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

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question of first impression—whether a disclosure contained in appendices submitted with a patent application should be withdrawn from the public as prior art under 35 U.S.C. § 102(e) due to the prior art patent's alleged failure to properly incorporate those appendices by reference.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

BOX 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, 9 ("***Our determination is based on finding***[1] that Petitioner's challenge relies on appendices (Ex. 1005, 69–245) missing from the '695 patent (Ex. 1004) and ***insufficient indication on the record that the appendices have been incorporated into the '695 patent***, and that as a result, the relied-upon appendices do not 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 11. From this, the Board concluded they had not been properly incorporated by reference. *Id*. at 11-12 (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.

Appendices to be part of the Slivka Patent and to constitute a public disclosure of the material contained therein. Nor is there any question that the Slivka Appendices were in fact made available to the public at the *same time* and via the *same means* as if they had been properly incorporated by reference. There are also no legitimate concerns with public notice—the often-cited rationale for requiring material incorporated by reference be identified with "detailed particularity." Indeed, the Slivka Appendices that were submitted as part of the application are contained within the file history and are referred to as "attached" throughout the specification. Further, as illustrated in the following excerpt, the Slivka Patent provides extensive and specific detail as to how the portions of the Slivka Appendices relied upon by Petitioner *relate to* and *elaborate on* the relevant disclosures in the Slivka Patent:

> FIG. **5** illustrates an example hypertext desktop view **150** produced and displayed in the desktop display **52** (FIG. **2**) on a video screen of the computer **20** (FIG. **1**) according to the illustrated embodiment of the invention. The example hypertext desktop view **150** is produced in the illustrated shell **50** by processing a set of templates using the pre-processor **60** (FIG. **2**), including a "Desktop.htm" template, and a "Dsk_1.htm" template which are listed in the attached Appendices A and B, respectively. As a result of this processing, the pre-processor **60** outputs a hypertext page consisting of a "Sfv2395.tmp" and a "Sfv15143.htm" HTML format files which are listed in the attached Appendices G and H, respectively. This synthesized hypertext page additionally incorporates data from the HTML format files, "Infopane.htm," "news.htm," "ticker.htm," and "tickhost.htm" which are listed in the attached Appendices C through F, respectively. The synthesized hypertext page is parsed by the hypertext viewer **70** to generate the example hypertext desktop view **150**.

Ex. 1004 (Slivka Patent), 18:49-67 (explaining the relevance of specific portions of the Slivka Appendices to specific portions of the Slivka Patent) (annotated); Paper 1, 12-15 (explaining teachings from the Slivka Patent and Slivka Appendices relevant to the proposed grounds). Accordingly, the Slivka Patent identifies with detailed particularity how the Slivka Appendices relied upon by Petitioner are *relevant to* and *elaborate on* specific portions of the Slivka Patent specification.

The policy rationale underlying §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, ensuring that no patent is issued on material previously submitted by another to the Office. 35 U.S.C. § 102(e)(2); *Hazeltine Research, Inc. v. Brenner,* 382 U.S. 252, 255-256 (1965) (explaining that prior art 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."). Indeed, the legislative history confirms § 102(e) is founded on the principle that an invention's priority is assessed as of the date of filing "for the purpose of anticipating a subsequent inventor." S. Rep. No. 1979, 82d Cong., 2d Sess. 17 (1952); *see also* H. R. Rep. No. 1923, 82d Cong., 2d Sess. 17 (1952) (noting that under §102(e), "for the purpose of anticipating subsequent inventors, a patent disclosing the subject matter speaks from the filing date of the application ***disclosing the subject matter***."). Excluding the Slivka Appendices from the prior art solely because the applicant referenced the appendices using what the Board deemed the

wrong particularized language is directly at odds with the rationale underlying § 102(e). Any failure on the part of the applicant to use procedurally correct language when referring to the Slivka Appendices should impact only the scope and/or validity of the Slivka Patent. The public should not be punished by allowing others to patent that which had already been disclosed to the Office.

II. LEGAL STANDARD

"Requests for Director Review of the Board's decision whether to institute an AIA trial, or decisions granting rehearing of such a decision, shall be limited to decisions presenting (a) an abuse of discretion or (b) important issues of law or policy." USPTO, Revised Interim Director Review Process at 2.B, Availability of Director Review: AIA Trial Proceedings (last modified July 25, 2023), https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process.

