

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 IPR2014-01533
Patent 7,805,749

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

BRADEN, *Administrative Patent Judge*.

DECISION
Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Amazon.Com, Inc. and Amazon Web Services, LLC (“Petitioner”) filed a Request for Rehearing (Paper 11, “Reh’g Req.”) of the Board’s Decision to Institute (Paper 7, “Decision”). Personalized Media Communications LLC (“Patent Owner”) filed a Request for Rehearing (Paper 14, “PO Reh’g Req.”) Patent Owner disagrees with the Decision due to alleged errors in claim construction. PO Reh’g Req. 1–2.

For the reasons provided below, we *deny* Patent Owner’s request with respect to making any change thereto.

II. ANALYSIS

A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d). The party challenging a decision bears the burden of showing the decision should be modified. *Id.* When rehearing a decision on a petition, a panel will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

Patent Owner challenges our construction of the term “decrypting” as incorrect, arguing we abused our discretion by (i) not following two decisions issued previously by other panels of the Board, and (ii) overlooking Patent Owner’s disclaimer of analog descrambling being encompassed by the term “decryption.” PO Reh’g Req. 3-6. Patent Owner contends that during prosecution of related U.S. Patent Nos. 4,965,825 and 5,335,277, Patent Owner disclaimed “decryption” from encompassing analog descrambling. *Id.* at 5–6 (citing Exs. 2007, 2008). Patent Owner argues that this disclaimer was relied upon by the Board in issuing two prior decisions where the term “decrypting” was construed. *Id.* at 6. Thus, Patent Owner disagrees with our Decision diverging from the claim

construction in the Board’s prior decisions and requests that “the Chief Judge grant the request for rehearing with an expanded panel to address the harm caused by a panel inexplicably disregarding prior decisions of other panels on the very same issue.” *Id.* at 2.

Contrary to Patent Owner’s arguments, the prior decisions of other panels of the Board appear to have relied upon characterizations of the invention and the specification provided by Patent Owner. *See* Ex. 1026, 67–68, 91. The prior decisions make no mention of the Patent Owner disclaiming claim scope with regards to the term “decrypting.” *See* Ex. 1026, 1027. To the extent that Patent Owner argues it affirmatively gave up the ability to have a claim in the ’749 patent with the scope to cover “analog descrambling” (*see* PO Reh’g Req. 5–6), that argument does not appear to have been made in Patent Owner’s Preliminary Response. A request for rehearing is not an opportunity to present new arguments or evidence that could have been presented and developed in the Preliminary Response. *See* 37 C.F.R. § 42.71(d) (stating that the request must specifically identify . . . the place where each matter was previously addressed in a motion, an opposition, or a reply”). We could not have overlooked or misapprehended arguments or evidence not presented and developed by Patent Owner in the first instance. In any event, as stated in the Decision, we are not persuaded that the specification (Ex. 1001) or the prosecution history of the ’749 patent (Ex. 1003) shows that Patent Owner affirmatively relinquished claim scope that would encompass “analog descrambling.” *See* Decision 10.

Patent Owner also challenges our construction of the term “decrypting” as incorrect, because we relied on all of the embodiments disclosed in the specification and not just the preferred embodiments. PO Reh’g Req. 7–8. According to Patent Owner, “[t]he analog descrambling embodiment that spans

several lines in the instant specification is the farthest thing from a preferred embodiment,” and, thus, should not be considered during our claim construction analysis. *Id.* at 8.

Patent Owner is correct in that we relied on all the embodiments disclosed in the specification to inform our claim construction. In other words, we have construed the claim term “decrypting” consistently with the specification of the ’749 patent. *In re Suitco Surface, Inc.* 603 F.3d 1255, 1260 (Fed. Cir. 2010). The broadest reasonable interpretation of a claim must be consistent with the specification. *See In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *see also TiVo, Inc. v. EchoStar Communications Corp.*, 516 F.3d 1290, 1298 (Fed. Cir. 2008) (concluding that the claim term “multitude of standards” includes not only broadcast standards of the type set forth in the claim, but also data standards of the type set forth in the written description portion of the specification). Patent Owner cites to no case law holding that only the preferred embodiments of an invention disclosed in a specification are to be used during claim construction. In fact, later in its Request for Rehearing regarding another claim term, Patent Owner appears to recognize the importance of the specification for claim construction when it states that “[e]ven when applying broadest reasonable construction, ‘the specification is always highly relevant to the claim construction analysis . . . [u]sually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” PO Reh’g Req. 12 (citing *In re Abbott Diabetes Care, Inc.*, 696 F.3d 1142, 1149 (Fed. Cir. 2012)).

Patent Owner also challenges our construction of the term “decrypting” as moot, “arbitrary[,] and capricious,” because our grant of an *inter partes* review based on Powell in view of Guillou did not turn on whether “decrypting” includes analog descrambling. PO Reh’g Req. 7, 9. Patent Owner, however, fails to

identify what we misapprehended or overlooked as required by 37 C.F.R. § 42.71(d). Thus, Patent Owner's challenge does not meet the standard set forth for a request for rehearing.

Patent Owner lastly challenges our construction of the term "selecting," asserting we overlooked their request to construe this term. PO Reh'g Req. 11. Patent Owner specifically argues that we "abdicated its duty to conscientiously evaluate each argument raised by the parties" when it failed to construe "key claim terms like 'selecting.'" *Id.* at 1. Patent Owner, however, argued originally that "selecting" should be "construed according to its plain and ordinary meaning" (Prelim. Resp. 17–18), and our Decision states, "absent any special definitions, we give claim terms their ordinary and customary meaning" (Decision 7). Thus, we did not overlook Patent Owner's request for construction of the term "selecting." Rather, we simply applied the ordinary and customary meaning of the term "selecting" during our analysis.

Moreover, we note that merely disagreeing with our analysis or conclusions does not serve as a proper basis for a rehearing. It is not an abuse of discretion to provide analysis or conclusions with which a party disagrees. As discussed above, Patent Owner believes that we committed an error in this *inter partes* review by not articulating our application of the ordinary and customary meaning of the term "selecting" in our claim construction. PO Reh'g Req. 11–15. That contention can be submitted by Patent Owner in its Patent Owner Response.

For the forgoing reasons, Patent Owner has not shown that the Board abused its discretion in construing the claim term "decryption" to encompass analog descrambling. As noted in the Decision, we determined that the Patent Owner's proposed construction for this limitation is not the broadest reasonable construction. The Request for Rehearing similarly is not persuasive as to Patent

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.