

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

GAMBA GROUP HOLDINGS LLC,
Patent Owner.

Case No. IPR2026-00156
U.S. Patent No. 9,772,193

DECLARATION OF ROBERT W. BAHR

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I, Robert W. Bahr, declare as follows:

I. INTRODUCTION

1. I am submitting this declaration on behalf of Google LLC (“Google”) in connection with a petition for *inter partes* review of U.S. Patent No. 9,772,193 (“’193 patent”), which I understand is being submitted to the Patent Trial and Appeal Board (“PTAB”) of the United States Patent and Trademark Office (“USPTO”).

2. I am a partner at the law firm of Maier & Maier PLLC, where I specialize in USPTO patent policy, practice, and procedure. My expertise includes USPTO patent policy, practice, and procedures, and advising attorneys and our clients on complex patent prosecution matters. My curriculum vitae is attached hereto as **Appendix A**.

3. Google has retained me as an expert to investigate the file history of U.S. Patent No. 9,772,193 (the ’193 patent) and provide my expert opinion relating to the filing and examination of the application leading to the ’193 patent: U.S. Patent Application No. 15/403,146 (“the ’146 application”). Google Ex. 1001, Google Ex. 1013. I have been asked to provide information about the relevant procedures that govern patent application examination, and the applicable rules and guidance provided by the edition of the Manual of Patent Examining Procedure

(“MPEP”) that was in effect during the filing and examination of the ’146 application,¹ and I have compared these standard procedures with what occurred during the actual prosecution and examination of the ’146 application. Google Ex. 1013. I am being compensated for my work at my standard hourly rate. My compensation is not in any way contingent on the substance of my opinions or the outcome of these proceedings.

4. It is my opinion, based on my experience and knowledge of the relevant procedures governing patent examination, that the file history of the ’193 patent indicates that: (1) the benefit claims in the ’146 application are dubious, but were accepted at face value, during the examination of the ’146 application, leading to possible intervening prior art not being considered; and (2) the searches conducted during the examination of the ’146 application—even accepting the ’146 application’s benefit claims at face value—were inadequate as unduly narrow, resulting in the failure to uncover pertinent prior art, including U.S. Patent Application Publication No. US 2002/0082025 to Baese et al. (Baese), U.S. Patent

¹ All references to the MPEP are to the Ninth Edition, Revision 07.2015 (Nov. 2015). In addition, all references to 35 U.S.C. § 102 or 103 are to pre-AIA 35 U.S.C. § 102 or 103.

Application Publication No. US 2003/0055560 to Phillips (Phillips), and U.S. Patent No. 6,081,229 to Soliman et al. (Soliman).² It is also my opinion, based on my experience and knowledge of the relevant procedures governing patent examination, that the file history of the '146 application is unclear as to whether the '146 application was examined under the pre-AIA first to invent (FTI) or the AIA first inventor to file (FITF) provisions of 35 U.S.C. §§ 102 and 103.

II. BACKGROUND AND QUALIFICATIONS

5. I worked at the USPTO for over 38 years. I began my career at the USPTO in September 1984, and was a patent examiner in Examining Group 330

² I understand from the petition for *inter partes* review (“IPR petition”) of the '193 patent that Google has taken the position that: (1) claims 12, 13, and 15-18 of the '193 patent are anticipated under 35 U.S.C. § 102 by Baese (Google Ex. 1003); (2) claims 12, 13, and 15-18 of the '193 patent are unpatentable under 35 U.S.C. § 103 over Baese; (3) claims 12, 13, and 15-18 of the '193 patent are anticipated under 35 U.S.C. § 102 by Phillips (Google Ex. 1004); (4) claims 12, 13, and 15-18 of the '193 patent are unpatentable under 35 U.S.C. § 103 over Phillips; and (5) claims 12, 13, and 15-18 of the '193 patent are unpatentable under 35 U.S.C. § 103 over Phillips and Soliman (Google Ex. 1005). Google Pet. at 7.

(now Technology Center 3700) until April 1994. Between March 2016 and August 2023, I served as the Deputy Commissioner for Patents responsible for the patent examination policy area (“Deputy Commissioner for Patent Examination Policy”).³ I also served as the acting Deputy Commissioner for Patent Examination Policy between August of 2015 and March 2016, and from November 2009 until December 2011. Between November 2000 and March 2016, I served as the Senior Patent Counsel to the Deputy Commissioner for Patent Examination Policy (except when I was acting Deputy Commissioner). Between April 1994 and July 2000, I was a Legal Advisor in the Office of Patent Legal Administration (OPLA).

6. I led the implementation of numerous rulemakings while at the USPTO, most notably the patent examination provisions of the Leahy-Smith America Invents Act (AIA), including the changes to the patent rules and examination guidelines to implement the first inventor to file provisions of the AIA, the Patent Law Treaty provisions of the Patent Law Treaties Implementation

³ From 2016 to 2020, this position was titled “Deputy Commissioner for Patent Examination Policy,” and in October 2020 that title changed to “Deputy Commissioner for Patents.” This position was titled “Associate Commissioner for Patent Examination Policy” from 2009 to 2011.

Act (PLTIA), and the continued examination, patent term adjustment, and eighteen-month publication provisions of the American Inventors Protection Act of 1999 (AIPA). I also provided training to patent examiners on various changes to the patent laws, regulations, and examining procedures, including the first inventor to file provisions of the AIA, and the continued examination, patent term adjustment, and eighteen-month publication provisions of the AIPA.

7. I completed my undergraduate studies at the University of Maryland in 1983 with a Bachelor of Science in Mechanical Engineering. I attended the National Law Center of George Washington University, receiving my Juris Doctor in law with honors in May of 1993. I am a member of the Virginia State Bar and the Bars of the U.S. Court of Appeals for the Federal Circuit (Federal Circuit), and U.S. Supreme Court. I am registered to practice as a patent attorney before the U.S. Patent and Trademark Office.

III. PERTINENT REQUIREMENTS FOR ENTITLEMENT TO BENEFIT UNDER 35 U.S.C. § 120 OF A PRIOR APPLICATION

A. Stating the Relationship of the Applications

8. When claiming the benefit of a prior nonprovisional application under 35 U.S.C. § 120, patent applicants are required to state the relationship of the applications: namely, whether the later application is a continuation, divisional, or continuation-in-part of the prior application. *See* 37 C.F.R. § 1.78(d)(2) and MPEP

§ 211.02(II). The MPEP also instructs examiners that these relationships are mutually exclusive, in that an application may not be both a divisional and a continuation application, or both a divisional and a continuation-in-part application. MPEP § 211.02(II). The applicant in the '146 application designated that application as a “division” of a prior application.

9. The MPEP defines a divisional application as an application claiming benefit under 35 U.S.C. § 120 of a prior nonprovisional application for one or more independent or distinct inventions carved out of the prior nonprovisional application. *See* MPEP § 201.06. The MPEP also indicates that a divisional application is limited to inventions adequately disclosed in the earlier-filed nonprovisional application, and that a divisional application may not include any subject matter that would have been “new matter” if submitted by amendment in the earlier-filed nonprovisional application. *See* MPEP § 201.06.⁴

⁴ The MPEP provides that a continuation application, like a divisional application, may not include any subject matter that would have been “new matter” if submitted by amendment in the earlier-filed nonprovisional application, but unlike a divisional application, a continuation application is **not** limited to an

10. A divisional (or continuation) application is not required to be a photocopy of the preceding application; however, a divisional (or continuation) application may not include any subject matter that would constitute “new matter” in the preceding application. The MPEP specifically advises that “[w]hile a divisional application may depart from the phraseology used in the parent application there may be no departure therefrom in substance or variation in the disclosure that would amount to ‘new matter’ if introduced by amendment into the parent application.” *See* MPEP § 201.06.

