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 REPLY TO PATENT OWNER'S RESPONSE

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I. Introduction

Petitioner requests cancellation of claims 1, 3, 4, 6, 9, and 11 of U.S. Patent No. 7,860,131 ("the '131 patent") as unpatentable under 35 U.S.C. § 102. In initiating the trial, the Board correctly found that, unless rebutted by the Patent Owner, Personalized Media Communications, LLC ("PMC"), the applied references invalidate these claims of the '131 patent. In response, PMC filed a Motion to Amend the claims of the '131 patent and a Patent Owner Response.

PMC's Motion to Amend should be denied as PMC has failed to meet its burden of showing that the amended claims are patentable over the prior art of record and those not of record but known to PMC. Further details of the Motion's shortcomings are detailed in Petitioner's Response to PMC's Motion to Amend.

With respect to the Patent Owner Response, PMC repeatedly argues for overly narrow claim constructions, unrelated to its Motion to Amend, that are inconsistent with the broadest reasonable interpretation standard to be applied in this *inter partes* review proceeding. In effect, PMC asks the Board to treat the claims as if they had been amended without PMC having done so itself. But if PMC had wanted the claims to be construed more narrowly, then it should have included claim language in accordance with its narrow claim constructions in its Motion to Amend. As explained by the Federal Circuit, a Patent Owner's ability to amend claims to avoid prior art – which exists in these proceedings pursuant to 37 C.F.R. § 42.121 –

distinguishes Office proceedings from district court proceedings and justifies the broadest reasonable interpretation standard. *In re Yamamoto*, 740 F.2d 1569, 1572 (Fed. Cir. 1984).

The Board should reject PMC's requests to improperly import limitations into the claims via its proposed overly narrow claim constructions. Accordingly, because PMC has failed to distinguish the claims as written from the cited prior art, the Board's institution decision was correct and claims 1, 3, 4, 6, 9, and 11 should be invalidated.

II. Claims 1, 3, 4, 6, 9, and 11 Are Anticipated by Higgins (Pat. No. 5,270,922)

A. Higgins discloses "storing programming … comprising a computer program and a portion to be completed"

Higgins discloses a workstation controlled by a computer program for generating and displaying personalized stock information. (*See* Exhibit 1007, Abstract.) An example of the display is depicted in Figure 2 of Higgins, which contains multiple fields (*e.g.*, labels 142, 147, 149, 151, 153, and 157), populated with stock data received from remote sources (*e.g.*, ticker plant 35). The fields are populated under the control of a computer program stored in ROM 109 or RAM 111 (which may store "programs or program portions"). (*See* Exhibit 1007 at 2:18-26, 6:16-24, 8:16-24, Figs. 3-4; Ex. 1012 at ¶¶ 6-13.) PMC argues, however, that Higgins does not disclose the "storing programming" limitation.

PMC begins by providing an overly narrow construction that would require the programming be completed "as stored." (*See* Response at p. 18). Claim 1 has no such

restriction, however, as it merely specifies a step of storing the programming and a computer program's operability to "place information … into said portion to be completed" when executed. (*See* Exhibit 1001, Claim 1). Nothing in the claim language suggests that the "programming" and its "portion to be completed" must remain "as stored" when being completed by the computer program. PMC's own citation to the specification (*i.e.*, Exhibit 1001 at 252:11-253:55) shows that the step of "completing" can be performed as the "programming" and the "information" used for completing the programming are being outputted. Specifically, the specification describes placing selected audio segments into audio RAM (*see* Exhibit 1001 at 252:11-14) and calculated prices into video RAM (*see id.* at 250:54-58), and outputting the stored audio and video while programming Q is simultaneously being outputted (*see id.* at 253:17-23, 254:5-17). Thus, absent an explicit amendment to the claim, PMC has no basis to construe the claim to require the programming be completed "as stored."

Based on its faulty claim construction, PMC next mischaracterizes Petitioner's reading of the "programming" limitation to be confined to Higgins' display 107 itself and argues that the display cannot "be a portion of this alleged programming *as it is stored* ….." (*See* Response at pp. 19-20, emphasis original.) First, as discussed *supra*, the claim does not require the programming to be completed "as stored." Second, the display itself is the visual manifestation evidencing a portion of Higgins' computer program ("programming") being completed. (*See* Ex. 1012 at ¶¶ 8-13.)

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