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MAIL STOP INTERFERENCE

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Paper No._____

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Sally C. Medley

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JOHN C. **MITCHELL**, ALAN J. HEARD,
STEVEN N. CORBETT, and NICHOLAS J. DANIEL
Junior Party,
(PATENT NUMBER 5,799,273)

v.

DOUGLAS **HOLT**, MICHAEL K. DAVIS,
And JOSEPH H. MIGLIETTA
Senior Party.
(APPLICATION NUMBER 09/351,542)

————————————

Interference No. 105,746 (SCM)
(Technology Center 2600)

HOLT'S CORRECTED REQUEST FOR REHEARING

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I.   Precise Relief Requested

Holt requests rehearing of the April 27, 2012 Decision (hereinafter referred to as "the opinion") granting Mitchell's Motion 2 and dismissing Holt's motions 1-5. In particular, Holt requests rehearing of (i) the panel's conclusion that Mitchell met its burdens of proof and persuasion in establishing that Holt's Group III claims do not satisfy the written description requirement of 35 USC 112, 1st paragraph and (ii) the panel's decision to dismiss Holt's fairly raised and fully developed motions 1-5.

II.   Background

This interference is an intensely contested litigation between two relatively small computer software companies. Holt's assignee has invested substantial money and time in provoking and litigating the interference. Moreover, because Mitchell's assignee has asserted the patent in interference against Microsoft in the District Court of Washington and the parties there have sought discovery from Holt's assignee, substantial additional expenses have been incurred by the parties here in connection with the overall case.

III.   Argument

A.   Introduction

Although not waiving its right to appeal to the Federal Circuit or pursue a 35 USC 146 civil action, Holt does not request here rehearing of many aspects of the panel's decision. In particular, Holt does not request rehearing of the panel's decision to grant-in-part Mitchell's motion 7 to exclude the testimony of Holt's expert witness Porter. Holt does, however, wish to point out that the panel's decision to take as fact Mitchell's expert's direct testimony and to give

no weight to Holt's attorney's arguments based on Porter's testimony is inequitable and has lead to the Board's overlooking and misapprehending significant pieces of evidence.

B. Estee Lauder and the Evidence in the Record

On page 30, lines 20-22, the opinion states that, because Porter's testimony is excluded,

5 "Holt's argument is unsupported and not persuasive." In support the opinion cites Estee Lauder Inc. v. L'Oreal, S.A., 129 F.3d 588, 595, 44 USPQ2d 1610, 1615 (Fed. Cir. 1997).

The opinion is believed to have overlooked the facts (i) that the only relevant holding on the cited page of Estee Lauder is the holding that "arguments of counsel cannot take the place of evidence lacking in the record" and (ii) that, as established below, Holt did rely on

10 "evidence…in the record." While it is true that Porter commented on and explained that evidence, the evidence itself was in the record. Moreover, as stated in Orikasa v. Oonishi, 10 USPQ2d 1996, 2000 n.. 12, a motion does not necessarily have to be supported by "evidence," since a party may be able to make a necessary showing with attorney argument. That is, in view of the fact that the APJs are 35 USC 6 "persons of competent legal knowledge and scientific

15 ability," they sometimes do not require the submission of any evidence at all to support the grant of a substantive motion.

In sum, the panel has reached conclusions regarding Holt's Group III claims inconsistent with its own findings of fact and overlooked or misapprehended disclosures in Holt's specification which does provide written description support for the Group III claims.

20 Further, as discussed next, in litigating the issues raised in Holt Motions 1-5, the panel has not served the interests of justice in electing to dismiss those fairly raised and fully developed motions.

C.   The Dismissal of Holt's Motions

On page 53, lines 5-9, the opinion states that Holt's Motions 1-5 are DISMISSED

because Holt lacks standing to continue in this interference in view of the fact that Mitchell's

Motion 2 is granted.

