

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.: IPR2016-00755
Patent No.: 8,191,091

**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO
PETITION FOR *INTER PARTES* REVIEW**

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PMC makes an unfounded priority date claim, advances narrow claim constructions, and argues against the prior art primarily on the basis of those constructions. PMC's arguments are not supported, but contradicted, by the record. The Board should reject them and find the Challenged Claims of the '091 patent unpatentable.

I. THE CHALLENGED CLAIMS ARE NOT ENTITLED TO CLAIM PRIORITY TO THE 1981 SPECIFICATION.

PMC's priority date argument fails for two reasons: the 1987 specification broadened the scope of the term "programming," a term in all Challenged Claims, and PMC is bound by the patentee's statements during prosecution about priority. PMC's analysis of whether every limitation of claim 13 is supported by the 1981 specification is therefore unnecessary as well as incorrect.

A. The 1987 Specification Broadened the Scope of "Programming."

A patent may only rely on the filing date of an earlier application "if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112." *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008). When a claim term would receive a broader construction in view of the later filing, the claim is not entitled to the benefit of the earlier filing. *Id.* at 1310-11.

In the 1981 specification, "programming" was defined as "everything transmitted over television or radio" Ex. 1009 at Abstract. The 1987

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