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### UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS AMERICA, INC. Petitioner

v.

E-WATCH, INC. Patent Owner

Patent No. 7,365,871

PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,365,871

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# LIST OF EXHIBITS<sup>1</sup>

1001	U.S. Patent No. 7,365,871, as filed in IPR2015-00411
1002	WO 1999/035818, as filed in IPR2015-00411
1003	File History for Application Serial No. 09/006,073, as filed in IPR2015-00411
1004	File History for Application Serial No. 09/790,381, as filed in IPR2015-00411
1005	Declaration of Steven Sasson, as filed in IPR2015-00411
1006	Apple Inc. v. e-Watch, Inc., IPR2015-00411, Petition, Paper No. 2 (Dec. 11, 2014)
1007	HTC Corp. v. e-Watch, Inc., IPR2014-00987, Institution Decision, Paper No. 6 (Dec. 9, 2014)

<sup>&</sup>lt;sup>1</sup> Citations to non-patent publications are to the page numbers of the publication and citations to patent publications are to column:line or page:line numbers.

#### I. INTRODUCTION

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Petitioner") request *inter partes* review of claims 1-15 of U.S. Patent No. 7,365,871 ("the '871 patent") (Ex. 1001), which is assigned to e-Watch, Inc. ("e-Watch" or "Patent Owner"). On December 11, 2014, Apple Inc. ("Apple") filed an *inter partes* review challenging claims 1-15 of the '871 patent (IPR2015-00411) ("Apple IPR"). Ex. 1006. This Petition proposes the same ground of rejection proposed in the Apple IPR, and relies on the same analysis, evidence, and expert testimony. Therefore, Petitioner submits concurrently herewith a request for joinder with the Apple IPR. If joinder is not granted, Petitioner respectfully requests that a proceeding be instituted based on this petition alone.

This Petition shows, by a preponderance of the evidence, that there is a reasonable likelihood that Petitioner will prevail on claims 1-15 of the '871 patent based on prior art that the U.S. Patent and Trademark Office ("PTO") did not have before it or did not fully consider during prosecution, and that anticipates claims 1-15 of the '871 patent. In particular, during prosecution, the '871 patent was examined based on a priority date that was improper due to a defective claim for priority. Therefore, the PTO did not consider a corresponding PCT application that was published more than a year before the true priority date of the '871 patent. The PCT publication shares substantially the same disclosure as the '871 patent, and

anticipates all the claims (1-15) of the '871 patent under 35 U.S.C. § 102(b) either explicitly or inherently. Accordingly, all the claims of the '871 patent should be found unpatentable and canceled.

The '871 patent is allegedly related to a family of patent applications filed by Mr. David A. Monroe. The relevant portion of the family includes at least:

- U.S. Application No. 09/006,073 ("the '073 application" abandoned), filed January 12, 1998;
- PCT/US99/00664 (published in 1999 as WO1999/035818 ("the '818 publication")), claimed benefit of the '073 application;
- U.S. Application No. 09/790,381 ("the '381 application" abandoned), claimed priority as a divisional to the '073 application; and
- U.S. Application No. 10/336,470 ("the '470 application") issued as the '871 patent and improperly claimed priority as a divisional to the '073 application.

This is illustrated in Figure A below.



#### **FIGURE A**

The sole basis for the '871 patent priority claim to the '073 application is an improper petition for revival under 37 C.F.R. § 1.137(b) of the deliberately abandoned '073 application. The deliberate, *i.e.*, intentional abandonment, is shown through the public record of the '073, '381, and '470 applications for two reasons, and Petitioner is not aware of any evidence to the contrary.<sup>2</sup> *First*, it was not until 22 months after the '073 application abandonment and after a mistake was made by the prosecuting attorneys in the '381 child application, which caused them

<sup>2</sup> Mr. Robert Curfiss and Mr. Richard Ruble, attorneys of record for the '073 application, were deposed in a related litigation, but counsel for e-Watch has refused to consent to the use of the confidential deposition transcripts under seal in an *inter partes* review.

to lose its filing date and priority claim, that the abandonment of the '073 parent application suddenly become "unintentional." *Second*, there is absolutely *no* evidence that shows the prosecuting attorneys performed the required due diligence needed to claim unintentional abandonment of the '073 application in the § 1.137(b) petition – rather only evidence to the contrary exists.

The basic timeline of events in the prosecution is as follows:

- On February 21, 2001, the Patent Owner filed a three-month extension of time in the '073 application, but without a substantive reply to the final Office action of August 29, 2000.
- 2. On February 21, 2001, the Patent Owner also filed the '381 divisional application in lieu of continuing prosecution of the '073 application.
- 3. The Patent Owner was informed, based on a filing error, the '381 divisional application would receive a filing date of April 11, 2002, so that it no longer was co-pending with the '073 application and could not claim priority. The '381 application went abandoned for failure to file a response to the October 3, 2002 Office action.
- 4. On January 3, 2003, "coincidentally" the three-month due date for the Office action in the '381 application, the Patent Owner filed the § 1.137(b) petition to revive the '073 application *22 months* after it was abandoned so that the concurrently filed '470 application could claim

priority to the '073 application the Patent Owner claimed was "unintentionally" abandoned.

Based on these facts, the abandonment of the '073 application should have been ruled *intentional* by the USPTO, and the '073 application should have remained abandoned. If abandoned, the '073 application and '470 application could never be co-pending, such that the '470 application could not have properly claimed priority to the '073 application. As such, the '871 patent is not entitled to the 1998 effective filing date of the '073 application and, if anything, can claim no more than its date of filing, *i.e.*, January 3, 2003.

Finally, as shown in Figure A above and most important to the invalidity of the '871 patent claims, the '664 PCT application was filed claiming priority back to the '073 Application. The '664 PCT application published in 1999 as WO1999/035818 ("the '818 publication"). The '818 publication has a substantially *identical* specification as the '871 patent, *i.e.*, it includes all the limitations of the claims 1-15. Because the '818 application was published more than one year prior (*i.e.*, 1999) to the earliest effective filing date of the '871 patent (*i.e.*, 2003), and disclosed all the claimed subject matter of the '871 patent, all the claims of the '871 patent are invalid under 35 U.S.C. § 102(b) either explicitly or inherently.

Petitioner respectfully submits that the Board has the authority to evaluate evidence and render decisions on factual and legal issues involving priority claims

and the status of a reference as prior art in instituting the instant Petition. *See, e.g.*, IPR2014-00439, Paper No. 16 (Aug. 4, 2014), pp. 5-8 (where the Board rendered a decision on the insufficiency of an inventor affidavit as to diligence in reduction to practice during prosecution (which impacted the alleged invention date) and made an associated determination as to the availability of a reference as prior art).

#### II. GROUNDS FOR STANDING PURSUANT TO 37 C.F.R. § 42.104

Petitioner certifies that the '871 patent is available for *inter partes* review and that Petitioner is not barred or estopped from requesting *inter partes* review challenging the patent claims on the grounds identified herein.

#### III. OVERVIEW OF THE '871 PATENT

The '871 patent contains approximately 14 columns of specification in which figures 1-9 are described and in which various embodiments are described that provide:

"an image capture, compression and transmission system that is specifically designed to permit reliable visual image transmission over land line or wireless communications using commercially available facsimile transmission techniques. *Embodiments incorporate a camera and signal converter into an integrated unit* wherein the converted signal may be transmitted on a real time basis or may be stored in memory for later recall and transmission." Ex. 1001, 1:25-

32.<sup>3</sup>

As issued, the '871 patent has 15 claims.

## IV. IDENTIFICATION OF CHALLENGE PURSUANT TO 37 C.F.R. § 42.104

## A. 37 C.F.R. § 42.104(b)(1): Claims for Which *Inter Partes* Review Is Requested

Inter partes review is requested for claims 1-15 of the '871 patent.

## B. 37 C.F.R. § 42.104(b)(2): The Prior Art and Specific Grounds on Which the Challenge to the Claims Is Based

Inter partes review is requested in view of the following prior art reference:

• WO 1999/035818 (Ex. 1002, "the '818 publication").

The specific statutory ground on which the challenge to the claims is based and the reference relied upon for the ground is as follows:

• Claims 1-15 are anticipated under 35 U.S.C. § 102(b) by the '818 publication.

