in its Patent Owner Response, that a query embodiment disclosed in the '490 patent uses Viewdata, and did not mention Viewdata with respect to this issue or with respect to any specific figure in the '490 patent, much less tie Viewdata to a disclosed query embodiment. *See* PO Resp. 10–12 (citing Ex. 2009 ¶¶ 46–48, 51, 52, and 58). As explained above, we could not have overlooked or misapprehended arguments made for the first time in a request for rehearing. We decline to reach these new arguments, which Patent Owner has waived.

Based on the foregoing discussion, we determine Patent Owner has not carried its burden of demonstrating that our Final Written Decision should be modified. *See* 37 C.F.R. § 42.71(d).

3. Disclaimer

In the Final Written Decision, we determined that during prosecution of the '243 patent, in response to a double patenting rejection to all the pending claims under *In re Schneller*, 397 F.2d 350 (CCPA 1968), that Patent Owner, as Patentee, affirmatively disclaimed priority (in terms of 35 U.S.C. 112, first paragraph support for pending claims, including challenged claim 13) to the '490 patent Specification (as opposed to CIP priority for common subject matter). *See* FWD 30–32. Patent Owner contends in its Rehearing Request that we erroneously found that Patentee disclaimed that priority (i.e., to the November 3, 1981 filing date of the '490 patent Specification). *See* Reh'g Req. 3, 7–9.

Patent Owner also contends that we performed a “flip-flop” by first deciding in the Institution Decision that it was unnecessary to resolve the disclaimer dispute, and then addressing the issue in our Final Written Decision. *See* Reh’g Req. 7. Patent Owner characterizes the alleged “flip-flop” as “misleading and unfair.” Reh’g Req. 7. Patent Owner’s characterization fails to acknowledge that we decided at the time of Institution that such a decision was unnecessary “at this juncture;” i.e., for purposes of institution. Dec. on Inst. 16. It also fails to acknowledge that Patent Owner and Petitioner each squarely continued to place the issue before us by arguing it in their briefs after the Institution Decision. *See* PO Resp. 9, 14–15; Pet. Reply 8–9. Nevertheless, to address Patent Owner’s allegations about fairness, as discussed above (*see* note 7), we grant Patent Owner some leeway to address the new *Schneller*-based arguments advanced in the Rehearing Request (i.e., as if they were part and parcel of the *Schneller*-based arguments advanced in the Patent Owner Response).

In the Final Written Decision, we found that, in arguing that the *Schneller* based double patenting rejection was improper, “Patent Owner does not dispute Petitioner’s contention” that Patent Owner “twice argued that the ’243 patent does not claim continuity to the ’490 patent specification.” FWD 29 (citing Pet. 15–16; Ex. 1004 (prosecution history of the ’243 patent) 127, 192).¹⁴ We also found that during prosecution of the

¹⁴ Under *Schneller*, 397 F.2d 350, the Examiner rejected all of the pending claims (claims 3–33) on the premise that there was no reason why Patentee

'243 patent, "Patent[ee] conceded '*a basis for claiming the present subject matter*' in its earlier filed '490 patent specification, rendering the Examiner's reliance thereon reasonable." *Id.* at 30 (citing Ex. 1004, 127, 192 (emphasis added)). Patent Owner does not dispute these findings in its Rehearing Request.

Rather than disputing that it *twice* made such a disclaimer during prosecution, Patent Owner stresses that its disclaimer was "a single ***mistake***," or "anything by a clear and unmistakable disavowal of priority." Reh'g Req. 9. In attempting to negate its "mistake[n]" disclaimer, Patent Owner alleges that during prosecution of the '243 patent it made competing assertions for priority to the '490 patent (i.e., allegedly undermining the otherwise clear disclaimers), and also argues that the "Board does not dispute" that priority to an earlier patent is "***completely irrelevant*** to *Schneller* double patenting rejection." See Reh'g Req. 9.

