

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

I. INTRODUCTION

Personalized Media Communications, LLC (“Patent Owner”) timely filed a Replacement Request for Rehearing under 37 C.F.R. § 42.71(d) on April 26, 2016. Paper 62 (“Req. Reh’g”).¹ Petitioner’s Request for Rehearing seeks reconsideration of our Final Written Decision (Paper 60, “Dec.”) entered on March 8, 2016, particularly our denial of Patent Owner’s Contingent Motion to Amend (Paper 26, “Mot. to Amend”) the issued claims U.S. Patent No. 7,805,749 B2 (Ex. 1001, “the ’749 patent”) with proposed substitute claims. See Dec. 31–41. Patent Owner alleges the Board misapprehended and overlooked the points made and evidence provided by Patent Owner in showing (1) that the references, individually and in combination, failed to disclose or teach at least one limitation of the substitute claims, and additionally, that (2) there was no apparent reason to combine the references. Reh’g Req. 1.

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 generally challenges our decision on its Motion to Amend and contends that we failed to recognize that the prior art did not teach multiple claim

¹ Patent Owner filed its original Request for Rehearing on April 7, 2016. Paper 61.

limitations because we “failed to consider the substitute claims as a whole” and instead “took a piecemeal approach of only looking at the language presented with the new limitations.”² Reh’g Req. 2 (emphasis omitted). Patent Owner further contends that we failed to recognize missing claim limitations because we repeatedly disregarded the testimony of Patent Owner’s Declarant, Dr. Alfred Weaver (Ex. 2014), whereas in nearly every instance we accorded weight to Petitioner’s Declarant. Reh’g Req. 3.

A. Arguments Regarding Proposed Substitute Claim 56

Patent Owner specifically argues that the prior art of record, alone or combined, is missing the following limitation: “receiving a message over said first communication channel, *responsive to said reply* . . . [and] processing said message to cause said . . . viewing apparatus to connect to a second communication channel.” *Id.* at 6. According to Patent Owner, “the Board parses words so as to eliminate the meaning and significance of the added language as part of the whole claim. *Id.* at 7. Patent Owner further argues:

What the Board completely overlooks is Patent Owner’s showing that the new limitation, when properly considered as part of the claim as a whole, is a significant and patentable advance over the art: It is **in response to a user reply at the receiver station** that a transmitter-side message is received and processed to cause the receiver to change from

² Patent Owner also argues that “[t]he approach taken by the Board infected the analysis from the start, when the Decision states: ‘Patent Owner specifically argues that no single piece of prior art discloses the steps of receiving a message on a first communication channel and causing a viewing apparatus to connect to a second communication channel, wherein the second communication channel is different from the first communication channel. *Id.* at 2.’ Decision at 35. Patent Owner never made that argument or took such a position.” Reh’g Req. 2. We are not persuaded by Patent Owner’s contention that it never made such an argument, because the quoted statement is found on page twelve of Patent Owner’s Contingent Motion to Amend. See Mot. to Amend 12.

a first communication channel to a second communication channel. Motion at 12. The references are completely missing that limitation. All of the references teach a “top-down” approach where a message can be delivered by a central facility (e.g., a head end or other transmitter station) to cause a channel change at a receiver station. None of the references teach a “bottoms-up” approach where a user input at the receiver causes a channel change message from a central facility to be processed to effectuate a communication channel change. This is precisely what is disclosed in the priority specifications, see Ex. 2014 at ¶¶ 139-147, and what is not remotely disclosed or suggested by the prior art.

Id. at 7–8.

Patent Owner then argues that the Campbell references do not disclose, “a **user input** at the receiver station causing the processing of head end transmitted messages that effectuate a change in communication channels.” *Id.* at 8. Patent Owner cites to testimony from its Declarant, Dr. Weaver, as evidence to support its position. See Ex. 2014 ¶¶ 170, 172. According to Patent Owner, the Board assigned no weight to its evidence. Reh’g Req. at 8. Thus, Patent Owner disagrees with our Decision and concludes that none of the references “teach[es] or suggest[s] receiving a message over a first channel **responsive to a user reply** and processing a message . . . from the central facility . . . that causes the television receiver to connect to a different communication channel . . .”, and because this limitation is nowhere found in the art, substitute claim 56 should be confirmed as patentable. *Id.* at 10 (citing Mot. to Amend. 15).

