

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SPOTIFY USA INC.  
Petitioner,

v.

MANUEL TIJERINO  
Patent Owner.

Patent No. 9,146,925

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*Inter Partes* Review No. IPR2025-01280

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**DECLARATION OF ROBERT L. STOLL**

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**EXHIBIT LIST**

| <b>Exhibit Description</b>                                                                                           | <b>Exhibit #</b> |
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| U.S. Patent No. 9,146,925 to Tijerino (“the ’925 Patent”)                                                            | EX1001           |
| Prosecution History of U.S. Patent No. 9,146,925                                                                     | EX1002           |
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| <i>Curriculum Vitae</i> of William Rosenblatt                                                                        | EX1004           |
| U.S. Patent No. 10,373,420 to Dion et al. (“Dion”)                                                                   | EX1005           |
| U.S. Patent No. 6,308,204 to Nathan et al. (“Nathan-204”)                                                            | EX1006           |
| U.S. Patent No. 9,608,583 to Nathan et al. (“Nathan-109”)                                                            | EX1007           |
| DEEPAK ALUR ET AL., CORE J2EE PATTERNS: BEST PRACTICES AND DESIGN STRATEGIES, 2ND ED. (Sun Microsystems Press 2001). | EX1008           |
| ANDREW S. TANENBAUM, MODERN OPERATING SYSTEMS (Prentice-Hall, Inc. 2nd ed. 2002).                                    | EX1009           |
| HAROLD ABELSON ET AL., STRUCTURE AND INTERPRETATION OF COMPUTER PROGRAMS, 2ND ED. (MIT Press 1996).                  | EX1010           |
| U.S. Patent Appl. Pub. No. 2004/0243482 to Laut (“Laut”)                                                             | EX1011           |
| U.S. Patent No. 7,469,208 to Kincaid (“Kincaid”)                                                                     | EX1012           |
| U.S. Patent Appl. Pub. No. 2008/0137881A1 to Bongiovi (“Bongiovi”)                                                   | EX1013           |
| LEONARD RICHARDSON ET AL., RESTFUL WEB SERVICES (O’Reilly Media, Inc. 2007).                                         | EX1014           |

| Exhibit Description                                                                                                                                                                                                                                                                                                                                                                        | Exhibit # |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------|
| ANDREW S. TANENBAUM, STRUCTURED COMPUTER ORGANIZATION (Prentice-Hall 6th ed. 2013).                                                                                                                                                                                                                                                                                                        | EX1015    |
| Scheduling Order (Dkt. 22) in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)                                                                                                                                                                                                                                                                                      | EX1016    |
| Defendant's Motion to Dismiss and related briefing (Dkt. 13, 25, 28) in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)                                                                                                                                                                                                                                            | EX1017    |
| June 25, 2025 Court Order (Dkt. 76) in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)                                                                                                                                                                                                                                                                             | EX1018    |
| Transcript of June 24, 2025 Hearing in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)                                                                                                                                                                                                                                                                             | EX1019    |
| LegalMetric District Report, New York Southern District Court in Patent Cases, January 2020-January 2025                                                                                                                                                                                                                                                                                   | EX1020    |
| LegalMetric District Report, Louisiana Eastern District Court in Patent Cases, January 2020-January 2025                                                                                                                                                                                                                                                                                   | EX1021    |
| Federal Court Management Statistics, December 2024 (available at <a href="https://www.uscourts.gov/data-news/reports/statistical-reports/federal-court-management-statistics/federal-court-management-statistics-december-2024">https://www.uscourts.gov/data-news/reports/statistical-reports/federal-court-management-statistics/federal-court-management-statistics-december-2024</a> ) | EX1022    |
| Associated Press, <i>Digital music service Spotify launches in US</i> (July 14, 2011)                                                                                                                                                                                                                                                                                                      | EX1023    |
| <i>Introducing Spotify Fan Insights</i> (November 17, 2015) ( <a href="https://artists.spotify.com/blog/introducing-spotify-fan-insights">https://artists.spotify.com/blog/introducing-spotify-fan-insights</a> )                                                                                                                                                                          | EX1024    |

| Exhibit Description                                                                                                                                                                                                        | Exhibit # |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------|
| <i>An Overview of Spotify for Artists</i> (April 18, 2017) ( <a href="https://artists.spotify.com/en/blog/an-overview-of-spotify-for-artists">https://artists.spotify.com/en/blog/an-overview-of-spotify-for-artists</a> ) | EX1025    |
| Exhibit J to Complaint (Dkt. 1-6) in <i>Tijerino v. Spotify USA Inc.</i> , Case No. 2:24-cv-02290 (E.D. La.)                                                                                                               | EX1026    |
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I, Robert L. Stoll, make this declaration in connection with the proceeding identified above.

## **I. INTRODUCTION**

1. I have been retained by Morrison & Foerster LLP for Spotify USA Inc. (“Petitioner” or “Spotify”) in connection with the proceeding identified above. I submit this declaration in support of Spotify’s *inter partes* review (“IPR”) challenge (IPR2025-01280) of United States Patent No. 9,146,925 (EX1001, “’925 patent”). I understand that Manuel Tijerino (“Patent Owner”) states that he is the owner of the ’925 patent.

2. I understand that Spotify has filed a Petition for *Inter Partes* Review (Paper No. 2) challenging claims 1-17 of the ’925 patent. After the Petition was filed, I understand that the Patent Trial and Appeal Board (“PTAB” or “Board”) issued a decision on institution (Paper No. 10, “DI”) that instituted trial for the challenged claims. I understand that Patent Owner has filed a Patent Owner’s Response (“POR”) in this proceeding (Paper No. 14).

3. I understand that the application that became the ’925 patent was filed on July 27, 2010 as U.S. Patent Appl. No. 12/804,665 (“the ’665 application”), and initially purported to be a continuation-in-part of U.S. Patent Appl. No. 11/744,228 (“the ’228 application”). I understand that Patent Owner’s position appears to be

that the claims of the '925 patent are entitled to the benefit of the May 4, 2007 filing date of the '228 application.

4. As set forth below, I provide expert analysis and testimony, including with respect to United States patent practice and procedures generally, and specifically as they relate to whether the claims of the '925 patent are entitled to the benefit of the '228 application's earlier filing date. In my opinion, the claims of the '925 patent are not entitled to any such benefit. If called to testify as to the matters stated herein, I could and would do so competently.

## **II. BACKGROUND AND QUALIFICATIONS**

5. I am President and CEO of Stoll Patent Consulting and Expert Testimony, LLC, located in Edgewater, Maryland. My curriculum vitae, which includes the list of publications that I have authored, is submitted hereto as EX1034.

