UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC

Patent Owner

Case No.: IPR2016-01520
Patent No.: 8,559,635
For: Signal Processing Apparatus and Methods

PATENT OWNER'S
REQUEST FOR REHEARING

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Cases

Regulations

I. INTRODUCTION

Patent Owner Personalized Media Communications LLC ("PMC") requests rehearing of the Board's February 16, 2016 decision authorizing *inter partes* review of U.S. Pat. 8,559,635 (the "'635 Patent") (Paper 7, "Institution Decision," "Dec."). PMC respectfully requests that the Board reconsider its decision regarding the priority date of Claims 3, 4, 7, 18, 20, 32 and 33. These claims are entitled to a priority date of November 3, 1981, the filing date of the parent application. Accordingly, the post-1981 cited references do not constitute prior art.

First, the Board's holding that Claims 18, 20, 32 and 33 are not entitled to the 1981 priority date was grounded upon a failure to consider all relevant embodiments in the '490 Patent regarding the limitation at issue ("receiving at least one encrypted digital information transmission [that] is unaccompanied by any non-digital information transmission" (the "all-digital transmission" limitation)). For example, the Board did not recognize that Figure 1 of the '490 Patent discloses the reception of all-digital information transmissions over a telephone link (*see* '490 Patent, Fig. 1: connection 22 to telephone link). Yet, Petitioner and its declarant agreed that data transmissions over such telephone links are "all digital" and "unaccompanied by any non-digital information," which is totally at odds with the Board's failure to credit Figure 1 with those characteristics.

Second, the Board's finding that Claims 3, 4 and 7 are not entitled to priority

because of the term "programming" is founded upon a legally-incorrect analysis of the '490 Patent's disclosure that violates the framework set forth in *PowerOasis Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008). While the Board held that the 1987 Specification "expanded" the meaning of "programming", the evidence of record is clearly to the contrary: The '490 Patent, like the 1987 Specification, describes that "programming" includes everything that is transmitted electronically to entertain, instruct or inform. The "programming" disclosed in the '490 Patent is not limited to "single channel, single medium presentations" as the Board concluded, but, rather, also includes "***other electronic transmissions***," and "***other programing*** *previously* ***transmitted*** *and recorded, or processed in* ***other fashion****s*," *i.e.*, "everything … that is transmitted electronically," no different from the 1987 Specification's disclosure of "programming." Notably, the Institution Decision does not identify any specific "programming" that lacks written description support in the '490 Patent.

II. LEGAL STANDARDS AND BACKGROUND

The Board reviews requests for rehearing under an "abuse of discretion" standard. 37 C.F.R. § 42.71. An abuse of discretion occurs when the Board "exercises its discretion 'based upon an error of law or clearly erroneous factual findings' or commits 'a clear error of judgment in weighing relevant factors.'" *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1336 (Fed. Cir. 2013).

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.