III. ARGUMENT

A number of statutes and Office rules are implicated by the Board's decision. Critically, none of the policy rationales underlying those implicated statutes and rules align with the result of the Board's decision. Indeed, the Board's decision withdraws from the public a prior art disclosure solely because the prior art applicant purportedly used the wrong language to reference a set of appendices. This decision fails to acknowledge that the Slivka Patent put the public on notice of the Slivka

Appendices disclosure that was intended to be public as part of the Slivka Patent. The decision also fails to credit the fact that the Slivka Appendices were indeed made public at the *same time* and via the *same means* as if the applicant has stated the appendices were "incorporated by reference," rather than "attached." This decision allows others to patent that which had already been disclosed to the Office, directly conflicting with the policy rationale underlying § 102(e).

A. The Board's Decision Undermines Policy Rationale of § 102(e)

Today, the Office maintains patent applications in confidence for eighteen months after filing. 35 U.S.C. §122; 37 C.F.R. §1.211. When the application that issued as the Slivka Patent was filed, applications were maintained confidentially until issuance. Ex. 1018, 37 C.F.R. § 1.11 (Rev. 2, July 1996), 4 (noting a patent and its file history were made public upon issuance). But for this confidentiality policy during which the Slivka Appendices were maintained confidentially for almost three and a half years, they would have been made public—as the applicant intended—upon filing. And had the Slivka application with appendices been made public upon filing, they would have been prior art pursuant to 35 U.S.C. § 102(b), having been filed many years before the earliest possible priority date for the Challenged Patent.

Accounting for this period of confidentiality post-filing and to ensure that the patent system accurately recognizes the true first inventor of a given concept, § 102(e) dictates that disclosures submitted to the patent office before the priority date

qualify as prior art even if they do not become publicly available until later. 35 U.S.C. § 102(e)(2); *Hazeltine Research*, 382 U.S. at 255-256 (explaining that prior art 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, Congress expressly codified this very rationale as § 102(e). S. Rep. No. 1979, 82d Cong., 2d Sess. 17 (1952) (explaining that § 102(e) "is new and enacts the rule of *Milburn v. Davis-Bournonville*. . . for the purpose of anticipating a subsequent inventor"). Further, 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).

The rationale underlying § 102(e) strongly supports concluding that the Slivka Appendices are prior art. They were submitted with the application well *before* the priority date of the Challenged Patent and they became public (as part of the Slivka Patent file history) *after* the priority date solely as a result of the Office policy that maintains applications in confidence for a period of time post-filing. § 102(e) ensures Office delay does not "cut down the effect of what has been done" "for the purpose of anticipating a subsequent inventor." Ignoring the Slivka Appendices, as the Board's decision did, fails to give effect to the full prior art disclosure and permits others to recapture material that has been previously submitted to the Office

by an earlier inventor. In doing so, the Board's decision undermines the foundation and purpose of § 102(e).

B. The Office's Practical Policy Concerning Large Appendices Does Not Justify Removing the Slivka Appendices From the Public

As a practical policy, the Office does not publish lengthy appendices with an issued patent, but instead makes those disclosures available in a patent's file history. Ex. 2008, 10-12; MPEP 608.05. When the application that issued as the Slivka Patent was filed, the MPEP expressly acknowledged "Computer Program Listings" as a type of disclosure that is part of the patent but is not printed with the patent. POPR, at 14, 25-26; Ex. 2008, 10-12. 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").

But for this practical policy, the Slivka Appendices would have published as part of the Slivka Patent, unquestionably constituting prior art pursuant to § 102(e). This was the intent of the applicant. As noted above, the Slivka Patent specification repeatedly refers to the appendices as "attached" to the patent and provides extensive detail as to how the portions of the Slivka Appendices relied upon by Petitioner *relate to* and *elaborate on* the relevant disclosures in the Slivka Patent. Having submitted 177 pages of appendices, however, Office policy ensured they did not print with the issued patent. The rationale for this policy turns on the considerations implicated by large supplemental disclosures submitted with a patent application. *See* Ex. 2008, 11 (noting that "lengthy computer program listings . . . can become burdensome" and "[t]he cost of printing long computer programs in patent documents is also very expensive"). No policy rationale supports the Board's decision to remove those disclosures from the prior art.

