

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Jonathan S. Steuer

Docket No.: 10004-2000107

Application No.: 16/660,633

Group Art Unit: 2421

Filing Date: October 22, 2019

Examiner: Chenea Davis

Title: MEDIA USAGE MONITORING AND
MEASUREMENT SYSTEM AND METHOD

Conf. No.: 7825

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION TO ACCEPT UNINTENTIONALLY DELAYED
BENEFIT CLAIMS UNDER 37 C.F.R. § 1.78(e)**

Applicant hereby submits a petition to the Office under 37 C.F.R. § 1.78(e) to accept the unintentionally delayed claims for benefit of prior-filed applications as noted in the Corrected Application Data Sheet and a Request for Certificate of Correction filed concurrently herewith. Pursuant to 37 C.F.R. § 1.78(e)(3), the entire delay between the date the priority claims were due and the date the priority claims were filed was unintentional.

U.S. Application No. 16/660,633 (the “‘633 application”) was filed on October 22, 2019, and issued as U.S. Patent No. 10,963,911 on March 30, 2021. This Petition Under 37 C.F.R. § 1.78(e) (the “Petition”) is being filed on November 22, 2024, more than two years after the date the domestic benefit claim was due. Thus, under 37 CFR § 1.78(e)(3), the Director may require additional information where there is a question whether the delay was unintentional.

Applicant refers to Exhibit A attached hereto to illustrate the entire U.S. family of patents and applications related to the ‘633 application. Applicant refers to Exhibit B attached hereto that provides the full list of pending reexamination applications, inter partes review proceedings and litigation of the family of patents.

Applicant first became aware of arguments against the benefit claim of the present

application after detailed analysis of the petitions for *Inter Partes* Review of the ‘896 patent¹ (IPR2024-01348), the ‘849 patent² (IPR2024-01349), and the ‘848 patent³ (IPR2024-01350) (“the Samsung IPRs”), all filed on August 26, 2024. As explained in detail in the Declaration of Michael Mauriel, attached as Exhibit C, he believed that the 12/954,604 application (the “‘604 application”), and all continuations and divisionals from the ‘604 application, benefited from the Provisional application’s (U.S. App. No. 60/574,836) priority date and were able to rely on its disclosures for written description support from the Provisional application’s filing date. A potential gap in the written description chain due to the omission of incorporation by reference of the Provisional application in the 11/139,330 application (the “‘330 application”), the parent of the ‘604 application, was noted in the Samsung IPRs and used as a ground for alleging that the ‘896, ‘849 and ‘848 patents could not rely on the Provisional for written description support.

In reviewing the family tree, it became clear that U.S. Patent Apps. Nos. 18/892,291, 18/741,696, 18/076,327, 17/199,355, 16/660,633, and 14/175,811 (“the ‘291, ‘696, ‘327, ‘355, ‘633 and ‘811 applications,” respectively) were in the same situation as the ‘896, ‘849 and ‘848 patents (U.S. Patent Apps. Nos. 16/403,204, 16/660,624 and 16/660,615, respectively – “the ‘204, ‘624 and ‘615 applications,” respectively). That review indicated the earliest application that contained the Provisional by incorporation was the ‘353 application (U.S. Patent App. No. 12/283,353, now U.S. Patent No. 8,677,389). The ‘811, ‘291, ‘696, ‘327, ‘355, ‘633, ‘615, ‘624, and ‘204 applications were entitled to claim priority to the ‘353 application, in addition to the existing priority chain. This Petition requests inclusion of the priority claim to the ‘353 application in the present application.

The omission of the priority claim to the ‘353 application was made unintentionally, based on the belief that the ‘604 application and all of the applications descending from the ‘604 application were entitled to rely on the Provisional’s date for priority and written support and resulted in the current priority chains in the ‘291, ‘696, ‘327, ‘355, ‘633, ‘615, ‘624, ‘204 and ‘811 applications.

