

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC

Patent Owner

Case: IPR2016-00755

Patent No. 8,191,091

**PATENT OWNER'S CONTINGENT MOTION TO AMEND THE CLAIMS
UNDER 37 C.F.R. § 42.121(c)**

TABLE OF CONTENTS

I. STATEMENT OF RELIEF REQUESTED	1
II. INTRODUCTION	1
III. LISTING OF AMENDMENTS	9
IV. SUPPORT FOR THE SUBSTITUTE CLAIMS	10
V. CLAIM CONSTRUCTION	12
A. “information particular to a subscriber at said receiver station”	12
VI. THE SUBSTITUE CLAIMS ARE PATENTABLE UNDER 35 U.S.C. §101	13
A. The Substitute Claims Are Statutory.....	13
VII. THE SUBSTITUTE CLAIMS ARE NOT ANTICIPATED BY THE PRIOR ART	15
VIII. THE SUBSTITUTE CLAIMS ARE NOT OBVIOUS OVER THE PRIOR ART	16
A. The Prior Art Does Not Disclose “receiving an encrypted digital information transmission including encrypted digital information and unencrypted digital information, wherein said encrypted digital information transmission is unaccompanied by any scrambled analog encoded information” accompanied by at least one other element of the claims.....	16
B. The Prior Art Does Not Disclose “creating, based on at least a portion of said encrypted digital information transmission, a digital record including a unique digital code identifying said receiver station; automatically transmitting said digital record to a remote station, wherein said transmitting transmits digital information unaccompanied by any non-digital information transmission” accompanied by at least one other element of the claims.....	19
C. The Prior Art Does Not Disclose “storing digital data comprising information particular to a subscriber at said receiver station and originated at said receiver station, wherein said receiver station comprises a central processing unit, said central processing unit interacting with random access memory, and reprogrammable nonvolatile memory storing said digital data, wherein said receiver station stores a unique digital code capable of identifying said receiver station” accompanied by at least one other element of the claims.	20

D. The Prior Art Does Not Disclose “automatically tuning said receiver station to a channel designated by said instruct-to-enable signal; ... outputting said digital programming based on said step of decrypting and based on user input at a local input of said receiver station” accompanied by at least one other element of the claims.....22

E. The Prior Art Does Not Disclose “decrypt[ing] a digital video portion” or “encrypted digital information includes digital television programming, wherein said digital television programming comprises digital video and digital audio” accompanied by at least one other element of the claims.....23