# C. 37 C.F.R. § 42.104(b)(3): Claim Construction

Pursuant to 37 C.F.R. § 41.100(b), solely for the purposes of this review,

Petitioner construes the claim language such that the claims are given their broadest reasonable interpretation in light of the disclosure of the '871 patent. Petitioner submits that, for the purposes of this review, each claim should be construed in accordance with its plain and ordinary meaning under the required

<sup>&</sup>lt;sup>3</sup> In this Petition, all emphasis is added unless otherwise indicated.

broadest reasonable interpretation, which for the avoidance of doubt for one term is presented below. Because the standard for claim construction at the Patent Office is different than that used during a litigation in a United States District Court (*See also, In re Am. Acad. Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 1369 (Fed. Cir. 2004); MPEP § 2111) Petitioner expressly reserves the right to assert a different claim construction in litigation for any term of the '871 patent as appropriate in any such proceeding.<sup>4</sup>

*Framing an image*: This term appears in the claims in different variations: "an image framed by the camera" (claim 1); "framing the [an] image to be captured" (claims 2, 9, 12); "visually framing a visual image to be captured" (claim 6); "framing the visual image" (claim 7). In IPR2015-00411, Apple proposed that the broadest reasonable interpretation of these phrases is "obtaining data representing an image as shown on a display." Ex. 1006 at 8. The Board, however, has already construed these phrases in IPR2014-00987. Ex. 1007 at 6-7. Specifically, the Board interpreted "image framed by the camera" as "an image having boundaries established by the camera," and all other "framing" terms as "establishing the boundaries of the image to be captured." *Id*.

As explained by the Board in IPR2014-00987, "[t]he term 'frame' is used in the Specification, but it is used as a noun, not as a verb, and only in an image-

<sup>&</sup>lt;sup>4</sup> Petitioner reserves all other arguments, such as § 112 arguments, for litigation.

processing context," and "[t]he terms 'framed' and 'framing' are not used in the Specification." *Id.* at 6. But, "[a]s used in the claims, 'framed' and 'framing' appear to refer to composing an image by positioning the subject of the image within the boundaries of the camera's field of view." *Id.* 

For purposes of this proceeding, Petitioner proposes that the broadest reasonable interpretation of "image framed by the camera" is "an image having boundaries established by the camera," and of all other "framing" terms is "establishing the boundaries of the image to be captured," as adopted by the Board in IPR2014-00987. *See id.* at 6-7. Petitioner notes, however, that the prior art analysis provided by Apple meets both Apple's interpretation and the Board's interpretation.

# D. 37 C.F.R. § 42.104(b)(4): How the Construed Claims Are Unpatentable

A detailed explanation of how claims 1-15 are unpatentable, including the identification of how each claim element is found in the prior art, is set forth below in Section V.

#### E. 37 C.F.R. § 42.104(b)(5): Supporting Evidence

A list of exhibits is provided at the beginning of this petition. Included at Ex. 1005 is a Declaration of Steven Sasson ("Sasson Decl."), an expert with over 35 years of experience in this technology space, under 37 C.F.R. § 1.68, further supporting the petition. In addition, the relevance of the evidence to the challenged

claims, including an identification of the specific portions of the evidence supporting the challenge, is included in Section V.

### V. THERE IS A REASONABLE LIKELIHOOD THAT AT LEAST ONE CLAIM OF THE '871 PATENT IS UNPATENTABLE

### A. Claims 1-15 Are Anticipated by WO 1999/035818

Claims 1-15 are anticipated, either explicitly or inherently, under 35 U.S.C. § 102(b) by the disclosure of the '818 publication. *See*, Ex. 1002. The '818 publication was published on July 15, 1999 -- more than one year prior to the earliest effective filing date for the '871 patent, January 3, 2003. The '818 publication also has substantially the same disclosure as the '871 patent. Ex. 1005, Sasson Decl., ¶ 19. The '818 publication anticipates all the claims (1-15) of the '871 patent under 35 U.S.C. § 102(b) either explicitly or inherently.

# 1. The Effective Filing Date for the '871 Patent Is January 3, 2003

The earliest effective date for the '871 patent is January 3, 2003,<sup>5</sup> because the claim for priority in the '470 application (which matured into the '871 patent), back to the filing date of the '073 application (January 12, 1998), is defective. The basis for the priority claim in the '470 application is *co-pendency* with the '073

<sup>&</sup>lt;sup>5</sup> The '470 application was filed January 3, 2003.

application.<sup>6</sup> However, because the '073 application was *purposefully* abandoned on March 1, 2001 -- twenty-two (22) months prior to the January 3, 2003 filing date for the '470 application -- the '073 application should not and could not have been revived as "unintentionally" abandoned to provide co-pendency with the '470 application. Since there was no proper basis for co-pendency between the '073 and '470 applications, the '470 application is not entitled to the benefit of the January 12, 1998 priority date of the '073 application. The legally correct effective date for the '470 application is January 3, 2003.

#### 2. '073 Prosecution History

The prosecution history of the '073 application begins with its initial filing on January 12, 1998. The initial application contained 266 claims. Ex. 1003, p. EW 005 ("Patent Application Transmittal Letter"). On December 7, 1999, the PTO mailed an office action requiring a restriction to one of nine groups of claims. *Id.*, p. EW 299-302. The Applicant elected Group I (claims 1-28, 181 and 190). *Id.*, p. EW 304. Those claims were rejected. *Id.*, pp. EW 307-317. After an amendment in

<sup>6</sup> Under 35 U.S.C. § 120, "An application for patent for an invention disclosed . . . in an application previously filed in the United States . . . shall have the same effect . . . as though filed on the date of the prior application, if filed before the patenting or abandonment of . . . the first application . . . ." This temporal overlap of two applications pending before the PTO is referred to herein as co-pendency.

which claims 5-8, 181, and 190 were canceled (*Id.* at EW 524-527), all of the then pending claims were subject to a final office action mailed August 29, 2000. *Id.*, p. EW 529-530.

From August 29, 2000, the six (6) month statutory period for response to the final office action would have ended Wednesday, February 28, 2001.<sup>7</sup> On February 21, 2001 -- one week prior to running of the statutory bar -- the applicant filed a three month extension of time ("EOT"). Ex. 1003, p. EW 593. That EOT *was not* accompanied by any amendment or other substantive response. On April 10, 2001, the PTO mailed a notice of abandonment ("NOA") of the '073 application to the Applicant. *Id.*, p. EW 595. The NOA recited the fact that the Applicant failed "to timely file a proper reply to the Office letter mailed on 29 August 2000." *Id*.

On the same day that the EOT in the '073 application was filed -- February 21, 2001 -- a separate application with serial number 09/790,381 ("the '381 application") was filed at the PTO. Ex. 1004 at 6-37 ("Utility Patent Application Transmittal," *see*, barcoded date stamp). This application claimed priority as a divisional of the '073 application. *Id*. This application included 42 claims, which were an exact copy of the unelected Group III claims of the '073 application. *Id*.

<sup>7</sup> See, 35 U.S.C. § 133 ("Upon failure of the applicant to prosecute the application within six months after any action therein, . . . the application shall be regarded as abandoned by the parties thereto.").

Notwithstanding its February 21, 2001 date stamp, the '381 application was not complete as filed. *See, id.* at 64, Notice of Incomplete Nonprovisional Application, mailed January 28, 2002. On March 26, 2002, the Applicant provided the missing parts of the incomplete application. *Id.* at 66-110, Response to Notice of Incomplete Nonprovisional Application, filed March 26, 2002. Thereafter, the PTO recorded the filing date of the '381 application as April 11, 2002. *See, e.g., id.* at 111, Office Action mailed October 3, 2003. However, because the '381 application received a filing date of April 11, 2002, it was not co-pending with the '073 application. Under 35 U.S.C. § 120, the claim for priority in the '381 application back to '073 application filing date of January 12, 1998 became ineffective. The Applicant subsequently permitted the '381 application to go abandoned. *Id.* at 281.

After the PTO determined that the '381 application had a filing date of April 11, 2002, and was *not* co-pending with the '073 application, Applicant improperly returned to prosecuting the previously deliberately and intentionally abandoned '073 application. On January 3, 2003, Applicant filed a petition to revive the '073 application based on unintentional abandonment under 37 C.F.R. § 1.137(b). Ex.

1002, p. EW 598-599.<sup>8</sup> This petition contains the form statement that "The entire delay in filing the required reply from the due date for the required reply until the filing of the grantable petition under 37 C.F.R. § 1.137(b) was unintentional." *Id.*, EW 599, ¶ 4. This statement was signed by Richard Ruble (Reg. No. 45,720). *Id.* 

The PTO subsequently granted the petition. Ex. 1002, p. EW 603. However, in so doing, the PTO explained: "It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue." *Id.* The PTO *assumed* that both a proper inquiry had been made and that the proper standard had been met.<sup>9</sup> The record evidence now shows that both assumptions were incorrect. <sup>8</sup> This petition was accompanied by a continuing application as required by 37 C.F.R. § 1.137(c). That application was assigned Serial No. 10/336,470 – the '470 application eventually matured into the '871 patent.