11. By contrast, the MPEP defines a continuation-in-part application as an application claiming benefit of a prior application that is distinguished from a divisional (or continuation) application in that a continuation-in-part application may include subject matter that would have been “new matter” if submitted by amendment in the prior nonprovisional application. *See* MPEP § 201.08. The MPEP instructs examiners that claims in a continuation-in-part application that are not adequately disclosed in the prior nonprovisional application are entitled only to the filing date of the continuation-in-part application, but that claims in a

independent or distinct invention carved out of the prior nonprovisional application. *See* MPEP § 201.07.

continuation-in-part application that are adequately disclosed in the prior nonprovisional application are entitled to the filing date of the prior nonprovisional application. *See* MPEP § 211.05(I)(B).

12. The USPTO does not require examiners to determine if a claim in a continuation-in-part application is adequately disclosed in the earlier-filed nonprovisional application, unless the filing date of the earlier-filed nonprovisional application is being relied upon. *See* MPEP § 201.08. The MPEP also provides that if the examiner determines that an application identified as a continuation or divisional application contains new matter relative to the preceding application, the examiner should so notify the applicant in the next Office action and indicate that the application should be redesignated as a continuation-in-part. *See* MPEP §§ 201.06(c) and 211.05.

B. Relevant Requirements and Conditions for Entitlement to Benefit of a Prior Application

- 1. Support for the claim under 35 U.S.C. § 112(a)⁵ must exist in a single prior application*

13. The MPEP instructs examiners that a claim in a later application must be supported in the prior application in a manner so as to satisfy the requirements of 35 U.S.C. § 112(a) for that claim to be entitled to the benefit of the prior application under 35 U.S.C. § 120. *See* MPEP § 211.05. The MPEP also instructs examiners that a claim that relies upon or requires a **combination** of prior applications for support may not be entitled to the benefit of the prior applications under 35 U.S.C. § 120. *See* MPEP § 211.05. That is, a claim in a later application must have support meeting all the requirements of 35 U.S.C. § 112(a) in the (a

⁵ All reference to 35 U.S.C. § 112 are to AIA 35 U.S.C. § 112, as the change to 35 U.S.C. § 112 in the AIA, redesignating the previously undesignated paragraphs of 35 U.S.C. § 112 as 35 U.S.C. §§ 112(a) through (f), is applicable to patent applications filed on or after September 16, 2012 (regardless of any benefit or priority claim). *See* MPEP § 2161.

single) prior application for the claim to be entitled to the benefit of that prior application under 35 U.S.C. § 120.

2. *A benefit claim must identify all prior applications*

14. The MPEP instructs examiners that an application may claim the benefit or priority of a first-filed application through one or more intermediate nonprovisional applications, but that (1) such an application must make specific reference (benefit claim) to the first-filed application, in addition to making the benefit claim to the intermediate nonprovisional application(s); (2) the benefit claim to the prior applications must identify **all** of the prior applications and indicate the relationship (*i.e.*, continuation, divisional, or continuation-in-part) between each nonprovisional application; and (3) there must be a benefit claim (specific reference) in each intermediate application in the chain of prior applications. *See* MPEP § 211.01(b)(II).

3. *Intervening publication may bar a claim not supported in the prior application*

15. The MPEP instructs examiners that if a claim is not fully supported in a prior application for which benefit is claimed under 35 U.S.C. § 120, the claim is not entitled to the benefit of that prior application. *See* MPEP § 211.05. The MPEP also instructs examiners that the disclosure necessary for a publication to anticipate (or render obvious) a claim is less than the disclosure required to support that claim

under 35 U.S.C. § 112(a). *See* MPEP § 2152.02(b). Thus, the examiner guidance is that if a claim in a later application is not entitled to the benefit of a prior application, that claim may be rejected over a publication (or public use, offer for sale, or patenting) after the prior application's filing date but before the later application's filing date (an intervening publication). *See* MPEP § 211.05. The MPEP provides examples or cases of interest in which a claim in a continuation-in-part application did not have support under 35 U.S.C. § 112(a) in a prior application, but was still rejected as anticipated or obvious over a publication of the disclosure of that prior application that was more than one year prior to the continuation-in-part application's filing date. *See* MPEP § 211.05.⁶

⁶ The PTAB's decision in *Arthrex*, affirmed by the Federal Circuit in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328 (Fed. Cir. 2022), is also an example of a situation in which the claims of a patent having a chain of applications for which a benefit is claimed was held unpatentable as anticipated by a publication of a prior application in the chain, despite the patent being entitled to the benefit of that prior application.

C. Statement Required for AIA Transition Applications

16. Applications filed on or after March 16, 2013 that claim the benefit of or priority to a domestic or foreign application filed before March 16, 2013 are considered AIA transition applications. *See* MPEP § 210(III)(A). The USPTO rules require that if a transition application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013, the applicant must provide a statement to that effect in a timely manner. *See* 37 C.F.R. §§ 1.55(k) and 1.78(a)(6) and (d)(6); *see also* MPEP §§ 210(III)(A), 211.01(III) and 213.02(III). The USPTO requires this statement to assist the USPTO in determining whether the application should be examined under the FITF provisions of 35 U.S.C. §§ 102 and 103 as an AIA application or under the FITF provisions of 35 U.S.C. §§ 102 and 103 as a pre-AIA application. *See* MPEP § 2159.04.⁷

⁷ *See also Changes to Implement the First Inventor to File Provisions of the Leahy-Smith America Invents Act*, 78 Fed. Reg. 11024, 11052 (Feb. 14, 2013)(final rule) (“[t]he Office will use the statement . . . to readily determine whether the nonprovisional application is subject to the changes to 35 U.S.C. 102 and 103 in the AIA”).

IV. USPTO SEARCH SYSTEMS AND GUIDANCE IN THE 2017 TIMEFRAME

A. Examiner Search Tools

17. In the 2017 timeframe, the USPTO employed two desktop search tools for examiners to search U.S. patents and U.S. patent application publications: the Examiner's Automated Search Tool ("EAST") and the Web-based Examiner Search Tool ("WEST"). *See* MPEP § 902.03(e). EAST and WEST each provide examiners with access to a common text-searchable database of U.S. patents and U.S. patent application publications, and each permit an examiner to view retrieved documents as either images or text. The MPEP instructs examiners that great care should be taken so as to clearly indicate the places searched and the date(s) on which the search was conducted. *See* MPEP § 719.05.

B. Examiner Search Guidance

18. The MPEP instructs examiners that: (1) "the breadth of the claims in the application should always be carefully noted"; they "should be fully aware of what the claims do *not* call for, as well as what they do require"; and "[d]uring patent examination and reexamination, the claims are given the broadest reasonable interpretation consistent with the specification." *See* MPEP § 904.01. The MPEP specifically notes that "[f]requently, a claim includes within its breadth or scope one or more variant embodiments that are not disclosed in the application,

but which would anticipate the claimed invention if found in a reference,” and that “[t]he claim must be so analyzed and any such variant encountered during the search should be recognized.” *See* MPEP § 904.01(a).

19. The USPTO instructs examiners that U.S. patent application publications are, for purposes of 35 U.S.C. §§ 102(a) and (b) (and AIA 35 U.S.C. § 102(a)(1)), publications as of their publication date, regardless of whether the underlying application is subsequently abandoned or patented. *See* MPEP §§ 901.02 and 901.03. In addition, U.S. patent application publications are prior art under 35 U.S.C. § 102(e) (and AIA 35 U.S.C. § 102(a)(2)) as of the earliest effective U.S. filing date of the published application. *See* MPEP §§ 901.02 and 901.03.

V. SUMMARY OF THE PROSECUTION AND EXAMINATION OF THE '193 PATENT

A. Filing of the '146 Application

20. The application for the '193 patent was filed on January 10, 2017, and was assigned Application No. 15/403,146 (“the '146 application”). Google Ex. 1013, pp. 045-048 (Filing Receipt). The '146 application included an application data sheet (ADS), a specification having 117 pages of written description and twenty-one (21) claims (claims 1 and 12 being independent claims), an abstract, and thirteen (13) sheets of drawings. Google Ex. 1013, pp. 056-066 and 104-241.

