

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

**DECLARATION OF THOMAS J. SCOTT, JR.
IN SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE**

I, Thomas J. Scott, Jr., 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. Relevant to this declaration, I was counseling and assisting John C. Harvey and his co-inventor James W. Cuddihy in connection with preparing and filing patent application Serial No. 06/317,510, which was accorded the filing date of November 3, 1981 and issued as U.S. Pat. No. 4,694,490 (the "'490 Patent").

3. Ultimately, while the '217 Patent is a continuation-in-part of the '490 Patent, the Board confirmed that the '217 Patent claims find support in the '490 Patent specification:

We find that the 1981 ['490 Patent specification] and 1987 Specifications adequately describe in compliance with § 112 ¶ 1, the subject matter that is now claimed in claims 2-4, 7, 10, 13-15, and 17 [claim 2 issued as claim 1]. . . . The claims, when read in light of the CIP disclosure, are not broader than the original claims read in light of the original disclosure. Therefore, these

generic claims are entitled to the priority date of the 1981 Specification.

The '217 Appeal Decision, Ex. 1012 at 43-44.

4. Included with this declaration are four documents.
 - a. Exhibit 2009 (“Initial Disclosure Materials”), is a true and correct copy of the initial disclosure materials provided to me by Mr. Harvey shortly after a meeting in the Lounge of the Yale Club of New York City in April 1981 in which Mr. Harvey and Mr. Cuddihy disclosed their invention to me in confidence as developed to that point. My understanding is that Ex. 2009 is a partial copy of Mr. Harvey’s inventor’s notebook pages on which he had written up to that date. My understanding is that even after April 1981, Mr. Harvey continued making notes in his inventor’s notebook. I understand that a copy of Mr. Harvey’s inventor’s notebook is attached to his declaration as Ex. 2004.
 - b. Exhibit 2010 (“August Meeting Notes”) is a true and correct copy of the notes of a meeting in New York City at the Yale Club on August 11, 1981, in which I discussed the patentability of the Harvey-Cuddihy inventions and made very rough notes of possible claims to cover their inventions.
 - c. Exhibit 2011 (“October Mailing Receipts”), are true and correct

copies of United States Post Office receipts for Express Mail packages I sent to Mr. Harvey on October 6, 1981 and October 9, 1981, transmitting my comments on draft versions of the Harvey-Cuddihy patent application that was filed on November 3, 1981.

d. Exhibit 2012 contains true and correct copies of documents from my file related to preparing and filing of patent application Serial No. 06/317,510. The Initial Disclosure Materials, August Meeting Notes, and October Mailing Receipts (Exs. 2009, 2010, and 2011) are all part of this file.

5. Mr. Harvey and Mr. Cuddihy asked me to assist them in the drafting of their patent application beginning in April 1981. I received the Initial Disclosures (Ex. 2009) around that time.

6. I know of my own personal knowledge that, from April 1981 through the November 3, 1981 filing date, Mr. Harvey worked on the patent application, drafted the disclosure and claims, and prepared figures, communicating with me by mail and phone, and revising the draft until the application was filed.

7. My informal collection of materials I collected in helping Mr. Harvey file, Ex. 2012, contains numerous versions of the specification, figures, and claims drafts respecting Mr. Harvey's work on the application as it was progressing.

8. I am also aware that during this time, Mr. Harvey continued to

develop technical aspects and business applications of his invention. *See* Grossman Memorandum, Ex. 2004 (to Harvey Decl., Ex. 2003), a copy of which I received shortly after it was prepared; *see also* the Clott Letter, Ex. 2006 (to Harvey Decl., Ex. 2003), of which I was one of the recipients.

9. During the process of preparing the patent application, Mr. Harvey and I had regular phone and mail communication. In addition, on August 11, 1981 we had an in-person meeting. Shortly after the meeting I prepared the August Meeting Notes related to the invention. *See* Ex. 2010.

10. Mr. Harvey provided drafts of his application to me and I returned my comments to him by mail. On October 6, 1981 and October 9, 1981, I sent my comments on the application drafts to Mr. Harvey. *See* Ex. 2011.

11. Shortly after these mailings, the application was finalized, and Mr. Harvey filed it with the Patent and Trademark Office.

12. From my experience as a patent attorney with nearly 45 years of practice, four (4) months to draft a patent application is not unreasonable (counting early July through early November).

13. During this four-month period, Mr. Harvey and I were in regular contact, with Mr. Harvey supplying additional information, such as disclosure regarding privacy and encryption. Mr. Harvey was diligent in his effort to prepare and file a patent application and he had not abandoned his invention.

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 23, 2020

A handwritten signature in blue ink that reads "Thomas J. Scott Jr." in a cursive script.

Thomas J. Scott Jr.