Contrary to Patent Owner’s arguments, we did not misapprehend or overlook its arguments; rather, we disagreed with Patent Owner’s position. Dec. 36. Specifically, we disagreed that none of the references “teach[es] or suggest[s] receiving a message over a first channel **responsive to a user reply** and processing a message . . . from the central facility . . . that causes the television

receiver to connect to a different communication channel” because Campbell teaches that, when pay-per-view programming is selected, the system displays a message requiring the subscriber to enter their key number (prompting whether user wants promoted data) on a keyboard (input device). *Id.*; see Ex. 1033, 26:25–30, 23:33–24:6, Fig. 12, 14:14–28. Furthermore, as discussed in our Decision, Campbell discloses receiving a signal that causes a viewer’s receiver to change channels and that Furukawa describes a television system in which a signal is received from a central facility that causes the television to tune to a different channel. Dec. 36 (citing Opp. 11 (citing Mot. 13, 15; Ex. 1038, 133:4–18, 137:11–24)). Thus, we concluded that the combination of Campbell and Furukawa “receives a message over a first channel responsive to a user reply” as recited in proposed substitute claim 56. *Id.* 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. For the forgoing reasons, Patent Owner has not carried its burden of demonstrating that the Board’s Decision should be modified. See 37 C.F.R. § 42.71(d).

Patent Owner also challenges our Decision and specifically argues that the prior art of record, alone or combined, is missing the following limitation: “message [received] over the first communication channel” is “process[ed] . . . to connect to a second communication channel . . . *for receiving encrypted digital programming.*” Reh’g Req. 10. According to Patent Owner, the Board failed to (1) perform the proper analysis of whether the prior art, alone or together, teach the limitation (*id.* at 11), (2) provide an articulated reasoning explaining how the art is combined or modified to achieved the claimed result (*id.* at 12), and (3) explain why Patent Owner’s showing and evidence was not entitled to any weight (*id.* at 13).

Contrary to Patent Owner’s arguments, we explained that we were not persuaded by Patent Owner’s position regarding claim 56 given the state of the art as shown by Guillou, which we had discussed in detail previously in the Decision. Dec. 38. We specifically stated that Guillou discloses the decryption of digital data (Ex. 2014 ¶ 85) and explains that such technology “could be applied to other systems without difficulty for the man skilled in the art, and notably to the CEEFAX or ORACLE systems or the VIEWDATA or PRESTEL systems.” Dec. 38 (citing Ex. 1022, 21:23–28). We concluded that “we are satisfied that a person of skill in the art would have had reason to use ‘automatic channel tuning’ and apply digital encryption technology in order to ‘transmit messages to a receiver station on a first communication channel that, when processed by the receiver station, causes the receiver station to connect [to] a communication channel different from the first channel to receive encrypted programming or data.’” *Id.* Again, Patent Owner has not shown how we overlooked or misapprehended its arguments or evidence as required by 37 C.F.R. § 42.71(d). Rather, Patent Owner uses its Request for Rehearing as an opportunity to reargue its position; a position with which we disagree. Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a rehearing. Thus, Patent Owner’s challenge does not meet the standard set forth for a request for rehearing. *See* 37 C.F.R. § 42.71(d).

B. Arguments Regarding Proposed Substitute Claim 65

Patent Owner specifically argues that the prior art of record, alone or combined, is missing the following limitation: “processing said message to cause said receiver station to connect to a second communication channel . . . for receiving information transmitted from a *second remote site* . . . including said additional material in encrypted form” as recited in proposed substitute claim 65.