The '146 application was accompanied by a nonpublication request under 35 U.S.C. § 122(b) and 37 C.F.R. § 1.213. Google Ex. 1013, pp. 057 and 103.

B. Benefit Claims in the '146 Application

21. The '146 application ADS includes an extensive set of benefit claims under 35 U.S.C. §§ 119(e) and 120, ultimately reaching back to two provisional applications filed in 2005: (1) a provisional application filed on April 12, 2005, which was assigned Provisional Application No. 60/670,097 (“the '097 provisional application”); and (2) a provisional application filed on May 9, 2005, and which was assigned Provisional Application No. 60/678,947 (“the '947 provisional application”). Google Ex. 1013, pp. 058-061. The '146 application ADS claims benefit under 35 U.S.C. § 119(e) of the '097 provisional application through a chain of nine (9) intermediate nonprovisional applications for which there is a benefit claim under 35 U.S.C. § 120. The '146 application ADS claims benefit under 35 U.S.C. § 119(e) of the '947 provisional application through two chains of intermediate nonprovisional applications for which there is a benefit claim under 35 U.S.C. § 120: the first being a chain of twelve (12) intermediate nonprovisional applications; and the second being a chain of nine (9) intermediate nonprovisional applications.

1. Common applications in the chains of applications to the '097 and '947 provisional applications

22. The first seven intermediate nonprovisional applications are the same in each of the chains leading from the '146 application back to the '097 provisional application and the '947 provisional application. The chain of these seven applications as claimed by the applicant in the '146 application is as follows:

(1) The '146 application is identified as a division of Application No. 15/397,685 (“the '685 application”), filed January 3, 2017;⁸

(2) The '685 application is identified as a division of Application No. 15/237,727 (“the '727 application”), filed August 16, 2016, now U.S. Patent No. 9,538,332;

(3) The '727 application is identified as a division of Application No. 15/086,028 (“the '028 application”), filed March 30, 2016, now U.S. Patent No. 9,420,423;

(4) The '028 application is identified as a division of Application No. 14/285,406 (“the '406 application”), filed May 22, 2014;⁹

⁸ The '685 application is now U.S. Patent No. 9,674,684.

⁹ The '406 application is now U.S. Patent No. 9,602,193.

(5) The '406 application is identified as a division of Application No. 14/285,332 ("the '332 application"), filed May 22, 2014, now U.S. Patent No. 9,491,584 ("the '584 patent");

(6) The '332 application is identified as a division of Application No. 14/285,273 ("the '273 application"), filed May 22, 2014, now U.S. Patent No. 9,204,257; and

(7) The '273 application is identified as a division of Application No. 14/285,209 ("the '209 application"), filed May 22, 2014, now U.S. Patent No. 9,204,251.

2. *Chain of applications from the '209 application to the '097 provisional application*

23. The chain of intermediate nonprovisional applications leading from the '209 application back to the '097 provisional application as claimed by applicant in the '146 application is as follows:

(1) The '209 application is identified as a division of Application No. 12/930,735 ("the '735 application"), filed January 14, 2011, now U.S. Patent No. 9,020,687;

(2) The '735 application is identified as a division of Application No. 11/396,843 ("the '843 application"), filed April 3, 2006, now U.S. Patent

No. 7,899,583 (Google Ex. 1002). The '843 application claims benefit of the '097 provisional application.

24. The '843 application as filed included a specification having 33 pages of written description and twenty-four (24) claims (claims 1 and 7 being independent claims), an abstract, and five (5) sheets of drawings. The '843 application was not accompanied by a nonpublication request, and was published on November 9, 2006 as U.S. Patent Application Publication No. US 2006/0253226.

3. *Chains of applications from the '209 application to the '947 provisional application*

25. The first chain of intermediate nonprovisional applications leading from the '209 application back to the '947 provisional application as claimed by applicant in the '146 application is as follows:

(1) The '209 application is identified as a division of Application No. 13/135,421 (“the '421 application”), filed July 5, 2011, now U.S. Patent No. 9,374,673;

(2) The '421 application is identified as a division of Application No. 13/932,811 (“the '811 application”), filed March 7, 2011, now U.S. Patent No. 8,941,485;

(3) The '811 application is identified as a division of Application No. 12/069,899 (“the '899 application”), filed February 13, 2008, now U.S. Patent No. 7,924,149; and

(4) The '899 application is identified as a division of Application No. 11/472,706 (“the '706 application”), filed June 22, 2006, now U.S. Patent No. 8,896,485; and

(5) The '706 application is identified as a division of Application No. 11/429,864 (“the '864 application”), filed May 8, 2006, now U.S. Patent No. 8,836,580. The '864 application claims benefit of the '947 provisional application.

26. The '864 application as filed included a specification having 38 pages of written description and eighteen claims (claim 1 being the sole independent claim), an abstract, and eight sheets of drawings. Google Ex. 1022, pp. 450-504. The '864 application was not accompanied by a nonpublication request, and was published on January 4, 2007 as U.S. Patent Application Publication No. US 2007/0001904.

27. The second chain of intermediate nonprovisional applications leading from the '209 application back to the '947 provisional application as claimed by applicant in the '146 application is as follows:

(1) The '209 application is identified as a division of Application No. 12/587,042 ("the '042 application"), filed October 1, 2009, now U.S. Patent No. 8,866,673; and

(2) The '042 application is identified as a division of the '864 application, which again claims benefit of the '947 provisional application.

28. As previously discussed, the '864 application included a specification having 38 pages of written description and eighteen (18) claims (claim 1 being the sole independent claim), an abstract, and eight (8) sheets of drawings.

4. *Transition applications in the chains of applications to the '097 and '947 provisional applications*

29. As previously discussed, the first seven intermediate nonprovisional applications are the same in each of the chains leading from the '146 application back to the '097 provisional application and the '947 provisional application. In addition, these first seven intermediate nonprovisional applications are "transition applications," meaning that each of these applications was filed on or after March 16, 2013, but claim the benefit or priority of an application filed prior to March 16, 2013.¹⁰ Neither the '146 application (also a transition application) nor any of these

¹⁰ The remaining applications for which the '146 application claims benefit under 35 U.S.C. § 120 were filed before March 16, 2013.

seven intermediate applications include a statement that the application contains, or ever contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

5. *Inconsistent characterization of the relationship between the '735 application and '843 application*

30. As previously discussed, the '146 application ADS identifies the '735 application as a division of the '843 application. The '735 application,¹¹ however, identifies itself as a continuation-in-part of the '843 application. Google Ex. 1031, pp. 129 and 151.

¹¹ The '735 application is identified as a continuation-in-part of the '843 application in the first sentence of its specification. For applications filed on or after September 12, 2012, a benefit claim under 35 U.S.C. § 120 must be stated in the ADS. *See* MPEP § 211.02. A benefit claim for applications filed on or after September 12, 2012 may also be in the first sentence of the specification for applications filed before September 16, 2012, such as the '735 application. *See* MPEP § 211.02.

6. *The '146 application does not identify an intermediate application*

31. The ADS for the '146 application identifies the '028 application as a division of the '406 application. The ADS of the '028 application, however, identifies it as a division of application 14/285,439 (“the '439 application”), which is now abandoned. Google Ex. 1020, p. 111. A proper benefit claim for the '146 application would have identified the '028 application as a division (or continuation or continuation-in-part as appropriate) of the '439 application, which in turn is a division (or continuation or continuation-in-part as appropriate) of the '406 application.

7. *The '273 application, '332 application, and '406 application do not identify all prior intermediate applications*

32. The benefit claims in the '146 application have inconsistencies with the benefit claims in three intermediate nonprovisional applications in the two benefit chains leading back to the '947 provisional application, in that these three intermediate nonprovisional applications fail to identify all of the applications for which benefit is claimed in the '146 application.

