

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

APPLE INC.,

Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,

Patent Owner.

Inter Partes Review Nos.
IPR2016-00754
IPR2016-01520
U.S. Patent No. 8,559,635 B1

**PATENT OWNER'S RESPONSE BRIEF
ON REMAND FROM THE FEDERAL CIRCUIT**

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TABLE OF AUTHORITIES

Page(s)

Cases

Personalized Media Commc 'ns, LLC v. Apple Inc.,
2021 WL 2697846 (E.D. Tex. Mar. 14, 2021)20, 21, 22, 23

Personalized Media Communications, LLC v. Apple Inc.,
952 F.3d 1336 (Fed. Cir. 2020)*passim*

Teva Pharm. USA, Inc. v. Sandoz, Inc.,
789 F.3d 1335 (Fed. Cir. 2015)12

GLOSSARY

'490 patent	U.S. Patent No. 4,694,490
'635 patent	U.S. Patent No. 8,559,635
'091 patent	U.S. Patent No. 8,191,091
'304 patent	U.S. Patent No. 7,801,304, reissued as U.S. Patent No. RE47,642
FWD-754	IPR2016-00754 Final Written Decision, Paper 41, for U.S. Patent No. 8,559,635
FWD-1520	IPR2016-01520 Final Written Decision, Paper 38, for U.S. Patent No. 8,559,635
'263 application	Prosecution History of U.S. Patent Application No. 08/449,263, for U.S. Patent No. 7,801,304, reissued as U.S. Patent No. RE47,642
Davidson	U.S. Patent No. Re. 31,735 to Davidson
Guillou	U.S. Patent No. 4,337,483 to Guillou
<i>PMC '091</i>	<i>Personalized Media Communications, LLC v. Apple Inc.</i> , 952 F.3d 1336 (Fed. Cir. 2020)
<i>PMC EDTX</i>	<i>Personalized Media Commc 'ns, LLC v. Apple Inc.</i> , No. 15-cv-1366, 2021, Document 553, WL 2697846 (E.D. Tex. Mar. 14, 2021),
PMC	Patent Owner, Personalized Media Communications, LLC

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