<sup>9</sup> See MPEP 711.03(c)(II)(C):

[T]he Office relies upon the applicant's duty of candor and good faith . . . without requiring further information in the vast majority of petitions . . . because the applicant is obligated under 37 CFR 11.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office . . . . [P]roviding an inappropriate statement in a petition under 37 CFR

# **3.** The Public Record Demonstrates Deliberate Abandonment of the '073 Application

The law is clear that "the failure of a patent applicant, acting through his or her representative, to file a required response to a patent office action is a *deliberate* decision to allow an application to become abandoned, and is not subject to revival under 37 C.F.R. § 1.137(b)." *Lawman Armor Corp. v. Simon*, 2005 U.S. Dist. Lexis 10843, \*15 (E.D. Mich., March 29, 2005). A "change in circumstances that occurred subsequent to the abandonment of an application does not render 'unintentional' the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application." MPEP 711.03(c)(II)(C)(1). "An intentional act is

1.137(b) . . . may have an adverse effect when attempting to enforce any patent resulting from the application. *See Lumenyte Int'l Corp. v. Cable Lite Corp.*, Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional). not rendered unintentional when an applicant reviewing the same facts changes his mind as to the appropriate course of action to pursue." *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r 1988). *See also, In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r, 1989) (where applicant deliberately chooses not to file a response to an office action, that course of conduct cannot amount to unintentional abandonment under § 1.137(b)).

There is no dispute concerning the public record facts. They show that the '073 application was subject to a final office action rejection mailed August 29, 2000, and that a three (3) month EOT was filed on February 21, 2001. That 3-month EOT was *not* accompanied by a proper response to the final office action. On that same day -- February 21, 2001 -- the '381 application (claiming priority back to the '073 application and copying claims therefrom) was filed. Thereafter, a PTO notice of abandonment of the '073 application was mailed on April 10, 2001. No further action was taken in the '073 application until the '381 application failed, and the petition to revive was filed on January 3, 2003. Therefore, the public record shows deliberate acts regarding abandonment of the parent '073 application and use of the divisional '381 application to continue prosecution described above, and Petitioner is not aware of any evidence to the contrary.<sup>10</sup>

<sup>&</sup>lt;sup>10</sup> Mr. Robert Curfiss, one of two attorneys of record for the '073 application (Ex.
1003 at EW 94-97), was deposed in a related litigation, but counsel for e-Watch

There can be no dispute that the natural consequence (*i.e.*, abandonment) of filing the EOT without a suitable substantive response, and simultaneously filing a continuation application, was deliberate at the time the acts were taken. These deliberate acts cannot later -- in hindsight after the '381 application had been deemed by the PTO to be *not* co-pending with the '073 application -- become unintentional. The abandonment of the '073 application as of March 1, 2001, was deliberate. In these circumstances, 37 C.F.R. § 1.137(b) is not available to revive the '073 application.

#### 4. No Record Evidence of "Unintentional" Delay

The attorney signing the petition was Mr. Ruble (Reg. No. 45,720) who at the time of the petition was a relatively young lawyer working for Mr. Curfiss -the senior attorney working on the matter. Mr. Ruble signed the petition, including the statement of "unintentional" delay. As discussed above, however, the record evidence shows deliberate acts regarding abandonment of the '073 application, and Petitioner is not aware of any evidence to the contrary.<sup>11</sup>

has refused to provide consent to the use of the deposition transcript under seal in an *inter partes* review.

<sup>11</sup> Mr. Ruble was deposed in a related litigation, but counsel for e-Watch has refused to provide consent to the use of the confidential deposition transcript under seal in an *inter partes* review.

The PTO's decision on the petition to revive explained that it "is *not apparent* whether the person signing the statement of unintentional delay was in a position to have first hand or direct knowledge of the facts and circumstances of the delay at issue." Ex. 1003, p. EW 603. The Petitioner is aware of no evidence concerning any attorney inquiry into the delay period of alleged unintentional abandonment. The lack of evidence concerning any inquiry into the '073 application delay period starkly contrasts with the fact that during the delay period, the PTO expressly notified Applicant's attorney on April 10, 2001, of the abandonment of the '073 application. *See id.*, p. EW 595-597. No action was taken in the '073 application in response to the Notice of Abandonment during the time period of April 10, 2001, until the Petition to Revive was filed on January 3, 2003.

Moreover, during this delay period, Mr. Curfiss continued to prosecute the '381 application (allegedly a divisional of the '073 application). He filed a Submission of Missing Parts on April 26, 2001, and he filed a Response to Notice of Incomplete Nonprovisional Application on March 26, 2002. Ex. 1004, Submission of Missing Parts filed April 26, 2001, Response to Notice of Incomplete Nonprovisional Application filed March 26, 2002.

The record evidence to date shows a lack of evidence to support an allegation that the abandonment of the '073 application and the entire period of delay before filing the petition to revive was unintentional. The file histories of

both the '073 application and the '381 application demonstrate deliberate abandonment of the '073 application and show that there was no response to the PTO's notice of abandonment prior to the filing of the petition for revival, even though these same attorneys were prosecuting allegedly related applications during the delay period. There is *no evidence* that the entire 22 month delay (March 1, 2001 until January 3, 2003) was unintentional. On the contrary, the only record evidence is that the abandonment was intentional.

#### 5. The PTO "Assumed" Unintentional Delay -- It Did Not Decide the Merits of the Issue

In its decision on the petition to revive, the PTO Office of Petitions was explicit that they were not deciding the merits of the delay issue -- that is, the "statement of unintentional delay" made by the attorney was "being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay." Ex. 1003, p. EW 603. There simply was no evidence presented at the time of the petition which the PTO could evaluate. The PTO relied on the duty of candor of the practitioner to have made that inquiry and to be able to substantiate such an inquiry in the event it became necessary.<sup>12</sup> The PTO opted to avoid making any evaluation of whether the delay was unintentional. The grant of the petition was merely a procedural device to facilitate processing of the pending

<sup>&</sup>lt;sup>12</sup> See FN 8.

application. Now, with the merits of the decision squarely-at-issue, the record is devoid of any evidence that the "entire period" of delay -- March 1, 2001 through January 3, 2003 -- was unintentional.

# 6. The Effective Filing Date of the '871 Patent Is January 3, 2003

The only record evidence concerning the abandonment of the '073 application -- the public file histories -- demonstrates that the abandonment was deliberate. The statement in the petition for revival under 37 C.F.R. § 1.137(b) that the delay was unintentional was made by a junior lawyer with no factual basis to make the statement he signed. The PTO recognized this fact and notified the attorney that it was not apparent whether the person signing the statement of unintentional delay had firsthand or direct knowledge of the facts and circumstances of the delay at issue, and stating that, if that inquiry had not been made, the petitioner must make that inquiry. Ex. 1003, p. EW 603. Notwithstanding this notice, there is no evidence of any inquiry into the facts of the delay. There is no record evidence to show that the abandonment of the '073 application and the entire period of delay until the January 3, 2003 filing of the petition for revival was unintentional as required under 37 C.F.R. § 1.137(b). On these facts and circumstances, there can only be one conclusion -- that is, the '470 application is not entitled to claim priority back to the '073 filing date and the earliest effective date for the '871 patent is January 3, 2003.

#### B. The '818 Publication Has the Same Disclosure as the '871 Patent, Rendering Claims 1-15 of the '871 Patent Anticipated

As the '871 patent and the '818 publication have substantially identical specifications, the Patent Owner cannot rebut the fact that the '818 publication teaches each and every feature of the claims without admitting that the claims or specific claim term is not supported by the '871 patent specification. So, each claim term is explicitly or inherently found disclosed in the '818 publication. Ex. 1005, Sasson Decl., ¶ 19.

The following discussion identifies exemplary disclosure in the '818 publication that corresponds to each limitation of claims 1-15 of the '871 patent. *Id.* In the excerpts that follow, all emphasis is added unless otherwise indicated.

