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Paper 42
Entered: March 23, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON WEB SERVICES, LLC,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner.

Case IPR2014-01527
Patent 5,887,243

Before KARL D. EASTHOM, TRENTON A. WARD, and GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner filed a Petition requesting an *inter partes* review of claim 13 of U.S. Patent No. 5,887,243 (Ex. 1003, "the '243 patent"). Paper 1 ("Pet."). Patent Owner filed a Preliminary Response. Paper 6 ("Prelim. Resp."). The panel instituted an *inter partes* review of claim 13. Paper 7 ("Dec. on Inst." or "Institution Decision"), 36.

Patent Owner filed a Response (Paper 20, "PO Resp."), to which Petitioner filed a Reply (Paper 29, "Pet. Reply"). Patent Owner filed Observations on Cross Examination (Paper 38), and Petitioner filed Responses to Patent Owner's Observations (Paper 40). The parties presented arguments at an oral hearing before the panel, which was transcribed by a court reporter. *See* Paper 41 ("Tr.).

In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine Petitioner has shown by a preponderance of the evidence that challenged claim 13 is unpatentable.

A. Related Proceedings

According to the Petition, the '243 patent, including claim 13, is involved in *Personalized Media Commc'ns, LLC v. Amazon.com, Inc.*, No. 1:13-cv-1608-RGA (D. Del., filed Sept. 23, 2013) and *Personalized Media Commc'ns, LLC v. Motorola Inc.*, No. 2:08-cv-70-RSP (E.D. Tex., filed 2008). Pet. 1–2. Granting a motion for judgment on the pleadings, the U.S. District Court for the District of Delaware found claim 13 of the '243 patent invalid as not directed to patentable subject matter. *See Personalized Media Commc'ns, LLC v. Amazon.com, Inc.*, No. 1:13-cv-1608-RGA,

Memorandum Opinion, slip op. at 5–6 (D. Del. Aug. 10, 2015) (cited in IPR 2014-01528 as Ex. 1040). According to Petitioner, Patent Owner appealed that judgment in the Court of Appeals for the Federal Circuit as Appeal No. 15-2008. Paper 31, 1.

The ’243 patent also was involved in an *ex parte* reexamination, which culminated in an appeal to the Board: *Personalized Media Commc’ns, LLC,* Appeal 2008-004816 (BPAI Mar. 5, 2009) (Reexam. Control. No. 90/006,688) (“the ’243 Reexam. Appeal,” Ex. 1005, 56). Petitioner filed petitions seeking *inter partes* review of related U.S. Patent Nos. 7,783,252 B1 (IPR2014-01528); 7,864,956 B1 (IPR2014-01530); 8,046,791 B1 (IPR2014-01531); 7,801,304 B1 (IPR2014-01532); 7,805,749 B1 (IPR2014-01533); and 7,827,587 B1 (IPR2014-01534).

B. The ’243 Patent

The ’243 patent discloses a system for viewing a conventional broadcast program simultaneously with relevant user specific information at a subscriber station. Ex. 1003, 6:61–67.

Figure 1, below, is illustrative of the system.

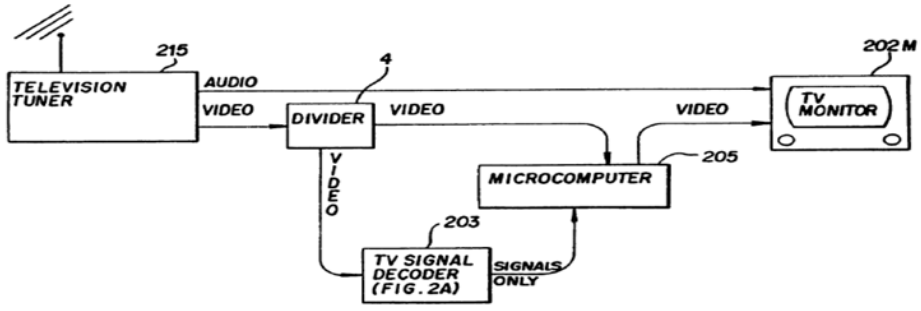

FIG. 1

Figure 1 "is a block diagram of a video/computer combined medium receiver station." Ex. 1003, 9:39–40. The subscriber (receiver) station includes television tuner 215 for receiving a broadcast transmission, divider 4, TV signal decoder 203, microcomputer 205, and TV monitor 202M. Microcomputer 205 sends a query to a remote data source, and after receiving data from that source, generates graphics from that data that can be combined with the television broadcast video signal displayed by TV monitor 202M. *Id*. at 10:56–11:37; 236:65–237:20.

The '243 patent provides an example of combining a graph of the market performance from a "Wall Street Week" program and financial data specific to each subscriber. In other words, monitor 205 displays "Wall Street Week" at the same time it displays previously stored data from another remote source that contains data about a user's stock portfolio. *Id*. at 14:13–39. Microprocessor 205 accesses a floppy disk that holds a data file containing a portfolio of financial instruments owned by the specific subscriber at that subscriber station. During a program broadcast, microcomputer 205 also receives instruction signals embedded in the "Wall Street Week" programming transmission. *Id*. at 14:23–37. The embedded signals include a set of control instructions to control microcomputer 205 at each subscriber station. *Id*. at 13:1–14:38.

In response to the embedded signals, microcomputer 205 enters information at the video RAM of the graphics card for graphing the subscriber's portfolio information. *Id*. at 13:44–65. A subsequent embedded signal instructs the microcomputer to overlay the graphic

information onto the received video broadcast and transmit the combined information to TV monitor 202M, thereby displaying a dual graph showing a subscriber's portfolio performance relative to the overall market performance generated during the "Wall Street Week" show. *Id*. at 14:23–36.

Figure 1C below, reproduced from the '243 patent, depicts such an overlay:

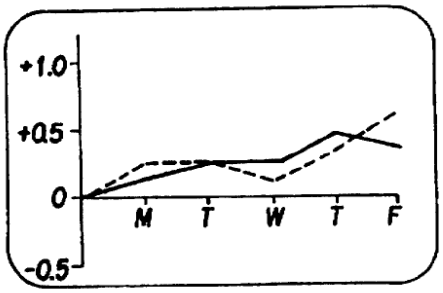

FIG. 1C

Figure 1C above depicts a dual graph representing an individual subscriber's portfolio performance overlaid on the Wall Street Week graph that represents overall market performance. As an example of creating the instruction signal to stimulate the overlay, during the broadcast of Wall Street Week, after the host describes overall market performance,

> the host says, "[a]nd here is what your portfolio did." At this point, an instruction signal is generated at said program origination studio, embedded in the programming transmission, and transmitted. . . . Said signal instructs microcomputer[] 205 . . . to overlay composite video information and transmit the combined information to TV monitor [205].

Id. at 14:23–33.

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