33. The '146 application identifies the '273 application as a division of the '209 application in the two chains of benefit claims leading back to the '947 provisional application. Google Ex. 1013, pp. 059 and 061. The '273 application, however, is identified in the '273 application itself as a direct division of the '421

application and a direct division of the '042 application, without any intermediate reference to the '209 application. Google Ex. 1029, p. 423.

34. The '146 application identifies the '332 application as a division of the '273 application in the two chains of benefit claims leading back to the '947 provisional application. Google Ex. 1013, pp. 059 and 061. The '332 application, however, is identified in the '332 application itself as a direct division of the '421 application and a direct division of the '042 application, without any intermediate reference to the '273 application or the '209 application. Google Ex. 1028, p. 510.

35. The '146 application identifies the '406 application as a division of the '332 application in the two chains of benefit claims leading back to the '947 provisional application. Google Ex. 1013, pp. 059 and 061. The '406 application, however, is identified in the '406 application itself as a direct division of the '421 application and a direct division of the '042 application, without any intermediate reference to the '332 application, the '273 application, or the '209 application. Google Ex. 1030, p. 551.

C. Search Conducted for the '146 Application

36. The file history of the '146 application indicates that the examiner conducted a classification search and a keyword (automated) search on July 10, 2017, using the Examiner's Automated Search Tool ("EAST").

37. The file history of the '146 application indicates that the examiner conducted a classification search of U.S. Patent Classification ("USPC") class 455 (Telecommunications), subclass 41.2 (Short range RF communication), and of several subgroups of Cooperative Patent Classification ("CPC") subclass H04W (Wireless Communication Networks). Google Ex. 1013, p. 040.

38. The file history of the '146 application also indicates that the examiner conducted a keyword search in EAST of the U.S. Patent ("USPAT") and U.S. Patent Application Publication ("PGPUB") databases. Google Ex. 1013, pp. 036-038. The EAST Search History Printout in the file history of the '146 application indicates: (1) eight searches (L1 and S16-S22) involving a forward citation search of U.S. patents and U.S. patent application publications; (2) thirteen searches (L2, L5-L6, L9, and S1-S9) each including the terms "beacon" and "encoding" (four of these searches included the inventor's last name (L6, L9 and S8-S9)); (3) one search (S10) limiting an earlier search (S1) to USPS class 455, subclass 41.2; and (4) five searches (S11-S15) limiting that earlier search (S1) to subgroups of CPC subclass H04W.

39. The forward citation search of U.S. Patent No. 6,028,537 (L1) returned 723 hits. The remaining forward citation search of U.S. patents and U.S. patent application publications returned 18 or fewer hits.

40. Nine of the searches including the term “beacon” and “encoding” (L2, L5-L6, L9, S4, S6-S9) returned no hits. The remaining searches including the term “beacon” returned 18 or fewer hits.

41. The search (S1) that was subsequently limited to USPS class 455, subclass 41.2, and subgroups of CPC subclass H04W, itself returned 18 hits. Limiting that search (S1) to USPS class 455, subclass 41.2, returned no hits, and limiting that search (S1) to subgroups of CPC subclass H04W, returned 11 or fewer hits.

D. Allowance and Issue of the '146 Application

42. The USPTO issued a Notice of Allowance and Notice of Allowability on July 11, 2017. Google Ex. 1013, pp. 020-029. The examiner indicated in the Notice of Allowability that “[t]he present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.” Google Ex. 1013, p. 025. The examiner provided the following as the reasons for allowance of claims 12 through 21:

Consider **claim 12**, the best prior art of record found during the examination of the present application, **Suman et al. (US 6,028,537 herein Suman)**, fails to specifically teach, suggest, or disclose a method of utilizing a Bluetooth transceiver for conveying desired information, the method comprising steps of:

employing the Bluetooth transceiver integrated within a vehicle, the Bluetooth transceiver configured to transmit a Bluetooth

signal detectable by a Bluetooth circuit of a mobile device located within a communication range of the respective Bluetooth transceiver; registering an exact parking space location of the vehicle on the mobile device using information provided by the Bluetooth transceiver; and

subsequently using the mobile device to provide navigation to the parking space location where the vehicle is parked.

Suman teaches a vehicle communication and control system that includes a transceiver for sending and receiving RF signals, a processor coupled to the transceiver, a location identifying sensor coupled to the processor for supplying vehicle location data, a user interface coupled to the processor for providing information to a user and for enabling a user input commands to be executed by the processor, and a vehicle accessory interface for coupling the processor to a vehicle accessory control circuit to enable the processor to issue commands to a vehicle accessory. Some of the functions include establishing a two-way communication link, requesting and providing location-specific information, enabling remote tracking of the vehicle, issuing an emergency request or a request for roadside assistance, requesting and receiving navigational information, remote control of vehicle functions, enabling remote diagnostics of the vehicle, and enabling reprogramming of various vehicle accessories and components (Abstract). These teachings of Suman differ and fall short of the present application, therefore claim 12 is considered novel and non-obvious over the prior art and therefore is allowed.

Claims 13-21 depend upon allowable claim 12, therefore these claims are also allowed.

Google Ex. 1013, pp. 026-027.

43. The '146 application issued on September 26, 2017 as the '193 patent.

Claims 12, 13, and 15-18 of the '193 patent read as follows:

12. A method of utilizing a Bluetooth transceiver for conveying desired information, the method comprising steps of:

employing the Bluetooth transceiver integrated within a vehicle, the Bluetooth transceiver configured to transmit a Bluetooth signal detectable by a Bluetooth circuit of a mobile device located within a communication range of the respective Bluetooth transceiver;

registering an exact parking space location of the vehicle on the mobile device using information provided by the Bluetooth transceiver; and

subsequently using the mobile device to provide navigation to the parking space location where the vehicle is parked.

13. The method as recited in claim 12, further comprising a step of:

displaying on a display of the mobile device, a map between a current location of the mobile device and the exact parking space location of the vehicle.

15. The method as recited in claim 12, further comprising a step of:

employing a Global Positioning System (GPS) to register the location of the exact parking space location of the vehicle.

16. The method as recited in claim 12, further comprising steps of:

employing a Global Positioning System (GPS) to register a location of the vehicle; and

subsequently using the registered location of the vehicle to provide navigation to the parking space location where the vehicle is parked.

17. The method as recited in claim 12, further comprising steps of:

employing a Global Positioning System (GPS) to register a location of the vehicle; and

displaying on a display of the mobile device, a map between a current location of the mobile device and the registered location of the vehicle.

18. The method as recited in claim 12, further comprising steps of:

employing a Global Positioning System (GPS) to register a location of the vehicle;

displaying on a display of the mobile device, a map between a current location of the mobile device and the registered location of the vehicle; and

providing navigation from the current location of the mobile device and the registered location of the vehicle.

Google Ex. 1001, pp. 53-54.

VI. THE '146 APPLICATION WAS NOT EXAMINED TO DETERMINE THE ENTITLEMENT OF ITS CLAIMS TO THE BENEFIT OF THE PRIOR APPLICATIONS

44. The '146 application and all intermediate nonprovisional applications in the three chains of benefit claims leading back to the '843 application and '864 application are indicated as a “division” of the preceding application. As discussed previously, while a divisional (or continuation) application is not required to be a photocopy of the preceding application, the application may not include any subject matter that would be “new matter” in the preceding application.

