

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC,
Patent Owner.

IPR2016-00754
IPR2016-01520
Patent 8,559,635 B1

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

TURNER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

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On March 3, 2022, the Commissioner for Patents, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, ordered the Board’s prior Final Written Decisions (IPR2016-00754, Paper 41 and IPR2016-01520, Paper 38) to be vacated, and ordered that the Board issue new final written decisions. Paper 50, 3¹.

Previously, we determined that certain claims of U.S. Patent No. 8,559,635 B1 (“the ’635 Patent”) to be unpatentable, specifically determining claims to be unpatentable over some of the grounds listed below:

Reference(s)	Basis	Claim(s)	Proceeding
Guillou ²	§ 102	7, 21, 29	IPR2016-00754
Guillou	§ 103	4, 13, 28, 30	IPR2016-00754
Aminetzah ³	§ 103	21, 28–30	IPR2016-00754
Aminetzah, Bitzer ⁴	§ 103	4	IPR2016-00754
Chandra ⁵	§ 102	13, 18, 20, 32	IPR2016-01520
Chandra, Nachbar ⁶ .	§ 103	33	IPR2016-01520
Seth-Smith ⁷	§ 102	4, 7	IPR2016-01520
Campbell ⁸	§ 103	3	IPR2016-01520

¹ We refer to the Papers listed in IPR2016-00754, where the same paper was made of record in both proceedings.

² US Patent No. 4,337,483, filed Jan. 31, 1980 (Ex. 1006) (“Guillou”).

³ US Patent No. 4,388,643, filed Apr. 6, 1981 (Ex. 1008) (“Aminetzah”).

⁴ US Patent No. 3,743,767, issued July 3, 1973 (Ex. 1009) (“Bitzer”).

⁵ US Patent No. 4,817,140, filed Nov. 5, 1986 (Ex. 1041) (“Chandra”).

⁶ Daniel Nachbar, *When Network File Systems Aren’t Enough: Automatic Software Distribution Revisited*, USENIX Conference Proceedings, June 9-13, 1986 (Ex. 1042) (“Nachbar”).

⁷ US Patent No. 4,886,770, filed Aug. 14, 1986 (Ex. 1043) (“Seth-Smith”).

⁸ US Patent No. 4,536,791, PCT filed Mar. 31, 1981 (Ex. 1044)

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In the latter Final Written Decision in IPR2016-01520, we dismissed some grounds of unpatentability with respect to certain claims (claims 4, 7, 13, 21, and 28–30), where those claims were previously found to be unpatentable in the prior Final Written Decision (*see* IPR2016-01520, Paper 38, 4), and could not be sustained; because both Decisions have now been vacated, all prior grounds of unpatentability previously set forth by Petitioner remain viable.

Before the Director, Patent Owner argued that we applied a similar analysis in the above-referenced final written decisions to that discussed in *Apple Inc. v. Personalized Media Communications, LLC*, IPR2016-00755, Paper 42 (PTAB Feb. 14, 2019), which the U.S. Court of Appeals for the Federal Circuit reversed in relevant part on the issue of claim construction. *See Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336, 1339 (Fed. Cir. 2020) (construing the term “encrypted digital information transmission including encrypted information” as limited to digital information). Paper 50, 2–3. The Director agreed, vacating the prior Final Written Decisions, and remanding the cases to address the claim construction set forth by U.S. Court of Appeals for the Federal Circuit. *Id.* at 3.

As such, we determine it is necessary to receive additional briefing from the parties and we set a schedule of that briefing below. Petitioner may file, on or before April 15, 2022, an Opening Brief detailing the applicability of the grounds identified above in view of the claim construction set for by the U.S. Court of Appeals for the Federal Circuit. That Opening Brief will

(“Campbell”).

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be limited to twenty five (25) pages and will discuss all of the grounds of unpatentability set forth in the Petitions of IPR2016-00754 and IPR2016-01520. If additional pages are needed to address all grounds sufficiently, Petitioner may email a request to the Board for additional pages, on or before April 8, 2022, with an explanation of why additional pages are necessary. The panel will inform Petitioner if that request is approved.

Thereafter, Patent Owner may file, on or before May 15, 2022, a Responsive Brief detailing why the grounds identified above are not applicable to the claims of the '635 Patent, and traversing arguments raised by Petitioner. Patent Owner's brief will also be limited to twenty five (25) pages, unless Petitioner was granted additional pages, with Patent Owner limited to the same number, or if Patent Owner determines that additional pages are needed to address all grounds and arguments sufficiently, Patent Owner may email a request to the Board for additional pages, with an explanation of why additional pages are necessary, on or before May 8, 2022. In the latter case, the panel will inform Patent Owner if that request is approved.

Petitioner may seek to file a Reply Brief by requesting the same via email, on or before May 22, 2022, explaining why such briefing is needed, and if approved, Patent Owner will receive the right to file a Sur-Reply Brief subsequently. The timing and page limits of any reply briefing will be determined by the panel. A common heading, applicable to both proceedings, such as that used in this order, may be used by the parties, with a copy of the same briefing to be filed in both proceedings.

It is

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ORDERED that Petitioner may file an Opening Brief, limited to twenty five (25) pages, detailing the applicability of the all of the grounds of unpatentability set forth in the Petitions of IPR2016-00754 and IPR2016-01520, in view of the claim construction set for by the U.S. Court of Appeals for the Federal Circuit, with that brief to be filed on or before April 15, 2022;

FURTHER ORDERED that Patent Owner may file a Responsive Brief, limited to twenty five (25) pages, detailing why the grounds identified above are not applicable to the claims of the '635 Patent, and traversing arguments raised by Petitioner, with that brief to be filed on or before May 15, 2022;

FURTHER ORDERED that additional pages and subsequent briefs may be requested by the parties according the methods described above.

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