#### 1. Independent Claim 1 Is Disclosed by the '818 Publication

Claim 1 preamble: The preamble recites "<u>A handheld self-contained</u> cellular telephone and integrated image processing system for both sending and receiving telephonic audio signals and for capturing a visual image and transmitting it to a compatible remote receiving station of a wireless telephone network, the system comprising." The '818 publication generally discloses "[a]n image *capture*, conversion, compression, storage and *transmission* system [that] provides a data signal representing the *image* in a format and protocol capable of being transmitted over any of a plurality of readily available transmission systems and received by readily available, standard equipment *receiving stations*. In its most comprehensive form, *the system is capable of sending and receiving audio, documentary and visual image data to and from standard remote stations* readily available throughout the world." Ex. 1002, '818 publication at Abstract. Ex. 1005, Sasson Decl., ¶ 21.

Figures 7A and 7B disclose a "camera body 190 [that] is similar to a standard 35 millimeter camera housing and is adapted to receive a standard lens 192 with a viewfinder 194." Ex. 1002, '818 publication at p. 15:22-23. "[A]n *integral cellular phone* can be incorporated in the camera housing and transmission can be sent directly from the camera housing to a remote receiving station." Ex. 1002, '818 publication at p. 15:29-31, Figs. 7A, 7B. Ex. 1005, Sasson Decl., ¶ 22.

The '818 publication also discloses, "The amplifiers 122, 124 [of the cellular phone] amplify the input of the modem 104 and are controlled by the FETs 126, 128, respectively. The FETs are controlled by the control register 102 and allow selection of the audio either coming in from the cellular interface 130 or from the telephone line 104 to the modem. This permits the cellular phone to be used for three distinct functions: (1) as an *audio telephone*, (2) *as a transmitting system for transmitting the captured image and related signals via a cellular system*, and (3) for receiving incoming transmissions to the *processor* such as remote control.

remote configuration, or images." Ex. 1002, '818 publication at p. 13:22-29 (referring to Fig. 5). Ex. 1005, Sasson Decl., ¶ 23.

<u>Claim 1 (b)</u> recites "the system comprising: a manually portable housing." The '818 publication discloses, "The configuration shown in Fig. 6B is a basic *portable* system . . . ." Ex. 1002, '818 publication at p. 15:1. "Figs. 7A and 7B illustrate the subject invention as incorporated in a *standard 35 millimeter type camera housing*." *Id*. at p. 14:27-28. Ex. 1005, Sasson Decl., ¶ 24.

Claim 1 (c) recites "an integral image capture device comprising an electronic camera contained within the portable housing." The '818 publication discloses that "*a camera 10 may be an integral feature* of the portable module 160." Ex. 1002, '818 publication at p. 15:4 (referring to Fig. 6B). The "preferred embodiment permits capture of a video image using a *digital camera, an analog camera, or a video camera such as a camcorder*." *Id*. at p. 3:1-2. *See also id. at* Figs. 7A, 7B. Ex. 1005, Sasson Decl., ¶ 25.

<u>Claim 1 (d)</u> recites "<u>a display for displaying an image framed by the</u> <u>camera, the display being supported by the housing, the display and the electronic</u> <u>camera being commonly movable in the housing when the housing is moved by</u> <u>hand</u>." The '818 publication discloses, "Turning now to Figs. 7A and 7B, the camera body 190 is similar to a standard 35 millimeter camera housing and is adapted to receive a standard lens 192 *with a viewfinder* 194 . . . . The LCD unit may be positioned to be visible through the viewfinder 194 or may be in a separate *back window 198.*" Ex. 1002, '818 publication at p. 15:22-27. *See also id. at* Fig. 8A-1. Ex. 1005, Sasson Decl., ¶ 26. Thus, the '818 publication discloses a display, which is supported by and commonly movable in the housing, that displays an image having boundaries established by the camera.

<u>Claim 1 (e)</u> recites "<u>a processor in the housing for generating an image data</u> <u>signal representing the image framed by the camera</u>." The '818 publication discloses that "when the camera is activated either by the operator or by automation, the system *processor* 86 detects the initiation of the camera and capture sequence and sends a *signal* via line 88 to the read/write control 84." Ex. 1002, '818 publication at p. 11:28-30. Ex. 1005, Sasson Decl., ¶ 27.

<u>Claim 1 (f)</u> recites "<u>a memory associated with the processor for receiving</u> and storing the digitized framed image, accessible for selectively displaying in the display window and accessible for selectively transmitting over the wireless telephone network the digitized framed image." The '818 publication discloses, "Once the image is captured by the camera 10 and is presented at 44 to the *memory device* 46, it is stored for later *recall* and *transmission*." Ex. 1002, '818 publication at p. 9:19-20. "In the embodiment shown in Fig. 2, an *optional viewer device* 48 is provided. This permits the operator to *recall and view* all or selective images before transmission, as indicated by the operator interface/recall interface 54." *Id.* at p. 9:25-27. *See also id.*, at Figs. 3-4. Ex. 1005, Sasson Decl., ¶ 28.

Claim 1 (g) recites "a user interface for enabling a user to select the image data signal for viewing and transmission." The '818 publication discloses, "In the embodiment shown in Fig. 2, an optional viewer device 48 is provided. This permits the operator to recall and view all or selective images before transmission, as indicated by the *operator interface/recall* interface 54. This permits the operator to review all images retained in the memory 46 and transmit selective images, as desired, to the Group-III transmission system." Ex. 1002, '818 publication at p. 9:23-29. See also id., at Figs. 3-4. Furthermore: "Fig. 4 illustrates the use of the image capture and/or retention configured in any of the optional embodiments of Figs. 1-3 and adapted for use in combination with *any of a variety of transmitting* and receiving schemes such as, by way of example, the Group-III system shown in Figs. 1-3, a modem, direct connection to a personal computer, serial or parallel transmission, or *any selected transmitting/receiving protocol*." *Id.* at p. 10:14-18. Ex. 1005, Sasson Decl., ¶ 29.

<u>Claim 1 (h)</u> recites "<u>a telephonic system in the housing for sending and</u> <u>receiving digitized audio signals and for sending the image data signal</u>." The '818 publication discloses, "The system of the present invention [] contemplates wireless *transmission over a cellular telephone*, radio frequency, satellite

transmission or the like." Ex. 1002, '818 publication at p. 13:20-21. "In its most comprehensive form, the system is capable of sending and receiving *audio*, documentary and *visual image data* to and from standard remote stations readily available throughout the world." *Id.* at Abstract.

"In the exemplary embodiment, the specific configuration for a cellular telephone interface is shown in detail. The amplifiers 122, 124 amplify the input of the modem 104 and are controlled by the FETs 126, 128, respectively. The FETs are controlled by the control register 102 and allow selection of the audio either coming in from the cellular interface 130 or from the telephone line 104 to the modem. This permits the cellular phone to be used for three distinct functions: (1) *as an audio telephone*, (2) as a transmitting system for *transmitting the captured image* and related signals via a cellular system, and (3) for *receiving incoming transmissions* to the processor such as remote control, remote configuration, or images." *Id.* at p. 13:21-29 (referring to Fig. 5).

In the preferred embodiment, "the system includes a video camera and an *integral cellular telephone*, wherein the telephone using the standard audio mode or *future digital modes*, can be used to *transmit and receive* visual image signals." *Id.* at p. 3:18-20. Ex. 1005, Sasson Decl., ¶¶ 30-31.

<u>Claim 1(i)</u> recites "<u>alphanumeric input keys in the housing for permitting</u> manually input digitized alphanumeric signals to be input to the processor, the

telephonic system further used for sending the digitized alphanumeric signals." The '818 publication discloses that "[i]n its most comprehensive form, the system is capable of sending and receiving audio, *documentary* and visual image data to and from standard remote stations readily available throughout the world." Ex. 1002, '818 publication at Abstract. "In the preferred embodiment, the system is adapted for tagging a collected image, video, audio, and other data such as a GPS signal, with a real time clock and *added text*. This permits the complete historical data to be transmitted simultaneously with the image signal." *Id.* at p. 18:19-21. The text "*may be input from an integrated keyboard* or from a remote device." *Id.* at p. 4:9. Ex. 1005, Sasson Decl., ¶ 32.

<u>Claim 1 (j)</u> recites "<u>a wireless communications device adapted for</u> <u>transmitting any of the digitized signals to the compatible remote receiving</u> <u>station</u>." The '818 publication discloses that "[i]n its most comprehensive form, the system is capable of sending and *receiving audio, documentary and visual image data to and from standard remote stations* readily available throughout the world." Ex. 1002, '818 publication at Abstract. "In the preferred embodiment of the invention, the system includes a video camera and an integral cellular telephone, wherein the telephone using the standard audio mode or future digital modes, can be used to transmit and receive visual image signals." *Id.* at p. 3:18-20. Furthermore, "[t]he system of the present invention . . . permits the cellular phone to be used for three distinct functions: (1) as an audio telephone, (2) as a transmitting system for *transmitting the captured image and related signals* via a cellular system, and (3) for receiving incoming transmissions to the processor such as remote control, remote configuration, or images." *Id.* at p. 13:20-29 (referring to Fig. 5). Ex. 1005, Sasson Decl., ¶ 33.