A. Applicant's Representations to the USPTO in These Benefit Claims

45. The statement that each of the '146 application and intermediate nonprovisional applications leading back to the '843 application and '864 application are a “division” of the preceding application is a representation¹² to the

¹² The representation that each of the '146 application and intermediate nonprovisional applications leading back to the '843 application and '864 application are a “division” of the preceding application is subject to the certification requirement of 37 C.F.R. § 11.18 (as are all representations contained in a patent application, or other papers submitted to the USPTO). This certification under 37 C.F.R. § 11.18 includes the requirement that the legal contentions are warranted and the factual contentions have evidentiary support (unless so identified), and are formed “after an inquiry reasonable under the circumstances.” *See* 37 C.F.R. § 11.18(b)(2). The “inquiry reasonable under the circumstances” requirement includes an obligation to conduct an appropriate investigation into the facts that is objectively reasonable under the circumstances, and permits neither contentions having no factual basis or justification nor persistence in positions that are no longer tenable. *See* MPEP § 410. These requirements apply both during *ex*

USPTO and the examiner that each of these nonprovisional applications contain no material that would constitute “new matter” relative to each preceding nonprovisional application.¹³

46. The ’146 application and the intermediate nonprovisional applications leading back to the ’843 application and ’864 application are each identified as a “division” of the preceding application. This requires that the ’146 application not contain any new matter relative to the ’843 application, because each application in the chain from ’146 application back to the ’843 application is identified as a “division” of the preceding application. It also requires that the ’146 application not contain any new matter relative to the ’864 application, since each application in both chains from the ’146 application back to the ’864 application is identified

parte examination as well as during *inter partes* review proceedings. *See* 37 C.F.R. § 42.11(c).

¹³ The statement that each of the ’146 application and intermediate nonprovisional applications leading back to the ’843 application and ’864 application are a “division” of the preceding application is also a representation each of these applications is for one or more independent or distinct inventions carved out of the preceding application. *See* MPEP § 201.06.

as a “division” of the preceding application. That is, applicant’s representation of the relationship of the ’146 application in the three chains of benefit claims leading back to the ’843 application and ’864 application (*i.e.*, that the ’146 application and every one of the intermediate nonprovisional applications is a “division”) is a representation that the ’146 application does not contain any new matter relative to the ’843 application and also does not contain any new matter relative to the ’864 application.

B. Reasons for Questioning the Benefit Claims as Stated by Applicant

1. Differences between the written description of the ’146 application and the ’864 application and ’843 application

47. A cursory comparison of the written descriptions of the ’146 application (117 pages), ’864 application (38 pages), and ’843 applications (33 pages) show a significant difference in the number of pages of description. Google Ex. 1013, pp. 104-220; Google Ex. 1022, pp. 450-487; Google Ex. 1021, pp. 282-314. For the changes in phraseology permitted between a divisional (or continuation) application and its preceding application to result in this amount of disparity in pages of written description would be nothing short of remarkable. It would certainly warrant a comparison of the claims of the ’146 application to the disclosures of the applications for which it claims benefit to ensure that the claims of the ’146 application were being accorded the appropriate effective filing date.

2. *Conflicting characterization of the relationship between the '735 application and the '843 application*

48. In addition, the applicant has presented conflicting characterization of the relationship between the '735 application and the '843 application. The '146 application states that the '735 application is a divisional of the '843 application. The '735 application, however, states that the '735 application is a continuation-in-part of the '843 application. Google Ex. 1031, pp. 129 and 151. As discussed previously, an application may not be both a divisional and continuation-in-part of the preceding application. This conflicting characterization of the relationship between the '735 application and the '843 application is itself a basis to call into question the characterization of the '735 application as a divisional of the '843 application, and to ensure that the claims of the '146 application were being accorded the appropriate effective filing date.

3. *Inconsistencies between the claims and the written description of the '146 application*

49. The declaration of Dr. Thomas La Porta (La Porta declaration) indicates that the written description of the '193 patent and '583 patent ('146 application and '843 application) do not describe using the Global Positioning System ("GPS") to provide (register) the location of the exact parking space location of the vehicle, but rather disparages the use of GPS for this function due to accuracy and line of sight limitations of GPS. La Porta declaration, ¶¶ 42-68,

Google Ex. 1006, pp. 022-036. The La Porta declaration cites a number of instances in which the written description of the '193 patent and '583 patent identifies the limitations of GPS and does not require the use of GPS. La Porta declaration, ¶¶ 50-56, and 60, Google Ex. 1006, pp. 026-031, 033-034. The La Porta declaration also explains that the written description of the '193 patent and '583 patent discloses an invention in which RF sensors (Bluetooth or RFID devices, or devices using Wi-Fi or other RF technology) are used in place of GPS to provide the location of the exact parking space location of the vehicle. La Porta declaration, ¶¶ 61-65, Google Ex. 1006, pp. 034-036. Regardless of whether Dr. La Porta's opinion of what those skilled in the art would understand the '193 patent and '583 patent specification to disclose is correct, the passages of the written description of the '193 patent and '583 patent cited are themselves a basis to look into whether the claims of the '146 application are actually entitled to the benefit of the prior application for which benefit is being claimed.

4. *Failure of the '146 application to identify a prior intermediate application*

50. As discussed previously, the ADS in the '146 application seeks to claim the benefit of the '843 application and '864 application through the '028 application, but does not make a specific reference to the '439 application whose benefit is claimed in the '028 application. That is, the ADS in the '146 application

states that the '028 application is a division of the '406 application; however, the '028 application claims the benefit of the '406 application through the '439 application. Google Ex. 1020, p. 111. The MPEP provides that where an application claims the benefit of a first-filed application through a series or chain of prior applications, the reference to the prior applications must identify **all** of the prior applications and indicate the relationship (*i.e.*, continuation, divisional, or continuation-in-part) between each nonprovisional application in order to establish copendency throughout the entire chain of prior applications, and that appropriate references must be made in each intermediate application in the chain of prior application. *See* MPEP § 211.01(b)(II). The failure to include a specific reference to the '439 application terminates the benefit claim of the '146 application at the '028 application, and should have been treated as limiting the claims of the '146 application to an earliest possible effective filing (priority) date of March 30, 2016 (the filing date of the '028 application).

5. *Failure of the '273 application, '332 application, and '406 application to identify all prior intermediate applications*

51. As discussed previously, the '146 application identifies the '273 application, '332 application, and '406 application in the two chains of benefit claims leading back to the '947 provisional application as follows: (1) the '273 application as a division of the '209 application; (2) the '332 application as a

division of the '273 application; and (3) the '406 application as a division of the '332 application. Google Ex. 1013, pp. 059 and 061.

52. The '273 application, '332 application, and '406 application, however, contain benefit claims that fail to identify the prior intermediate applications identified in the benefit claims of the '146 application. The '273 application identifies itself as a direct division of both the '421 and the '042 application, without any intermediate reference to the '209 application. Google Ex. 1029, p. 423. The '332 application identifies itself as a direct division of both the '421 application and the '042 application, without any intermediate reference to the '273 application or the '209 application. Google Ex. 1028, p. 510. The '406 application identifies itself as a direct division of both the '421 application and the '042 application, without any intermediate reference to the '332 application, the '273 application, or the '209 application. Google Ex. 1030, p. 551.

53. As previously discussed, the MPEP provides that where an application claims the benefit of a first-filed application through a series or chain of prior applications, appropriate references must be made in *each* intermediate application in the chain of prior application. *See* MPEP § 211.01(b)(II). The failure to include a specific reference to the '332 application, the '273 application, or the '209

application in the '406 application terminates the two chains of benefit claims in the '146 application to the '947 provisional application at the '406 application.

C. Relevance of the Questionable Benefit Claims to the Examination Process

54. As discussed previously, I was involved in implementing and training examiners on the first inventor to file provisions of the AIA and the eighteen-month publication provisions of the AIPA (among other subjects). The USPTO places considerable reliance upon an applicant's proper categorization of continuing applications as "continuation," "divisional," or "continuation-in-part" applications, both during the examination of the continuing application at issue, as well as when using patent documents (patents and patent application publications) resulting from continuing applications during the examination of other applications. Identifying an application containing new matter vis-à-vis the prior application as a "division" rather than "continuation-in-part" impacts not only the examination of that application but the patent examination process as a whole.