6. I completed my undergraduate studies at University of Maryland in December 1979 with a B.S. degree in Chemical Engineering. I attended the Catholic University of America, receiving my Juris Doctor in 1985. I am a member of the Maryland State Bar, and the Bar of the District of Columbia. I am a member of the USPTO Bar and am registered to practice as a patent attorney before the United States Patent and Trademark Office ("USPTO" or "Patent Office").

7. From January 2012 through September 2024, I was a partner at the law firm Faegre Drinker Biddle & Reath LLP in Washington, DC.

8. From October 2009 through December 2011, I served as Commissioner for Patents at the USPTO. In my two years as Commissioner for Patents, I led an organization of about 8,000 employees. In this position I was responsible for all processing of patent applications at the USPTO and the development of policy and procedure related to the issuance of valid patents in a timely manner. I also developed intimate knowledge about USPTO practice and procedure from my almost three decades there before becoming Commissioner.

9. Before my appointment to the position of Commissioner for Patents, I served as Dean of Training and Education for the USPTO, from 2007 to 2009. As Dean of Training and Education, I helped lead efforts to train foreign officials and the public on various matters of intellectual property.

10. From 2002 until 2007 I served as Director of the Office of Enforcement for the USPTO. As Director, I worked to improve intellectual property protection, both in the United States, and abroad. Prior to my work as Director of the Office of Enforcement, I worked as Administrator of the Office of Legislative and International Affairs for the USPTO, from 1996 until 2002. As Administrator of the Office of Legislative and International Affairs, I led a staff of attorneys representing the USPTO before Congress and in diplomatic and policy

arenas worldwide. I also helped develop and plan strategic goals, as well as objectives and priorities, for the USPTO. I also served as a liaison with patent and trademark bar groups, and academic and scientific communities.

11. From November 1994 until February 1996, I served as Executive Assistant to the Director for Patents for the USPTO.

12. From June 1982 through April 1990, I served as a Patent Examiner in the USPTO. In 1990, I assumed the position of Supervisory Patent Examiner (“SPE”), which I held until 1994. In this position, I supervised an art unit of approximately 15 patent examiners, reviewing and signing the actions of the non-primary examiners and monitoring the work of the primary examiners. As both a patent examiner and SPE, I performed or supervised the work required to be performed by the examiner to (1) examine originally filed patent applications; and (2) examine continuing applications, including continuations, continuations-in-part, and divisional applications.

13. Since leaving my position as Commissioner for Patents, I have used my knowledge and experience from my time with the USPTO to advise and educate judges and others in the intellectual property community regarding intellectual property issues. In October of 2013, I was appointed by Chief Judge Rader to a three-year term as an Advisory Council Member to the U.S. Court of Appeals for the Federal Circuit. I was subsequently reappointed to two more

three-year terms beginning in 2016 by Chief Judge Sharon Prost. In 2018 I was elected to a three-year term on the board of the American Intellectual Property Law Association (AIPLA).

14. I have considerable direct experience in reviewing the work of patent examiners to determine whether they followed existing patent policies, practices, and procedures and performed examinations of the required quality. This experience came as a result of my serving as Supervisory Patent Examiner. As Supervisory Patent Examiner, I was often called upon to review and sign the work of non-primary examiners, and monitor the work of primary examiners.

15. Based on my experience from the many examination and policy positions I held at the USPTO over the years, I have significant familiarity with all aspects related to the examination of patent applications. This includes knowledge about current and historical versions of the Manual of Patent Examining Procedure (“MPEP”)<sup>1</sup>, which the USPTO publishes as a binding guide to examiners, as well as the rules and statutes relating to examination of applications set forth in Title 37 of the Code of Federal Regulations (“C.F.R.”) and Title 35 of the United States Code (“U.S.C.”), respectively.

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<sup>1</sup> <https://mpep.uspto.gov/RDMS/MPEP/current> (Ninth Edition, Revision 01.2024).

16. In private practice as an attorney, I have routinely advised attorneys and clients on USPTO practice and procedure, including the rules for application filing, continuity, and priority. As a partner and Deputy Leader of the Intellectual Property Practice Group at Faegre Drinker Biddle & Reath LLP, I frequently troubleshooted difficult applications and supervised associates in their drafting and prosecuting of patent applications.

17. I have considerable experience in reviewing patent prosecution histories, including analyzing continuity and priority issues, as a result of the positions I held at the USPTO for 30 years, and as an attorney in private practice.

18. I do not profess to have special technical expertise regarding the '925 patent. I have been asked only to opine on matters related to USPTO patent practice and procedures and their application to '925 patent. For technical matters in support of my opinions in this report, I am relying on the analysis and opinions of Spotify's technical expert, William Rosenblatt.

19. I cite case law to inform how I arrive at my positions. I recognize that the Board may interpret the cases differently and the Board's interpretation controls in this proceeding.

20. I have testified at a trial or deposition in the past four years. A list of the cases in which I testified is attached to my curriculum vitae (EX1034).

21. I am being compensated at my standard hourly rate of \$1,335/hour for the time spent on this case. My compensation is not contingent upon the outcome of this proceeding.

### **III. MATERIALS CONSIDERED**

22. I have considered and reviewed the materials discussed in this report as well as other documents as they relate to the benefit, if any, of an earlier filing date for the '925 patent, including:

- the Petition;
- Patent Owner's Preliminary Response (Paper No. 6);
- Spotify's Reply to Patent Owner's Preliminary Response (Paper No. 8);
- Patent Owner's Sur-Reply (Paper No. 9);
- the Board's Decision on Institution (DI);
- the Patent Owner Response (POR);
- the prosecution history of the '925 patent (EX1002);
- the prosecution history of the '228 application (EX1029);
- the USPTO publication of the '228 application (EX1032);
- Screen capture of the USPTO Public Search portal for the '925 patent (EX1030); and

- a related PCT application to the '925 patent as published (EX2003) and its prosecution history (EX1031).

23. In forming my opinions, I have also relied on my training and experience. I have also consulted, as needed, with Mr. Rosenblatt regarding the technical issues addressed in my report.

#### **IV. LEGAL STANDARDS**

24. Before providing my opinions, I briefly set out the legal standards for obtaining the benefit of an earlier filing date. I provide additional legal standards in Section VI in supporting my opinions. Because both the '665 application (which matured into the '925 patent) and the '228 application were filed before March 16, 2013, these applications would be considered “pre-AIA,” i.e., prior to the applicability of the America Invents Act. The statutory sections and other legal citations below are thus also pre-AIA.

##### **A. 35 U.S.C. § 120**

25. The statutory section relating to benefit of an earlier filing date is 35 U.S.C. § 120. That section provides:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as

to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

26. This section sets forth four requirements for Patent Owner to claim the benefit of the filing date of the earlier filed '228 application.