¹ U.S. Patent No. 10,572,896

² U.S. Patent No. 10,719,849

³ U.S. Patent No. 10,719, 848

The time period from receipt of the Samsung IPRs to filing of this Petition for Correction and Petitions for Correction in related family members reflects a reasonable period of time for Applicant to conduct a diligent investigation into the challenges in each of the Samsung IPRs, including invalidity and priority issues, investigation of the extensive patent family and prosecution histories of each family member, as well as consulting with IPR and litigation counsel to take into consideration the procedural complexities presented by co-pending litigations and IPRs.

Concurrently petitions under 37 C.F.R. § 1.78 and requests for certificates of correction or specification amendments are being filed in the '696, '327, '355, '633, '624, '615, '204 and '811 applications. The '291 application is being amended and does not need a petition, as it is within the four months from filing window.

As explained above, the entire delay between the date the claim for benefit of prior-filed applications was due and the date the claim was filed was unintentional.

Applicant and Applicant's representatives submit the following:

- Each of the '291, '696, '327, '355, '633, '624, '615, '204 and '811 applications only included a single priority claim path before the '811 application. That path was to U.S. Patent Apps. Nos. 13/914,870 to 12/954,604 to 11/139,330 to 60/574,836.
- Applicant became aware of unintentional omissions in the benefit claim of the '291, '696, '327, '355, '633, '624, '615, '204 and '811 applications after detailed analysis of the petitions for Inter Partes Review of U.S. Patent Nos. 10,572,896 (IPR2024-01348), 10,719,849 (IPR2024-01349), and 10,719,846 (IPR2024-01350), all filed on August 26, 2024.
- Each of the '291, '696, '327, '355, '633, '624, '615, '204 and '811 applications were examined under the pre-AIA first to invent provisions. Thus, the correction sought with this petition would not change the statutory framework under which all of the '291, '696, '327, '355, '633, '624, '615, '204 and '811 applications were examined, and further examination would not be required.

A Corrected Application Data Sheet and a Request for Certificate of Correction are

being filed with this Petition to include the references required by 37 C.F.R. § 1.78(e)(1).

A Petition for Expedited Review Under 37 C.F.R. § 1.182 is also being filed with this Petition.

The required petition fee as set forth in 37 C.F.R. § 1.17(m) is submitted herewith to satisfy 37 C.F.R. § 1.78(e)(2).

And, as required by 37 C.F.R. § 1.78(e)(3), the entire delay between the date the benefit claim was due under paragraph (a)(4) or (d)(3) of this section and the date the benefit claim is being filed was unintentional.

Accordingly, Applicant respectfully requests that the Office grant this Petition, and grant the Request for Certificate of Correction filed concurrently herewith.

The small entity fee of \$840 required by 37 C.F.R. § 1.17(m) is being paid with this request. Please apply any other necessary charges or credits to Deposit Account No. 50-5394, referencing the above docket number.