5   The opinion is believed to have overlooked the facts (i) that the Federal Circuit "has held

that 'the Board <u>should</u> decide issues relating to priority and patentability that are fairly raised and

fully developed during the interference, despite the permissive language of § 135(a) with respect

to patentability issues'." <u>Koninklijke Philips Electronics N.V.</u> v. <u>Cardiac Science Operating Co.</u>,

590 F.3d 1326, 1334, 93 USPQ2d 1227, 1232-33 (Fed. Cir. 2010)(emphasis by the Federal

10   Circuit), quoting from <u>In re Gartside</u>, 203 F.3d 1305, 1317, 53 USPQ2d 1769,. 1776 (Fed. Cir.

2000), and also citing <u>Schulze</u> v. <u>Green</u>, 136 F.3d 786, 791, 45 USPQ2d 1769, 1774-75 (Fed.

Cir. 1998); <u>Perkins</u> v. <u>Kwon</u>, 886 F.2d 325, 328, 12 USPQ2d 1308, 1310-11 (Fed. Cir. 1989);

and 130 Cong. Rec. 28,065, 28,072 (1984), and (ii) that Holt's Motions 1-5 were "fairly raised"

(since they were all authorized by the APJ) and "fully developed" (since they were briefed, the

15   supporting expert witness (Porter) was cross-examined, the motions were opposed, the

supporting expert witness (Sonnier) was cross-examined, the oppositions were replied to, the

supporting expert witness (Porter) was again cross-examined, the movant filed observations on

the results of that cross-examination, and the opponent filed responses to the movant's

observations--all at great expense to two small companies).

20   This point was set forth in Holt Motion 1 at page 1 lines 6-18; in Holt Motion 2 at page 1

lines 9-21, in Holt Motion 3 at page 1 lines 4-16, in Holt Motion 4 at page 1 lines 4-16, and in

Holt Motion 5 at page 1 lines 5-17.

Holt is aware that it is the BPAI's practice to ignore the Federal Circuit's case law cited above. Karim v. Jobson, 2007 Pat. App. LEXIS 1 at page 11 (BPAI 2007); and Ben-Haim v. Mower, 2012 Pat. App. LEXIS 916 at pages 14-15 (BPAI 2012). However, that practice has not been approved by the Federal Circuit, and Holt hopes to give the Federal Circuit the opportunity

5   to indicate whether it does so--or whether it meant what it said in Koninklijke and its earlier opinions. Accordingly, a real purpose of this request for rehearing is to give the BPAI the opportunity to explain to the Federal Circuit why it feels entitled to ignore what the court said in Koninklijke and the earlier opinions cited in Koninklijke.

Finally, with respect to the opinion's assertion that Holt's motions were DISMISSED

10   because Holt lacks standing to continue in this interference in view of the fact that Mitchell's Motion 2 is granted, Holt points out that, in Schwartz v. Sawhney, 2006 Pat. App. LEXIS 31 at pages 62-67, a panel of the board ruled that, although there are loose references in some Federal Circuit opinions to threshold issues as being jurisdictional, they are in fact not jurisdictional. See generally Gholz and Kile, Are Threshold Issues Really Jurisdictional?, 19 Intellectual Property

15   Today No. 2 (2012) at page 10. It is respectfully submitted that the panel here unquestionably had (and has) jurisdiction over Holt's Motions 1-5 under the standards set forth in Schwartz.

D. Support in the Record for Holt's Group III Claims

i. The Conclusions in the Opinion Regarding the Group III Claims is Inconsistent with the Findings of Fact and the Teachings of the Holt Specification

5 On page 50, lines 5-8, the opinion concludes:

> 5 Mitchell has, however, sufficiently demonstrated that the Holt Application
> 6 does not describe an interface application program that is operative to compare the
> 7 identity of a selected word (by a user) with said link data to identify any
> 8 corresponding audio component.

In reaching this conclusion, the opinion is believed to have overlooked that, with regard

to the embedded tagging embodiments of the Holt application, the panel made the following

10 finding of fact (hereinafter referred to as "FF").

> 12 39. A user can select on a text in the word processor application and the
> 13 system finds the sound bite in the audio file 53 and replays the sound. (Ex. 2003 at
> 14 9:2-4).

FF 44 (reproduced below) recognizes that, in the embedded tagging embodiment, the tagger

editor 62 constitutes the interface application program. Thus, it is clear that the panel at least

15 reached the conclusion that, for the embedded tagging embodiment, the Holt application

describes an interface program that, in response to a user selected text in a word processor

application, the tagger editor 62 is operative to find a sound bite in an audio file.

