

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC

Patent Owner

Case: IPR2016-00754

Patent No. 8,559,635

**DECLARATION OF DR. TIMOTHY DORNEY, PH.D. IN SUPPORT OF
REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S
CONTINGENT MOTION TO AMEND**

Introduction and Qualifications

1. I, Timothy D. Dorney, submit the following sworn declaration in IPR2016-00754 in support of the validity of U.S. Patent No. 8,559,635 (“’635 patent”). I am an employee of Patent Owner, Personalized Media Communications, L.L.C. (“PMC”).

2. My background and qualifications are set forth in my Declaration in Support of Patent Owner’s Contingent Motion to Amend the Claims, Ex. 2130.

3. A copy of my *curriculum vitae* is attached as Exhibit 2129.

Motion to Amend

4. I have been informed and understand that if the Patent Trial and Appeal Board (“Board”) should accept the Petitioner’s arguments and cancel any of the issued ’091 patent claims as unpatentable, PMC has made a contingent motion to amend to substitute the canceled claim(s) with corresponding proposed substitute claims 32-43.

5. I have reviewed all relevant papers and exhibits in connection with IPR2016-00754, including PMC’s Reply to Opposition to Motion to Amend filed concurrently herewith.

a. The Proposed Substitute Claims are Supported by the Written Description of the Provisional Application

6. As I described before, it is my understanding that the ’635 Patent and its U.S. Application Serial No. 08/449,413 (“’413 application”) (Ex. 2135), is a

continuation-in-part claiming priority to U.S. Application No. 06/317,510 (“ ’510 application”) (Ex.2050). I have reviewed the ’510 and ’413 applications and it is my opinion that a Person of Ordinary Skill in the Art (“POSA”) reading the ’510 and ’413 applications would have understood that the inventors of the ’635 patent, Mr. Harvey *et al.*, would have been in possession of the invention as recited in the substitute claims. *See*, Ex. 2130 at ¶13.

7. I maintain that my original declaration (Ex. 2130) for IPR2016-00754 in support of the Motion to Amend (Paper 16) provided full specification support for all claim limitations, including both the original and amended claim elements. My declaration relied on Example #7 for Substitute Claims 34-35 and 37- 40, Example #4 for Substitute Claim 36, and disclosure of the functionality of the apparatus that supports all embodiments at the beginning of the Harvey *et al.* ’413 specification. *See, generally*, Ex. 2130.

8. However, Petitioner has alleged that the substitute claims are not supported by the specification. *See*, Paper 24 at 5-13. As such, I have set forth additional embodiments that fully support the Substitute Claims as shown in the table below. As in the original declaration, the additional support relies on Example #7 for Substitute Claims 34-35 and 37- 40, Example #4 for Substitute Claim 36, and disclosure of the functionality of the apparatus that supports all embodiments at the beginning of the Harvey *et al.* ’413 specification.

9. Each limitation of the substitute claims is disclosed in the '510 and '413 applications. Support for the proposed substitute '635 patent claims is shown below:

Substitute Claim	Disclosure in the 06/317,510 Application (Ex. 2050)	Disclosure in the 08/449,413 Application (Ex. 2135)
<p>2. A method for controlling the decryption of programming at a subscriber station, said method comprising the steps of:</p>	<p>8:20-9:1: “The present invention provides a method for obscuring the meaning of the signals to prevent unauthorized use of the signals and of their associated programing. Their meanings may be obscured through encryption so that apparatus described below are necessary to decrypt them. In addition, the pattern of the composition, timing, and location of the signals may vary in such ways that only receiving apparatus that are preinformed regarding the patterns that obtain at any given time will be able to process the signals correctly. Both the arrangement of signal units in signal words and the locations, timings, and lengths of signal words in individual transmissions or groups of transmissions may vary in fashions that can only be interpreted accurately by apparatus that are preprogramed with the keys to such variations.”</p>	<p>286:34-287:7: “FIG. 4 shows five additional devices – three decryptors, 107, 224 and 231, a signal stripper, 229, and a signal generator, 230 associated with matrix switch, 258. <i>Decryptors, 107, 224 and 231, are conventional decryptors, well known in the art, with capacity for receiving encrypted digital information, decrypting said information by means of a selected cipher algorithm and a selected cipher key, and outputting the decrypted information.</i>”</p> <p>289:15-19: “Prior to retransmission, said station encrypts the digital audio information of said transmission, in a fashion well known in the art, using particular cipher algorithm C and cipher key Ca, then transmits the information of said program...”</p>

Substitute Claim	Disclosure in the 06/317,510 Application (Ex. 2050)	Disclosure in the 08/449,413 Application (Ex. 2135)
	<p>25:20-26: “FIGS. 4A through 4E illustrate methods for governing the reception of programing and the use of signal processor apparatus in these methods. All of these methods involve the use of one or more devices, of which various models exist well known in the art, for the decryption of programing transmissions ...”</p> <p>7:6-11: “This method provides techniques whereby, automatically, single channel, single medium presentations, be they television, radio, or other electronic transmissions, may be recorded, coordinated in time with other programing previously transmitted and recorded, or processed in other fashions.”</p> <p>10:4-10: “It has a read only memory for recording permanent operating instructions and other information and a programmable random access memory controller (“PRAM controller”) that permits revision of operating patterns and instructions. The PRAM</p>	

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