Dated: November 22, 2024

Respectfully submitted,

By: /Michael Mauriel/ Reg. No. 44,226

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Exhibit A

Family tree illustration

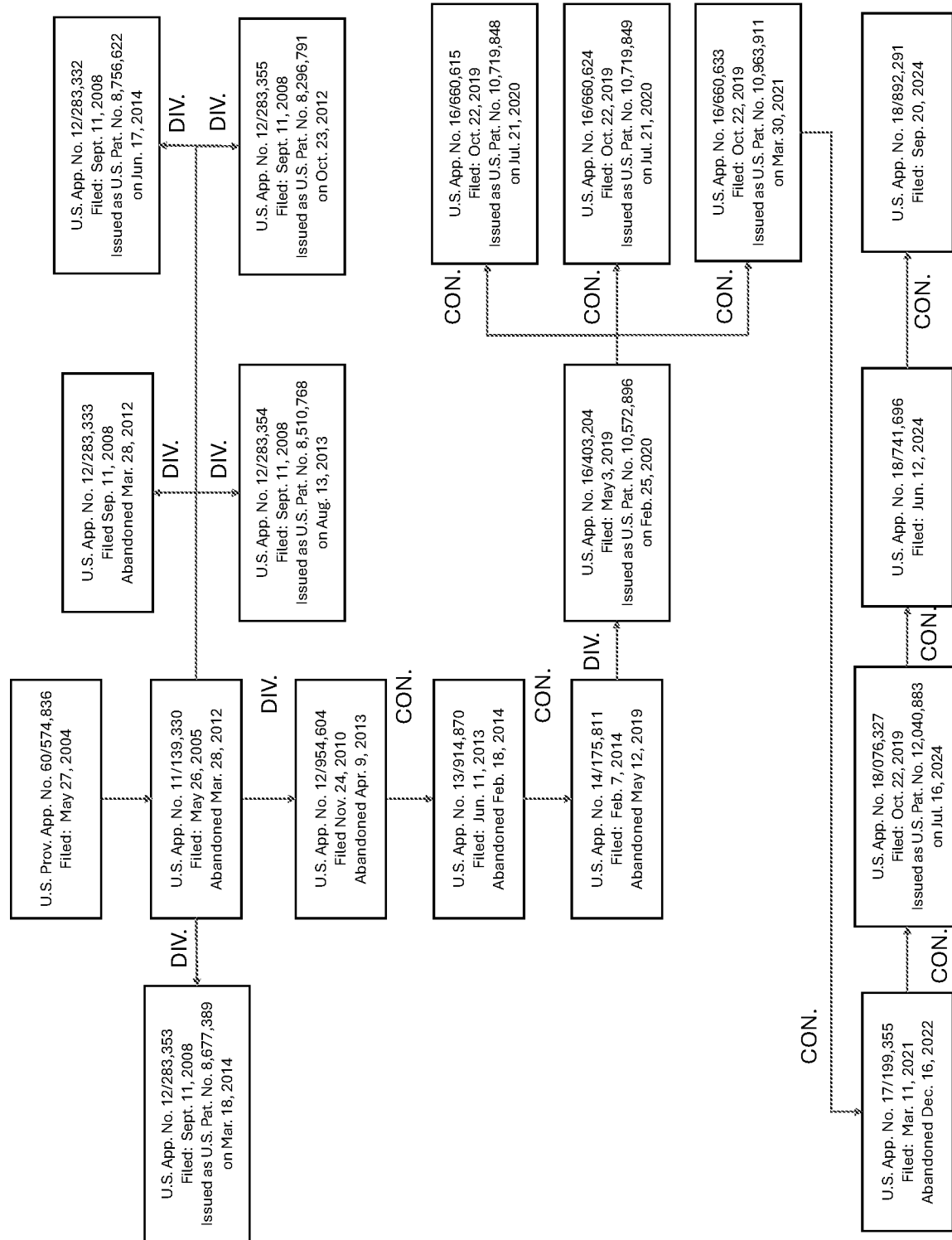


Exhibit B

Prior and Concurrent Proceedings in the Family

- *Anonymous Media Research Holdings, LLC v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, No. 2:23-cv-00439 (E.D. Tex.) (filed Sept. 22, 2023) (‘791, ‘768, ‘622, 896, ‘849 and ‘848 patents)
- *Anonymous Media Research Holdings, LLC v. Roku, Inc.*, No. 1:23-cv-01143 W.D. Tex.) (transferred to N.D. Cal. on July 10, 2024) (‘791, ‘768, ‘622, 896, ‘849 and ‘848 patents)
- *Anonymous Media Research Holdings, LLC v. Roku, Inc.*, No. 3:24-cv-04171 (N.D. Cal.) (transferred in from W.D. Tex. on July 12, 2024) (‘791, ‘768, ‘622, 896, ‘849 and ‘848 patents)
- *Roku, Inc. v. Anonymous Media Research Holdings, LLC*, IPR2024-01053 (P.T.A.B.) (filed July 15, 2024) (‘791 patent)
- *Roku, Inc. v. Anonymous Media Research Holdings, LLC*, IPR2024-01054 (P.T.A.B.) (filed July 15, 2024) (‘768 patent)
- *Roku, Inc. v. Anonymous Media Research Holdings, LLC*, IPR2024-01055 (P.T.A.B.) (filed July 15, 2024) (‘622 patent)
- *Roku, Inc. v. Anonymous Media Research Holdings, LLC*, IPR2024-01056 (P.T.A.B.) (filed July 15, 2024) (‘896 patent)