FFs 42 and 43 acknowledge that, in the embedded tagging embodiment, a bookmark

"allows the word tag information to be associated with the text even when it is placed into a

20 clipboard or moved around."

18   41. The Holt specification describes that in the case of Microsoft Word®,
19   tag information is stored by way of a bookmark and the bookmark stores the tag in
20   its name. (Ex. 2003 at 14:3-4).
21   42. The bookmark is described as going with the text that is cut or copied
22   and pasted into a new location within the same or another document. (Ex. 2003 at
23   12:9-12).

1   43. The Holt specification explains that this method, using the Microsoft
2   Word® and its bookmark capability, allows the word tag information to be
3   associated with the text even when it is placed into a clipboard or moved around.
4   (Ex. 2003 12:14-19 to 13:2).
5   44. Sonnier explains that for the embedded tagging embodiments, the
6   interface application would be the tagger editor shown as element 62 in Figure 2 of
7   Holt's application. (Ex. 2005, ¶ 31).

Thus, it is clear in light of the panels' FFs 39 and 41-44 that the Holt application does

5   describe an interface application (tagger editor 62, see FF 44) that is operative to compare the

identity of a selected word (see FF 39) with said link data (e.g., word tag information, see FF 43)

to identify any corresponding audio (see FF 39).

On page 50, lines 8-13, the opinion states:

8   For reasons already discussed, Mitchell has
9   sufficiently demonstrated, with supporting evidence, that for the tagging
10   embodiments, the tagger editor does not store the recognized words and the tags
11   because the word processor file and word processor stores and maintains the
12   association between the recognized words and their embedded tags whenever the
13   words are moved.

10   The opinion is believed to have misapprehended that, with regard to the Group III claims,

it is irrelevant whether the interface application (i.e., the tagger editor) or the word processor

"stores and maintains the association between the recognized words and their embedded tags whenever the words are moved." Rather, the independent claims of Group III, including representative claim 87, does <u>not</u> require the interface application to store and maintain link data. Rather, claim 87, for example, requires that the interface application "***forms*** link data linking the audio data to the recognized words."[1]

5

According to the Holt specification, in the embedded tag embodiment (Fig. 2), the tagger editor 62 forms the "TAG INFO" (i.e., link data) and then sends it to the word processor for embedding into the word processor file as a "[TAG]." See FFs 34-36.
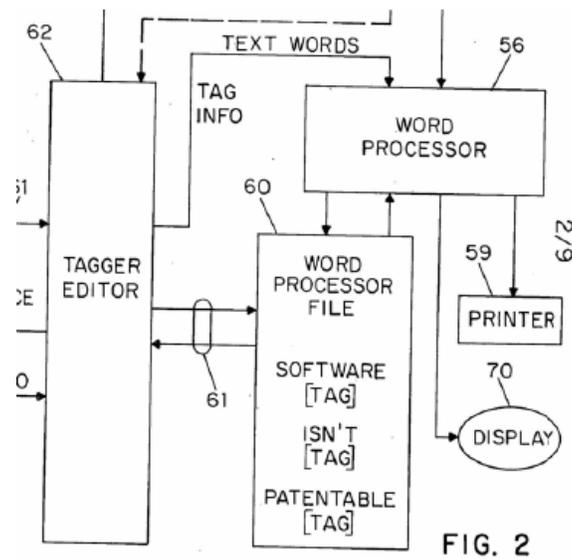
FIG. 2

10   Consistent with Fig 2, FF 43 acknowledges that the tag information in the form of a bookmark allows the tag information to be associated with the text (e.g., "software") even if the text is placed on the clipboard and moved, for example.

On page 51, lines 1-6 the opinion states:

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[1] The dependent claims in Group III provide that the interface application store "said link data, and said audio data."

1   The missing part is the

2   "information." It must be something other than the word itself. Holt claim 87 is

3   identical to Mitchell claim 69. Viewing the "information" in light of Mitchell's

4   specification, it is clear that the information is something other than the

5   corresponding word. (Ex. 2005, ¶ 38, citing Ex. 2001, col. 6:66 to col. 7:15,

6   Figure 4).

It appears from the opinion that the panel believes that a broad reasonable interpretation of the

claim term "information" in light of the Mitchell specification[2] merely requires the "link data" to

include information other than the recognized word corresponding to the audio. Accordingly,

5   the opinion is believed to have overlooked that FF 38 acknowledges that the tag *information*

"follows the text if it is cut or copied or pasted using standard editing features of the word

processor application."