Nor is the Board's decision supported by the Patent Owner's suggestion that the Slivka applicant failed to follow proper procedure when submitting the Slivka Appendices. Paper 6, 25 ("[T]he appendices cannot be considered part of the Slivka application because Slivka failed to comply with MPEP 608.05 and 37 C.F.R. 1.96, which set forth the specific steps an applicant is required to take when depositing computer program listings with a patent application."). Of the 177 pages submitted, the vast majority of the Slivka Appendices are not material that could be properly

characterized as "computer program listings." Paper 8, 2-3 (explaining that "only 24 of the 177 pages of appendices relate to computer code, and those pages are merely HTML templates" and that "[t]he remaining 153 pages of appendices are not directed toward any type of computer code at all, and instead comprise material such as textbook excerpts"). Accordingly, any procedural requirements imposed upon an applicant when submitting "computer program" appendices did not apply to the Slivka applicant. But even if the applicant were obligated to follow a specific procedure, the Board correctly concluded rules do not set forth any consequence for failing to comply. Paper 12, 14 ("[T]he relevant guidance and regulation at the time . . . does not describe the effect if submissions were not compliant."). Accordingly, even if the Director were to find the applicant failed to follow the Office procedure when submitting the Slivka Appendices, there is no guidance as to what consequences result from that failure. More importantly, there is no suggestion in the rules or rationale underlying Office policy that support punishing the public by excluding the Slivka Appendices from the prior art. Any consequences that result from an alleged procedural/clerical error perpetrated by the prior art applicant should be imposed exclusively on the applicant, e.g., preventing the applicant from relying on the Slivka Appendices for purposes of establishing compliance with the written description or enablement requirements.

C. None of the Case Law Relied Upon by the Board Supports Punishing the Public by Withdrawing the Slivka Appendices From the Prior Art

The Board cites two categories of cases in support of its conclusion that the Slivka Appendices should be withdrawn from the prior art as a result of the applicant having allegedly failed to properly incorporate them by reference into the Slivka Patent. Neither supports the Board's decision.

A first category of cases focuses on the need for an applicant to identify material incorporated by reference with detailed particularity. Paper 12, 11-12 (citing *Advanced Display* and *Callaway Golf Co. v. Acushnet Co*., 576 F.3d 1331, 1346 (Fed. Cir. 2009)). The Board quotes *Advanced Display* for the proposition that, "[t]o incorporate material by reference, the host document must ***identify with detailed particularity*** what specific material it incorporates and clearly indicate where that material is found in the various documents." Paper 12, 11. And it quotes *Callaway Golf* for the proposition that "***mere reference to another application, or patent, or publication is not an incorporation of anything therein***." *Id*. at 11-12.

Here, there is no relevant concern that the applicant failed to reference the Slivka Appendices with "detailed particularity." As set forth above, the Slivka Appendices were submitted as part of the application, are contained within the file history, and are referred to as "attached" throughout the specification. Further, the Slivka Patent provides extensive detail as to how the portions of the Slivka

Appendices relied upon by Petitioner *relate to* and *elaborate on* the relevant disclosures in the Slivka Patent. Ex. 1004 (Slivka Patent), 18:49-67 (explaining the relevance of specific portions of the Slivka Appendices to specific portions of the Slivka Patent) (annotated); Paper 1, 12-15 (explaining teachings from the Slivka Patent and Slivka Appendices relevant to the proposed grounds).

Despite this extensive detail, the Board appears to have concluded that the applicant failed to use the correct terminology that indicated a desire to formally "incorporate" the Slivka Appendices into the Slivka Patent. Paper 12, 12 ("We agree with Patent Owner that 'Slivka did *not* note that he was incorporating the appendices to the specification.'") (emphasis in original). But not even the Board's cited case law stands for the proposition that the Office mandates language as specific as the Board suggests. In *Callaway Golf*, the Federal Circuit concluded the language, "***[r]eference is made to[,]"*** . . . sufficient to indicate to one of skill in the art that the referenced material is fully incorporated in the host document." 576 F.3d at 1346. The Federal Circuit has additionally explained that it "does not require 'magic words' of reference or of incorporation." *Northrop Grumman Info. Tech., Inc. v. United States*, 535 F.3d 1339, 1346 (Fed. Cir. 2008) (discussing patent jurisprudence in the context of a government contract issue). Indeed, the Federal Circuit recently found that a user guide incorporated by reference a separate feature reference guide where "the two documents were 'collectively distributed as a single reference

document,' and that the User Guide directs users to consult specific parts of the Extended Feature Reference to implement the VPN features of the BinGO! Router." *VirnetX Inc. v. Apple Inc.*, No. 2022-1523, 2023 WL 6933812, at *3 (Fed. Cir. Oct. 20, 2023) (concluding "that the two references can be considered as one for purposes of anticipation"). Similar to the Federal Circuit's analysis in *VirnetX*, the Slivka Patent treats the Slivka Appendices as a part of its disclosure, repeatedly referring the reader to the appendices as "attached" to the patent. For purposes of invalidity, as in *VirnetX*, the Slivka Patent and Slivka Appendices should be considered a single document. The Board's overly narrow view that specific language is required for incorporation by reference fails to properly credit that the Slivka Appendices were referenced with particularity in the Slivka Patent, submitted together in a single submission, and repeatedly described as "attached" to the Slivka Patent.