<u>Claim 1 (k)</u> recites "<u>a power supply for powering the system</u>." "It is contemplated that the system of the invention would be self-contained with an *integral power unit* such as a disposable battery, rechargeable battery source or the like." Ex. 1002, '818 publication at p. 4:24-25. For example, "[t]he configuration shown in Fig. 6B is a basic portable system, with a battery powered portable module 160 having a self-contained power source 162." *Id.* at p. 15:1-2. Ex. 1005, Sasson Decl., ¶ 34.

#### 2. Independent Claim 6 Is Disclosed by the '818 Publication

<u>Claim 6 preamble</u>: The preamble recites "<u>A handheld cellular telephone</u> having an integrated electronic camera for both sending and receiving telephonic audio signals and for capturing a visual image, converting the visual image to a digitized image data signal and transmitting digitized image data signal via a cellular telephone network, the cellular telephone comprising." This element is similar to the claim 1 preamble, and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp.

3:18-20, 11:15-17, 13:20-29, 15:22-23, 15:28-31, Figs. 5, 7A, 7B. Ex. 1005, Sasson Decl., ¶¶ 40-41.

<u>Claim 6 (b)</u> recites "<u>a manually portable housing supporting the cellular</u> <u>telephone and the integrated electronic camera, the cellular telephone and the</u> <u>integrated electronic camera being movable in common with the housing</u>." Figures 7A and 7B of the '818 publication disclose a handheld "camera body 190 [that] is similar to a standard 35 millimeter camera housing and is adapted to receive a standard lens 192 with a viewfinder 194." Ex. 1002, '818 publication at p. 15:22-23. "This camera has the appearance of a standard SLR 35 millimeter camera. In addition, where desired, an *integral cellular phone* can be incorporated in the camera housing and transmission can be sent directly from the camera housing to a remote receiving station." *Id.* at p. 15:28-31. Ex. 1005, Sasson Decl., ¶ 42.

<u>Claim 6 (c)</u> recites "<u>a cellular telephone in the housing, the cellular</u> telephone further including a transmitter/receiver for transmitting and receiving audio telephone messages over a cellular telephone network, a keypad for entering manually input alphanumeric signals to be transmitted over the cellular telephone network, and a display window for viewing the manually input alphanumeric signals." The '818 publication discloses that "[i]n its most comprehensive form, the system is capable of sending and *receiving audio, documentary and visual image data to and from standard remote stations* readily available throughout the

world." Ex. 1002, '818 publication at Abstract. "In the preferred embodiment of the invention, the system includes a video camera and an *integral cellular telephone*, wherein the telephone using the standard audio mode or *future digital modes*, can be used to *transmit and receive* visual image signals." *Id.* at p. 3:18-20. Furthermore, "[t]he system of the present invention . . . permits the cellular phone to be used for three distinct functions: (1) *as an audio telephone*, (2) as a transmitting system for *transmitting the captured image and related signals* via a cellular system, and (3) for receiving incoming transmissions to the processor such as remote control, remote configuration, or images." *Id.* at p. 13:20-29 (referring to Fig. 5).

The '818 publication also discloses that the "*integral cellular phone* can be incorporated in the camera housing and *transmission* can be sent directly from the camera housing to a remote receiving station. The *keypad* for the telephone is indicated at 202." *Id.* at p. 15:29-31. *See also id.* at Figs. 7A, 7B. "In the preferred embodiment, the system is adapted for tagging a collected image, video, audio, and other data such as a GPS signal, with a real time clock and *added text*. This permits the complete historical data to be *transmitted simultaneously with the image signal.*" *Id.* at p. 18:19-21. The text "*may be input from an integrated keyboard* or from a remote device." *Id.* at p. 4:9.

The schematic in Fig. 5 of the '818 publication shows the button interface in connection with the display: "The display unit 94 is connected through a typical interface 96, and provides visual user interface at the camera body to give the operator a visual read-out of the status of the collection and transmission of a selected frame. In the exemplary embodiment, the display unit is a two line, multicharacter LCD display, *but other sizes or technology displays could be readily incorporated*, depending, for example, on the amount of graphics desired in the display module. The bank of *operator buttons and/or switches 98 are connected to the system through the button interface* 100." *Id.* at p. 12:14-19 (referring to the schematic in Fig. 5). *See also id.* at Fig. 8L-2 (showing schematic for "Keyboard/Display Micro Controller") and Fig. 8L-5 (showing schematic for "Keyboard/Display Interface Connectors"). Ex. 1005, Sasson Decl., ¶¶ 43-45.

<u>Claim 6 (d)</u> recites <u>"an integral electronic camera in the housing, the camera</u> for visually framing a visual image to be captured." The '818 publication discloses, "*The camera 10 may be an integral feature* of the portable module 160 . . . ." Ex. 1002, '818 publication at p. 15:4. The system also "incorporates a standard analog or *digital camera device* 10 for capturing a visual image in the typical fashion." *Id.* at p. 8:11-12. Furthermore, the '818 publication discloses a "camera body 190 [] similar to a standard 35 millimeter camera housing and [] adapted to receive a standard lens 192 *with a viewfinder* 194," which is used to establish the boundaries of the image to be captured. *Id.* at p. 15:22-23 (referring to Figs. 7A and 7B). Ex. 1005, Sasson Decl., ¶ 46.

Claim 6 (e) recites "a processor associated with the electronic camera for capturing and digitizing the framed image in a format for transmission over the cellular telephone network via the cellular telephone." The '818 publication discloses, "The preferred embodiment permits capture of a video image using a digital camera, an analog camera, or a video camera such as a camcorder. The captured video image is then converted into still frame digitized format for transmission over any of a variety of transmission systems ....." Ex. 1002, '818 publication at p. 3:1-3. "[W]hen the camera is activated either by the operator or by automation, the system *processor* 86 detects the initiation of the camera and capture sequence and sends a signal via line 88 to the read/write control 84. The read/write control then monitors the incoming video signal 83 to find the horizontal and vertical sync pulse to identify the beginning of a frame. The read/write control then initiates writing to memory at the RAM devices to initiate capture of the frame. The read/write control continues to 'write' to memory until the appropriate sync signal is received, indicating the end of the frame. At this point a single frame is *captured* in RAM 71 and/or on the portable medium RAM 72." Id. at p. 11:28-12:4 (referring to Fig. 5). Ex. 1005, Sasson Decl., ¶ 47.

Claim 6 (f) recites "a memory associated with the processor for receiving and storing the digitized framed image, accessible for selectively displaying in the display window and accessible for selectively transmitting over the cellular telephone network the digitized framed image." This element is the same as element claim 1 (f), and the '818 publication discloses this subject matter as explained above for that element. Ex. 1002, '818 publication at pp. 9:19-20, 9:25-27. *See also id.* at Figs. 3-4. Ex. 1005, Sasson Decl., ¶ 48.

**Claim 6 (g)** recites "a user interface for enabling a user to selectively display the digitized framed image in the display window and subsequently transmit the digitized framed image over the cellular telephone network." The '818 publication discloses, "[t]he memory may selectively capture images, as indicated by the operator interface/capture interface 52, or may be programmed to selectively capture periodic images or all images. In the embodiment shown in Fig. 2, an optional viewer device 48 is provided. This permits the operator to recall and view all or selective images before transmission, as indicated by the operator interface/recall interface 54. This permits the operator to *review all images* retained in the memory 46 and transmit selective images, as desired, to the Group-III transmission system." Ex. 1002, '818 publication at p. 9:23-29 (referring to the schematic in Fig. 2). Furthermore: "Fig. 4 illustrates the use of the image capture and/or retention configured in any of the optional embodiments of Figs. 13 and adapted for use in combination with any of a variety of transmitting and receiving schemes such as, by way of example, the Group-III system shown in Figs. 1-3, a modem, direct connection to a personal computer, serial or parallel transmission, or *any selected transmitting/receiving protocol*." *Id.* at p. 10:14-18 (referring to the schematic in Fig. 4). Ex. 1005, Sasson Decl., ¶ 49.