Since the tag information *follows the text*, the tag information must constitute "something

other" than the recognized text which can be cut or copied or pasted as recognized by FF 38. In

10   the unlikely circumstance that the panel intended an even narrower interpretation[3] of the claim

term "information" such that it requires information which enables the system to find or

determine the position of the recognized term, the Holt specification provides written description

support for that narrower interpretation as well. As suggested by FF 38, in the embedded tag

embodiment, when a user selects a word, the embedded tag (in the form of a bookmark in the

15   Word embodiment) enables the tagger editor to locate the corresponding recognized word even

when that word has been moved during word processing. Thus, it is clear that the Holt

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[2] Because the term "information" is clear on its face, Holt maintains that reference to the Mitchell specification is not required here pursuant to Agilent.

specification does support the "information" limitation of the Group III claims whether that term is given a broad reasonable interpretation in light of the Mitchell specification or a narrower interpretation as discussed above.

On page 51, line 21 – page 52, line 2 the opinion states:

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21                                                                              Even
22    assuming this to mean that it is the tagger editor 62 that links the word text with the
23    audio data, the above passage does not describe the "manner" in which the linking
 1    is achieved or the content of the link data, e.g., that the link data comprises audio
 2    identifiers and information identifying the corresponding recognized words.
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The opinion is believed to have overlooked that, with regard to the Group III claims, FF 41 acknowledges the Holt specification describes in the case of Microsoft Word® the "manner" of linking is achieved by way of a bookmark and the bookmark stores the tag in its name. Further, the opinion is believed to have misapprehended that in generating the bookmark for embedding into the word processor file, the tagger editor 62 is "forming" link data. See FF 41 and Figure 2 of the Holt specification. The bookmark including the tag in its name comprises audio identifiers (index information) and the bookmark is utilized to identify the corresponding recognized words. See FFs 42 and 43, and page 10, lines 10-15 and page 14, lines 3-7 of the Holt specification.

For the foregoing reasons, the opinion misapprehends/overlooks that the Holt specification does describe an interface application 62 which compares a selected word with tag information ("link data") so that the system can find the corresponding audio byte wherein the tag information constitutes something other than the recognized word. Thus, for at least these

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[3] Such a narrower interpretation would be contrary to the broadest reasonable interpretation standard employed in interferences.

reasons, Mitchell does not satisfy its burdens of proof and persuasion with regard to the Group

III claims.

ii.   **Support for Holt's Group III Claims in the Testimony of Mitchell's Expert Witness**

5   In addition to the panel reaching conclusions regarding Holt's Group III claims

inconsistent with its own findings of fact and overlooked or misapprehended disclosures in

Holt's specification, the opinion has overlooked testimony from Mitchell's expert, Richard

Sonnier, supporting the conclusion that Mitchell has not satisfied its burdens of proof and

persuasion with regard to the Group III claims. That is, in addition to the key parts of Sonnier's

10   direct testimony adopted in the opinion as FF, the cross-examination testimony identified below

supports the finding that the Holt specification supports the Group III claims.

See, for example, page 96, line 23 – page 97, line 13 of the August 6, 2010 Transcript of

Richard Sonnier (Exhibit 2052, hereinafter referred to as "the Sonnier transcript") where Sonnier

acknowledged that in the case of the embedded tagging embodiment and in particular the

15   Microsoft Word embodiment that "it's the Bookmark that enables [the system to find the sound

byte within the audio file], and the Bookmark is constructed such that the name of the Bookmark

gives you the tag" and the tagger editor uses that information to find the audio file.

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20   23 Q. So, on Page 9 of the spec, GWS 121178 --

24   A. Right.

25   Q. -- it states, "The user can select an item of

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1   text and provide a user input, asking that it be

2   replayed and, again, quite importantly, the system finds

3   the sound byte within the audio file 53 corresponding to

4   the selected item and replace it over the speaker 66."