Contrary to these arguments, we found that Patentee forcefully argued to the Examiner that the *Schneller* rejection was improper. FWD 30. As noted in the Final Written Decision, Patentee argued during prosecution that "the [E]xaminer's rejection . . . under the Schneller patenting theory []was *improper because the present application does not claim the benefit of those applications under 35 § U.S.C. 120. Thus, there could never have been a*

could not have presented the claims in the earlier '490 patent application; i.e., at least implicitly asserting (prima facie) written description support for the claims in the '490 patent application as necessary under *Schneller*. See Ex. 1004, 212–217, 221–22; PO Resp. 14.

basis for claiming the present subject matter.” Ex. 1004, 127 (emphasis added, quoting Applicant’s Supplemental Response and Amendment (Dec. 5, 1997)), *see also id.* at 76 (Supplemental Response cover sheet); FWD 30 (similar quotation). This disclaimer virtually duplicates an earlier response by Patentee making the same clear disclaimer. *See* Ex. 1004, 192 (corresponding to Applicant’s Amendment (July 8, 1997), *id.* at 143 (Amendment cover sheet)).

Contrary to Patent Owner’s current characterization, this was not “a single ***mistake***” (Reh’g Req. 9)—it was a concerted, well-reasoned argument that Patentee advanced on the two separately noted occasions during prosecution. *See* Ex. 1004, 127, 192. Patent Owner’s clear and repeated arguments stressing that *Schneller* does not apply, based on a lack of written description support, does not carry any evidentiary hallmarks of a mere “misstatement” or “obvious mistake,” contrary to the arguments now advanced by Patent Owner. *See* Reh’g Req. 3, 9. Advancing its disclaimer argument in a “detailed, consistent, and repeated” fashion in two separate Office Action responses (Ex. 1004, 127, 192) shows it was no mistake. *See Springs Window Fashions LP*, 323 F.3d 989, 995 (Fed. Cir. 2003) (“The statements distinguishing Pluber were *detailed, consistent, and repeated*. A reasonable competitor would have believed that the applicant’s disclaiming statements were not a mere mistake.”) (emphasis added).

In other words, the *Schneller* doctrine, as Patentee persuasively twice argued during prosecution, required “a basis for claiming the present subject matter”—i.e., that doctrine requires written description support in the earlier

filed 1981 application (for the rejected claims) in order to support the double patenting rejection, and Patentee specifically stated it did not claim the priority benefit under 35 § U.S.C. 120. *See supra* note 14; Ex. 1004, 127, 192. In response to Applicant’s Supplemental Response (December 5, 1997) that included the disclaimer argument, the Examiner withdrew its *Schneller* based double patenting rejection. Ex. 1004, 63 (Final Office Action (Dec. 23, 1997), withdrawing the *Schneller* based rejection “[i]n view of further analysis and applicant’s arguments”); Ex. 1004, 212, 221 (Office Action (June 7, 1995) rejecting all of the original claims under *Schneller*, claims 3–33).

Although Patent Owner asserts that the Examiner did not rely on the disclaimer, but relied on other arguments made by Patentee (*see* PO Resp. 14), as noted, the record shows that the Examiner relied on Patentee’s arguments, without indicating which particular argument (i.e., including the disclaimer) overcame the rejection. Ex. 1004, 63. In any case, the Examiner’s response, especially one that accepts Patentee’s arguments, does not negate a clear disclaimer by a Patent Owner. *See Springs Window Fashions*, 323 F.3d at 995 (“even if it is not clear from the record why the [E]xaminer allowed the claims. . . . the [E]xaminer’s remarks do not negate the effect of the applicant’s disclaimer”); *Laitram Corp. v. Morehouse Indus., Inc.*, 143 F.3d 1456, 1462 (Fed.Cir.1998) (“Regardless of the examiner’s motives, arguments made during prosecution shed light on what the applicant meant by its various terms. . . . The fact that an examiner placed no reliance on an applicant’s statement distinguishing prior art does

not mean that the statement is inconsequential for purposes of claim construction.”) (cited and quoted by *Springs Window Fashions*, 323 F.3d at 995).