- Requirement #1: The written description of the earlier filed application (the '228 application) discloses the invention claimed in the later filed application (the '665 application) sufficient to satisfy the requirements of § 112. This requirement is sometimes referred to as the “continuity of disclosure” requirement.
- Requirement #2: The applications (the '228 and '665 applications) have at least one common inventor.

- Requirement #3: The later application (the '665 application) is filed before the issuance or abandonment of the earlier filed application (the '228 application). This requirement is sometimes referred to as the “co-pendency” requirement.
- Requirement #4: the later application (the '665 application) contains a reference to the earlier filed application.

27. All four requirements must be met for any claim of the '925 patent to be entitled to the earlier filing date of the '228 application. I understand that the Board also identified these four requirements in its DI at pages 51-52. I provide below additional legal standards for the first, third, and fourth requirements.

**B. First Requirement (Continuity of Disclosure): 35 U.S.C. § 112**

28. The first requirement refers to 35 U.S.C. § 112, specifically its first paragraph. That paragraph provides: “The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.”

29. This first paragraph of § 112 sets forth at least one requirement for the written description of the '228 application to support the claims of the '925 patent.

It must contain a “written description” of the invention claimed in the ’665 application (which matured into the ’925 patent).

**C. Third Requirement (Co-Pendency): 35 U.S.C. § 133, 37 C.F.R. §§ 1.134-1.136, and § MPEP 711.04(a)**

30. The third requirement refers to the abandonment of the earlier filed application (the ’228 application). As set forth in MPEP § 211.01(b), co-pendency requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application. If the prior application is abandoned, including for failure to prosecute, the later-filed application must be filed before the abandonment in order for it to be co-pending with the prior application. MPEP § 211.01(b).

31. Abandonment is referenced in 35 U.S.C. § 133: “Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto.” The time period for reply to an Office action is set forth in 37 C.F.R. § 1.134: “An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required

in less than six months, a maximum period of six months is allowed.” The next rule, 37 C.F.R. § 1.135(a), provides that “[i]f an applicant of a patent application fails to reply within the time period provided under § 1.134 and 1.136 [relating to extensions], the application will become abandoned unless an Office action indicates otherwise.”

32. Most actions at the USPTO set a shorter time than the maximum six months. For example, Office Actions rejecting applications typically set a shortened statutory period of three months, with up to three one-month extensions under 37 C.F.R. § 1.136. As explained in MPEP § 711.04(a), the “date of abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 C.F.R. 1.136, expired.”

33. The USPTO typically waits one month after the maximum permissible time period, including extensions, to issue a Notice of Abandonment. But, as noted in MPEP § 711.04(a), the date of abandonment is the end of shortened statutory period for reply: “Although the abandoned files are not pulled until the maximum permissible period for which an extension of time under 37 C.F.R. 1.136(a) plus 1 month expired, the date of abandonment is after midnight of the date the period for reply actually expired. This is normally the end of the 3-month shortened statutory period.”

34. The MPEP quotes above are from the Eighth Edition of the MPEP (Rev. 7 (July 2008) and Rev. 8 (July 2010)) when the '228 application was pending, but the current version of the MPEP provides the same explanation. In fact, the current version provides the following example: “A non-final Office action was mailed on May 15, 2019 and set a 3 month shortened statutory period that expired on Thursday, August 15, 2019, which was a normal business day when the Office was open. In this situation, the date of abandonment is Friday, August 16, 2019.”

35. I understand at least one panel of the PTAB has cited MPEP § 711.04(a) in determining the abandonment date of an application. That case, *Tanklogix, LLC v. SitePro*, IPR2025-00650, Paper 11 (P.T.A.B. Oct. 10, 2025), dealt with whether a prior art reference was entitled to an earlier filing date. That prior art analysis is the same analysis as discussed herein, because 35 U.S.C. § 120 governs in both cases. In *Tanklogix*, the Board found that an earlier application had been abandoned as of the date set forth in MPEP 711.04(a): “We agree with Patent Owner that, because the applicant failed to reply within the shortened time period and did not pay an extension of time, the '898 application was abandoned as of October 31, 2024. *See* 37 C.F.R. §§ 1.134-1.136; *see also* MPEP § 711.04(a)[.]” *Tanklogix*, Paper 11 at 24 (quotation omitted). The shortened time period for reply expired on October 31, 2024 in *Tanklogix*.

**D. Fourth Requirement (Reference): 37 C.F.R. § 1.78**

36. The fourth requirement of §120 requires that the patent application (here, the '665 application) “contain a specific reference to the earlier filed application” (the '228 application). This requirement, as well as other requirements, are addressed in 37 C.F.R. § 1.78. Sub-section (d) of this section relates to claims under § 120 for the benefit of a prior-filed non-provisional application, and (d)(2) specifically requires that the later-filed application contain a reference to each prior-filed application.

37. For applications filed prior to September 16, 2012, the specific reference must be in an application data sheet and/or in the first sentence(s) of the specification following the title. MPEP § 211.02.

38. A benefit claim, if any, must be made during the pendency of the application and within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. MPEP § 211.03.

39. A benefit claim may be deleted. For applications filed prior to September 16, 2012, an applicant may do so by amending the specification (if the benefit claim is in the specification) or by submitting a supplemental application data sheet in compliance with pre-AIA 37 CFR 1.76(c) to delete any references to prior applications. MPEP § 211.02(a).III.

40. Under MPEP § 211.02(a).III, a cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

41. A goal of § 120 is to eliminate the burden on the public in determining the filing date of a patent. The Federal Circuit has explained that “[a]lthough § 120 might appear to be a technical provision, courts have long-recognized that it embodies an important public policy and thus have required strict adherence to its requirements.” *Droplets, Inc. v. E\*Trade Bank*, 887 F.3d 1309, 1316 (Fed. Cir. 2018) (quoting *Sampson v. Ampex Corp.*, 463 F.2d 1042, 1045 (2d Cir. 1972) (internal quotations omitted)).

## **V. PROSECUTION HISTORIES OF THE ’228 AND ’665 APPLICATIONS**

42. I next summarize below the prosecution histories of the ’228 and ’655 applications, respectively. The brief summaries below are not meant to be an exhaustive review of every event during prosecution, and I provide additional

discussion of the prosecution histories in Section VI as needed to support my opinions.

**A. Prosecution History of the '228 Application (EX1029)**

43. Patent Owner as the applicant filed the '228 application on May 4, 2007. The original filing had a single page of written description, a single figure, an abstract, and 20 claims. (EX1029, 106-110.)

