

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDERSECRETARY AND DIRECTOR
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLE INC.,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner.

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

Before ANDREW HIRSHFELD, *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.*

ORDER

Personalized Media Communications, LLC (“Patent Owner”) requests Director review of two separate Final Written Decisions issued by the Patent Trial and Appeal Board (“Board”) determining certain claims of U.S. Patent No. 8,559,635 B1 (“the ’635 patent”) unpatentable (IPR2016-00754, Paper 41; IPR2016-01520, Paper 38).¹ See Paper 48; Ex. 3100. The Board found claims 4, 7, 13, 21, and 28–30 unpatentable in IPR2016-00754, and claims 3, 18, 20, 32, and 33 unpatentable in IPR2016-01520. Paper 41; IPR2016-01520, Paper 38. In both decisions, the Board construed the terms “encrypted” and “decrypted,” determining that neither term was limited to scrambling and descrambling operations on digital information, but could also include scrambling and descrambling on analog information. See Paper 41 at 7–18.

Patent Owner argues that Director review is appropriate because the Board erred by adopting erroneous claim constructions for “encrypted” and “decrypted.” Paper 48, 4–9. Patent Owner argues that the Board applied a similar analysis in its final written decision 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 Paper 48 at 1–2, 4–18 (citing *Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336, 1339 (Fed. Cir. 2020) (construing the term “encrypted digital

¹ The Final Written Decision in IPR2016-00754 is representative of both the decisions in IPR2016-00754 and IPR2016-01520. The request for Director review in IPR2016-00754 is also representative of the request in IPR2016-01520. Accordingly, all citations are to IPR2016-00754 Paper and Exhibit numbers, unless otherwise noted.

information transmission including encrypted information” as limited to digital information) (“*PMC*”).

I have considered Patent Owner’s requests. The Board’s claim construction analysis for the terms “encrypted” and “decrypted” in the cases is substantially similar to the Board’s related analysis of the term “encrypted digital information transmission including encrypted information” at issue in the Federal Circuit case noted above. As such, I grant Director review, vacate the prior Final Written Decisions, and remand the cases for the Board to address its claim construction for the terms “encrypted” and “decrypted” in light of the Federal Circuit’s decision in *PMC*. See *PMC*, 952 F.3d at 1339–46.

Based on the foregoing, it is:

ORDERED that the Board’s Final Written Decisions (IPR2016-00754, Paper 41 and IPR2016-01520, Paper 38) are vacated; and

FURTHER ORDERED that the Board shall issue new final written decisions that address the Federal Circuit’s claim construction in *Personalized Media Communications, LLC v. Apple Inc.*, 952 F.3d 1336 (Fed. Cir. 2020).

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

For PETITIONER:

Marcus E. Sernel
Joel R. Merkin
Eugene Goryunov
Gregory S. Arovas
KIRKLAND & ELLIS LLP
msernel@kirkland.com
joel.merkin@kirkland.com
egoryunov@kirkland.com
greg.arovas@kirkland.com

For PATENT OWNER:

Douglas Kline
GOODWIN PROCTER LLP
dkline@goodwinlaw.com

Thomas J. Scott, Jr.
PERSONALIZED MEDIA COMMUNICATIONS, LLC
tscott@pmcip.com