Claim 6 (h) recites "an integrated power supply for powering both the cellular telephone and the camera." This element is similar to claim element claim 1 (k), and the '818 publication discloses this subject matter for reasons explained with that element. Ex. 1002, '818 publication at pp. 4:24-25, 15:1-2. Ex. 1005, Sasson Decl., ¶ 50.

#### 3. Independent Claim 9 Is Disclosed by the '818 Publication

<u>Claim 9 preamble</u>: The preamble recites "<u>A combination of handheld</u> <u>cellular telephone and electronic camera comprising</u>." This element is similar to the claim 1 preamble, and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp. 3:18-20, 13:20-29, 5:22-23, 15:28-31, Figs. 5, 7A, 7B. Ex. 1005, Sasson Decl., ¶¶ 54-55.

<u>Claim 9 (b)</u> recites "<u>a housing</u>." This element is similar to claim element <u>claim 6 (b)</u>, and the '818 publication discloses this subject matter as explained for that element. Ex. 1002, '818 publication at pp. 15:22-23,15:28-31. Ex. 1005, Sasson Decl., ¶ 56.

<u>Claim 9 (c)</u> recites "<u>an electronic camera integral within the housing</u>." This element is similar to claim element <u>claim 6 (d)</u>, and the '818 publication discloses this subject matter as explained for that element. Ex. 1002, '818 publication at pp. 15:4, 8:11-12, 15:22-23, Figs. 7A and 7B. Ex. 1005, Sasson Decl., ¶ 57.

<u>Claim 9 (d)</u> recites "<u>a display in the housing for framing the image to be</u> <u>captured by an image capture device and for viewing the image, whereby an</u> <u>operator can view and frame the image prior to capture</u>." The '818 publication discloses, "Turning now to Figs. 7A and 7B, the camera body 190 is similar to a standard 35 millimeter camera housing and is adapted to receive a standard lens 192 *with a viewfinder* 194 . . . . The LCD unit may be positioned to be visible through the viewfinder 194 or may be in a separate *back window 198*." Ex. 1002, '818 publication at p. 15:22-27. *See also id.* at Fig. 8A-1. Ex. 1005, Sasson Decl., ¶ 58. Thus, the '818 publication discloses a display used to establish the boundaries of the image to be captured.

<u>Claim 9 (e)</u> recites "<u>a processor for processing the image framed by the</u> <u>camera for generating a digitized framed image as displayed in the display</u>." The '818 publication discloses, "The preferred embodiment permits capture of a video image using a digital camera, an analog camera, or a video camera such as a camcorder. The captured video image is then converted into still frame digitized format for transmission over any of a variety of transmission systems . . . ." Ex.

1002, '818 publication at p. 3:1-3. The '818 publication also states, "[W]hen the camera is activated either by the operator or by automation, the system processor 86 detects the initiation of the camera and capture sequence and sends a signal via line 88 to the read/write control 84. The read/write control then monitors the incoming video signal 83 to find the horizontal and vertical sync pulse to identify the beginning of a frame. The read/write control then initiates writing to memory at the RAM devices to initiate capture of the frame. The read/write control continues to 'write' to memory until the appropriate sync signal is received, indicating the end of the frame. At this point a single frame is captured in RAM 71 and/or on the portable medium RAM 72." *Id.* at p. 11:28-12:4 (referring to Fig. 5).

The '818 publication further states, "In the exemplary embodiment, the image card 72 is a DRAM card or non-volatile storage card such as a Flash RAM or the like and provides a removable medium for storing the image data as either raw or compressed data . . . . By incorporating the digital to analog (D/ A) converter into the system and pulling the signal from the RAM 71 (or portable RAM 72), the signal can be displayed right at the camera viewfinder 134 or other display device connected at port 138." *Id.* at p. 13:30-14:6. Ex. 1005, Sasson Decl., ¶ 59.

<u>Claim 9 (f)</u> recites <u>"a memory associated with the processor for receiving</u> and storing the digitized framed image for selectively displaying the digitized

framed image in the display window and for selectively transmitting the digitized framed image over a cellular telephone network." This element is substantially the same as claim element claim 1 (f), and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp. 9:19-20, 9:25-27, Figs. 3-4. Ex. 1005, Sasson Decl., ¶ 60.

Claim 9 (g) recites "a cellular telephone in the housing for accepting and digitizing audio signals to be transmitted and for convening received digitized audio signals into acoustic audio, the cellular telephone further for transmitting and receiving non-audio digital signals including digitized image signals." The '818 publication discloses that "[i]n its most comprehensive form, the system is capable of sending and *receiving audio*, *documentary and visual image data to and from* standard remote stations readily available throughout the world." Ex. 1002, '818 publication at Abstract. "In the preferred embodiment of the invention, the system includes a video camera and an *integral cellular telephone*, wherein the telephone using the standard audio mode or *future digital modes*, can be used to *transmit* and receive visual image signals." Id. at p. 3:18-20. Furthermore, "[t]he system of the present invention . . . permits the cellular phone to be used for three distinct functions: (1) as an *audio telephone*, (2) as a transmitting system for *transmitting* the captured image and related signals via a cellular system, and (3) for receiving

incoming transmissions to the processor such as remote control, remote configuration, or images." *Id.* at p. 13:20-29 (referring to Fig. 5).

The "*integral cellular phone* can be incorporated in the camera housing and *transmission* can be sent directly from the camera housing to a remote receiving station. The *keypad* for the telephone is indicated at 202." *Id.* at p. 15:29-31. *See also id.* at Fig. 7A, 7B. The '818 publication discloses, "In the preferred embodiment, the system is adapted for tagging a collected image, video, audio, and other data such as a GPS signal, with a real time clock and *added text*. This permits the complete historical data to be *transmitted simultaneously with the image signal.*" *Id.* at p. 18:19-21. The text "*may be input from an integrated keyboard* or from a remote device." *Id.* at p. 4:9.

The schematic in Fig. 5 of the '818 publication shows the button interface in connection with the display: "The display unit 94 is connected through a typical interface 96, and provides visual user interface at the camera body to give the operator a visual read-out of the status of the collection and transmission of a selected frame. In the exemplary embodiment, the display unit is a two line, multicharacter LCD display, *but other sizes or technology displays could be readily incorporated*, depending, for example, on the amount of graphics desired in the display module. The bank of *operator buttons and/or switches 98 are connected to the system through the button interface* 100." *Id.* at p. 12:14-19

(referring to the schematic in Fig. 5). *See also id.* at Fig. 8L-2 (showing schematic for "Keyboard/Display Micro Controller"), Fig. 8L-5 (showing schematic for "Keyboard/Display Interface Connectors"). Ex. 1005, Sasson Decl., ¶¶ 61-64.

Claim 9 (h) recites "alphanumeric input keys in the housing for permitting manually input alphanumeric signals to be input into the cellular telephone, the manually input alphanumeric signals being presented in the display." The '818 publication discloses, "In the preferred embodiment, the system is adapted for tagging a collected image, video, audio, and other data such as a GPS signal, with a real time clock and *added text*. This permits the complete historical data to be transmitted simultaneously with the image signal." Ex. 1002, '818 publication at p. 18:19-21. The text "may be input from an integrated keyboard or from a remote device." Id. at p. 4:9. The schematic in Fig. 5 of the '818 publication shows the button interface in connection with the display: "The display unit 94 is connected through a typical interface 96, and provides visual user interface at the camera body to give the operator a visual read-out of the status of the collection and transmission of a selected frame. In the exemplary embodiment, the display unit is a two line, multicharacter LCD display, *but other sizes or technology displays could be readily incorporated*, depending, for example, on the amount of graphics desired in the display module. The bank of *operator buttons and/or* switches 98 are connected to the system through the button interface 100." Id. at

p. 12:14-19 (referring to the schematic in Fig. 5). *See also id.* at Fig. 8L-2 (showing schematic for "Keyboard/Display Micro Controller") and Fig. 8L-5 (showing schematic for "Keyboard/Display Interface Connectors"). Ex. 1005, Sasson Decl., ¶ 65.

<u>Claim 9 (i)</u> recites "a power supply in the housing for powering the processor, the cellular telephone, the display and the camera." This element is similar to claim element <u>claim 1 (k)</u>, and the '818 publication discloses this subject matter for reasons explained with that element. Ex. 1002, '818 publication at pp. 4:24-25, 15:1-2. Ex. 1005, Sasson Decl., ¶ 66.