55. The reliability of the applicant's statement of the relationship of applications (all divisions) in the '146 application and the intermediate nonprovisional applications in the three chains leading from the '146 application back to each of the '843 application and the '864 application, as well as the failure to include a specific reference to the '439 application, was critical to the

examination of the '146 application. The publication (as a patent or patent application publication) of any prior application to which the '146 application claims benefit is prior art under 35 U.S.C. § 102(b) to any claim in the '146 application, unless that claim has support in a prior application filed no later than one year from the date of publication of the patent or patent application publication.¹⁴ As previously discussed, examiners are instructed that a disclosure may be sufficient to anticipate or render obvious a claim, but yet insufficient to support that claim under 35 U.S.C. § 112(a) (*e.g.*, the disclosure of a species may not support a genus, but does anticipate the genus; a disparaging disclosure is still a disclosure for purposes of anticipation or obviousness).

¹⁴ This result is the same whether the '146 application is an AIA application or pre-AIA application. As to AIA applications, the publication of a prior application to which it claims benefit (as a patent or patent application publication) is prior art under 35 U.S.C. § 102(a)(1), and may not be disqualified under 35 U.S.C. § 102(b), with respect to any claim in the application, unless that claim has support in a prior application filed no later than one year from the date of publication of the patent or patent application publication.

VII. THE SEARCH FOR THE '146 APPLICATION WAS INADEQUATE

56. As discussed previously, the MPEP instructs examiners to consider the breadth of the claims when developing a search, being aware of what the claims require as well as what the claims do not require.

57. While “global positioning system” or “GPS” is not expressly mentioned in independent claim 12, each of dependent claims 15 through 18 further limit the registering an exact parking space location of the vehicle limitation of claim 12 to employing GPS to register a location of the vehicle. Thus, dependent claims 15 through 18 make clear that registering an exact parking space location of the vehicle limitation of claim 12 could and would include employing GPS to determine the location of the vehicle. *See* 35 U.S.C. § 112(d). The MPEP instructs examiners that when a claim covers alternatives, either generically or expressly, the claim is met by any one of the alternatives. *See* MPEP § 2131. Properly considering the scope of claims 12 through 21 in developing a search for the '146 application would require considering using GPS to register a location of the vehicle.

A. Unduly Narrow Keyword Search Queries

58. The examiner’s keyword searching was almost exclusively limited to:
(1) searches for U.S. patents and patent application publications that had themselves cited one or more of eight other U.S. patents and patent application

publications (*i.e.*, a “forward citation” query); and (2) searches for U.S. patents and patent application publications that contained the term “beacon” (in combination with other terms).

59. A forward citation search can be useful; *e.g.*, when an examiner is aware of an earlier pertinent U.S. patent, a forward citation search of that earlier patent might retrieve later U.S. patents citing the earlier U.S. patent that could also be pertinent. A forward citation search, however, is a supplement to a complete search and is not a substitute for a complete search.¹⁵

60. The examiner’s text queries do not consider the scope of claims 12 through 21, or show awareness of what these claims require and do not require. The terms “beacon” or “encoding” do not appear in claims 12 through 21 of the ’146 application; however, the terms “beacon” and “encoding” appear in each text query. The text queries also include other terms not appearing in claim 12, such as

¹⁵ Patent examiners are trained on forward and backward citation searches. Nonetheless, MPEP chapter 900 sets out the USPTO’s instructions on the USPTO’s search tools (MPEP § 902) and how to conduct a search (MPEP § 904), and does NOT describe forward citation searches as part of a complete search or have any discussion of forward citation searches.

“wireless,” “RF,” “decoding” and “broadcasting.” The text queries, however, do not include the term “global positioning system” or “GPS”: a term that appears in each of claims 15 through 18.

61. In addition, no text queries returned more than twenty hits. This should have alerted the examiner that the text queries were unduly narrow, even for a search of claims that actually contain or cover the terms in the text queries. Rather, six (6) of the examiner’s queries (S10-S15) were actually further limiting the results of a prior query (S1) that itself returned only 18 hits.

B. Limited Classification Search Conducted

62. The examiner’s classification search also does not consider the scope of claims 12 through 21, or show awareness of what these claims require and do not require.

63. The examiner searched a single USPC subclass: class 455, subclass 41.2: short range RF (radio frequency) communication under a telecommunications class. Claims 12 through 21 were not limited to RF communication. A complete USPC search for the claims of the ’146 application would have included search areas such as class 455, subclass 456 *et seq.* (location monitoring), and a search including location positioning via GPS would have included search areas such as class 342, subclass 356 *et seq.* (*e.g.*, subclass 357.02:

satellite radio beacon positioning system transmitting time-stamped messages; *e.g.*, GPS [Global Positioning System], *etc.*).

64. The examiner searched four (4) subgroups in CPC H04W (wireless communications): 4/008 (using short range communications, *e.g.*, NFC, RFID, or PAN), 4/021 (mobile application, services making use of user/terminal location, *e.g.*, OMA, SUPL, OMA MLP, or 3GPP LCS: based on location controlled areas (geofencing)), 48/10 (push to talk or push on call mobile applications), and 76/007 (connection management for emergency connection handling). Again, claims 12 through 21 were not limited to these types of location positioning or communications. A complete CPC search for the claims of the '146 application would have included subgroups within G01S *e.g.*, subgroup 19/01: satellite radio beacon positioning system transmitting time-stamped messages; *e.g.*, GPS [Global Positioning System], *etc.*).

65. The examiner characterized U.S. Patent No. 6,028,537 (Suman) as “the best prior art of record.” Google Ex. 1013, p. 026. Suman was classified in CPC G08G 1/123 and USPC class 340, subclasses 426 and 988, class 342, subclass 457, and class 455, subclass 422. Setting aside that the examiner was not considering the scope of claims 12 through 21 (what these claims require and do not require), the patent document considered to be the “best prior art of record”

(Suman) was found in no area in which the examiner conducted a classification search, which should have alerted the examiner that the classification search areas for the '146 application were unduly limited.

C. The Searches Conducted for the '146 Application Failed to Uncover Pertinent Prior Art

66. For the previously discussed reasons, the keyword and classification searches for the '146 application, as well as the reasons for allowance of claim 12, reveal that the examiner did not consider the full breadth of the claims in conducting the search for the '146 application: *i.e.*, did not consider that the registering an exact parking space location of the vehicle limitation of claim 12 could include using GPS to determine the location of the vehicle. Moreover, beyond not properly considering the breadth of the claims, the keyword and classification searches for what the invention was considered to be were overly restrictive. That is, the keyword searches were returning few hits, yet were restricted rather than expanded, and the classification search did not cover a patent document considered to be “the best prior art of record.”

67. As previously discussed, a complete USPC search for the claims of the '146 application would have included search areas such as class 455, subclass 456 *et seq.*, and a search including location positioning via GPS would have included search areas such as class 342, subclass 356 *et seq.* A search of USPC

class 455, subclass 456.6 or 457 would have uncovered Baese, a search of USPC class 342, subclass 357.75 or 357.76 would have uncovered Phillips, and a search of USPC class 342, subclass 357.42, 357.46, or 357.64 would have uncovered Soliman. As also previously discussed, a complete CPC search would have included subgroups within G01S *e.g.*, subgroup 19/01. A search of CPC G01S 19/ would have uncovered Phillips and Soliman. Google Exs. 1003, 1004, 1005.

VIII. IT IS UNCLEAR WHETHER THE '146 APPLICATION WAS EXAMINED AS AN AIA OR PRE-AIA APPLICATION

68. In addition to the concerns with the benefit claims and the search conducted for the '146 application, it is not clear whether the '146 application was considered a pre-AIA application or an AIA application during examination. As discussed previously, none of the '146 application or the other seven transition applications include a statement that the application contains, or ever contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013. The '406 application, '332 application, '273 application, and '209 application are each identified in the USPTO's Patent Center records as well as the examiner's Notice of Allowability as being a pre-AIA application. The '685 application, '727 application, and '028 application, however, are each identified in the USPTO's Patent Center records as well as the examiner's Notice of

Allowability as being an AIA application.¹⁶ The '146 application, '685 application, '727 application, and '028 application, however, are each identified in the USPTO's Patent Center records as well as the examiner's Notice of Allowability as being an AIA application.

