

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFORMATICA CORPORATION,
Petitioner,

v.

PROTEGRITY CORPORATION,
Patent Owner.

CBM2015-00021
Patent 6,321,201 B1

Before KEVIN F. TURNER, MEREDITH C. PETRAVICK, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Informatica Corporation (“Petitioner”) filed a Petition (Paper 1) requesting a review under the transitional program for covered business method patents of U.S. Patent No. 6,321,201 B1 (Ex. 1001, “the ’201 Patent”). Protegrity Corporation (“Patent Owner”) filed a Preliminary Response (Paper 8).

The Board instituted covered business method patent review of the '201 Patent based upon the following grounds:

Ground	Prior Art	Challenged Claims
§ 101	n/a	1–8 and 18–53
§ 103	Hoffman and IBM D2	1, 2, 8, 19–26, 29, 31–34, 37–44, 47, and 49–52
§ 103	Hoffman, IBM D2, and Du	35 and 53

Paper 14 (“Decision”).

Patent Owner filed a Request for Rehearing asking the Board to reconsider its Decision. Paper 19 (“Req.”). We have considered Patent Owner’s request, but decline to modify our Decision in view of the Request.

II. ANALYSIS

A. Standard of Review

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004).

The party challenging the decision has the burden of showing a decision should be modified, and the request for rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). In its Request for Rehearing, the dissatisfied party must (1) “specifically identify all matter that party believes

the Board misapprehended or overlooked” and (2) identify the place where each matter was previously addressed. *Id.*

B. Patent Owner’s Request for Rehearing

i. Misapplication of 35 U.S.C. § 325(a)(1)

Patent Owner argues that the Board ignored the plain language of 35 U.S.C. § 325(a)(1) and the precedential Board decision in *SecureBuy, LLC v. Cardinal Commerce Corp.*, CBM2014-00035 (PTAB April 25, 2014) (Paper 12). Req. 3–4. Patent Owner continues that the statute and *SecureBuy* precludes the present Petition because Petitioner filed a civil action challenging the validity of a claim of the ’201 Patent prior to filing the Petition. *Id.* We do not agree.

We did not ignore the statute or the precedential decision in *SecureBuy*. In *SecureBuy*, the Board determined that 35 U.S.C. § 325(a)(1) applied to covered business method review proceedings, but made no determination as to whether or not a dismissal without prejudice triggered the statutory bar. *See SecureBuy* slip op. at 2–3. Although only an informative Decision, the Board has also determined that “[t]he dismissal of an action without prejudice leaves the parties as though the action had never been brought.” *Ariosa Diagnostics v. Isis Innovation Ltd.*, IPR2012-00022, slip op. at 16–18 (PTAB Sept. 2, 2014)(Paper 166) (citing *Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002)). *See also* Decision 9.

In this case, Petitioner’s filing of a civil action before filing the Petition did not trigger the statutory bar because the civil action was dismissed without prejudice. *See* Decision 9. Dismissal without prejudice does not trigger the statutory bar. *See Cyanotech Corp. v. Bd. of Trustees of*

the Univ. of Ill., IPR2013-00401, slip op. at 11–12 (PTAB Dec. 19, 2013) (Paper 17) (“Excluding an action that de jure never existed from the scope of § 315(a)(1) is consistent with both relevant case law and legislative history.”); *Callidus Software, Inc. v. Versata Software, Inc.*, CBM2013-00052, slip op. at 5–7 (PTAB Mar. 4, 2014) (Paper 21). As such, we did not ignore the statute or the precedential decision in *SecureBuy*, but applied both and took into account that the action for declaratory judgment of non-infringement and invalidity dismissed without prejudice. As well, we also do not agree that we cited to *Ariosa Diagnostics* as authority, as Patent Owner alleges (Req. 4), but rather agreed with the reasoning provided in that informative decision.

ii. CBM Standing — Financial Product or Service

Patent Owner argues that the Board overlooked its arguments concerning standing in a covered business method patent review. Req. 5–7. In particular, Patent Owner argues that the Board overlooked its argument that the claim language does not describe the use of the claimed data processing method as for a financial service and failed to address conflicting panel decisions raised by the Patent Owner. *Id.* at 5.

We did not overlook Patent Owner’s argument. See Decision 11–12. As we stated in our Decision, a covered business method patent “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” *Id.* at 10 (quoting AIA § 18(d)(1)). The “legislative history explains that the definition of covered business method patent was drafted to encompass patents ‘claiming activities that are

financial in nature, incidental to a financial activity or complementary to a financial activity.’” *Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention*, 77 Fed. Reg. 48,734, 48,735 (Aug. 14, 2012) (Final Rule) (quoting 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer)). The legislative history indicates that “financial product or service” should be interpreted broadly. Decision 9.