Claim 9 (i) recites "a wireless transmitter/receiver in the housing for transmitting digital signals sent from and receiving digital signals sent to the cellular telephone." The '818 publication discloses, "The system of the present invention also contemplates wireless transmission over a cellular telephone, radio frequency, satellite transmission or the like." Ex. 1002, '818 publication at p. 13:20-21. In the preferred embodiment, "the system includes a video camera and an integral cellular telephone, wherein the telephone using the standard audio mode or future digital modes, can be used to transmit and receive visual image signals." *Id.* at p. 3:18-20. Ex. 1005, Sasson Decl., ¶ 67.

<u>Claim 9(k)</u> recites "and digital/analog circuits for convening digital commands to analog signals for controlling gain, pedestal, setup, white clip, lens

focus, white balance, lens iris, lens zoom and other functions of the camera from a local input device, a remote device or as automatic or programmed functions." The '818 publication discloses, "Where desired, the system also includes camera operation control capability through the use of a digital/analog *circuits* for converting digital commands to analog signals for controlling the *gain, pedestal, setup, white clip, lens focus, white balance, lens iris, lens zoom* and other functions . . . ." Ex. 1002, '818 publication at p. 5:1-3. Ex. 1005, Sasson Decl., ¶ 68.

#### 4. Independent Claim 12 Is Disclosed by the '818 Publication

<u>Claim 12 preamble</u>: The preamble recites "<u>A combination of a handheld</u> wireless telephone and digital camera comprising." This element is similar to the <u>claim 1 preamble</u>, and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp. 3:18-20, 13:20-29, 15:22-23, 15:29-31, Fig. 5. Ex. 1005, Sasson Decl., ¶ 72.

<u>Claim 12 (b)</u> recites "<u>a handheld housing which supports both the wireless</u> <u>telephone and the digital camera, the wireless telephone and electronic camera</u> <u>being commonly moveable with the housing</u>." This element is similar to claim element <u>claim 6 (b)</u>, and the '818 publication discloses this subject matter as explained for that element. Ex. 1002, '818 publication at pp. 15:22-23, 15:28-31. Ex. 1005, Sasson Decl., ¶ 73.

Claim 12 (c) recites "a display supported in the housing for framing an image to be captured and for viewing the image, whereby an operator can view and frame the image prior to capture." This element is similar to claim element claim 9 (d), and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at p. 15:22-27, Figs. 7A, 7B, 8A-1. Ex. 1005, Sasson Decl., ¶ 74.

<u>Claim 12 (d)</u> recites "<u>a processor for processing the image framed by the</u> <u>camera for generating a digitized framed image as displayed in the display</u>." This element is the same as claim element <u>claim 9 (e)</u>, and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp. 3:1-3, 11: 28-12:4, 13:30-14:6. Ex. 1005, Sasson Decl., ¶ 75.

<u>Claim 12 (e)</u> recites <u>"a memory associated with the processor for receiving</u> and storing the digitized framed image, for selectively displaying in the display window and for selectively transmitting over a wireless telephone network the <u>digitized framed image</u>." This element is substantially the same as claim element <u>claim 1 (f)</u>, and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp. 9:19-20, 9:25-27, Figs. 3-4. Ex. 1005, Sasson Decl., ¶ 76.

<u>Claim 12 (f)</u> recites "<u>the wireless telephone being selectively operable to</u> accept and digitize audio signals to be transmitted, the wireless telephone being

selectively operable to convert received digitized audio signals into acoustic audio, the wireless telephone being selectively operable to transmit and receive non-audio digital signals, the non-audio digital signals including a selected digitized frame image." This element is substantially the same as claim element claim 9 (g), and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at Abstract, pp. 3:18-20, 13:20-29, 15:29-31, 18:19-21, 4:9, 12:14-19, Figs. 5, 7A, 7B, 8L-2, 8L-5. Ex. 1005, Sasson Decl., ¶¶ 77-80.

Claim 12 (g) recites "a set of input keys supported by the housing to permit alphanumeric signals to be manually input by an operator into the wireless telephone, the alphanumeric signals being presented in the display for viewing by the operator." This element is substantially the same as claim element claim 9 (h), and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp. 18:19-21, 4:9, 12:14-19, Figs. 8L-2, 8L-5. Ex. 1005, Sasson Decl., ¶ 81-82.

<u>Claim 12 (h)</u> recites "<u>a power supply supported by the housing</u>." This element is similar to claim element <u>claim 1 (k)</u>, and the '818 publication discloses this subject matter for reasons explained with that element. Ex. 1002, '818 publication at pp. 4:24-25, 15:1-2. Ex. 1005, Sasson Decl., ¶ 83. Claim 12 (i) recites "the wireless telephone including a wireless

transmitter/receiver for transmitting digital signals sent from and receiving digital signals sent to the wireless telephone." This element is similar to claim element claim 9 (j), and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at pp. 13:20-21, 3:18-20. Ex. 1005, Sasson Decl., ¶ 84.

<u>Claim 12 (j)</u> recites "<u>at least one camera control circuit connected to an</u> <u>input device for controlling at least one of the following functions: gain, pedestal,</u> <u>setup, white clip, lens focus, white balance, lens iris, lens zoom</u>." This element is similar to claim element <u>claim 9 (k)</u>, and the '818 publication discloses this subject matter for reasons explained for that element. Ex. 1002, '818 publication at p. 5:1-3. Ex. 1005, Sasson Decl., ¶ 85.

#### 5. Dependent Claims 2-5, 7, 8, 10, 11, and 13-15 Are Disclosed by the '818 Publication

<u>Claim 2</u> recites "<u>wherein the display for framing the image to be captured</u> by the image capture device is operable to display the image at the system whereby the image can be viewed and framed prior to capture in the memory." Schematics in Figs. 2-4 of the '818 publication each show a camera with a viewfinder and show an operator capture feature. Ex. 1002, '818 publication at Fig. 2. Furthermore, the '818 publication discloses that "the camera body 190 is similar to a standard 35 millimeter camera housing and is adapted to receive a standard lens 192 *with a viewfinder* 194." *Id.* at p. 15:22-23 (referring to Figs. 7A and 7B). *See also, id.* at Fig. 8A-1. Ex. 1005, Sasson Decl., ¶ 36. Thus, the '818 publication discloses a display for establishing the boundaries of the image to be captured whereby the image can be viewed and framed prior to capture in the memory.

Claim 3 recites "wherein the display is operable to display for viewing alphanumeric messages input at the alphanumeric keys." The schematic in Fig. 5 of the '818 publication shows the button interface in connection with the display: "The display unit 94 is connected through a typical interface 96, and provides visual user interface at the camera body to give the operator a visual read-out of the status of the collection and transmission of a selected frame. In the exemplary embodiment, the display unit is a two line, multicharacter LCD display, but other sizes or technology displays could be readily incorporated, depending, for example, on the amount of graphics desired in the display module. The bank of operator buttons and/or switches 98 are connected to the system through the button interface 100." Ex. 1002, '818 publication at p. 12:14-19 (referring to the schematic in Fig. 5). See also id. at Fig. 8L-2 (showing schematic for "Keyboard/Display Micro Controller") and Fig. 8L-5 (showing schematic for "Keyboard/Display Interface Connectors"). Ex. 1005, Sasson Decl., ¶ 37.

<u>Claims 4, 8, 10, and 13</u> are directed to a removable memory or removable memory module, which may be removable from the housing (claims 4, 8, 10, 13),

and which may store captured image data signals (claims 4, 10, 13). The '818 publication discloses, "Once the image is captured by the camera 10 and is presented at 44 to the memory device 46, it is stored for later recall and transmission. The specific type of memory device is optional and may include, for example, an SRAM device, a DRAM, Flash RAM, hard drive, floppy disk, *PCMCIA format removable memory* (see, for example, the PCMCIA card 50 in

Fig. 7A), writeable optical media or other storage device." Ex. 1002, '818 publication at p. 9:19-23 (referring to Fig. 2). *See also id.* at Figs. 3-4. Ex. 1005, Sasson Decl., ¶¶ 38, 53, 70, 87.

Claims 5, 11 and 14: Claim 5 recites "wherein the display is operable to display for viewing incoming image data signals," claim 11 recites "wherein the display is suitable also for viewing image data signals received by the receiver," and claim 14 recites "the display also being operable for viewing images received by the receiver." The '818 publication discloses that "the system is capable of both sending and *receiving* image data via Group-III fax or other protocol. By incorporating the digital to analog (D/A) converter into the system and pulling the signal from the RAM 71 (or portable RAM 72), *the signal can be displayed right at the camera viewfinder 134 or other display device* connected at port 138." Ex. 1002, '818 publication at p. 14:2-6 (referring to Fig. 5). Ex. 1005, Sasson Decl., ¶¶ 39, 71, 88.

