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

U.S. Patent No. 8,191,091

PATENT OWNER'S RESPONSE TO PETITION FOR INTER PARTES REVIEW PURSUANT TO 37 C.F.R. § 42

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TABLE OF AUTHORITIES

Cases

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