69. The USPTO's Patent Center records as well as the examiner's Notice of Allowability for the '146 application indicate that it was examined as an AIA application, despite that the '146 application is a transition application and neither the '146 application nor any application to which it claims benefit include a statement that the application contains, or contained at any time, a claim to a claimed invention that has an effective filing date on or after March 16, 2013.

¹⁶ If the claims of the '146 application are limited to an earliest effective filing date of March 30, 2016 (the filing date of the '028 application) due to the failure to include a specific reference to the '439 application, the '193 patent ('146 application) is subject to the AIA's FITF provisions of 35 U.S.C. §§ 102 and 103. Setting the AIA indicator in PALM to "Yes" in the USPTO's Patent Center records for the '028 application would result in the AIA indicator for any application claiming benefit of the '028 application (such as the '146 application, '685 application, '727 application) also being set to "Yes."

Moreover, the file history and other USPTO's records for the '146 application this application do not indicate why this application was being treated as an AIA application (first inventor to file ("FITF") provisions of 35 U.S.C. §§ 102 and 103).

IX. CONCLUSION

70. For the reasons previously discussed, the file history of the '193 patent and its benefit applications reveal that the identification of each application in the benefit chains as a "division," and the acceptance of that identification without question, led to possible intervening prior art not being considered during the examination of the '146 application. In addition, for the reasons also previously discussed, the keyword and classification searches for the '146 application (as well as the reasons for allowance of claim 12) reveal that the examiner did not consider the full breadth of the claims in conducting the search for the '146 application: *i.e.*, did not consider that the registering an exact parking space location of the vehicle limitation of claim 12 could be met by employing GPS to register a location of the vehicle. This unduly narrow search resulted in the failure to uncover pertinent prior art, including Baese, Phillips, and Soliman. Finally, the USPTO's records (file history and Patent Center information) for the '193 patent contain inconsistent information concerning whether the '146 application was examined as an AIA application or a pre-AIA application.

71. I hereby declare that all the statements made herein of my own knowledge are true and are the whole truth, 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 Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the results of this proceeding.

72. I declare under penalty of perjury that the foregoing is true and correct.

Respectfully submitted,



April 3, 2026

Robert W. Bahr

EXHIBITS CITED

EX1001	U.S. Patent No. 9,420,193
EX1002	U.S. Patent No. 7,899,583
EX1003	Baese (US 2002/0082025)
EX1004	Phillips (US 2003/0055560)
EX1005	Soliman (U.S. Patent No. 6,081,229)
EX1006	Declaration of Thomas La Porta, Phd.
EX1013	File history of '193 patent.
EX1020	File History of U.S. Pat. No. 9,420,423
EX1021	File History of U.S. Pat. No. 7,899,583
EX1022	File History of U.S. Pat. No. 8,836,580
EX1028	File History of U.S. Pat. No. 9,491,583
EX1029	File History of U.S. Pat. No. 9,204,257
EX1030	File History of U.S. Pat. No. 9,602,193
EX1031	File History of U.S. Pat. No. 9,020,687

APPENDIX A

Robert W. Bahr
Partner

Maier & Maier
345 S. Patrick Street
Alexandria, VA 22314

Current Position: Partner, Maier & Maier. Specializes in all areas of patent practice, including includes post-issuance proceedings at the United States Patent Office (USPTO), advising attorneys and our clients on complex patent prosecution matters, patent litigation strategy, and USPTO patent policy, practice and procedure.

Prior USPTO Experience: I began my career at the U.S. Patent and Trademark Office (PTO) in 1984. The greater part of my career at the PTO was spent in the patent examination policy area, first beginning in 1994 as a Legal Advisor in the Office of Patent Legal Administration (OPLA), then as the Senior Patent Counsel to the Deputy Commissioner for Patent Examination Policy beginning in November 2000, and ultimately as Deputy Commissioner for Patent Examination Policy beginning in 2016.

March 2016 – August 2023: Deputy Commissioner for Patent Examination Policy (title change to Deputy Commissioner for Patents in October 2020)

As the Deputy Commissioner for Patent Examination Policy, I —

- Oversaw day-to-day operation of the Office of Patent Legal Administration (OPLA), the Office of Petitions, the Office of Patent Quality Assurance (OPQA), the Central Reexamination Unit (CRU), and the Manual of Patent Examining Procedure (MPEP) staff.
- Led the development/implementation of the—
 - 2019 Revised Patent Subject Matter Eligibility Guidance and the Deferred Subject Matter Eligibility Response (DSMER) program
 - 2019 guidance for Examining Computer-Implemented Functional Limitations for Compliance with 35 U.S.C. 112,
 - Patent examination aspects of the CARES (Coronavirus Aid, Relief, and Economic Security) Act,
 - Federal Circuit patent term adjustment decision in *Supernus v. Iancu*,
 - Revision of the sequence listing rules to implement WIPO Standard ST.26,
 - 2016 proposed rule to harmonize the PTO duty of disclosure standard with the Federal Circuit inequitable conduct standard adopted in *Therasense, Inc. v. Becton, Dickinson & Co.*, and
 - January 2018, June 2020, and February 2023 revisions of the MPEP.

- Issued memoranda on changes in patent law and procedure to the Patent Examining Corps.
- Gave numerous presentations on specialized subjects in patent law and procedure to patent examiners, the patent bar, and members of the public ranging from leading members of the patent bar to inexperienced inventors.

November 2009 – December 2011 and August 2015 – March 2016: Acting Deputy Commissioner for Patent Examination Policy

As the Acting Deputy Commissioner for Patent Examination Policy, I —

- Oversaw day-to-day operation of the organizations under the Deputy Commissioner for Patent Examination Policy.
- Led the development/implementation of the—
 - Federal Circuit patent term adjustment decision in *Wyeth v. Kappos*,
 - Supreme Court subject matter eligibility decision in *Bilski v. Kappos*,
 - 2011 examination guidelines for determining compliance with 35 U.S.C. 112,
 - 2011 proposed rule to harmonize the PTO duty of disclosure standard with the Federal Circuit inequitable conduct standard adopted in *Therasense, Inc. v. Becton, Dickinson & Co.*,
 - 2010 update to the 35 U.S.C. 103 examination guidelines to incorporate post-*KSR* case law developments, and
 - July 2010 revision of the MPEP.
- Issued memoranda on changes in patent law and procedure to the Patent Examining Corps.
- Gave presentations on specialized subjects in patent law and procedure to patent examiners, the patent bar, and members of the public.

November 2000 – November 2009 and January 2012 – August 2015: Senior Patent Counsel, Office of the Deputy Commissioner for Patent Examination Policy

As the Senior Patent Counsel to the Deputy Commissioner for Patent Examination Policy, I—

- Managed patent-related rulemakings and advised the Deputy Commissioner for Patent Examination Policy and Commissioner for Patents on patent-related procedure or policy decisions.
- Led the rulemaking effort to implement the patent examination provisions of the Leahy-Smith America Invents Act (AIA), Patent Law Treaties Implementation Act (PLTIA), the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act), and the Federal Circuit patent term adjustment decision in *Novartis v. Lee*.
- Developed and formulated new examining practices and procedures, and revised existing practices and procedures, prepared and reviewed official notices and memoranda to the Patent Corps as to PTO policy.