**Claim 7** recites "wherein the display window for viewing the alphanumeric signals is within the display window for framing the visual image." The schematic in Fig. 5 of the '818 publication shows the button interface in connection with the display: "The display unit 94 is connected through a typical interface 96, and provides visual user interface at the camera body to give the operator a visual readout of the status of the collection and transmission of a selected frame. In the exemplary embodiment, the display unit is a two line, multicharacter LCD display, but other sizes or technology displays could be readily incorporated, depending, for example, on the amount of graphics desired in the display module. The bank of operator buttons and/or switches 98 are connected to the system through the button interface 100." Ex. 1002, '818 publication at p. 12:14-19 (referring to the schematic in Fig. 5). See also id. at Fig. 8L-2 (showing schematic for "Keyboard/Display Micro Controller"); Id. at Fig. 8L-5 (showing schematic for "Keyboard/Display Interface Connectors"). Furthermore, "[t]he LCD unit may be positioned to be *visible through the viewfinder* 194 or may be in a separate back window 198." Id. at p. 15:26-27 (referring to Figs. 7A and 7B). Ex. 1005, Sasson Decl., ¶ 52. Thus, the '818 publication discloses a display window for viewing the alphanumeric signals within a display window for establishing the boundaries of the image to be captured.

**Claim 15** recites "further comprising: the housing having a first portion, the housing having a second portion joined to the first portion, at least one of the first portion and the second portion being moveable in relation to the other of the first portion and the second portion, the first portion and the second portion also being commonly movable by hand when fixed in relation to each other." The '818 publication discloses that "the system is capable of both sending and receiving" image data via Group-III fax or other protocol. By incorporating the digital to analog (D/A) converter into the system and pulling the signal from the RAM 71 (or portable RAM 72), the signal can be displayed right at the camera viewfinder 134 or other display device connected at port 138." Ex. 1002, '818 publication at page 14:2-6 (referring to Fig. 5). The '818 publication also discloses that "[t]he design of the invention permits maximum flexibility, with the camera/converter/telephone or other transmission device being designed in a modular configuration wherein any or all of the devices may exist as integrated or independent units." Id. at page 2:28-31. Ex. 1005, Sasson Decl., ¶¶ 89-90.

#### C. Summary -- Claims 1-15 of the '871 Patent Are Invalid as Anticipated by the '818 Publication

As explained above, the earliest effective date for the '871 patent is January 3, 2003. The '818 publication was published in July 1999, more than one year prior to the '871 patent effective date. The '818 publication has the same specification disclosure as the '871 patent. In fact, the '818 publication claims priority to the

'073 Application -- the same application alleged to provide priority to the '871 patent. The same disclosure of the '871 patent that allegedly enables and provides the written description support for the '871 patent claims is present in the '818 publication, which renders the '871 patent claims anticipated. Ex. 1005, Sasson Decl., ¶ 19.

#### VI. MANDATORY NOTICES PURSUANT TO 37 C.F.R. § 42.8

Pursuant to 37 C.F.R. § 42.8(a)(1), the mandatory notices identified in 37 C.F.R. § 42.8(b) are provided below as part of this Petition.

#### A. Real Party-in-Interest

Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. are the real parties-in-interest.

#### **B.** Related Matters

In accordance with 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related matters.

#### 1. Litigations

Patent Owner has asserted the '871 patent and U.S. Patent No. 7,643,168 ("the '168 patent"), which claims priority to the '871 patent, against Samsung Electronics Co., Ltd. and Samsung Telecommunications America, LLC in a patent litigation filed on December 9, 2013, in the U.S. District Court for the Eastern District of Texas (case no. 2:13-cv-01062).<sup>13</sup> Patent Owner has also asserted the '871 patent and '168 patent against other entities in nine other lawsuits in the Eastern District of Texas (case nos. 2:13-cv-01061, -01063, -01064, -01069, -01070, -01071, -01072, -01073, -01074, -01075, -01076, -01077, and -01078). These litigations have been consolidated and case no. 2:13-cv-01061 has been designated as the lead case.

#### 2. Inter Partes Reviews

Several petitions for *inter partes* review have been filed challenging the '871 and '168 patents.

Regarding the '871 patent, the Board instituted an *inter partes* review of the '871 patent on December 9, 2014, based on a petition filed by HTC Corporation and HTC America, Inc. ("HTC") on June 19, 2014 (IPR2014-00987). On January 7, 2015, Petitioner filed a petition that substantially copies the ground in HTC's petition that was adopted by the Board, along with a motion for joinder. *See* IPR2015-00541. Petitioner is filing concurrently herewith another petition challenging the claims not challenged in HTC's petition. The Board also instituted an *inter partes* review of the '871 Patent on August 4, 2014, based on a petition

<sup>13</sup> Effective January 1, 2015, Samsung Telecommunications America, LLC
("STA") merged into Samsung Electronics America, Inc., and STA ceased to exist as a separate corporate entity.

filed by Iron Dome LLC on February 18, 2014 (IPR2014-00439). On December 11, 2014, Apple filed an *inter partes* review petition challenging all claims of the '871 patent (IPR2015-00411) ("Apple IPR"). Ex. 1006. This Petition substantially copies the ground of rejection proposed in the Apple IPR. In addition, other entities have filed petitions for *inter partes* review of the '871 Patent (IPR2015-00402, IPR2015-00404, IPR2015-00406, IPR2015-00412, and IPR2015-00413). These matters remain pending.

As for the '168 Patent, the Board instituted an *inter partes* review of the '168 Patent on December 9, 2014, based on a petition filed by HTC on June 19, 2014 (IPR2014-00989). On January 7, 2015, Petitioner filed a petition that substantially copies the grounds raised in HTC's petition, which were adopted by the Board, along with a motion for joinder. *See* IPR2015-00543. Petitioner is filing concurrently herewith another petition challenging the claims not challenged in HTC's petition. Other entities have also filed petitions for *inter partes* review of the '168 Patent (IPR2015-00401, IPR2015-00407, IPR2015-00408, and IPR2015-00414). Petitioner is filing concurrently herewith a petition that substantially copies the petition filed in IPR2015-00414. These matters remain pending.

#### C. Lead and Back-up Counsel and Service Information

In accordance with 37 C.F.R. §§ 42.8(b)(3)-(4), Petitioner identifies the following lead and back-up counsel and service information.

Lead counsel is Steven L. Park (Reg. No. 47,842), Paul Hastings LLP, 1170 Peachtree Street, NE, Suite 100, Atlanta, GA 30309, Telephone: (404) 815-2223, Fax: (404) 685-5223, E-mail: stevenpark@paulhastings.com; and back-up counsel is Naveen Modi (Reg. No. 46,224), Paul Hastings LLP, 875 15th St. N.W., Washington, D.C., 20005, Telephone: 202.551.1700, Fax: 202.551.1705, Email: naveenmodi@paulhastings.com; and Elizabeth L. Brann (Reg. No. 63,987), Paul Hastings LLP, 4747 Executive Drive, 12th Floor, San Diego, CA 92121, Telephone: (858) 458-3014, Fax: (858) 458-3114, E-mail: elizabethbrann@paulhastings.com.

### VII. PAYMENT OF FEES UNDER 37 C.F.R. § 42.15

The required fees are submitted herewith. The Office is authorized to charge any additional fees due at any time during this proceeding to Deposit Account No. 50-2613.

## **VIII. CONCLUSION**

For the reasons given above, Petitioner requests inter partes review of the

'871 Patent and cancellation of claims 1-15 of the '871 Patent.

Respectfully submitted,

Dated: January 23, 2015

By: /Steven L. Park/ Steven L. Park (Reg. No. 47,842) Naveen Modi (Reg. No. 46,224) Elizabeth L. Brann (Reg. No. 63,987)

Counsel for Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.

## **CERTIFICATE OF SERVICE**

I hereby certify that on this 23rd day of January 2015, a copy of the

foregoing Petition for Inter Partes Review of U.S. Patent No. 7,365,871 and

supporting materials were served by express mail on the Patent Owner at the

following correspondence address of record for the subject patent:

Robert C. Curfiss Law Office of Robert Curfiss 19826 Sundance Drive Humble, TX 77346-1402

In addition, a courtesy copy of all the materials was served by express mail

on Patent Owner's litigation counsel at the following address:

Christopher V. Goodpastor DiNovo Price Ellwanger & Hardy LLP 7000 North MoPac Expressway Suite 350 Austin, TX 78731

Respectfully submitted,

Dated: January 23, 2015

By: /Steven L. Park/ Steven L. Park (Reg. No. 47,842)

Counsel for Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.