UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Zynga Inc.
Petitioner

v.

Personalized Media Communications, LLC
Patent Owner

Case IPR2013-00156
U.S. Patent No. 7,860,131

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO AMEND

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I. Introduction

In response to the Board's decision to institute this IPR proceeding, Patent Owner, Personalized Media Communications, LLC ("PMC"), filed a Motion to Amend ("Motion") the claims at issue. As required by the Board, PMC has the burden to show that the proposed claims are patentable over the prior art of record and prior art not of record but known to PMC. PMC's Motion, however, fails to even make a conclusory statement about the prior art not of record. PMC's Motion, therefore, should be dismissed for this reason alone. Additionally, the Motion should be dismissed because the proposed amendments do not overcome the prior art of record, Higgins (U.S. Pat. No. 5,270,922) and Hedges (U.S. Pat. No. 4,339,798), either when viewed individually or in combination with additional art.

Moreover, the proposed amendments are flawed. Specifically, the proposed construction for the "advertisement" limitation is overly narrow, especially in light of the Board's construction of "commercial" in a related IPR proceeding involving a related patent.

Accordingly, the Board should deny PMC's Motion to Amend.

II. PMC Fails to Satisfy its Burden of Proof

In IPR proceedings, a patent owner proposing a substitute claim has the burden "to persuade the Board that the proposed substitute claim is patentable over the prior art of record, and over prior art not of record but known to the patent

owner." (*Idle Free Systems, Inc.* v. *Bergstrom, Inc.*, IPR2012-00027, Paper 66, Final Written Decision, at p. 34 (quoting Paper 26 at pp. 7-8).) The burden cannot be satisfied with "just a conclusory remark that no prior art known to the patent owner renders obvious the proposed substitute claims." (*Id.*)

PMC's Motion to Amend fails this burden of proof. With respect to the prior art of record, PMC fails to establish that the proposed substitute claim is patentable over Higgins and Hedges for reasons stated in Sections V and VI below. With respect to the prior art not of record but known to PMC, PMC has not even made a conclusory statement that its proposed claim is patentable over prior art not of record, let alone satisfying the higher burden of proof set forth in *Idle Free*.

Furthermore, PMC cannot claim that it is unaware of any other prior art relevant to the patentability of the '131 patent because it was served with detailed invalidity contentions based on 18 distinct patents during PMC's litigation against Zynga. Similarly, PMC is also aware of the 17 patents served against its U.S. Pat. No. 7,797,717 patent ("'717 patent") to show disclosure of the patent's "commercial" limitation, which is closely related to the currently proposed "advertisement" limitation. Because PMC has made no representation what-so-ever that the substitute claim is patentable over these known prior art, PMC has failed to meet its burden set forth in *Idle Free*.

III. PMC's Proposed Construction for "Advertisement" Is Overly Narrow

PMC proposes that the new term "advertisement" should be construed to mean "a notice or statement about goods, products or services for the purpose of attracting customers or supporters." (Motion at p. 6.) The meaning of "advertisement," however, should be at least as broad as "commercial," which the Board has construed to mean "information for a particular product or service" in a related IPR proceeding involving the '717 patent, which has the same specification as that of the '131 patent. (IPR2013-00164, Paper 10 at p. 7.) Instead of arguing for a narrower construction from the Board, PMC could have incorporated it into its proposed amendment; but it did not.

IV. Higgins invalidates the substitute claim

A. Higgins discloses the "advertisement" limitation

Higgins discloses a system for providing investors a variety of stock information to facilitate the purchasing of stocks. One type of information provided is stock prices. (Ex. 1007 at 6:1-5.) PMC argues that "just as a person of ordinary skill in the art would recognize that price attached to merchandise is not an advertisement, the price of a stock symbol displayed at display 107 cannot be interpreted to be an advertisement." (Motion at p. 11.) Yet during its litigation against Zynga, PMC read the "commercial" limitation in its '717 patent on precisely a display of "price attached to merchandise," as evident from Figure 26 of PMC's infringement contentions, reproduced below:

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