44. On June 20, 2007, Patent Owner filed an amended specification with three pages of written description, the same single figure and abstract, and 20 claims. He explained that the amended specification did not introduce new matter. (EX1029, 79-95.)

45. The USPTO published the amended specification on November 6, 2008 as U.S. Patent Appl. Pub. No. 2008/0275942 (EX2002). The written description of the published application had a total of 13 paragraphs.

46. On June 4, 2009, the USPTO issued an Office Action objecting to and rejecting the claims under §§ 112 (second paragraph), 101, 102, and 103. (EX1029, 49-63.) The Examiner advised Patent Owner “to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution.” (EX1029, 51.)

47. Patent Owner then engaged a patent attorney, who filed a Power of Attorney on September 14, 2009. (EX1029, 47-48.) The Power of Attorney was accepted on September 30, 2009. (EX1029, 46.)

48. On October 5, 2009, Patent Owner's counsel responded to the pending Office Action by cancelling the pending 20 claims and presenting three new claims. (EX1029, 36-41.) He argued that the new claims were patentable over the art in the Office Action. (EX1029, 40-41.) With the response, Patent Owner's counsel submitted a petition for a one-month extension of time and the accompanying fee. (EX1029, 42-44.) That same day, Patent Owner's counsel conducted an interview with the Examiner and his supervisor regarding the proposed amendment, but no agreement was reached. (EX1028, 33-35.)

49. Patent Owner then revoked the power of attorney of his counsel on October 26, 2009. (EX1029, 13, 32.) He then personally re-filed the response to the Office Action on November 3, 2009, as well as requesting (and paying for) a two-month extension of time. (EX1029, 14-21.)

50. On January 27, 2010, the Examiner issued a final Office Action rejecting the three claims under § 102. (EX1029, 3-8.) The Examiner set a shortened statutory period of three months for reply. (EX1029, 4.)

51. On September 8, 2010, the Examiner issued a Notice of Abandonment, because of "Applicant's failure to timely file a proper reply to the

Office letter mailed on 27 January 2010.” (EX1029, 1-2.) The prosecution history does not include any response by Patent Owner to the final Office Action dated January 27, 2010, nor does it include any request for an extension of time to respond to the final Office Action.

**B. Prosecution History of the '665 Application (EX1002)**

52. The Patent Owner as applicant filed the '665 application on July 27, 2010. (EX1002, 68.) The application was filed by the same counsel that Patent Owner had engaged during the prosecution of the '228 application. (EX1002, 68, 74.) With the filing of the application, Patent Owner's counsel submitted payment of \$545 for utility filing, search, and examination fees. (EX1002, 50, 67, 69.) No other fees were paid.

53. The written description of the filed application had 94 paragraphs. Paragraph [0001] referenced that “this application is a continuation-in-part of application Ser. No. 11/744,228, filed May 4, 2007.” (EX1002, 53.) The transmittal with the patent application also referenced that the '665 application is a continuation-in-part of the '228 application. (EX1002, 68.)

54. On August 16, 2010, the USPTO issued a Filing Receipt indicating that “[t]his application is a CIP of 11/744,228 05/04/2007.” (EX1002, 77.) On October 25, 2010, the USPTO issued an Updated Filing Receipt indicating that the '228 application has been abandoned. (EX1002, 133.)

55. The USPTO published the filed application on February 3, 2011 as U.S. Patent Appl. Pub. No. 2011/0029417. The written description of the published application had a total of 93 paragraphs, including paragraph [0081] relating to “on the fly” mastering.

56. On March 6, 2012, the Examiner initially rejected the pending claims under §§ 101 and 102. (EX1002, 142-148.) Prosecution then proceeded through a series of Office Actions and responses, culminating in a February 28, 2014 response with extensive claim amendments by new counsel for Patent Owner. (EX1002, 254-267.)

57. The Examiner issued an Office Action on May 2, 2014 with a section entitled “Priority.” (EX1002, 271-291.) In that section, the Examiner asserted that “the disclosure of the prior-filed application, Application No. 11744228 (now abandoned), fails to provide adequate support or enablement in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph for the claimed invention presented in the instant application.” (EX1002, 273.) The Examiner then noted: “As such, the priority date for the instant application is the filing date, 7/27/2010.” (EX1002, 273.)

58. Patent Owner’s counsel responded on September 2, 2014. (EX1002, 311-326.) She acknowledged the Examiner’s assertion on priority and deleted the priority claim to the ’228 application in the following remarks:

The Examiner notes that the disclosure of the prior-filed application, Application No. 11/744,228 fails to provide adequate support or enablement for the claimed invention in the instant application. Accordingly, Applicant has deleted the claim of priority to Application no. 11/744,228. Entry of the Amendment is respectfully requested.

(EX1002, 316)

59. Accompanying those remarks, Patent Owner's counsel made two changes to the prosecution record. First, she deleted the reference to the '228 application in the specification as shown below (EX1002, 311):

**Amendments to the Specification:**

Please delete the first paragraph on page 1:

~~{0001}—This application is a continuation-in-part of application Ser. No. 11/744,228, filed May 4, 2007.~~

60. Second, she submitted a "Letter to Correct Filing Receipt" (EX1002, 306-310) where she deleted the claim to priority as shown below:

Under "Domestic Priority data as claimed by applicant", please correct the Filing Receipt as follows:

~~This application is a CIP of 11/744,228 05/04/2007 None~~

Applicant is filing concurrently herewith a marked-up Filing Receipt to reflect the above change.

61. After an Advisory Action and an RCE, the Examiner issued a new Office Action on October 16, 2014. (EX1002, 360-378.) In the Office Action, the

Examiner repeated the same “priority” paragraph, concluding that “the priority date for the instant application is the filing date, 7/27/2010.” (EX1002, 362.)

62. Prosecution then proceeded again with the Examiner suggesting that the Patent Owner add details relating to “on-the-fly” mastering found in paragraph [0081] of the ’665 application. (EX1002, 408, 412.) Paragraph [0081] was not in the ’228 application.

63. After adding limitations suggested by the Examiner, the ’665 application was allowed on May 18, 2015. (EX1002, 439-443.)

64. On June 15, 2015, the USPTO issued a Corrected Filing Receipt. (EX1002, 448.) For “Domestic Applications for which benefit is claimed,” the Corrected Filing Receipt provides “none.” The Corrected Filing Receipt also stated (in bold): “If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction.” No written request was submitted by Patent Owner.

65. On September 20, 2015, the ’665 application matured into the ’925 patent, without any claim to priority on its cover page.

## **VI. THE CLAIMS OF THE ’925 PATENT ARE NOT ENTITLED TO THE BENEFIT OF THE ’228 APPLICATION**

66. In my opinion, none of the claims of the ’925 patent is entitled to the May 4, 2007 filing date of the ’228 application. I reach this conclusion because

none of the first, third, and fourth requirements of § 120 is met. I address these requirements below.