Patent Owner argues in its Patent Owner Response that Patentee advanced two central theories during prosecution to overcome the *Schneller* rejection: that Patentee 1) “demonstrated that the claims were patentably distinct,” and 2) “in error, included a statement about priority.” PO Resp. 15. The record supports Patent Owner’s contention that it advanced two central theories, but nothing shows the priority argument was in error. *See* Ex. 1004, 192–93 (arguing *Schneller* does not apply because 1) “there was no [priority] basis for claiming the present subject matter” and also 2) because the current application claims “are distinct from the claims in the [earlier] Harvey patents”); *accord* Ex. 1004, 127–28 (same arguments—i.e., advancing both theories).

In light of the clear arguments (twice made) overcoming the *Schneller* rejection, the priority statement was not made in error.¹⁵ Patent Owner’s

¹⁵ In the related case, *Apple Inc. v. Personalized Media Commc’ns, LLC*, IPR2016-00755, slip. op. at 4 (PTAB July 27, 2016) (Paper 12, Patent Owner’s Sur-reply in Response to Petitioner’s Preliminary Reply) (*see supra* note 8), Patent Owner implies that virtually the same disclaimer statement it made during prosecution of a related CIP patent would have applied only to its then pending claims (which were later cancelled), because they were not supported by the 1981 Specification:

The early statements made by PMC were directed to claims 3–32 which each recited “*modifying a fashion in which*

allegations that it claimed priority to its earlier '490 patent specification “multiple times,” based on CIP status, does not negate Patentee’s clear priority disclaimer. Reh’g Req. 7; *see also id.* at 8 (citing Ex. 1004 as showing priority assertions made during prosecution). Regardless of these alleged continuity assertions, any statements allegedly claiming priority simply either coalesce with Patentee’s alternative theory to overcome the *Schneller* based rejection (i.e., its prosecution argument that the claims are distinct over the prior application claims), or simply refer to CIP priority to common subject matter.

As to the latter, claiming CIP priority to the earlier-filed '490 patent, which the '243 patent does, does not conflict with the disclaimer, because under CIP status, the later-filed application may support all the claims—i.e., without any support for the claims in the earlier-filed application. An applicant may claim CIP status merely if two applications have common subject matter (and other formal requirements are met), where the later application adds new matter, regardless of whether there is 35 U.S.C. 112, first paragraph support for any of the claims. *See PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1304, n.3 (Fed. Cir. 2008) (“A ‘CIP’ application is a continuation-in-part application containing a portion or all of

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.* *Id.* at 4 (emphasis added).

the disclosure of an earlier application together with added matter not present in that earlier application. . . . [T]he quintessential difference between a continuation and a continuation-in-part is the addition of new matter.”). “Since CIPs generally add new matter, the claims may be fully supported by the parent application *or they may rely on the new matter for support.*” *Id.* at 1305, n.4 (emphasis added). “Determining the effective filing date each claim in a CIP application is entitled to can be quite complex.” *Id.* “The PTO’s . . . procedures indicate that examiners do not make priority determinations except where necessary”—e.g. “unless a filing date is actually needed.” *Id.* at 1305 (citing and quoting M.P.E.P., Seventh Ed. (July 1998), at § 201.08).¹⁶

Therefore, similar to the situation in *Springs Window Fashions*, “[t]here is nothing in the prosecuting attorney’s remarks that is at odds with anything in the specification or the claims,” or any other arguments. *See Springs Window Fashions*, 323 F.3d at 996. A competitor would not have interpreted any alleged CIP priority assertions to the ’490 patent as conflicting with the clear disclaimer. Also, as indicated above, even if any priority assertions in the prosecution history somehow may be interpreted as priority assertions to *claimed* subject matter, a competitor reasonably would

¹⁶ *Accord* M.P.E.P., Sixth Ed. (Jan. 1995), at § 201.08 (“no need [normally exists to determine compliance] with the first paragraph of 35 U.S.C. 112,” “an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier application if the alleged [CIP] application complies with . . . formal requirements of 35 U.S.C. 120”).

have interpreted such a CIP priority assertion as an attempt to obtain priority at most to one or more unspecified claim(s) under Patent Owner's alternative theory of distinct claims. Advancing two competing theories does not show one was made in error.

