

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC  
Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC  
Patent Owner

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

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**DECLARATION OF JOHN C. HARVEY  
IN SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE**

I, John C. Harvey, do hereby declare:

1. I am making this declaration in support of Patent Owner Personalized Media Communications, LLC's ("PMC") Preliminary Response in *Inter Partes* Review proceeding No. IPR2020-00723, in which Petitioner, Google LLC ("Google"), challenges the validity of certain claims of U.S. Patent No. 7,747,217 ("217 Patent"). The purpose of this declaration is to provide facts and documents sufficient to disqualify the following two references as prior art to the '217 Patent claims 1, 11, 16, and 20: (1) publication WO 81/02961 to Campbell et al. ("Campbell") and (2) U.S. Patent No. 4,413,281 to Thonnart ("Thonnart").

2. Included with this declaration are four documents.

a. Exhibit 2004 ("Grossman Memorandum"), is a true and correct copy of a handwritten memorandum that I prepared on June 23, 1981, and, on June 25, 1981, provided to Mark Grossman, my business associate and an investor in the assignee of the '217 Patent. For the Board's convenience, Ex. 2004 includes a typeset version of this handwritten document starting on page 6.

b. Exhibit 2005 ("Inventor's Notebook"), is a true and correct copy of my Inventor's Notebook where I recorded my and co-inventor James Cuddihy's ideas relating to the invention that was ultimately disclosed in Application Serial No. 06/317,510 filed on November 3,

1981 that issued as U.S. Pat. No. 4,694,490 (the “’490 Patent”). For the Board’s convenience, beginning at page 301, Ex. 2005 includes a typeset version of the title page and pages 1-23.

c. Exhibit 2006 (“Clott Letter”), is a true and correct copy of business correspondence dated June 29, 1981, from me to Nancy P. Clott, a Vice President and Media Director for Ted Bates & Co., Inc. Mr. Grossman and Mr. Thomas J. Scott Jr., along with others, are copied on the letter.

d. Exhibit 2007 (“1981 Calendar”) is a true and correct copy of my 1981 calendar with personal information redacted.

3. As reflected in my Inventor’s Notebook, I first conceived of the invention that formed the basis of PMC’s patent portfolio in April 1981. *See* Ex. 2005 at 3-21 (typeset at 304-322). Following the initial conception, James Cuddihy and I worked on improving different technical and business applications of the invention and preparing a patent application.

4. On June 23, 1981, I prepared the Grossman Memorandum. *See* Ex. 2004. On June 25, 1981, I provided the Grossman Memorandum to Mr. Grossman, who witnessed it on the same day. *See id.* at 5 (typeset at 10). In the Grossman Memorandum, I described a training system for doctors developed by Wicat Systems, Inc. (“WICAT”) of Tulsa, Oklahoma. I also described the

shortcomings of the WICAT system relative to our invention then in development. In the Grossman Memorandum, I further described the operation of my and James Cuddihy's invention in sufficient detail to support the "Wall Street Week" example of the '490 Patent, col. 19:30-20:10.

5. Collectively, my Inventor's Notebook and the Grossman Memorandum demonstrate the conception of a receiver for outputting multimedia presentations using locally-generated graphical overlays as the one described in the "Wall Street Week" example of the '490 Patent by June 23, 1981.

6. In the Clott Letter, I described the various business objectives of the invention that was later described and claimed in the '217 Patent, and other inventions that I was then developing. The Clott Letter also describes my efforts to develop commercial interest in our inventions. On page 3, paragraph 2, I stated that I expected to file a patent application in July 1981. *See* Ex. 2006 at 3.

7. In support of my and Mr. Cuddihy's efforts to obtain patent protection for our inventions, in April 1981, Mr. Cuddihy and I met with a patent attorney who was a longtime friend of mine from my college days, Thomas J. Scott Jr., at the Yale Club of New York City for the purpose of disclosing our invention to him and obtaining his view as to their patentability. Based on Mr. Scott's views as expressed at that meeting, he agreed to advise and help us with drafting and filing a patent application covering our inventions which I undertook to prepare.

8. As I was preparing the patent application, I had regular communication with Mr. Scott over the phone and sometimes in person. I made notes about some of those conversations in my 1981 Calendar. For example, Mr. Scott and I had phone conversation regarding the patent application at least on June 29, 1981, July 9, 1981, and July 14, 1981. Ex. 2007 at 59, 62, 63. We also had a meeting in New York on August 11, 1981 where we had a discussion related to the invention and Mr. Scott made notes related to it. The August 11, 1981 meeting with Mr. Scott is also reflected in the 1981 Calendar. Ex. 2007 at 71.

9. During the Summer 1981, I continued to work closely with Mr. Cuddihy on the invention and was in frequent contact with him, by phone and in person. I made notes about some of those meetings in my 1981 Calendar. For example, Mr. Cuddihy and I met at least on August 6, 1981 and September 4, 1981. Ex. 2007 at 70 and 78.

10. While working on the draft application, I continued to develop the invention. By August 24, 1981, for example, I made notes regarding my developments concerning privacy and encryption related to the invention. *See* Ex. 2005 at 22 (typeset at 323). I communicated the content of those notes to Mr. Scott shortly after making them in drafts of the application I sent to him for review and comment.

11. As we progressed closer to the filing, in October 1981, I sent Mr.

Scott further drafts of the application and he returned his comments and suggestions by mail.

12. Shortly after the exchanges made in these October 1981 mailings, I finalized the application and, on November 3, 1981, travelled to Washington DC. Ex. 2007 at 97. I met with Mr. Scott at his office in the Justice Department for one last review. Then I personally went to the Patent and Trademark Office satellite mail room in the Commerce Department Building on Constitution Avenue and filed the application.

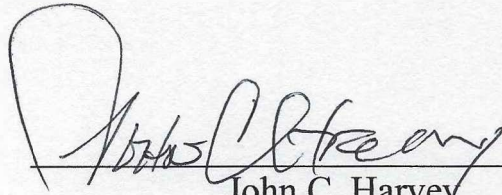
13. From June 23, 1981 until the November 3, 1981 filing date, I worked essentially every day not only on technical aspects of the invention and its business applications but was continually perfecting my application for filing with the Patent and Trademark Office. In this time period, I was in regular communication with Mr. Scott to obtain his views on the patent application as well as to update him on my progress on the technical aspects of our invention.

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Patent No: 7,747,217

Declaration of John C. Harvey

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 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.

Executed on June 24, 2020

  
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John C. Harvey