67. For the purposes of this Declaration, I am not providing any opinion on the second requirement of § 120.

**A. Continuity Requirement (First Requirement)**

68. The first requirement is that the written description of the earlier filed application (the '228 application) discloses the invention claimed in the later filed application (the '665 application which issued as the '925 patent) sufficiently to satisfy the requirements of § 112. The first requirement is sometimes referred to as the “continuity of disclosure” requirement.

69. I have reviewed the Supplemental Declaration of Mr. Rosenblatt. Mr. Rosenblatt analyzes the '228 application with respect to the claims of the '925 patent. He concludes that the '228 application does not provide written description support, as required by § 112, first paragraph, at least for the following independent limitations of claim 1 (and analogous limitations of claim 3):

[I] automatically analyzing, by the processor, audio signals of the new media for determining a root mean square (RMS) value, wherein the RMS value is further mathematically manipulated for obtaining a positive RMS value less than 1;

[J] storing, by the processor, the obtained RMS value less than 1 as metadata for the new media;

[P] wherein, the audio signals of the new media are normalized by the processor or jukebox by applying gain to the signals based on the obtained positive RMS value less than 1, and

[Q] wherein, the audio signals of the new media are further compressed for reducing a dynamic range of the signal based on a preset compression ratio and a preset threshold value.

(EX1035, ¶¶35-36.)

70. Based on that testimony, I conclude there is no continuity of disclosure between the '228 application and the inventions claimed in the '665 application that matured into the '925 patent. As such, the '925 patent is not entitled to the benefit of the filing date of the '228 application.

**B. Co-pendency Requirement (Third Requirement)**

71. The third requirement is that the later application must be co-pending with the earlier application. 35 U.S.C. § 120. I have provided the legal standards above, but I will briefly summarize them here. A later-filed application which is not co-pending with the earlier application is not entitled to the benefit of the filing date of the prior application. MPEP § 211.01(b); *see also Urologix, Inc. v. Prostalund AB*, 227 F. Supp. 2d 1033, 1035-40 (E.D. Wis. 2002).

72. As set forth in MPEP § 211.01(b), co-pendency requires that the later-filed application must be filed before: (A) the patenting of the prior application; (B) the abandonment of the prior application; or (C) the termination of proceedings in the prior application.

73. If the prior application is abandoned, including for failure to prosecute, the later-filed application must be filed before the abandonment in order for it to be co-pending with the prior application. MPEP § 211.01(b).

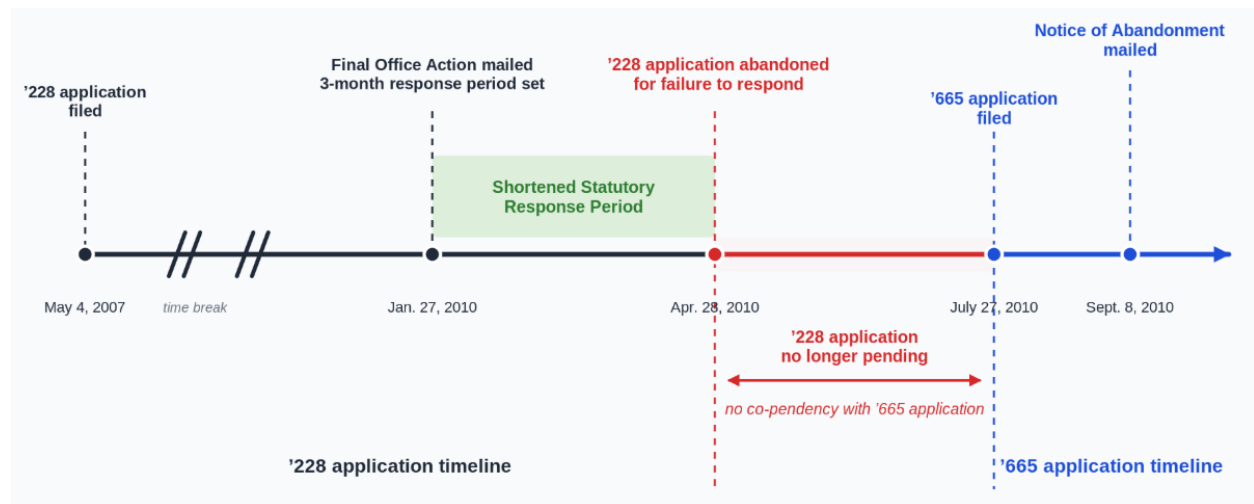
74. On January 27, 2010, the USPTO issued a final Office Action rejecting the claims of the '228 application and set a three-month shortened statutory period for response, i.e., by April 27, 2010. No response to the Office Action was filed, and no extension fees were paid after the three-month shortened statutory period expired. Accordingly, the '228 application went abandoned for failure to prosecute.

75. Section 711.04 of the MPEP sets forth the rule for when an application goes abandoned for failure to respond to an Office Action. Section 711.04(a) states: "If the application is abandoned, the date of the abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired. This is normally the end of the 3-month shortened statutory period." Because no extensions were taken, the set shortened statutory period was to April 27, 2010, and the '228 application went abandoned after midnight of that date. *See Urologix* at 1036-1040 (applying MPEP § 711.04(a) to conclude the patent application became abandoned at midnight upon expiration of the three-month shortened statutory period).

76. The '665 application was filed on July 27, 2010. As of that date, the '228 application had been abandoned for three months and was no longer pending. The prosecution history of the '228 application also does not show that any extensions of time were requested when the '665 application was filed.

77. Because the '665 application was not filed before the '228 application went abandoned on April 28, 2010, the applications do not meet the co-pendency requirement.

78. The following graphic illustrates the timing of the '228 application and the '665 application, in relevant part:



79. Although the USPTO did not issue a Notice of Abandonment for the '228 application until September 8, 2010, the date of the Notice is immaterial to the abandonment date. As set forth in the MPEP at § 711.04(a), the effective date

of abandonment is “the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired” and is unaffected by the timing of the Notice of Abandonment.

80. Because the co-pendency requirement is not met, any claim of the ’665 application to the benefit of the ’228 application’s priority date is ineffective—even if that claim were otherwise proper, and even if all other requirements were met. MPEP § 211.01(b).

81. In the Decision on Institution, the Board stated the following:

We note the official USPTO electronic file record for Application No. 11/744,228 indicates that this application was abandoned on September 8, 2010, for failure to respond to an office action. The ’925 patent was filed on July 27, 2010, before the September 8, 2010, date of the abandonment of parent application No. 11/744,228.

(DI, 53.)

