

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.: IPR2016-01520
Patent No.: 8,559,635

**PETITIONER'S OPPOSITION
TO PATENT OWNER'S CONTINGENT MOTION TO AMEND**

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PMC's Contingent Motion to Amend the claims of the '635 patent does not come close to satisfying the legal requirements for such a motion. The Motion is filled with conclusory statements, unsupported by any citations to the evidence or expert testimony, and fails on any one of multiple independent grounds. First, PMC does not meet its burden to show that the Substitute Claims are directed to patent-eligible subject matter, despite the fact that the Federal Circuit has affirmed the invalidity of dozens of highly-related PMC claims on this basis. Second, PMC does not establish that the Substitute Claims, each of which add multiple limitations, find support in the specification to satisfy 35 U.S.C. § 112. Third, PMC does not analyze the prior art with any specificity, and fails to address, at any level, not only the nearly 2,700 references cited in the '635 patent, but also more than 80 references that PMC itself submitted as exhibits in this proceeding. For any one of these reasons, PMC's Motion must be denied.

I. THE SUBSTITUTE CLAIMS DO NOT SATISFY § 101.

Not only must PMC establish the Substitute Claims claim patent-eligible subject matter under § 101, but it must do so against the backdrop of dozens of related and highly-similar PMC claims being found invalid on this basis by the Federal Circuit. A Delaware district court, in a decision affirmed by the Federal Circuit, found the claims of seven PMC patents invalid under § 101. *PMC v. Amazon.com, Inc.*, 161 F.Supp.3d 325 (D. Del. 2015), *aff'd* Case No. 2015-2008,

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