We do not interpret the statute as requiring the literal recitation of the terms data processing of financial products or services. As recognized in the legislative history: “[t]o meet this [eligibility] requirement the patent need not recite a specific financial product or service. Rather, the patent claims must only be broad enough to cover a financial product or service.” 157 Cong. Rec. S1365 (daily ed. Mar. 8, 2011) (Statement of Sen. Schumer).

Claim 1 recites, “one or more protection attributes stating processing rules for data element values” and “controlling the user’s processing of the given data element value in conformity with the collected protection attribute/attributes.” The Specification discloses the claimed data processing rules are used to protect against unauthorized access of a data portion in a database. *See* Ex. 1001, 4:33–41. The data processing rules can restrict which user or program can access or process the data portion in a database. *Id.* at 4:11–16; 9:20–28. The Specification discloses that banking is a field where protection against unauthorized access to databases that are used for administering and storing sensitive information is desired. *Id.* at 1:27–31. Banking is a financial activity. Further, Figure 5 of the ’201 Patent depicts an example of a user interface by which a person can alter the data processing rules. *Id.* at 11:1–5; Fig. 5. In the example, a “Financial

manager” or “Controller” is a person who is authorized to access a data portion, which is depicted as a “Social allowance” or “Housing allowance” data element type. *See id.* at Fig. 5.

We, thus, are not persuaded by Patent Owner that we abused our discretion in determining that at least claim 1 encompasses a method for performing data processing or other operations that are at least incidental or complementary to the practice, administration, or management of a financial product or service.

Patent Owner also argues that we overlooked its argument regarding allegedly conflicting non-precedential Board decisions, in particular *PNC Financial Services Grp., Inc. v. Intellectual Ventures I, LLC*, CBM2014-00032 (PTAB May 22, 2014)(Paper 13); *J.P. Morgan Chase & Co. v. Intellectual Ventures II LLC*, CBM2014-00160 (PTAB Jan. 29, 2015) (Paper 11); and *Salesforce.com, Inc. v. Applications in Internet Time, LLC*, CBM2014-00162 (PTAB Feb. 2, 2015)(Paper 11). Req. 5–7. Patent Owner cites these decisions to support its argument that a method, which could be used in the financial service industry, is not necessarily eligible for covered business method review. *Id.*

The decisions cited by the Patent Owner are not precedential and are not binding on this panel. Nonetheless, we have reviewed the allegedly conflicting decisions. Our review of these decisions, however, reveals that the determination of whether the patent is a covered business method patent rests upon the specific facts of those proceedings. For example, in *PNC Financial Services*, the Board determined that a showing that the patent was asserted against a financial service in an infringement proceeding was not enough to establish that the patent was a covered business method patent.

See PNC Financial Services, CBM2014-00032, slip op. at 14. The Board stated that whether an allegedly infringing product was a financial service was just one factor and that the Petitioners had not shown how “the ’298 patent, either through its claims, Specification, or prosecution history, encompasses ‘activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.’” *Id.* at 13–14. Similarly in *J.P. Morgan* and *Salesforce*, the Board determined whether the patent was a covered business method patent based upon the particular facts of those proceedings. Patent Owner does not establish that the facts in those proceedings are sufficiently similar to the facts in this proceeding. As discussed above, we determined, based upon the facts in this proceeding, that the ’201 Patent is a covered business method patent.

We, thus, are not persuaded by Patent Owner’s argument that we abused our discretion in determining that at least claim 1 encompasses a method for performing data processing or other operations that are at least incidental or complementary to the practice, administration, or management of a financial product or service.

iii. Technical Solution and Technological Problem

Patent Owner argues that the Board overlooked its argument that the ’201 Patent recites a technological feature that is novel and unobvious over the prior art or solves a technological problem with a technological solution. Req. 7–9. Patent Owner argues that the Board failed to analyze the claims as whole. *Id.*

We did not overlook Patent Owner’s argument in the Preliminary Response. *See* Decision 13–14. First, in the Preliminary Response, Patent Owner argues:

The claims of the '201 Patent recite technological features that were novel and unobvious over the prior art at the time of the invention. For example, independent claims 1 and 8 (and therefore each of their dependent claims) require an unconventional data protection table and a specific association between data processing rules and data element types or data element values. The '201 Patent's claims are directed to protection of data in a first database based on rules stored in a second database.

Prelim. Resp. 21 (citation to the '201 Patent omitted). As we stated in our Decision, a patent need have only one claim directed to a covered business method to be eligible for review (Decision 10), and we determined at least claim 1 does not recite a technological feature that is novel or unobvious over the prior art (*id.* at 14). Patent Owner's argument in the Preliminary Response is not commensurate with the scope of claim 1. Claim 1 recites a data processing method that requires maintaining two separate databases, but data processing computers having databases, which store the data, were known at the time of filing the '201 Patent. *See* Decision 14 (citing Ex. 1001, col. 1, ll. 20–31). Further, a database containing access rules for a data portion in a separate database were known at the time of filing the '201 Patent. *See id.* Mere recitation of known technologies, such as . . . databases typically do not render a patent a technological invention. Decision 12 (citing 77 Fed. Reg. at 48,763–64).