A second category of cases addresses the consequences of failing to properly incorporate material by reference. The Board focuses this discussion on *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1295 (Fed. Cir. 2000). Paper 12, 14-17. There, the PTO mistakenly failed to print 330 pages of computer code with the asserted patent. *Southwest Software*, 226 F.3d at 1295-1296; Paper 12, 16. The question addressed by the Federal Circuit was whether, assuming the patent claim was invalid without the computer code (for failing to satisfy the written description and enablement requirements), an accused infringer can be held liable for

infringement that occurred before the certificate of correction issued. *Southwest Software*, 226 F.3d at 1295-1296. The Federal Circuit held that, if the claim was in fact invalid without the missing disclosure, the patentee's delay in seeking the correction should mean that an accused infringer cannot be held liable for infringing during the period before the certificate of correction issued. *Id*. Ultimately, the Federal Circuit remanded to determine if the uncorrected patent would have been invalid. *Id*. at 1297.

The Board contends *Southwest Software* is instructive, but it fails to acknowledge a critical distinction. Namely, the Federal Circuit punished the patentee in *Southwest Software* for failing to act promptly to correct its own patent, but the Board here punishes the *public* for an alleged failing on the part of the Slivka Patent applicant. Policy may well support finding that the Slivka Patent may not rely on the Slivka Appendices for purposes of supporting the scope or validity of its claims, finding such a result appropriate for any alleged failure on the patentee's part. But no policy supports withdrawing the disclosures contained in the Slivka Appendices from the public as a result of the Slivka patentee's purported procedural failures.

IV. CONCLUSION

The Director should vacate the panel's institution denial and remand for further consideration.

Respectfully submitted,

Date: January 16, 2024

BY: */s/ Paul R. Hart*

Paul R. Hart, Reg. No. 59,646
Adam Seitz, Reg. No. 52,206

COUNSEL FOR PETITIONER

APPENDIX OF EXHIBITS

Exhibit 1001	U.S. Patent No. 9,369,545 ("*'545 Patent*")
Exhibit 1002	Prosecution History for the '545 Patent ("*'545 File History*")
Exhibit 1003	Declaration of Loren Terveen ("*Dec*.")
Exhibit 1004	U.S. Patent No. 6,061,695 to Slivka et al. ("*Slivka*")
Exhibit 1005	File History of U.S. Patent No. 6,061,695 ("*Slivka FH"*)
Exhibit 1006	U.S. Patent No. 6,091,518 to Anabuki ("*Anabuki*")
Exhibit 1007	Declaration of June Munford ("*Munford Dec.*")
Exhibit 1008	PTAB - IPR2019-00988 ("*Lenovo '545 FWD*")
Exhibit 1009	*Lenovo Holding Company, Inc. v. DoDots Licensing Solutions LLC,* 21-1521, No. 16 (Fed. Cir. Dec. 8, 2021) ("*Federal Circuit Claim Construction*")
Exhibit 1010	PTAB – IPR2023-00756, Paper 2 ("*Samsung '545 IPR*")
Exhibit 1011	*Intentionally Left Blank*
Exhibit 1012	*Intentionally Left Blank*
Exhibit 1013	*HTML: The Complete Reference*, Osborne/McGraw-Hill, by Thomas A. Powell 1998 ("*Powell*")
Exhibit 1014	U.S. Patent No. 6,397,217 to Melbin ("*Melbin*")
Exhibit 1015	U.S. Patent No. 6,031,989 to Cordell ("*Cordell*")
Exhibit 1016	Dkt. 98, *Joint Claim Construction Statement*
Exhibit 1017	Federal Legislative History for 37 CFR, 61 FR 42790-01 (August 19, 1996)

Currently Filed by Petitioner

Exhibit 1018	37 C.F.R. § 1.11 (Rev. 2, July 1996),

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on January 16, 2024, a complete and entire copy of this Petitioner's Request for Rehearing by the Director was provided by email, to the Patent Owner by serving the correspondence addresses of record as follows:

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