82. The Board preliminarily found, on that basis, that “Patent Owner has satisfied requirements 2 and 3 under 35 U.S.C. § 120, showing that the applications have at least one common inventor and that the later application was filed before the issuance or abandonment of the earlier filed application.” (DI, 53.)

83. The Board incorrectly stated the date of abandonment of the ’228 application. The DI indicates that the Board determined the date of abandonment based on “the official USPTO electronic file record for Application No.

11/744,228.” (DI, 53.) While the DI does not provide the specific electronic file record in question, the USPTO’s Patent Center indicates that the status of the ’228 application is “Abandoned -- Failure to Respond to an Office Action 09/08/2010”, as shown below:

| 11/744,228   86179: User Defined Internet Jukebox Kiosks Set Top Box <span>PUBLIC VIEW</span> |                |                   |          |                        |                                                                |
|-----------------------------------------------------------------------------------------------|----------------|-------------------|----------|------------------------|----------------------------------------------------------------|
| Application #                                                                                 | Confirmation # | Attorney Docket # | Patent # | Filing or 371 (c) date | Status                                                         |
| 11/744,228                                                                                    | 8401           | 86179             | -        | 05/04/2007             | Abandoned -- Failure to Respond to an Office Action 09/08/2010 |

84. In this record, the “09/08/2010” date refers to the mailing date of the Notice of Abandonment on September 8, 2010. As discussed above, the date of the Notice of Abandonment is immaterial to the date that an application goes abandoned. This entry in Patent Center thus does not indicate the legal date of abandonment.

85. The DI does not indicate that the Board considered the three-month shortened statutory period set by the USPTO, which expired on April 27, 2010, or the applicant’s failure to request an extension of that period under 37 C.F.R. 1.136. The DI also does not indicate that the Board applied MPEP § 711.04 to determine the date on which the ’228 application went abandoned. As explained above, applying MPEP § 711.04 provides that the ’228 application went abandoned after midnight on April 27, 2010.

86. Because the Board relied on the incorrect date of abandonment for the '228 application, its preliminary finding that the applications satisfy the co-pendency requirement of 35 U.S.C. § 120 was also incorrect.

**C. Reference to Earlier Application Requirement (Fourth Requirement)**

87. The fourth requirement is that the later application must contain a specific reference to the earlier application. 35 U.S.C. § 120; 37 C.F.R. § 1.78; MPEP § 211.02. For applications filed prior to September 16, 2012, the specific reference must be in an Application Data Sheet and/or in the first sentence(s) of the specification following the title. *Id.*

88. A benefit claim, if any, must be made during the pendency of the application and within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. MPEP § 211.03.

89. A benefit claim may be deleted. For applications filed prior to September 16, 2012, applicant may do so by amending the specification (if the benefit claim is in the specification) or by submitting a supplemental application data sheet in compliance with pre-AIA 37 CFR 1.76(c) to delete any references to prior applications. MPEP § 211.02(a).III.

90. Under MPEP § 211.02(a).III, a cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

### **1. Prosecution History**

91. I provided a brief summary of the prosecution history of '665 application in Section V. I provide additional discussion of the prosecution histories here as needed to support my opinions.

92. The '665 application was filed on July 27, 2010, and included a reference to the '228 application in the first sentence of the specification as filed:

[0001] This application is a continuation-in-part of application Ser. No. 11/744,228, filed May 4, 2007.

(EX1002, 53.)

93. Additionally, the application transmittal sheet filed with the '665 application identified the application as a continuation-in-part of prior application 11/744,228. (EX1002, 1, 68.)

94. The USPTO mailed a filing receipt for the '665 application on August 16, 2010. The filing receipt reflected, under "Domestic Priority data as claimed by applicant": "This application is a CIP of 11/744,228 05/04/2007", as shown below:

| APPLICATION NUMBER |  | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY DOCKET NO | TOT CLAIMS | IND CLAIMS |
|--------------------|--|-----------------------|--------------|---------------|----------------|------------|------------|
| 12/804,665         |  | 07/27/2010            | 2447         | 545           | 86179          | 3          | 2          |

37237  
JUAN J. LIZARRAGA  
909 POYDRAS STREET, SUITE 2300  
NEW ORLEANS, LA 70112-1010

CONFIRMATION NO. 7385  
FILING RECEIPT

OC000000042988880

Date Mailed: 08/16/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Manuel Ignacio Tijerino, Slidell, LA;

**Power of Attorney:** The patent practitioners associated with Customer Number 37237

**Domestic Priority data as claimed by applicant**

This application is a CIP of 11/744,228 05/04/2007

**Foreign Applications**

(EX1002, 77 (annotated).)

95. The August 16, 2010 filing receipt thus reflected that the applicant claimed the '665 application to be a continuation-in-part of the '228 application.

96. A second filing receipt dated October 25, 2010, included substantially the same priority information. (EX1002, 133.)

97. The prosecution history indicates that an Application Data Sheet was never filed for the '665 application. (EX1002.)

98. On February 3, 2011, the '665 application was published as U.S. Patent Appl. Pub. No. 2011/0029417. (EX1002, 136; EX1001, (65).)

99. On March 6, 2012, the USPTO provided a bibliographic data sheet, which identified under "CONTINUING DATA" that "This application is a CIP of 11/744,228 05/04/2007 ABN". (EX1002, 140.)

100. On May 2, 2014, the USPTO Examiner issued a final Office Action that rejected the claims of the '665 application. The Office Action included the following:

Examiner notes that the disclosure of the prior-filed application, Application No. 11744228 (now abandoned), fails to provide adequate support or enablement in the manner provided by 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph for the claimed invention presented in the instant application. As such, the priority date for the instant application is the filing date, 7/27/2010.

(EX1002, 273.)

101. On September 2, 2014, the '665 applicant, acting through counsel from the law firm Christie, Parker & Hale, LLP, submitted a Letter to Correct Filing Receipt. The letter directed the Commissioner for Patents to correct the

Filing Receipt by striking the language “This application is a CIP of 11/744,228 05/04/2007” under “Domestic Priority data as claimed by applicant”, and replace it with “None”, as shown:

| LETTER TO CORRECT FILING RECEIPT                                                                                                                                |                                                                       |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------|
| Office of Initial Patent Examination's<br>Filing Receipt Corrections<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450                  | Post Office Box 29001<br>Glendale, CA 91209-9001<br>September 2, 2014 |
| Commissioner:                                                                                                                                                   |                                                                       |
| Under "Domestic Priority data as claimed by applicant", please correct the Filing Receipt as follows:                                                           |                                                                       |
| <div style="border: 2px solid red; padding: 5px; display: inline-block;"><b><del>This application is a CIP of 11/744,228 05/04/2007</del> <u>None</u></b></div> |                                                                       |
| Applicant is filing concurrently herewith a marked-up Filing Receipt to reflect the above change.                                                               |                                                                       |

(EX2002, 306-308 (annotated).)

