

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 IPR2014-01534
Patent 7,827,587

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 56 (“Req. Reh’g”). Petitioner’s Request for Rehearing seeks reconsideration of our Final Written Decision (Paper 55, “Decision”) entered on March 22, 2016. Patent Owner disagrees with the Decision due to alleged errors in claim construction. PO Reh’g Req. 1–3.

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.*

A. Construction of Claim Element: “*generating information to complete said incomplete processor instructions*”

Patent Owner requests rehearing of our construction of the term “generating information to complete said incomplete processor instructions” as incorrect, arguing we erred by (i) not applying the ordinary and customary meaning of “generating,” which Patent Owner argues means to “create” or “bring into existence” (PO Reh’g Req. 6); (ii) not following a decision issued previously by another panel of the Board during *an ex parte* appeal of a related patent application (*id.* at 6); and (iii) relying on all embodiments of

the patent specification rather than those identified by the Patent Owner as relevant to the claim term (*id.* at 7–8).

First, as explained in the Decision, when construing the claims at issue (1) we looked at the language of the claims themselves, (2) we consulted the patent’s specification to help clarify the meaning of claim terms, because the claims “must be read in view of the specification, of which they are a part,” *Trading Techs. Int’l, v. eSpeed, Inc.*, 595 F.3d 1340, 1352 (Fed. Cir. 2010) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (en banc), *aff’d*, 517 U.S. 370 (1996)), and (3) we reviewed “the patent’s prosecution history in proceedings in which the patent has been brought back to the [US Patent and Trademark Office] for a second review” (*Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015)). *See* Decision, 20–22.

Second, contrary to Patent Owner’s arguments, we considered the *ex parte* appeal decision rendered by another panel of the Board. Decision, 19–20 (discussing *Ex parte Harvey*, No. 2007-1837 (BPAI Mar. 20, 2009) (Ex. 2001, 18, 39)). The prior decision of another panel of the Board in *Harvey*, however, construed the claim element “generating an image by processing at least one user specific subscriber datum,” but did not construe the claim element “generating information to complete said incomplete processor instructions”; it thus interpreted a different claim phrase than what is at issue here. *See id.* at 19–20 (citing Ex. 2001, 38–40).

Lastly, Patent Owner is correct in that we relied on all the embodiments disclosed in the specification to inform our claim construction. In other words, we have construed the claim element “generating information to complete said incomplete processor instructions” consistently

with the specification of the '587 patent. *In re Suitco Surface, Inc.* 603 F.3d 1255, 1260 (Fed. Cir. 2010). The broadest reasonable interpretation of a claim must be consistent with the specification. *See In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *see also TiVo, Inc. v. EchoStar Communications Corp.*, 516 F.3d 1290, 1298 (Fed. Cir. 2008) (concluding that the claim term “multitude of standards” includes not only broadcast standards of the type set forth in the claim, but also data standards of the type set forth in the written description portion of the specification). Patent Owner cites to no case law holding that only the preferred embodiments of an invention disclosed in a specification are to be used during claim construction. Moreover, merely disagreeing with our analysis or conclusions does not serve as a proper basis for a rehearing, because it does not show an overlooked or misapprehended matter.

For the forgoing reasons, Patent Owner has not shown that the Board misapprehended or overlooked arguments or evidence in construing the claim term “generating information to complete said incomplete processor instructions” to encompass any action that produces data, information, or bits that completes an incomplete processor instruction. Decision, 22.¹ As noted in the Decision, we determined that the Patent Owner’s proposed construction for this limitation is not the broadest reasonable construction. The Request for Rehearing similarly is not persuasive as to Patent Owner’s position on the construction of this claim element. Patent Owner’s arguments regarding this limitation fail to identify what we misapprehended

¹ The construction rendered in the Final Written Decision is the same construction rendered in the Board’s Decision to Institute the *inter partes* review proceeding. *See* Paper 7, 17.

or overlooked as required by 37 C.F.R. § 42.71(d). Thus, 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).

B. Construction of Claim Element: “*incomplete processor instructions*”

Patent Owner challenges our construction of the term “incomplete processor instructions” as incorrect, arguing we erred by (i) not applying the ordinary and customary meaning of “incomplete processor instructions,” which Patent Owner argues means a “set of processor instructions that need to be completed before they can provide their intended function” (PO Reh’g Req. 8); (ii) requiring *in haec verba* support in the specification (*id.* at 9); and (iii) relying on all embodiments of the patent specification rather than those identified by the Patent Owner are relevant to the claim term (*id.* at 9–11).

First, as explained in the Decision, when construing the claims at issue (1) we looked at the language of the claims themselves, (2) we consulted the patent’s specification to help clarify the meaning of claim terms, because the claims “must be read in view of the specification, of which they are a part,” *Trading Techs.*, 595 F.3d at 1352 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d at 979 (en banc), *aff’d*, 517 U.S. 370 (1996)), and (3) we reviewed “the patent’s prosecution history in proceedings in which the patent has been brought back to the [US Patent and Trademark Office] for a second review” (*Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015)). *See* Decision, 14–16.

Second, contrary to Patent Owner’s arguments, we did not require *in haec verba* support in the specification for the challenged claim element.

Rather, we relied on all the embodiments disclosed in the specification to inform our claim construction, because each embodiment was relevant to the claim term and our analysis. *See id.* at 11–12, 17–21. In other words, we have construed the claim element “incomplete processor instructions” consistently with the specification of the ’587 patent. *See In re Suitco Surface, Inc.* 603 F.3d 1255, 1260 (Fed. Cir. 2010). The broadest reasonable interpretation of a claim must be consistent with the specification. *See id.*; *see also TiVo, Inc. v. EchoStar Communications Corp.*, 516 F.3d 1290, 1298 (Fed. Cir. 2008) (concluding that the claim term “multitude of standards” includes not only broadcast standards of the type set forth in the claim, but also data standards of the type set forth in the written description portion of the specification). Patent Owner cites to no case law holding that only the preferred embodiments of an invention disclosed in a specification are to be used during claim construction.

For the forgoing reasons, Patent Owner has not shown that the Board misapprehended or overlooked arguments or evidence in construing the claim term “incomplete processor instructions” to mean “processor instructions to which data, information, or bits must be added prior to the processor instructions being transmitted to, used, or executed by a particular processor.” Decision, 18.² As noted in the Decision, we determined that the Patent Owner’s proposed construction for this limitation is not the broadest reasonable construction. The Request for Rehearing similarly is not

² The construction rendered in the Final Written Decision is the same construction rendered in the Board’s Decision to Institute the *inter partes* review proceeding. *See* Paper 7, 15.

persuasive as to Patent Owner's position on the construction of this claim element.

Patent Owner's arguments regarding this limitation fail to identify what we misapprehended or overlooked 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 has not carried its burden of demonstrating that the Board's Decision should be modified. *See* 37 C.F.R. § 42.71(d).

IV. ORDER

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

IPR2014-01534
Patent 7, 827,587

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