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.: IPR2016-00754
Patent No.: 8,559,635

**PETITIONER'S SUR-REPLY IN OPPOSITION
TO PATENT OWNER'S CONTINGENT MOTION TO AMEND**

TABLE OF CONTENTS

In its Motion to Amend, PMC fails to present the necessary evidence that the proposed substitute claims are supported by the specification pursuant to 35 U.S.C. § 112. Paper 24 at 5-7. To attempt to cure this deficiency, PMC submitted a new, 143-page declaration (Ex. 2140, "Dorney Reply Declaration") that offers new citations to the specification and removes alleged support identified in a previously-submitted declaration (Ex. 2130, "Dorney Declaration"). PMC also improperly attempts to incorporate the Dorney Reply Declaration by reference into its Reply, citing over 135 pages of claim charts in a single conclusory cite (Paper 27 at 4-5 (citing Ex. 2140 ¶ 9)), and fails to provide any explanation in its Reply as to how the revised citations to the specification demonstrate that the substitute claims satisfy § 112 (Paper 24 at 5-7). Despite these attempts to circumvent the Board's rules, the Dorney Reply Declaration still fails to demonstrate that the substitute claims are supported by the specification.

I.   **Substitute Claims 34-35 Are Not Supported by the Specification.**

Nearly all of the disclosure from the '413 Application that the Dorney Reply Declaration cites in support of Substitute Claims 34 and 35 is new. *Compare* Ex. 2140 at 4-36, 50-61 *with* Ex. 2130 at 9-41, 52-55. For example, where the first Dorney Declaration identifies "2nd-WSW-program-enabling-message (#7)" as the claimed "first encrypted digital control signal portion" (Ex. 2130 at 31-32; Ex. 1052 at 94:9-13), the Dorney Reply Declaration identifies "local-cable-enabling-

message (#7)" (Ex. 2140 at 11-17).

The originally-cited disclosure fails to support the claims (*see* Paper 24 at 7-8), and the newly-cited disclosure fails too. The '413 Application never describes local-cable-enabling message (#7) as encrypted. In fact, Dr. Dorney himself previously submitted a declaration to this Board that explicitly stated that "[l]ocal-cable-enabling-message (#7) is **unencrypted** digital information." Ex. 2144 (IPR2016-00755, Ex. 2130) at 12, 23, 34 (emphasis added). As such, local-cable-enabling message (#7) cannot possibly support the claimed "**encrypted** digital control signal portion." The '413 Application also fails to describe the **decryption** of local-cable-enabling message (#7), leaving unsupported the limitation of Claim 2 that requires "decrypting said first encrypted digital control signal portion of said programming."

To attempt to rectify what is lacking from local-cable-enabling message (#7)—which, as its name implies, appears in **example #7**—Dr. Dorney cites disclosures pertaining to the "first message of **example #4**." *See* Ex. 2140 at 11-15 (citing Ex. 2135 at 198:10-29), 25-28 (citing Ex. 2135 at 198:10-199:2, 205:5-13, 206:32-34), 52-53 (citing Ex. 2135 at 198:10-29, 198:30-199:2). In doing so, Dr. Dorney improperly equates local-cable-enabling message (#7) and the first message of example #4, relying on a sentence that states that a matrix switch has the capacity "to cause the transfer of the information of [local-cable-enabling

message (#7)] to controller, 20, in the fashion in which information of first message of example #4 is transferred … to decryptor, 39K." Ex. 2140 at 12-13 (quoting Ex. 2135 at 291:33-292:6). But this language simply explains the role "matrix switch, 39I" plays in the transit of the two messages. It does not support equating local-cable-enabling message (#7) and the first message of example #4, as Dr. Dorney suggests, particularly given that the sentence states that the information of local-cable-enabling message (#7) is transferred to "controller, 20," unlike the first message of example #4, which is transferred to "decryptor, 39K." Ex. 2135 at 291:33-292:6. Nothing in the language cited by Dr. Dorney implies that local-cable-enabling message (#7) is encrypted or decrypted.

II. Substitute Claim 36 Is Not Supported by the Specification.

The Dorney Reply Declaration adds more than 10 pages of additional disclosure from the '413 Application purporting to support Substitute Claim 36, a clear admission that PMC did not identify sufficient support in its Motion to Amend or original Dorney Declaration. *Compare* Ex. 2140 at 61-103 *with* Ex. 2130 at 60-96. For example, the Dorney Declaration fails to identify both a "*first* of said plurality of signals" that causes a change in decryption technique and a "*second* of said plurality of signals" decrypted "on the basis of said changed decryption technique," because it identifies the first message of example #4 as both the first and second of said plurality of signals. *See* Paper 24 at 9-10.

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.