

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC
Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC
Patent Owner

Case No. IPR2020-00723
U.S. Patent No. 7,747,217

**PATENT OWNER'S RESPONSE TO PETITIONER'S SUPPLEMENTAL
PAPER REGARDING PARALLEL PETITIONS AND RANKING**

Despite the “Board’s experience [that] one petition should be sufficient to challenge the claims of a patent in most situations” (PTAB Consolidated Trial Practice Guide, Nov. 2019), Petitioner filed two Petitions challenging *the same* claims of U.S. Patent No. 7,747,217 (“’217 Patent”) based on *the same* two out of three references in each Petition. The Grounds presented in the two petitions are summarized as follows:

	IPR2020-00722	IPR2020-00723
<u>Ground 1</u> Claims: 1-3, 7-9, ¹ 11, 12, 16-18 and 20-22	<i>Millar, Keiser</i>	<i>Millar, Campbell</i>
<u>Ground 2</u> Claims 11, 12, and 16-18	<i>Millar, Keiser, Thonnart</i>	<i>Millar, Campbell, Thonnart</i>

Essentially, Petitioner substitutes *Keiser* in the -00722 Petition with *Campbell* in the -00723 Petition—the rest of the references in both grounds are the *same*.

Petitioner contends that “potential antedation presents an important and material distinction between the *Campbell* and *Millar* Petitions.” Petitioner uses *Thonnart* in an essentially identical way in both Petitions. Petitioner relies on

¹ Patent Owner disclaimed claims 7 and 8. *See* Ex. 2018.

Millar in both Petitions stating that *Millar* discloses some elements of the challenged claims and admits that *Millar* does not disclose other elements. *See e.g.* IPR2020-00722 Petition at 18 (“*Millar* does not expressly disclose determining the content of the other picture and sound television medium.”). The distinction between the Petitions would only be material if *Campbell* supplements *Millar* in ways that *Keiser* cannot. Yet, Petitioner fails to provide any such analysis, which indicates that in pertinent parts—the ones relevant to the claim elements not disclosed by *Millar*—*Campbell* is cumulative of *Keiser* and the -00723 *Campbell* Petition is cumulative of the -00722 *Millar* Petition. This is further exacerbated by the fact that during prosecution, the examiner relied on another *Campbell* reference, U.S. Patent No. U.S. Patent No. 4,536,791, with essentially the same disclosure as *Campbell*, to reject then-pending claims of the '217 Patent application.² But in response to applicant's persuasive arguments, the examiner put forth other rejections without relying on U.S. Patent No. U.S. Patent No. 4,536,791 to *Campbell* and mentioning *Campbell* only in a footnote in support of

² See the '217 Patent File History, Ex. 1002, 02/13/1997 Rejection at 5720-5730; 01/08/1998 Rejection at 5623-5633; 06/29/1998 Rejection at 5536-5545; 01/13/2001 Rejection at 5245-5262; and 09/04/2001 Rejection at 4805-4810.

an Official Notice without any substantive analysis.³ It is unnecessary to burden the Board with a reference that the examiner ultimately did not consider strong enough to reject the claims, and which is not even prior art to the challenged claims.

As set forth in the respective Preliminary Responses, the Board should not institute either of the two Petitions because of (1) the imminent trial in a parallel district court litigation; (2) a substantial overlap with the issues considered by the Office previously; and (3) substantive deficiencies in the Petitions and cited references.

The similarities between the two Petitions also indicate a likely waste of the Office resources and weigh against institution. Not only is there substantial similarity between the imminent trial and issues previously considered by the Office during prosecution and appeal, but the *substantive* deficiencies of the *Millar-Keiser* and *Millar-Campbell* combinations substantially overlap. As discussed in the Preliminary Responses, at this stage, Patent Owner identified the following claim elements missing from both the *Millar-Keiser* and *Millar-Campbell* combinations for similar reasons:

- 1[e] “. . . a medium comprising an identifier . . .”

³ See the '217 Patent File History, Ex. 1002, 02/28/2004 Rejection at 3279-3545.

- 1[e] “coordinating . . . based on said step of determining content”
- 11[b] “each signal of said subset of said plurality of signals including an identifier”
- 11[f] “identify content of said second medium”
- 11[g] “generate information based on said second medium based on identifying said content of said second medium”
- 16[c] “each signal of said plurality of signals including an identifier”
- 16[f] identifying content of said second medium”
- 16[g] ““processing, based on said content of said second medium, said second medium to generate information based on said second medium”
- 20[c] “each of said plurality of signals including an identifier”
- 20[e] “processing a control signal at said receiver station that causes execution of processor instructions to process data received in a second medium”
- 20[e] “. . . to create a series of discrete video images”⁴

⁴ Patent Owner reserves the right to identify further claim element missing from the asserted reference combinations.

Such a substantial overlap weighs strongly against instituting both Petitions.

To the extent the Board is inclined to institute one of the Petitions, Petitioner submits that it should be the -00722 *Millar* Petition. Patent Owner has presented evidence of earlier conception (including the feature-by-feature analysis) of the subject matter covered by challenged independent claims 1, 11, 16, and 20 and diligence in constructively reducing the invention to practice. If the Board accepts earlier conception and reduction to practice, at least Ground 1 of the -00722 *Millar* Petition will be considered on the merits, but neither Ground of the -00723 *Campbell* Petition will be considered on the merits because *Campbell* is not prior art.

In view of Petitioner's failure to explain any material difference between *Keiser* and *Campbell*, for the claim elements not disclosed by *Millar*, coupled with *Campbell*'s uncertain prior-art status, institution of the -00722 Petition guarantees the review of the '217 Patent claims on the merits, while the alternative does not.

Case No.: IPR2020-00723
Patent No: 7,747,217

Patent Owner's Response To
Supplemental Paper re Parallel Petitions

Respectfully submitted,

Date: June 25, 2020

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CERTIFICATE OF SERVICE

I hereby certify that on June 25, 2020, a true and correct copy of
Personalized Media Communications, LLC's above Response to Petitioner's
Supplemental Paper Regarding Parallel Petitions and Ranking was served via e-
mail upon Erika H. Arner, Daniel C. Cooley, Joshua L. Goldberg, Cory C. Bell,
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