- *Roku, Inc. v. Anonymous Media Research Holdings, LLC*, IPR2024-01057 (P.T.A.B.) (filed July 15, 2024) (‘849 patent)
- *Roku, Inc. v. Anonymous Media Research Holdings, LLC*, IPR2024-01058 (P.T.A.B.) (filed July 15, 2024) (‘848 patent)
- *Samsung Electronics Co., Ltd. v. Anonymous Media Research Holdings, LLC*, IPR2024-01348 (P.T.A.B.) (filed August 26, 2024) (‘896 patent)
- *Samsung Electronics Co., Ltd. v. Anonymous Media Research Holdings, LLC*, IPR2024-01349 (P.T.A.B.) (filed August 26, 2024) (‘849 patent)
- *Samsung Electronics Co., Ltd. v. Anonymous Media Research Holdings, LLC*, IPR2024-01350 (P.T.A.B.) (filed August 26, 2024) (‘848 patent)
- *Ex parte* reexamination Control No. 90/019,375 (filed January 16, 2024) (‘768 patent) (intent to issue *ex parte* reexam certificate issued Oct. 30, 2024)
- *Ex parte* reexamination Control No. 90/019,616 (filed August 8, 2024) (‘622 patent)

Exhibit C

Declaration of Michael Mauriel

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Inventor: Jonathan S. Steuer	§	Customer No.: 51417
	§	
App No.: 16/660,633	§	Confirmation No.: 7825
	§	
Filed: October 22, 2019	§	Art Unit: 2421
	§	
For: Media Usage Monitoring	§	Examiner: Chenea Davis
and Measurement System and	§	
Method	§	Docket No.: 10004-2000107