Furthermore, even if Patentee made an "error," Patentee did not acknowledge the disclaimer in allegedly correcting it (or, for example, attempt to claim continuity status, as opposed to CIP status, to the earlier filed application). See FWD 31. *Springs Window Fashions* indicates that an applicant must correct the file record wherein the error allegedly was made, not change course later. See *Springs Window Fashions*, 323 F.3d at 995 (stating "the applicant should have amended the file to reflect the error" and "[a] patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement."). Even "[i]f the applicant mistakenly disclaimed coverage of the claimed invention, then the applicant should have amended the file to reflect the error, as the applicant is the party in the best position to do so." *Id.* "The public notice function of a patent and its prosecution history *requires that a patentee be held to what he declares during the prosecution of his patent.*" *Id.* (emphasis added). Like the applicant in *Spring Window Fashions*, Patentee "*never retracted any of his statements*" and "*therefore must be held to the restrictive*" disclaimer of priority "*that was argued during prosecution.*" See *id.* (emphases added).

In a further attempt to show an unclear disclaimer, or mistake, Patent Owner cites to the face of the patent as showing "[t]he disclosure of the

priority document . . . filed November 3, 1981.” Reh’g Req. 8. Patent Owner fails to acknowledge that this “priority” merely claims “continuation-in-part” (CIP) status to the ’490 patent Specification (filed on November 3, 1981). Ex. 1003 [63]. Similarly, Patent Owner obscures the type of priority (CIP) asserted by arguing that “the face of the ’243 Patent *has a priority* assertion to 1981.” Reh’g Req. 7 (emphasis added). Patent Owner’s assertions of generic priority that only involves CIP priority highlights why a competitor properly would not rely on such prosecution history “priority” assertions as arguing support for *claimed* subject matter, but would rely on the clear priority disclaimer.

In its Patent Owner Response, in addition to citing reexamination proceedings, Patent Owner originally only cited to two places in the prosecution history record related to the original prosecution of the ’243 patent wherein Patent Owner allegedly corrected (or allegedly obscured) the clear disclaimer. See POR 15 (citing Ex. 1004, 48, 113–114). We addressed these citations to the original prosecution record in the Final Written Decision. See FWD 31–32. For example, Patent Owner does not challenge Petitioner’s assertion, noted in the Final Written Decision, that “PMC never advised the [E]xaminer that it was withdrawing its prior disclaimer, or that the double patenting rejection should be revisited.” See Pet. Reply 9; FWD 30–31. As also found in the Final Written Decision, during prosecution, the Examiner specifically noted “applicant’s latest effective filing date of 9/11/87” (Ex. 1004, 70), and Patentee’s self-serving statements did not amount to a clear correction. See FWD 31–32 & n.5 (citing Ex. 1004, 23–

24, 48, 51, 70, 139). This occurs in the same Final Office Action wherein the Examiner withdrew the *Schneller* double patenting rejection “[i]n view of further analysis and applicant’s arguments.” Ex. 1004, 63.

Moreover, in response to the Final Office Action, Patentee stated the following:

Examiner stated “[n]umerous references listed in the IDS [Information Disclosure Statement] are subsequent to the applicant’s latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear.” Upon further examination, *the Applicants have eliminated those patents and publications after the effective filing date for the present application.* It is Applicants’ *understanding that the effective [sic] for the present application is 11/3/81.*

Ex. 1004, 48 (March 6, 1998) (emphases added).

Patent Owner relies on this asserted “understanding” as “correct[ing] the examiner’s statement.” Reh’g Req. 8 (citing Ex. 1004, 48). Far from being a clear retraction of priority for any specific claim as required under *Springs Window Fashions*, this statement shows that Patentee acquiesced to the Examiner’s assertion of the later filing date by indicating it removed cited references after the 9/11/87 date from its attached IDS—i.e., *without removing references after the “11/3/81” filing date.*¹⁷ See Ex. 1004, 52–60

¹⁷ The IDS (March 6, 1998) submitted by Patentee verifies this understanding—it only lists references through 1987. The last reference to Faerber et al. (U.S. Pat. No. 4,782,401) dated November 1, 1988, refers to its issue date, not its filing date. The IDS shows that the references listed thereon have effective filing or publication dates prior to the Sept. 11, 1987, filing date at issue here. See Ex. 1004, 55.