F. The Invention Would Not Have Been Obvious.24

IX. PATENT OWNER IS NOT AWARE OF OTHER MATERIAL PRIOR ART.25

X. CONCLUSION25

PATENT OWNER'S UPDATED LIST OF EXHIBITS

Exh. No.	Description
2001.	Declaration Of Alfred C. Weaver, Ph.D., In Support Of Patent Owner's Preliminary Response
2002.	<i>Curriculum Vitae</i> of Dr. Alfred C. Weaver
2003.	Transcript of Depositions of Anthony Wechselberger, <i>Amazon v. PMC</i> , IPR2014-01532 (June 2-3 and August 25, 2014)
2004.	PMC's Appeal Brief in Reexam. of U.S. Pat. No. 4,965,825, Control No. 90/006,536 (January 29, 2007)
2005.	PMC's Reply Brief in Reexam. of U.S. Pat. No. 5,335,277, Control No. 90/006,536 & 90/006,698 (November 10, 2008)
2006.	PMC's Appeal Brief in Reexam. of U.S. Pat. No. 5,335,277, Control No. 90/006,536 & 90/006,698 (August 16, 2006)
2007.	Board Decision in Reexam. of U.S. Pat. No. 5,335,277, Control No. 90/006,536 (January 19, 2010)
2008.	Order (Dkt. No. 715) in <i>Pegasus Dev. Corp. et al. v. DirecTV, Inc. et al.</i> , C.A. No. 00-1020 (D. Del. May 15, 2013)
2009.	Board Decision in Reexam. of U.S. Pat. No. 4,965,825, Control No. 90/006,536 (December 19, 2008)
2010.	Expert Declaration Of Anthony J. Wechselberger In Support Of Defendants' Principal Opening Brief On Claim Construction (Dkt. No. 159) in <i>Broadcast Innovation, LLC v. Echostar Communications Corp, Hughes Electronics Corp, DirecTV, Thomson Multimedia, Dotcast, Pegasus Satellite Television Inc.</i> , C.A. No. 01-WY-2201 (D. Col. Sept. 16, 2002)
2011.	U.S. Pat. No. 4,893,248 to Pitts
2012.	Excerpt from Joint Claim Construction Chart (Dkt. No. 170) in <i>PMC v. Apple</i> , C.A. 2:15-cv-01366, (E.D. Tex. June 14, 2016)
2013.	Excerpts from 1981 New Collegiate Dictionary, definitions of "designate" and "locate"
2014.	Decision, Institution of <i>Inter Partes</i> Review for IPR2013-00217, U.S. Patent No. 7,162,549 (September 10, 2013)
2015.	Information Disclosure Statement in Application No. 08/485,507 (September 5, 1995)
2016.	Information Disclosure Statement in Application No. 08/485,507 (December 22, 2011)
2017.	Preliminary Amendment in Application No. 08/485,507 (June 7, 1995)

2018.	Notice of Allowance in Application No. 08/460,793 (July 10, 2013)
2019.	Notice of Allowance in Application No. 08/487,649 (October 8, 2013)
2020.	“Decision On Appeal” in <i>Ex Parte</i> Reexamination Control 90/006,536 (of U.S. Patent 4,965,825) (December 19, 2008)
2021.	“Decision On Appeal” in <i>Ex Parte</i> Reexamination Control Nos. 90/006,563 & 90/006,698 (of U.S. Patent 5,335,277) (January 19, 2010)
2022.	Declaration Of Alfred C. Weaver, Ph.D., In Support Of Patent Owner’s Response
2023.	Memorandum Opinion and Order (Dkt. 246) in <i>PMC v. Apple, C.A. 2:15-cv-01366</i> , (E.D. Tex. June 14, 2016)
2024.	Declaration of Thomas J. Scott, Jr., Supporting Patentability
2025.	Hisashi Kaneko and Tatsuo Ishiguro, <i>Digital Television Transmission Using Bandwith Compression Techniques</i> , IEEE Communications Magazine, July 1980, pp. 14-22
2026.	John Free, <i>High-Resolution TV – Here come wide-screen crystal-clear pictures</i> , Popular Science, Nov. 1981, pp. 108-110
2027.	Definition of “instruction” from Webster’s Ninth NewCollegiate Dictionary, 1988
2028.	Definition of “instruction” from Computer Dictionary, Fourth Edition, 1985
2029.	Definition of “execute” from Computer Dictionary and Handbook, Third Edition, 1980
2030.	E.S. Busby, <i>Principles of Digital Television Simplified</i> , Journal of the SMPTE, July 1975, pp. 542-545
2031.	David A. Howell, <i>A Primer on Digital Television</i> , Journal of the SMPTE, July 1975, pp. 538-540
2032.	Gwyneth Davies Heynes, <i>Digital Television – A Glossary and Bibliography</i> , SMPTE Journal, January 1977, pp. 6-9
2033.	Leonard S. Golding, <i>Quality Assessment of Digital Television Signals</i> , SMPTE Journal, March 1978, pp. 153-157
2034.	Jonathan H. Stott, <i>Design Technique for Multiplexing Asynchronous Digital Video and Audio Signals</i> , IEEE Transactions on Communications, May 1978, pp. 601-610
2035.	Toshio Koga, et al., <i>Statistical Performance Analysis of an Interframe Encoder for Broadcast Television Signals</i> , IEEE Transactions on Communications, Dec. 1981, pp. 1868-1876
2036.	Farhard A. Kamangar and K.R. Rao, <i>Interfield Hybrid Coding of</i>

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.