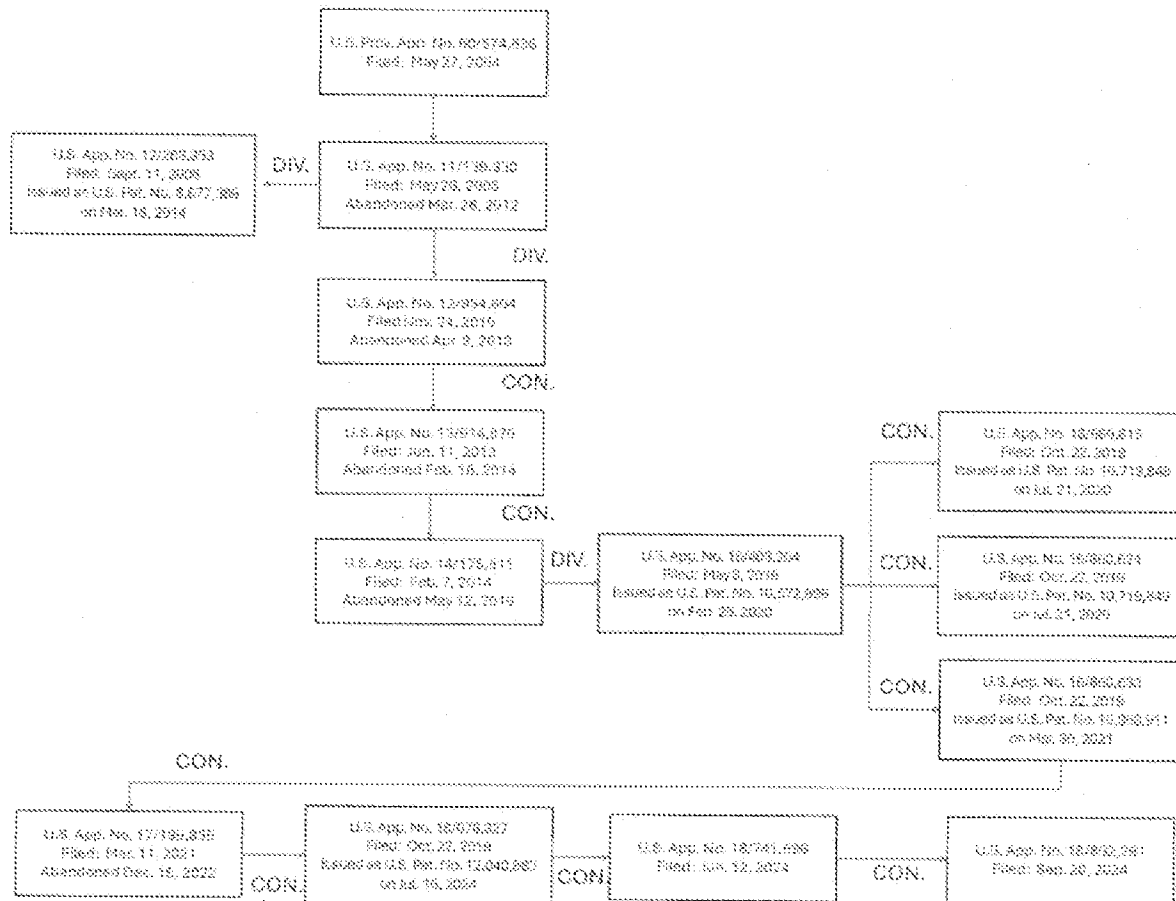
DECLARATION OF MICHAEL MAURIEL UNDER 37 CFR § 1.132

I, Michael Mauriel, hereby declare and state:

1. I am a registered patent attorney and partner at Maschoff Brennan Gilmore Israelsen & Mauriel LLP. I represent Anonymous Media Research Holdings, LLC ("Applicant") in prosecuting several pending patent applications in the United States Patent and Trademark Office ("the Office").

2. I assisted Jonathan S. Steuer ("Jonathan") and Christopher W. Otto ("Chris") in their preparation and filing of a provisional application (U.S. Provisional App. No. 60/574,836) ("Provisional") that numerous other patent applications of relevance here claim priority to. I also prosecuted those other patent applications on behalf of Applicant and its predecessor entities.

3. A graphical depiction of the relevant portions of the family tree is provided below:



As shown, U.S. Patent App. No. 16/660,615 ("the '615 Application")¹, U.S. Patent App. No. 16/660,624 ("the '624 Application")² and U.S. Patent App. No. 16/660,633 ("the '633 application")³ are continuation applications that claim priority to U.S. Patent App. No. 16/403,204 ("the '204 Application")⁴. The '204 Application is a divisional that claims priority to abandoned U.S. Patent App. No. 14/175,811 ("the '811 Application"), which is a continuation application that claims priority to abandoned U.S. Patent App. No. 13/914,870 ("the '870 Application"), which is a continuation that claims priority to abandoned U.S. Patent Application No. 12/954,604 ("the '604 Application"), which is a divisional application that claims priority to abandoned U.S. App. No. 11/139,330 ("the '330 Application") that claims

¹ Now U.S. Patent No. 10,719, 848 ("the '848 Patent")

² Now U.S. Patent No. 10,719,849 ("the '849 Patent")

³ Now U.S. Patent No. 10,963,911 ("the '911 Patent")

