UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,
Petitioner

v.

DODOTS LICENSING SOLUTIONS LLC,
Patent Owner

Case IPR2023-00937
U.S. Patent No. 9,369,545

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**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE**

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## I. Slivka failed to properly submit HTML code.

It is undisputed that the 177 pages of appendices Slivka submitted to the Patent Office is comprised of twenty separate appendices. Transmittal Letter, Ex. 2011. Though certain appendices are textbook excerpts (e.g., R, S, and T), Apple's Appendices (i.e. appendices A, C, D, E and F) comprise five different HTML files. And each of Apple's Appendices are less than 10 pages; in fact, they total less than 10 pages. These appendices that are not part of the application because Slivka failed to follow the requirements set forth in MPEP 608.05 and 37 C.F.R. 1.96.

In fact, Apple does not dispute that its appendices were submitted in a manner that runs afoul of these provisions. Instead, Apple argues that Slivka did not have to follow 37 CFR 1.96 because the Apple Appendices are not "computer program listings." *See* Reply at 2. Apple is wrong and its argument is counter to what Apple states in its petition. MPEP 608.05 defines "computer program listings" as a "printout that lists, in proper sequence, the *instructions*, routines and other contents of a program for a computer." *See* Ex. 2008 at 600-88. And in its petition, Apple's expert argues that "Slivka teaches exemplary *HTML instructions* in individual HTML documents, such as Appendices C-F." *See* Exhibit 1003 at ¶ 48. Given the plain words of MPEP 608.05 and Apple's expert admitting that Appendices C-F contain HTML "instructions," there can be no dispute that Apple's Appendices contain "computer program listings."

37 C.F.R. §1.96(b), "[m]aterial which will be printed in the patent," *requires* computer program listings of ten pages or less to be submitted "as drawings or as part of the specification" by positioning it at the "end of the description but before the claims." Ex. 1017 at 15. Alternatively, §1.96(c) titled "[a]s an appendix which will not be printed" *requires* submission of programs over ten pages "in the form of microfiche, [and must be] referred to in the specification…as 'microfiche appendix.'" *Id*. Slivka did *not* follow either of these two required procedures; the appendices are not printed in the patent and there is no reference to a "microfiche appendix." Therefore, Apple's Appendices are not part of Slivka.

## II. Slivka separated its appendices from specification.

DoDots agrees that the appendices were filed with the application and other documents, and that all of the documents were stamped with the same filing date. *Reply* at 1. But that fact carries no weight. Filing a collection of documents that includes an application and appendices does not mean that the appendices are incorporated into the patent specification. To conclude otherwise would eviscerate 37 C.F.R. 1.96. Apple's claim that the applicant "expressly not[ed] the incorporation of the appendices to the Examiner during prosecution of the Slivka patent" is also plainly false. *Reply* at 1. Slivka did *not* note that he was incorporating the appendices to the specification.

## III. Merely attaching references is not incorporation.

Apple argues that Slivka provides "clear and consistent references to the appendices throughout the specification." But every citation Apple provides to support its argument shows the opposite—that the appendices are not incorporated by reference into the patent specification and instead merely called out as an attachment to the patent. Every appendix is characterized as simply being "attached hereto" or "attached…respectively." Referencing appendices as being attached is not incorporating the contents of the appendices into the "entire disclosure" of specification. Per 37 CFR 1.96, simply noting that code is attached is not the proper way to incorporate computer program listings into a patent.

Further, Apple's discussion of the policy underlying 102(e) is irrelevant as to whether the Slivka appendices are 102(e) prior art.[1] 35 USC 316(e), which places the burden of proof to show unpatentability, overrides any policy argument. To meet its burden here, Apple must show that a document it relies on is actually prior art. For reasons set forth above and in the POPR, Apple failed to meet this burden.

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[1] Petitioner cites MPEP 2136.02 to say that Slivka's entire disclosure can be relied on to reject the claim. But Petitioner ignores that MPEP 2136.02 also states "that the *disclosure* relied on in the rejection *must be present* in the issued patent." Here, there is no dispute that the Apple Appendices are "not present" either at the "end of the description but before the claims" per §1.96(b) or in a "microfiche Appendix" per §1.96(c). As a result of this failure to follow §1.96, the "entire disclosure" of the Slivka application or patent as issued does not include the appendices.

Dated: November 1, 2023

Respectfully submitted,

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE was served electronically via email on November 1, 2023, on the following counsel of record for Petitioner:

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