

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC,
Patent Owner.

Case IPR2016-01520
Patent 8,559,635 B1

Record of Oral Hearing
Held: October 26, 2017

ORDER
Amended Trial Hearing
37 C.F.R. § 42.70

Before KARL D. EASTHOM, KEVIN F. TURNER, and GEORGIANNA
W. BRADEN, *Administrative Patent Judges*.

Case IPR2016-01520
Patent 8,559,635 B1

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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ON BEHALF OF THE PATENT OWNER:

DOUGLAS J. KLINE, ESQUIRE
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The above-entitled matter came on for hearing on Thursday, October 26, 2017, at 1 p.m., at the U.S. Patent and Trademark Office, Madison Building East, 600 Dulany Street, Alexandria, Virginia.

PROCEEDINGS

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2 JUDGE EASTHOM: Welcome to the Patent Trial & Appeal Board.
3 This is IPR2016-01520, U.S. patent No. 8,559,635, *Personalized Media*
4 *Communications LLC v. Apple, Inc.* We have Judge Braden in Dallas and
5 Judge Turner over to the – on the screen. He’s in San Jose. So if you would
6 just remember when you’re speaking to try to reference the slide numbers.
7 We have some slides in this case.

8 Why don’t we start out with introducing yourselves for the record, and
9 start with Petitioner, please.

10 MR. SERNEL: Your Honors, my name is Marc Sernel. I represent
11 Apple. With me today is Joel Merken (phonetic) –

12 JUDGE BRADEN: I’m sorry, counselor. Could we remind you to
13 please go to the podium and please speak into the microphone for the remote
14 judges.

15 MR. SERNEL: My apologies. My name is Marc Sernel. I represent
16 Petitioner Apple Incorporated. With me today are Joel Merken and Alan
17 Rabinowitz.

18 MR. KLINE: Good afternoon, Your Honors. My name is Doug
19 Kline. I represent Personalized Media Communications, LLC, the Patent
20 Owner in this matter. With me are Steve Schreiner, Fong Den (phonetic),
21 Tom Scott, Jennifer Albert. Thank you.

22 JUDGE EASTHOM: Welcome. Okay. Just a couple of
23 preliminaries. We’ve scheduled 45 minutes per side. We understand
24 Petitioner – well Patent Owner raised an issue with respect to another

1 proceeding IPR2016-00754, I believe claims 4, 7 and 13 in that case where -
2 - in a final written decision so it raises a 315 issue here and I understand the
3 Parties want to address that issue preliminarily or do you want to wait until -
4 - I think, why don't we just get that over with. It looks like Petitioner, from
5 your slides, it looks like you're not going to discuss those here; is that
6 correct?

7 MR. SERNEL: That's correct. We don't intend to present any
8 argument with respect to those three claims.

9 JUDGE EASTHOM: Okay. And Patent Owner?

10 MR. KLINE: We should be able to accomplish the same thing, Your
11 Honor.

12 JUDGE EASTHOM: Okay.

13 MR. KLINE: Thanks.

14 JUDGE EASTHOM: Thank you. So are you going to withdraw your
15 motion to -

16 MR. KLINE: Well no. I mean we think they should be dismissed
17 from the case, from this proceeding, and I understand that the request to file
18 the motion came in recently so it hasn't been able to -- the Board hasn't been
19 able to consider it and resolve it yet today, but I think for purposes of this
20 hearing I don't think it's going to influence significantly how this hearing
21 proceeds. But we would like to file the motion because we do think those
22 claims should be dismissed from this proceeding.

23 JUDGE EASTHOM: It's Mr. Kline, right?

24 MR. KLINE: Yes, I'm sorry, yes.

1 JUDGE EASTHOM: Okay, okay. Mr. Kline, I understand your
2 argument.

3 MR. KLINE: Right.

4 JUDGE EASTHOM: The way I think the panel views it is that
5 Petitioner cannot proceed on those claims but we've gone so far now that --
6 and because Petitioner can't proceed, they can't maintain it -- they're not
7 going to present argument here and that's their view of it.

8 MR. KLINE: Right.

9 JUDGE EASTHOM: I think that's a reasonable view. So we can go
10 ahead and proceed on those claims --

11 MR. KLINE: Right.

12 JUDGE EASTHOM: -- and the way we look at it without any more
13 input from Petitioner on them. But you're free to make an argument if you
14 want to about your motion and then we'll entertain it probably later.

15 MR. KLINE: Sure. I mean the argument I would make about the
16 motion is the Statute provides that when the claims are subject to a final
17 written decision, they're -- Petitioner is estopped from proceeding here, so --

18 JUDGE EASTHOM: Okay.

19 MR. KLINE: -- that's the argument.

20 JUDGE EASTHOM: I understand. Thank you, Mr. Kline.

21 MR. KLINE: Right, thank you.

22 JUDGE EASTHOM: Okay.

23 JUDGE BRADEN: Actually, Judge Easthom, I have a question for
24 the Patent Owner. Looking at the Rule it specifically says that Petitioner
25 may not maintain the claims within the IPR proceeding. Do you have

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