⁴ Now U.S. Patent No. 10,572,896 ("the '896 Patent")

priority to the Provisional Application. U.S. Patent App. No. 18/892,291 ("the '291 Application") is a continuation that claims priority to U.S. Patent App. No. 18/741,696 ("the '696 Application"), which is a continuation that claims priority to U.S. Patent Application No. 18/076,327 ("the '327 Application"), which is a continuation application that claims priority to abandoned U.S. Patent App. No. 17/199,355 ("the '355 Application"), which is a continuation that claims priority to the '633 Application. U.S. Patent App. No. 12/283,353 ("the '353 Application")⁵ is a divisional of the '330 Application.

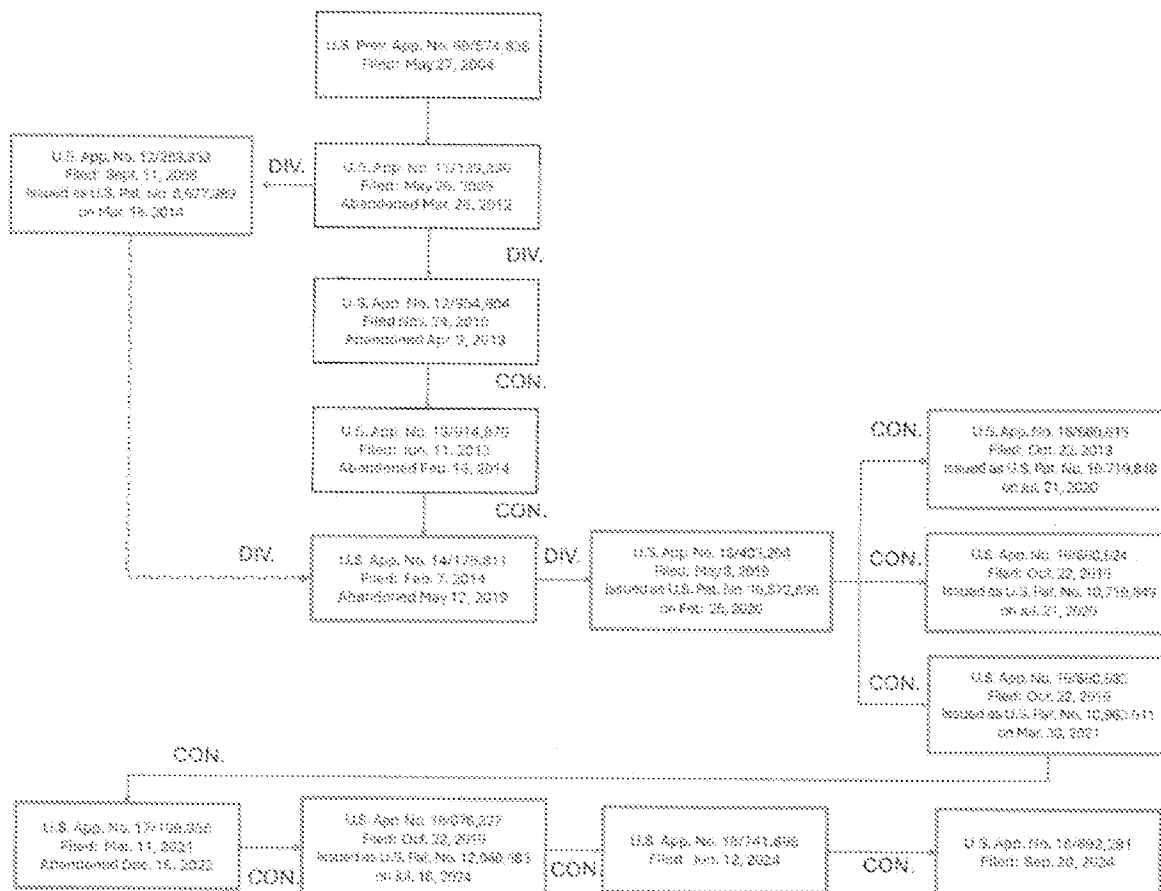
4. After detailed analysis of the petitions for *inter partes* review of the '896 Patent (IPR2024-01348), '848 Patent (IPR2024-01350) and '849 Patent (IPR2024-01349), all filed on August 26, 2024, Applicant became aware for the first time of unintentional omissions in the benefit claim of the '291, '696, '327, '355, '633, '615, '624, '204 and '811 Applications. Specifically, those petitions allege that the claims of the '896, '848, and '849 Patents are not entitled to rely on the Provisional for written description support because the Provisional is not expressly incorporated by reference into the '330 Application, which is the first non-provisional application in the priority chain of the '896, '848, and '849 Patents. All other applications expressly incorporate the Provisional by reference.

