UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,

Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,

Patent Owner.

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Case IPR2016-01520
Patent 8,559,635

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PATENT OWNER'S NOTICE OF APPEAL

NOTICE OF APPEAL TO THE FEDERAL CIRCUIT

Notice is hereby given, pursuant to 35 U.S.C. §§ 141 and 142 and 37 C.F.R. § 90.2, that Patent Owner Personalized Media Communications, LLC hereby appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision (FWD) entered on February 15, 2018 (Paper 38), the Decision on Request for Rehearing (RfR) entered on September 19, 2019 (Paper 40), and from all underlying orders, decisions, rulings, and opinions, regarding claims 3, 18, 20, 32, and 33[1] ("Challenged Claims") of U.S. Pat. No. 8,559,635 ("the '635 Patent").

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner further states that the issues on appeal include, but are not limited to:

(1) Whether the Board erred in finding that the Challenged Claims were not entitled to the claimed priority under 35 U.S.C. § 120 to the November 3, 1981 filing date of application No. 06/317,510 leading to U.S. Pat. No. 4,694,490 ("the '490 Patent" or "1981 Specification").

(2) Whether the Board erred in finding that the limitation in claims 18, 20, 32, and 33 for "receiving at least one encrypted digital information transmission … unaccompanied by any non-digital information transmission"

[1] At the oral hearing before the Board, the parties agreed that claims 4, 7 and 18 of the '635 Patent could be dismissed from this IPR. The Board dismissed said claims from this proceeding *sua sponte*.

lacks written description support in the 1981 Specification pursuant to 35 U.S.C. § 112.

(3) Whether the Board erred in finding that the term "programming" in claim 3 lacks written description support in the 1981 Specification pursuant to 35 U.S.C. § 112.

(4) Whether the Board erred as a matter of law in finding that *PowerOasis, Inc. v. T–Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008), requires that the priority determination under 35 U.S.C. §§ 120 and 112 be conducted by comparing the definition and/or scope of a claim term in the earlier specification to the definition and/or scope of that claim term in the later specification, rather than by evaluating whether the claim term as defined in the later specification finds written description support in the earlier application pursuant to 35 U.S.C. §112.

(5) Whether the Board erred in that its priority determination regarding the term "programming" in claim 3 is contrary to three prior Board decisions on the same issue, where the Board reasons that it "is not subject to the general principles of *stare decisis*," "is free to change prior rulings and decisions so long as such action is not done capriciously or arbitrarily," and here "the mere fact that in three previous decisions the Board arrived at a different determination for the term 'programming' is of no moment."

(6) Whether the Board erred as a matter of law in construing "decrypt" as

encompassing deciphering through the descrambling of analog information such as analog television signals, rather than being limited exclusively to the deciphering of digital information signals.

(7) Whether the Board incorrectly held that claims 13, 18, 20, and 32 are anticipated by U.S. Pat. No. 4,817,140 ("Chandra").

(8) Whether the Board incorrectly held that claim 33 is obvious based on Chandra further in view of the publication entitled "When Network File Systems Aren't Enough: Automatic Software Distribution Revisited" ("Nachbar").

(9) Whether the Board incorrectly held that claim 3 is obvious based on U.S. Pat. No. 4,536,791 ("Campbell").

(10) Whether, in arriving at its decision, the Board acted in a manner that was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law or was based on findings unsupported by substantial evidence.

(11) Whether the appointment of the Administrative Patent Judges (APJs) who presided over the *inter partes* review was unconstitutional, requiring at a minimum vacatur of that panel's rulings and decisions and remand to a new panel of APJs pursuant to *Arthrex, Inc. v. Smith & Nephew, Inc.*, No. 2018-2140 (Fed. Cir. Oct. 31, 2019).

Concurrently with this submission, a copy of this Notice of Appeal is being filed with the Patent Trial and Appeal Board, and a copy is being filed

electronically with the United States Court of Appeals for the Federal Circuit along with the requisite filing fee. No fees are believed to be due to the United States Patent and Trademark Office in connection with this filing, but authorization is hereby given for any required fees to be charged to Deposit Account No. 50-6989.

Dated: November 19, 2019

Respectfully submitted,

By: /Douglas J. Kline/

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