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 No. IPR2016-00754
U.S. Patent No. 8,559,635 B1

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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INTRODUCTION

Patent Owner Personalized Media Communications, LLC ("PMC") respectfully requests the Director's review of the Board's final written decision in this matter, which has been remanded from the Federal Circuit for further proceedings in light of *United States v. Arthrex*, 141 S. Ct. 1970 (2021). Vacatur of the Board's decision is warranted based on intervening precedent from the Federal Circuit that is irreconcilable with the Board's determination.

In *Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336, 1339 (Fed. Cir. 2020) ("*PMC '091*"), the Board had construed the terms "encrypted" and "decrypted" in U.S. Patent Number 8,191,091 (the '091 patent) to encompass non-digital information. The Federal Circuit reversed the Board's construction because the Board erroneously failed to consider the applicant's "repeated and consistent remarks during prosecution," which established that "encryption and decryption require a digital process in the context of the '091 patent." *Id.* at 1345.

The same Board panel in this case construed a closely-related patent: The patent has the same inventors and the same specification, is part of the same patent family, and includes many of the same claim terms, including "decrypt." The Board's decision in this case is irreconcilable with the Federal Circuit's decision in *PMC '091* in two related ways. First, and most importantly, the Board's construction of "decrypt" in this proceeding was identical to its flawed construction of that same

term in *PMC '091*. Second, the Board in this case failed to consider prosecution history that is highly relevant to other claim terms, and is just as "decisive" as the statements at issue in *PMC '091*. *Id.* at 1346.

The Board's decision is thus irreconcilable with the Federal Circuit's decision in *PMC '091*. In *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00733, Paper 95 (Nov. 18, 2021), Director review resulted in a remand to the Board where the Board's decision was "substantially similar" to one that the Federal Circuit had reversed. *Id.* at 3. The decision in this case is at least as "similar" to the decision at issue in *PMC '091*, and vacatur and remand is similarly warranted.

BACKGROUND

The Board's final written decision held unpatentable claims 4, 7, 13, 21, and 28-30 of PMC's U.S. Patent No. 8,559,635 ('635 patent).[1] Paper 41, at 72. A central issue was whether the claim term "decrypt" is limited to all-digital processes. The Board held that "decrypt" is not so limited, but can also encompass analog information. *Id.* at 7-18. The Board's decision rested on its conclusion that the prosecution history was not relevant because it did not "reveal a clear disavowal of claim scope." *Id.* at 18. The Board then held that the challenged claims are unpatentable on anticipation or obviousness grounds.

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[1] The Board initially denied institution on claims 3, 18, 20, 32, and 33 in this proceeding, but instituted review of those claims after Apple filed a second petition in IPR2016-01520. PMC is also seeking Director review in IPR2016-01520.

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