102. Also on September 2, 2014, the '665 applicant, again through counsel, responded to the May 2, 2014, Office Action by amending the claims and the specification. The applicant amended claims 1, 3, 9, and 10 by inserting new limitations, and added new claim 19. (EX1002, 322-326.) The applicant amended the specification by striking paragraph [0001] in its entirety, thus deleting the specification's reference to the '228 application, as shown:

**Appln No. 12/804,665**  
**Amdt date September 2, 2014**  
**Reply to Office action of May 2, 2014**

**Amendments to the Specification:**

Please delete the first paragraph on page 1:

~~{0001}—This application is a continuation-in-part of application Ser. No. 11/744,228, filed May 4, 2007.~~

(EX1002, 311.)

103. In the remarks of the September 2, 2014, Office Action response, the '665 applicant acknowledged that the Examiner noted that the disclosure of the '228 application “fails to provide adequate support or enablement” for the claims of the '665 application. The remarks stated: “Accordingly, Applicant has deleted the claim of priority to Application no. 11/744,228. Entry of the amendment is respectfully requested.” (EX1002, 316.) The remarks also presented arguments for the patentability of the claims under § 112(a) and § 103 in view of the cited prior art. (EX1002, 316-318.)

104. On September 15, 2014, the USPTO issued an Advisory Action, which indicated that the amendments presented in the September 2, 2014, response would not be entered because “The independent claims recite new limitations that will require further search and/or consideration.” (EX1002, 332.)

105. On October 2, 2014, the applicant filed a Request for Continued Examination (RCE), along with a request for a one-month extension of time and the associated fees. (EX1002, 334-340.) The RCE directed the USPTO to “Consider the amendments/reply under 37 CFR § 1.116 previously filed on September 2, 2014.” (EX1002, 335.)

106. On October 16, 2014, the Examiner issued a non-final Office Action “in response to the Amendment for Application Number 12/804,665 received on 09/02/2014.” (EX1002, 362.) This Office Action rejected the claims as obvious under § 103. The Office Action reflects the examination of the claims as amended by the applicant’s September 2, 2014 Office Action response, indicating that the amendments presented in that response were entered. (EX1002, 362-378.)

107. A Notice of Allowance was issued on May 18, 2025, following another claim amendment by the applicant to add “details relating to on-the-fly mastering found on [sic] paragraph 0081” of the specification. (EX1002, 408, 439-443.)

108. On June 15, 2015, the USPTO mailed a Corrected Filing Receipt. As shown below, the Corrected Filing Receipt included the text, “Domestic Applications for which benefit is claimed - None.”



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UNITED STATES DEPARTMENT OF COMMERCE  
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| APPLICATION<br>NUMBER | FILING or<br>371(c) DATE | GRP ART<br>UNIT | FIL FEE REC'D | ATTY. DOCKET NO | TOT CLAIMS | IND CLAIMS |
|-----------------------|--------------------------|-----------------|---------------|-----------------|------------|------------|
| 12/804,665            | 07/27/2010               | 2443            | 545           | 73572/T699      | 3          | 2          |

23363  
CHRISTIE, PARKER & HALE, LLP  
PO BOX 29001  
Glendale, CA 91209-9001

CONFIRMATION NO. 7385  
CORRECTED FILING RECEIPT



Date Mailed: 06/15/2015

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Inventor(s)**

Manuel Ignacio Tijerino, Slidell, LA;

**Applicant(s)**

Manuel Ignacio Tijerino, Slidell, LA;

**Power of Attorney:** The patent practitioners associated with Customer Number 23363

**Domestic Applications for which benefit is claimed - None.**

*A proper domestic benefit claim must be provided in an Application Data Sheet in order to constitute a claim for domestic benefit. See 37 CFR 1.76 and 1.78.*

**Foreign Applications** for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.) - None.

*Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.*

(EX1002, 448-450 (annotated).)

109. The Corrected Filing Receipt reflects that the applicant's September 2, 2014, Letter to Correct Filing Receipt—which directed the Office to strike the language "This application is a CIP of 11/744,228 05/04/2007" under "Domestic

Priority data as claimed by applicant”, and replace it with “None”—had been entered. (EX1002, 448.)

110. The Corrected Filing Receipt reminded the applicant of the reference to earlier application requirement:

*A proper domestic benefit claim must be provided in an Application Data Sheet in order to constitute a claim for domestic benefit. See 37 CFR 1.76 and 1.78.*

(EX1002, 448.)

111. The Corrected Filing Receipt additionally advised the applicant to “verify the accuracy of the data presented on this receipt,” and to “submit a written request for a Filing Receipt Correction” if an error in the Filing Receipt was noted. (EX1002, 448.)

112. The ’665 application issued on September 29, 2015 as the ’925 patent. (EX1002, 456; EX1001.) The issued patent does not include any reference to the ’228 application. That is, there is no reference to the ’228 patent on the face of the ’925 patent. This reflects the June 15, 2015, Corrected Filing Receipt, which indicated that no benefit was claimed for any domestic application. Additionally, the specification of the ’925 patent does not include any reference to the ’228 application. This reflects entry of the applicant’s September 2, 2014, amendment, which deleted the earlier reference to the ’228 application in paragraph [0001] of the specification as originally filed.

## **2. Analysis**

113. The '925 patent fails the reference to earlier application requirement under 35 U.S.C. § 120 because (1) its underlying '665 application did not contain a specific reference to the '228 application in an Application Data Sheet, and (2) the '665 application did not contain a specific reference to the '228 application in the first sentence(s) of the specification following the title, as reflected in the issued '925 patent. MPEP § 211.02.

114. The facts described above indicate that the '665 application initially included a reference to the earlier '228 application in paragraph [0001] of the specification. This reference was later deleted by the applicant's September 2, 2014 amendment to the specification, which deleted paragraph [0001] in its entirety. This deletion was made by counsel on behalf of the applicant and was consistent with the instructions of MPEP § 211.02(a).III for deleting benefit claims. Upon the deletion, the specification did not contain a specific reference to the '228 application.

115. This deletion is reflected in the issued '925 patent, which contains no reference to the '228 application in the specification (or anywhere else in the patent). (EX1001.)

116. For applications filed prior to September 16, 2012, such as the '665 application, a reference to an earlier application can alternatively be included in an

Application Data Sheet. However, the applicant never filed an Application Data Sheet. (EX1002.) The '665 application was filed with an application transmittal sheet that included a reference to the '228 application. But an application transmittal sheet is not an Application Data Sheet.