5. As the prosecuting attorney for the family of applications at issue, I believe that the '330 Application—as well as the intervening '604, '870, and '811 Applications—contains sufficient written description for all issued claims of the '896, '848, and '849 Patents. However, it had also been my intention, and always my belief, that the applications filed after the Provisional would also be entitled to rely on the Provisional for additional written description support based on its incorporation-by-reference into each of those applications. The priority chain for the '291, '696, '327, '355, '633, '615, '624, '204 and '811 Applications was proposed by me based on this understanding, and priority was not additionally perfected to other applications in the same family that also expressly incorporate the Provisional by reference.

6. Due to the *inter partes* review petitions, I am now aware that the Provisional not being incorporated-by-reference into the '330 Application is being relied on as the basis

⁵ Now U.S. Patent No. 8,677,389 ("the '389 Patent").

for arguing that the '896, '848, and '8u applications are not entitled to rely on the Provisional Application for written description support of the claims, as I had long believed. While I disagree that the claims lack written description support in the specification of the '330 Application as drafted, had I been aware that it could be argued that this would preclude later applications from relying on the Provisional for written description support, I would have proposed a priority chain where each of the '291, '696, '327, '355, '633, '615, '624, '204 and '8u Applications claim priority to the '353 Application, which does incorporate the Provisional by reference (and also claims priority to the May 27, 2004 Provisional). Specifically, as shown by the green arrow below, I would have included the '353 Application in the chain of priority by having the '8u Application claim priority to the '353 Application as a divisional application, and then having the '204, '615, '624, '633, '355, '327, '696 and '291 applications likewise include the '353 Application in their chain of priority to the '330 Application and Provisional.

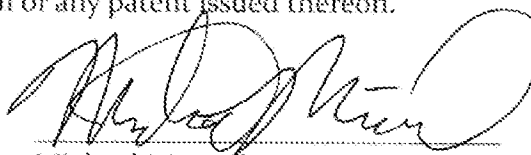


7. The delay in claiming priority as proposed in the accompanying Petition to Accept Unintentionally Delayed Benefit Claims Under 37 C.F.R. § 1.78(e) was entirely unintentional, and was based on my belief that any continuing application that was filed while the '330 application was still pending, incorporated the Provisional application by reference, and claimed priority to the Provisional application through the '330 application would, for any subject matter disclosed in the Provisional, benefit from the Provisional application's priority date and be able to rely on its disclosures for written description support. Had I believed that the incorporation-by-reference of the Provisional application into the '604 application, which was filed *prior* to abandonment of the '330 application, might not allow the '604 application to be able to rely on all of the Provisional application's disclosures as of the Provisional's filing date for written description support, the priority claim would have been timely made to at least ensure that the '811, '204, '615, '624, '633, '355, '327, '696 and '291 Applications claimed priority to the earliest filed application incorporating the Provisional by reference, which is the '353 Application, in addition to claiming (through that '353 Application) priority to the May 27, 2004 Provisional.

8. I, Michael Mauriel, declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date:

11-22-24



Michael Mauriel