Reh’g Req. 14. According to Patent Owner, the Board’s reliance on the testimony from Petitioner’s Declarant, Mr. Wechselberger, is misplaced because “it is clear that the information (e.g., emergency alert) from a second remote site is **not** transmitted from a second remote site on a second communication channel to the receiver station in Campbell.” *Id.*

Petitioner’s Declarant, Mr. Wechselberger, testifies that the disputed limitation does not require the information to be transmitted directly from the second remote site to the receiver station. Ex. 1035 ¶ 136. Mr. Wechselberger then testifies that the broadest reasonable interpretation of the limitation is that the message may be received either directly or indirectly from a first remote site, and the “additional material” may be received either directly or indirectly from a second remote site. *Id.* Mr. Wechselberger further testifies that an emergency alert signal is received from a first remote site, causing the receiver to switch to a different channel to broadcast an alert message and “[t]he content of the programming on the second channel would come, at least indirectly, from a different remote site ‘to address selected groups such as city officials, police, firemen, national guard and so forth.’” *Id.* at ¶ 137 (citing Ex. 1033 at 18:36-19:5; Ex. 1006 at 12:50-57; Ex. 1007 at 16:13-19).

Upon review and consideration of Mr. Wechselberger in light of the disclosure in Campbell, we agree with Mr. Wechselberger that the claims do not require that information be received directly from a second remote site. Thus, Campbell, Hartung, and Cogswell can be read as disclosing “receiving information transmitted from a second remote site,” even if the information is received indirectly from the second remote site. Dec. 40. Again, Patent Owner has not shown how we overlooked or misapprehended its arguments or evidence as required by 37 C.F.R. § 42.71(d). Rather, Patent Owner uses its Request for

Rehearing as an opportunity to reargue its position; a position with which we disagree. Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a rehearing. Thus, Patent Owner's challenge does not meet the standard set forth for a request for rehearing. *See* 37 C.F.R. § 42.71(d).

Patent Owner further argues that the prior art of record, alone or combined, is missing the following limitation: “decrypting said additional material [***in said second information transmission from a second remote site***] ***based on said control signal [from said] first information transmission*** including mass medium programming” as recited in proposed substitute claim 65. Reh'g Req. 15 (citing Ex. 2028 at 6-7). According to Patent Owner, it demonstrated that this claim feature for using a control signal (e.g., a key) from a first transmission to decrypt digital content delivered in a second transmission was not disclosed or suggested in the art, yet neither the Board's Decision nor Petitioner addressed, much less rebutted, this significant limitation. *Id.* (citing PO Reply 7).

The Board discussed the state of the art as shown by Guillou in detail in the Decision. Dec. 38. We specifically stated that Guillou discloses the decryption of digital data (Ex. 2014 ¶ 85) and explains that such technology “could be applied to other systems without difficulty for the man skilled in the art, and notably to the CEEFAX or ORACLE systems or the VIEWDATA or PRESTEL systems”. Dec. 38 (citing Ex. 1022, 21:23–28). Thus, the application of decryption of digital data transmitted from a second remote site would have been addressed by such technology as taught in Guillou. *Id.* Therefore, we were not persuaded in the Decision that Patent Owner carried its burden to demonstrate the patentability of proposed substitute claim 65. Dec. 39–41.

Accordingly, we deny Patent Owner's request for rehearing by an expanded panel.

IV. ORDER

It is hereby ORDERED that Patent Owner's request for rehearing is *denied*.

For PETITIONER:

Brenton Babcock
Colin Heideman
Kent Shum
Joseph Cianfrani
Jeremy Anapol
Knobbe Martens Olson & Bear, LLP
2BRB@knobbe.com
2cbh@knobbe.com
2kns@knobbe.com
2JSC@knobbe.com
2JAA@knobbe.com

For Patent Owner:

Stephen Schreiner
Phong Dinh
Jennifer Albert
Eleanor Yost
Goodwin Procter LLP
Ce Li
sschreiner@goodwinprocter.com
pdinh@goodwinprocter.com
JAlbert@goodwinprocter.com
EYost@goodwinprocter.com
cli@goodwinprocter.com

Thomas Scott
Personalized Media Communications LLC
tscott@pmcip.com