5   Is that enabled by the tag information?

6   MR. PERQUE: Objection. Lacks foundation.

7   A. With -- within the -- say the word case, it's the

8   Bookmark that enables it, and the Bookmark is

9   constructed such that the name of the Bookmark gives you

10   the tag.

11   Q. (BY MR. BAKER) What uses that information to

12   find the audio file?

13   A. The tag editor.

_____

Thus, it is clear that Sonnier recognized and acknowledges that the Holt specification describes

using the bookmark such that the "tag information" constitutes something more than the

corresponding recognized word.

Mr. Sonnier further acknowledged on pages 97 and 98 of the transcript that it was

understood from the Holt specification the manner in which the bookmark could be used as

linking data.

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14 Q. Okay. So, the tag editor is an interface between

15   the audio file and the Bookmark, which is stored in the

16   word processor file?

-11-

17   I'll ask you another way.

18   Once you identify a word "isn't" or "is" --

19   A. Right.

20   Q. -- and there's a Bookmark around that word, let's

21   say the Bookmark is C4 --

22   A. Okay.

23   Q. I'm just making a Bookmark name, C4.

24   A. C4.

25   Q. What does Holt teach the tagger editor will use

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1   C4 to do? What will it look up with C4?

2   A. I mean, it just -- in the most basic level, C4 is

3   the tag. So, when it has the tag, it can ask the engine

4   for the audio based on that tag.

5   Q. Is that not link data?

6   A. No, that's not link data in the sense of '273

7   because '273 requires a link data in the interface

8   applications, that is, the two components stored there,

9   that is, monitored, updated, formed, kept up to date,

10   all those operations are all part of the interface

11   application and its use of link data.

Interestingly, Sonnier's testimony on lines 6-11 (provided immediately above) that the link data is not *stored* in the interface application and is not "*monitored, updated, … kept up to date*" is irrelevant to the Group III independent claims since those claims merely recite "forms link data."[4]

See also the testimony bridging pages 100 and 101 of the Sonnier transcript.

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12 Q. And if the word processor -- well, if the user

13   clicks on "is" or "isn't" and alternative words are

14   provided, how is that alternative word communicated to

15   the word processing?

16   A. My opinion is that -- it's not exactly defined.

17   As I mentioned before, the whole correction process is

18   not as detailed as it is in some of the other things

19   I've seen but in the Holt patent, the selection happens

20   by the user, the user makes the selection, and then the

21   word processor, you know, determines what Bookmark was

22   selected and then that Bookmark name, which I said is

23   the tag or computed from the tag, is provided -- you

24   know, that goes back to the tag editor, and the tag

25   editor then makes a call to the engine to retrieve the

101

1   list of alternative words.

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[4] Holt is <u>not</u> acknowledging that its specification does not provide support for these features.

-13-

This testimony from Sonnier acknowledges that the Holt specification utilizes the bookmark such that it constitutes something more than just the corresponding word output by the speech recognition engine. This testimony is also consistent with the teachings of the Holt specification

5   at page 14, lines 3-7 which reflects that the tagging editor names the bookmark and provides additional information other than merely passing along the data output by the speech recognition engine. See also the teachings of the Holt specification at page 10, lines 10-15 which distinguishes the tag output from the speech recognition engine from the tag information generated by the tag editor.

10   Thus, it is clear that key parts of Sonnier's direct testimony adopted in the opinion as FF as well as Sonnier's cross-examination testimony support the misapprehended/overlooked findings of fact in the opinion and teachings in the Holt specification that the Holt specification supports the Group III claims.

IV.   <u>Conclusion</u>

For the foregoing reasons, the Decision should be modified to reflect that Mitchell's

Motion 2 is denied with regard to the Group III claims, and Holt's Motions 1-5 should be

decided on the merits.

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Respectfully submitted,

Charles L. Gholz /s/

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Certificate of Service

Pursuant to Holt's duty enunciated in S.O. ¶105.3, Applicant's undersigned

Representative certifies that the party Mitchell has been duly served with a copy of the forgoing

and a copy of this Certificate of Service. The party Mitchell has been served in the manner

5 provided by S.O. ¶105.3. Specifically, the party Mitchell was served by prior to 5:00PM Eastern

Time on May 31, 2012 by posting to the Interference Web Portal.

Respectfully submitted,

Charles L. Gholz /s/

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