UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC
Patent Owner

IPR2016-00754
IPR2016-01520
U.S. Patent No.: 8,559,635

PETITIONER'S BRIEF ON REMAND

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The Director granted review so that the Board could "address its claim construction for the terms 'encrypted' and 'decrypted' in light of the Federal Circuit's decision in" *Personalized Media Commc'ns, LLC v. Apple Inc.*, 952 F.3d 1336 (Fed. Cir. 2020) ("*PMC '091*"), regarding U.S. Patent No. 8,191,091 ("the '091 patent"), a patent related to U.S. Patent No. 8,559,635 ("the '635 patent"), at issue in these proceedings. IPR2016-00754, Paper 50 at 3; IPR2016-01520, Paper 47 at 3. Contrary to Patent Owner's arguments to the Director, however, the Federal Circuit expressly did ***not*** re-construe "encrypted" and "decrypted" in *PMC '091,* or find any error in the Board's construction of those general terms.

The holding and logic underlying the *PMC '091* opinion not only refutes Patent Owner's suggestion that it compels a different result here, it actually confirms the correctness of the Board's claim constructions and invalidity conclusions in its Final Written Decisions in IPR2016-00754 (Paper 41, "FWD-754") and IPR2016-01520 (Paper 38, "FWD-1520"). As explained further below, all of the grounds of unpatentability set forth in FWD-754 and FWD-1520 are still applicable and should not be disturbed. *See* IPR2016-00754, Paper 51 at 3-4; IPR2016-1520, Paper 48 at 3-4.

I. THE FEDERAL CIRCUIT'S DECISION

In *PMC '091*, the Federal Circuit construed the claim term "an encrypted digital information transmission including encrypted information," appearing in

independent claims 13 and 20 of the '091 patent. *PMC '091*, 952 F.3d at 1339. The Federal Circuit found "the applicant's repeated and consistent statements during prosecution, along with its amendment to the same effect, are decisive as to the meaning of the disputed claim term," and held "that the disputed claim term is limited to all-digital signals." *Id.* at 1346. Because the grounds of unpatentability for the claims that include the "disputed claim term" included a transmission of mixed digital and analog signals, the Federal Circuit reversed the Board's unpatentability determination for those claims. *Id.*

The Federal Circuit's decision that the "disputed claim term"—"an encrypted digital information transmission including encrypted information"—was limited to all-digital signals expressly did ***not*** extend to the terms "encrypt" and "decrypt" generally. Indeed, the Federal Circuit agreed with the Board that "the ordinary meaning of 'encrypted' does not impart a more precise understanding of the claim limitation" because "the meaning of 'encryption'—and particularly whether it applied to analog or digital data—was 'in flux' in the 1980s." *Id.* at 1341 n.3. The Federal Circuit also agreed that the passages in the specification that Patent Owner used to argue that "encrypted" and "decrypted" were limited to digital processes "fall far short of defining the relevant terms through repeated and consistent use." *Id.* at 1343. Rather, "the Board's construction is plausible in view of the specification, which expressly contemplates that mixed digital and analog systems

are within the 'spirit of the invention' and the 'Wall Street Week' embodiment." *Id.* The Board's construction was also "plausible in view of the claim language." *Id.* at 1342.

The Federal Circuit in fact affirmed the Board's invalidity finding for claims 26, 27, and 30 of the '091 patent, which include the "encrypt" and "decrypt" terms, but not the longer phrase "an encrypted digital information transmission including encrypted information" contained in the claims meriting reversal. Claim 26 of the '091 patent "recites 'an information transmission including encrypted information,' without the 'digital' modifier." *Id.* at 1342. In its Final Written Decision regarding claim 26 of the '091 patent, the Board found that the prior art relied upon by Petitioner disclosed decrypting "encrypted information" in the form of an analog "scrambled video signal." *Apple Inc. v. Personalized Media Commc'ns, LLC*, IPR2016-00755, Paper 42 at 104-105. The Board stated "[t]he structure of the challenged claims further shows … that encrypting and decrypting respectively include scrambling and descrambling. In essence, Patent Owner's argument that 'it is [not] necessary to distinguish 'encrypted digital information' from 'encrypted' information,'' underlies the problem with Patent Owner's claim construction argument—i.e., challenged claim 13 itself makes the distinction that Patent Owner urges must be ignored." *Id.* at 105.

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