(IDS); FWD 31 (discussing the same issue) (emphasis added); *Springs Window Fashions*, 323 F.3d at 995 (applicant “*never retracted any of his statements*” and “*therefore must be held to the restrictive*” disclaimer). Following the Examiner’s logic, which Patentee apparently did by removing the post-1987 dated references, had Patentee intended to clarify the record and claim priority for all rejected *claims* back to 1981, they at least could have eliminated references with publication or filing dates after 1981, rather than merely further obscuring the record by stating what it “understood” to be “effective.” *See* Ex. 1004, 48.

As another example, Patent Owner states that during prosecution it provided specific support for challenged claim 13 (then pending claim 15) in the Nov. 3, 1981, ’490 patent specification. *Reh’g* Req. 8 (citing Ex. 1004, 112–14). Patent Owner also asserts that the Examiner “made a finding establishing 1981 as the priority date when he withdrew his § 112 objection and allowed multiple claims.” *Id.* at 8, n.2 (citing Ex. 1004, 108, 118). Patent Owner mischaracterizes the prosecution history record. According to Patentee’s summary, the Examiner did not object to claim 13 (original claim 15), or reject it, under 35 U.S.C § 112, first paragraph. *See* Ex. 1004, 108. Rather, the Examiner merely “objected” to claim 15 “because of various informalities.” *Id.*; Ex. 1004, 222 (objecting to claim 15 and stating that “- - and- - should be inserted after ‘data’”). In response to this objection about certain informalities, Patentee stated that “claim 15 relates to similar concepts and, additionally, the concept of issuing a query to a data source.” Ex. 1004, 113 (citing the ’490 patent Specification). This response to an

objection about an informality by the Examiner fails to show written description support for the full claim, fails to correct the two disclaimers, and fails to indicate the disclaimers were in error or equivocal.¹⁸

Furthermore, this statement appears in the same Response as the latest disclaimer, and does not conflict with it. The Examiner's understanding of the priority date as 1987 in the Final Rejection (Dec. 23, 1997, Ex. 1004, 70) also contradicts Patent Owner's characterization that the Examiner earlier "made a finding establishing 1981 as the priority date." See Reh'g Req. 8, n.2 (citing Ex. 1004, 108, 118).

The record reflects that the Examiner only rejected one specific claim term in an unchallenged claim (i.e., unchallenged here) as lacking 35 U.S.C. 112, first paragraph support in '490 patent. See Ex. 1004, 225–26 (rejecting original claim 31, based on questioned support for the term "receiving the instruct signals concurrently"). Patentee's responses to the Examiner's objections address formalities relative to various terms objected to, and do not show support for any claim in full. Ex. 1004, 182 (Applicant responding to the "objection to the specification and rejection of claims 23–26 under 35 U.S.C. 112, first paragraph," and arguing that "the priority document, the '81 case, is fully enabling *regarding the terms objected to by the Examiner*"

¹⁸ Again, even if Patentee alleged prior support for all of the claimed subject matter of claim 13, this merely would coalesce with the alternative distinct claim theory; as such, it would not conflict with the disclaimer or show an unclear disclaimer.

(emphasis added)).¹⁹ Challenged claim 13 (original claim 15), like all of the claims except for original claim 31, was not rejected under 35 U.S.C. 112, first paragraph, or even objected to as lacking support in the 1981 '490 patent specification. *See* Ex. 1040, 226 (“Clam[s] 5, 11, 15, 17, and 18 are objected to because of the following informalities.”). Therefore, nothing in the record conflicts with Patentee’s disclaimer of support for challenged claim 13 (and most if not all of the other claims).