117. Under MPEP § 211.04, an applicant can file a petition for an unintentionally delayed benefit claim. The petition must be accompanied by: (A) the reference required by 35 U.S.C. 120 and 37 CFR 1.78 to the prior application (unless previously submitted); (B) a petition fee under 37 CFR 1.17(m); and (C) a statement that the entire delay between the date the benefit claim was due under 37 CFR 1.78 and the date the claim was filed was unintentional. Here, under 37 CFR 1.78(d)(3)(ii), the benefit claim was due no later than November 27, 2010, which is the later of four months from the actual filing date of the later-filed '665 application (July 27, 2010) or sixteen months from the filing date of the prior-filed '228 application (May 4, 2007). The prosecution history of the '925 patent indicates that no such petition was filed. (EX1002.)

118. The applicant here has forfeited any right to file a petition for an unintentionally delayed benefit claim because he cannot show that the entire delay from the date the benefit claim was due—November 27, 2010—was unintentional.

119. Applying MPEP § 211.02(a).III, the applicant's cancellation of any benefit claim to the '228 application may be considered as a showing that the

applicant is intentionally waiving that benefit claim. In my view, there is no question that the applicant intentionally waived any benefit claim under MPEP § 211.02(a).III, at least because the applicant expressly stated so through counsel in its September 2, 2014, Office Action response: “Applicant has deleted the claim of priority to Application no. 11/744,228.” (EX1002, 316.) Moreover, in the response, the applicant expressly indicated the reason for the deletion: “the disclosure of the prior-filed application, Application No. 11/744,228 fails to provide adequate support or enablement for the claimed invention in the instant application.” (EX1002, 316.)

120. The applicant’s deliberate amendment of the specification to delete the reference to the ’228 application is consistent with the applicant’s September 2, 2014, Letter to Correct Filing Receipt, which directed the Office to strike the domestic priority claim that appeared in the initial Filing Receipt, and replace it with “None.” This supports that the applicant’s failure to reinstate the benefit claim was intentional.

121. MPEP § 211.02(a).I provides that an applicant can request a corrected filing receipt if the applicant receives a filing receipt with missing or incorrect benefit claim information. Additionally, as described above, the June 15, 2015, Corrected Filing Receipt advised the applicant to verify its accuracy and submit a request for correction if an error was noted. However, the prosecution history of

the '925 patent indicates that the applicant did not make any such request.

(EX1002.) This further supports that the applicant's waiver of its initial benefit claim, and failure to reinstate that claim, was intentional: the applicant did not believe there to be any missing or incorrect benefit information in the Corrected Filing Receipt, which identified no claim of priority to the '228 application.

122. I note that the burden to establish a right to an earlier filing date is on the Patent Owner. I do not believe Patent Owner has made any showing that would satisfy this burden, and as discussed above, Patent Owner could not have made such a showing in view of the '925 patent's prosecution history.

123. In the POR, Patent Owner presents several rebuttal arguments to support the benefit of an earlier priority date. Although the burden is on the Patent Owner, as noted above, Patent Owner's rebuttals are separately insufficient.

124. The POR argues that the applicant's September 2, 2014, amendments—which included an amendment to the specification to delete its reference in paragraph [0001] to the '228 application—were not entered in view of the September 15, 2014, Advisory Action. (POR, 60; EX1002, 306-316, 332-333.) Patent Owner is incorrect. Because the Advisory Action indicated that the amendments would not be entered because “The independent claims recite new limitations that will require further search and/or consideration,” EX1002 at 332, it is unclear whether the Advisory Action declined to enter all amendments,

including the amendment to the specification, or just the applicant's amendments to the claims. However, the issue is moot: the applicant filed an RCE on October 2, 2014, after the Advisory Action, and requested the Office to consider the September 2, 2014, amendments. (EX1002, 334-335.) Accordingly, the Examiner then entered the amendments, as reflected in the non-final Office Action issued October 16, 2014 (which rejected the claims as amended). (EX1002, 362-378.) Further, the specification of the issued '925 patent does not contain the deleted reference to the '228 application, demonstrating that the amendment to the specification was in fact entered. (EX1001.)

125. The POR also refers to the published '665 application, the October 2010 filing receipt, and the "bibliographic data sheet" as identifying the '665 application as a continuation-in-part of the '228 application. (POR, 61.) These documents do not support a priority claim of the issued '925 patent. It is unsurprising that the '665 publication (published February 3, 2011), the filing receipt (dated October 25, 2010), and the bibliographic data sheet (published March 6, 2012) all identify the '665 application as a continuation-in-part of the '228 application. The applicant did not amend the specification to delete the reference to the '228 application, or request correction of the filing receipt to delete the priority claim, until September 2, 2014. (EX1002, 306-318.) These documents from before that date would not have reflected the deletion of the priority claim,

which removed the reference to the earlier application required by 35 U.S.C. § 120. As discussed above, the issued '925 patent does not include any claim of priority to the '228 application—consistent with the applicant's deletion.

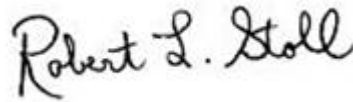
126. The POR also refers to “Examiner search notes” that “confirm that the parent application was reviewed during examination.” (POR, 61.) But Examiner search notes do not constitute the reference to an earlier application required by § 120. Further, whether or not the '228 application was reviewed by the Examiner during examination of the '925 patent is immaterial to whether the '925 patent is entitled to the benefit of the '228 application.

127. The POR also argues that the June 15, 2015, filing receipt was “administrative in nature,” and was issued after the Notice of Allowance, and thus “did not reopen prosecution or effect any substantive amendment to the application record.” (POR, 62.) The POR is incorrect. First, as a general matter, it is untrue that prosecution history events occurring after a Notice of Allowance cannot substantively affect an applicant's rights. Second, MPEP § 211.02(a).III does not limit the deletion of a benefit claim to deletions acknowledged before a Notice of Allowance. And third, as discussed above, the '665 application fails the reference to earlier application requirement not because of the Corrected Filing Receipt, but because it lacks the required reference to the '228 application, which was deleted

in the specification by the applicant on September 2, 2014, and entered by the Examiner.

128. Because the reference to earlier application requirement is not satisfied, the '925 patent cannot claim the benefit of the '228 application's priority date. This is in addition to the failure to satisfy the Co-pendency requirement, discussed above, and the Continuity requirement. Failure to satisfy *any* of these three requirements prevents the '925 patent from claiming the benefit of the '228 application.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code.

A handwritten signature in black ink that reads "Robert L. Stoll". The signature is written in a cursive, slightly slanted style.

Dated: June 16, 2026

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Robert L. Stoll