- Identified issues on which there is a need for a statement of policy, handled inquiries from the public requesting assistance in properly interpreting PTO practices, and reviewed decisions on petitions relating to matters before the Deputy Commissioner for Patent Examination Policy or Commissioner for Patents which require treatment of unusual issues involving patent policy and procedure.
- Represented the PTO in dealings with attorneys, industry representatives, and patent law associations in various matters, especially those concerning PTO practice and procedure.
- Acted as the Commissioner for Patents liaison with other organizations within the PTO on matters of patent law, regulations, procedures, and practices, and with members of the Patent Public Advisory Committee (PPAC), and foreign dignitaries during Trilateral meetings and other meetings with officials from foreign patent offices, such as the European Patent Office, the Korean Patent Office, and the Japan Patent Office.

July 2000 – November 2000: Administrative Patent Judge

In 2000, I was appointed as an administrative patent judge on the Board of Patent Appeals and Interferences (now Patent Trial and Appeal Board), but was detailed to the Commissioner for Patents until November 2000 to complete the rulemakings to implement the continued examination (RCE), patent term adjustment, and eighteen-month publication provisions of the American Inventors Protection Act of 1999 (AIPA).

April 1994 – July 2000: Legal Advisor, Office of Patent Legal Administration

As a Legal Advisor in the OPLA, I—

- Recommended and implemented revisions to the PTO's procedures concerning application filing dates and the revival of abandoned applications, including drafting proposed and final rules, other Federal Register notices, and MPEP provisions.
- Led the rulemaking effort to implement the continued examination, patent term adjustment, and eighteen-month publication provisions of the American Inventors Protection Act of 1999.
- Drafted rulemaking notices and documents pertaining to patent law and procedure for publication in the Federal Register or Official Gazette.
- Drafted decisions on petitions delegated to the Deputy Commissioner for Patent Examination Policy.
- Prepared and delivered training on specialized subjects in patent law and procedure to patent examiners and the PTO's technical support staff.
- Responded to inquiries concerning patent law and procedure and PTO policies through letters, phone calls, lectures, presentations, and other contacts with members of the public and the patent bar.

September 1984 – April 1994: Patent Examiner

I was an examiner in Examining Group 330 (now Technology Center 3700). I became a primary examiner in May 1990, and my primary docket was exercise and physical therapy equipment.

Awards:

- Department of Commerce Gold Medal in 2014 for implementation of the AIA.
- Department of Commerce Gold Medal in 2015 for implementation of the Federal Circuit decision in *Novartis*.
- Department of Commerce Bronze Medals in 1990 and 1997 for sustained superior performance.
- USPTO Award for Distinguished Achievement in 2001 for implementation of the AIPA.

Education:

Juris Doctor: George Washington University (May 1993).

Bachelor of Science in Mechanical Engineering: University of Maryland, College Park (December 1983).

Bar memberships:

Virginia bar (also admitted to the Supreme Court, Federal Circuit, and Fourth Circuit).

Registered to practice before the USPTO.

USPTO Memoranda (<https://www.uspto.gov/patents/laws/examination-policy/memoranda-examining-corps>):

Changes to Restriction Form Paragraphs (1-2010)

Revised Procedure for Appeal Brief Review (3-2010)

Revised Procedure for Appeal Brief Review of Ex Parte Reexamination Proceedings (5-2010)

Supreme Court Decision in Bilski v. Kappos (6-2010)

Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos (7-2010)

Streamlined Procedure for Appeal Brief Review and Examiner's Answers in Inter Partes Reexamination Proceedings (8-2010)

Supplementary Examination Guidelines for Determining Compliance with 35 U.S.C. § 112 and for Treatment of Related Issues in Patent Applications (2-2011)

Analogous Art for Obviousness Rejections (7-2011)

Requirement for a Disclosure of the Best Mode (9-2011)

Claims Directed to or Encompassing a Human Organism (9-2011)

Tax Strategies Are Deemed To Be Within the Prior Art (9-2011)

Recent Subject Matter Eligibility Decisions (Enfish, LLC v. Microsoft Corp. and TLI Communications LLC v. A.V. Automotive, LLC) (5-2016)

Recent Subject Matter Eligibility Rulings (Rapid Litigation Management v. CellzDirect and Sequenom v. Ariosa) (7-2016)

Recent Subject Matter Eligibility Decisions (11-2016)

Clarification of Written Description Guidance For Claims Drawn to Antibodies and Status of 2008 Training Materials (2-2018)

Recent Subject Matter Eligibility Decisions (4-2018)

Critical reference date under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent or U.S. published application claiming benefit of a prior U.S. provisional application during examination of an application (4-2018)

Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.) (4-2018)

Recent Subject Matter Eligibility Decision: Vanda Pharmaceuticals Inc. v. West-Ward Pharmaceuticals (7-2018)

Recent U.S. Supreme Court Decision (Helsinn Healthcare S. A. v. Teva Pharmaceuticals USA, Inc.) Concerning the Phrase “On Sale” in AIA 35 U.S.C. § 102(a)(1) (2-2019)

Amgen Inc. v. Sanofi (5-2023)

Publications:

Double Patenting, Recent Developments, and Practical Considerations, Japan Intellectual Property Association, Intellectual Property Management, Vol.75 No.8 pp.979-991 (8-2025).

The AIA Grace Period : Not Your Parents’s Grace Period (9-2024)
<https://maierandmaier.com/the-aia-grace-period-not-your-parents-grace-period/>

New Proposal Requirements for Terminal Disclaimers Filed to Overcome Non-Statutory double Patenting (5-2024)

<https://maierandmaier.com/new-proposal-requirements-for-terminal-disclaimers-filed-to-overcome-non-statutory-double-patenting/>

Federal Circuit rulings about patent term adjustment that patent prosecutors must know (3-2024) <https://www.iam-media.com/article/federal-circuit-rulings-about-patent-term-adjustment-patent-prosecutors-must-know>

A Perspective on USPTO Rulemaking Following In re Chestek (2-2024) <https://ipwatchdog.com/2024/02/27/perspective-uspto-rulemaking-following-re-chestek/id=173735/>

Expert Witness Engagements:

United States ex rel. Silbersher v. Janssen Biotech, Inc., Civil Action No. 19-12107-MEF-CLW (D.N.J.) (expert report, deposition).

FaceTec, Inc. v. Jumio Corp., Case No. 5:24-cv-3623-RFL (N.D. Cal.) (declaration).

OssiFi-Mab LLC v. Amgen, Inc., Civil Action No. 1:23-cv-10861-DJC (D. Mass.) (expert report, deposition).

Zest Labs, Inc. et al. v. Walmart Inc., Civil Action No. 4:18-cv-500-JM (E.D. Ark.) (expert report, deposition, testimony).

CareFirst of Maryland, Inc., et al. v. Johnson and Johnson, et al., Case No. 2:23-cv-00629-JKW-LRL (E.D. Va) (expert report, deposition).

In re Bhattacharyya, Patent Cooperation Treaty Application No. PCT/US2016/032408 (USPTO) (declaration).

Allergan, Inc. et al v. Amneal Pharmaceuticals of New York, LLC et al., Civil Action No. 2:23-cv-06208-NJC-ST (E.D.N.Y.) (expert report, deposition).

Impulse Downhole Solutions, LTP., et al. v. Downhole Well Solutions, LLC, Civil Action No. 4:23-cv-02954 (S.D. Tex.) (expert report, deposition).

SK Microworks America, Inc. v. Far Eastern New Century Corporation and Multi-Plastics, Inc., Case No.: 2:23-cv-10322-JAK-ADS (C.D. Cal.) (expert report, deposition).

Softex LLC v. Absolute Software Corporation and Absolute Software Inc., Case No. 2:22-cv-01308-DAE (W.D. Tex.) (expert report, deposition).

Taiwan Semiconductor Manufacturing Company, LTD. v. Marlin Semiconductor LTD., Inter Partes Review No. IPR2025-01082 (USPTO) (declaration).

Medtronic Inc. v. Moskowitz Family LLC., Inter Partes Review No. IPR2025-01598 (USPTO)
(declaration).