In *Springs Window Fashions*, the court indicated that the lack of a conflict with the record indicates that a disclaimer is not an error. *See Springs Window Fashions*, 323 F.3d at 996 (“There is nothing in the prosecuting attorney’s remarks that is at odds with anything in the specification or the claims.”). The applicant in that case advanced two theories, arguing that it had distinguished the claims over a reference to Pluber, and also that Pluber was not prior art. *Id.* at 994–95. As noted above, the court found that the reasons for allowance were not clear, but instead of relying on applicant’s assertion that “the examiner allowed the claims based on an entirely distinct rationale: that Pluber was not prior art,” *id.* at 994, the court held that the applicant had disclaimed subject matter based on applicant’s argued distinctions over the prior art. *See id.* at 995 (stating “the applicant should have amended the file to reflect the error”).

¹⁹ Notwithstanding Applicant’s response about an “enabling” disclosure with respect to claims 23–26, the Examiner rejected them “for the reasons set forth in the objection to the specification”—i.e., “in the ’87 disclosure,” and not the 1981 ’490 specification.

Contrary to Patent Owner's related argument that the Board "ignored the PTO's own prior decisions in reexamination" regarding priority, we discussed the proceedings in the Final Written Decision, and they do not conflict with the holding here, contrary to Patent Owner's characterizations. *Supra* Section II.C.1; FWD 3, 32–33 (discussing Ex. 1005, 2003, 2006). For example, Patent Owner contends that the in "reexamination proceedings," the Board "affirmatively [found] that the '243 Patent had priority to 1981." Reh'g Req. 9.

Assuming for the sake of argument that a later reexamination proceeding serves as a vehicle to correct an earlier disclaimer without informing the reexamination examiner about the disclaimer and the rejection it overcame, Patent Owner mischaracterizes the '243 patent Reexamination record. We addressed that record in the Final Written Decision and found after a similar argument by Patent Owner that the '243 patent Reexamination Examiner deemed "the issue of priority . . . moot as intervening references are not relied upon in any of the rejections." FWD 31–32 (quoting Ex. 1005, 139). Patent Owner does not challenge this finding. Furthermore, contrary to Patent Owner's arguments, as noted above, the Board specifically declined to reach the issue of priority in the '243 Reexamination Decision that Patent Owner appears to rely upon. *See* Ex. 1005, 69 n.6 (considering anticipation rejections to be under 35 U.S.C. § 102(e), instead of § 102(b), because the Examiner had deemed the issue of priority moot); *supra* note 10 (citing the '243 Reexamination Decision).

Allowing Patent Owner to take a “mulligan,” *see Spring Window Fashions*, 323 F.3d at 996, on its clear disclaimer that Patentee argued overcame the *Schneller* double patenting rejection, would allow Patent Owner to change course and raise the possibility of capturing early alleged infringers contrary to the thrust and holding of *Springs Window Fashions*, *id.* It also would violate clear precedent involving similar circumstances. *See Bradford Co. v. Conteyor N. Am., Inc.* 603 F.3d 1262, 1270 (Fed. Cir. 2010) (holding a patentee is estopped from asserting priority of a CIP application to an earlier-filed application after responding to a double patenting rejection with an argument that the earlier-filed application failed to disclose certain claim limitations, reasoning that “arguments made to persuade an examiner to allow an application trump an ambiguous disclosure that otherwise might have sufficed to obtain an earlier priority date”).²⁰

Based on the foregoing discussion, even considering Patent Owner’s new arguments in light of Patent Owner’s allegations of unfairness (*see note 7*), we determine Patent Owner has not carried its burden of demonstrating that our Final Written Decision should be modified. *See* 37 C.F.R. § 42.71(d).

²⁰ *Bradford* also addresses Patent Owner’s critique of the Board for not “cit[ing] any authority—even one case- -for the concept of ‘priority date disclaimer.’” Reh’g Req. 7.

4. Summary

Patent Owner has not shown that claim 13 in the '243 patent is entitled to a priority date prior to September 11, 1987. Thus, Reiter antedates the effective priority date of claim 13 of the '243 patent.

III. CONCLUSION

Based on the foregoing discussion, we deny Patent Owner's request to withdraw our finding and determination that claim 13 is unpatentable.

IV. ORDER

For the reasons given, it is ORDERED that the Patent Owner's Rehearing Request is *denied*.

IPR2014-01527
Patent 5,887,243

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