Contrary to Patent Owner's argument, claim 1 does not require an unconventional data protection table, and the mere association between data processing rules and data element types is not novel, as discussed in the Decision. Decision 14.

Second, in the Preliminary Response, Patent Owner argues:

The technical problem, as explained by the '201 Patent specification, is the incomplete data protection in a database that was provided by prior art protection methods and systems, such as “shell protections,” under which data “can often relatively easily be subjected to unauthorized access.” [Ex. 1001] at 2:3–18. The '201 Patent provides a solution to the problem of how to protect information stored in a database from users who might have appropriate access to the database, but should be denied access to sensitive *types* of records in the database.

The technical solution provided by the '201 Patent is (i) associating each data element type with one or more protection attributes “which are stored in a separate data element protection catalogue” and (ii) making compelling calls to the data element protection catalogue when data is requested. *Id.* at 3:44–4:33.

Prelim. Resp. 21–22.

As we stated in our Decision, we were persuaded by Petitioner that the '201 Patent fails to solve a technical problem with a technical solution. Decision 14–15. As discussed in our Decision, claim 1 recites a data processing method that grants access to data only if associated rules are satisfied. The method requires a database comprising data element values, and a separate database comprising data processing rules associated with the data element types. As discussed above, these features were known at the time of filing the '201 Patent.

We, thus, are not persuaded by Patent Owner that we abused our discretion in determining that at least claim 1 of the '201 Patent does not recite a novel or unobvious technological feature and does not solve a technological problem with a technological solution.

iv. “Non-User Based” Requirement

Patent Owner argues that our statement that “[w]e see nothing in the claims that requires the data processing rule to be non-user based” is directly contradicted by the Patent Owner’s argument, the Specification of the ’201 Patent, and the express language of the claims. Req. 9–11 (citing Decision 17). Patent Owner continues that the protection attributes must be linked to a specific category of data, and the data element values, and the data types associated with them, are not users. We do not agree.

Patent Owner’s argument is premised on the binary proposition that the protection attributes are linked to either the individual data element type or the individual user. We can find no such dichotomy disclosed in the Specification of the ’201 Patent, or in the claims; it would appear that a protection attribute could be linked to both a data element type and a user. Nonetheless, our statement in the Decision (Decision 17) follows directly from the language of claim 1, which even in the excerpt provided by Patent Owner (Req. 10), does not recite anything about a user. It is not clear how that claim would require the data processing rule to be non-user based, when no user is cited, and there is no evidence that a data processing rule must be based on either the individual data element type or the individual user, to the exclusion of the other. As such, we are not persuaded that we must reconsider the statement that the claims do not require the data processing rule to be non-user based.

v. Abstract Idea

Patent Owner argues that the Board overlooked its argument that the ’201 Patent is not directed to an abstract idea because the ’201 Patent seeks to solve a “problem [that] is necessarily rooted in computer technology.”

Req. 11–12 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)). Patent Owner states that “[t]he ’201 Patent’s claim language does not comprise mere data gathering steps but rather comprise a novel and unobvious solution to a long-felt problem in the industry—the ability to have field-level protection of data and preventing those with administrative responsibilities from having too much access to confidential information.” *Id.* at 12.

We did not overlook Patent Owner’s argument regarding patent-eligibility in reaching our Decision. As we stated in our Decision, we were not persuaded by Patent Owner’s argument in the Preliminary Response. Decision 21–23 (citing Prelim. Resp. 27–41). In the Preliminary Response, Patent Owner argues that the claims are directed toward protection of data in a database on a more granular level, namely at the data element level. Prelim. Resp. 31 (“[t]he ’201 Patent’s claims provide a solution to a computer technology problem – how to protect data at the data element level, something thought to be technologically not possible.”); *see also* Req. 12. However, the abstract idea we identified is that of “determining whether access to a given data element value in a database should be granted based on whether one or more rules are satisfied.” Decision 21. *See also* Pet. 17. As such, the abstract idea goes directly to the concept of protecting data at the data element level.

Patent Owner also argues that the claims are directed to more than a generic computing device. Req. 12. Such arguments, however, are not commensurate with the scopes of the contested claims, where those claims are drawn to processing of protected data, using conventional databases. Although the claims can be applied to “prevent those with administrative

responsibilities from having too much access to confidential information” (*id.* at 12), nothing in the subject claims themselves explicitly recites or suggests such an intrinsic utility, and is not specifically addressed in the Specification.

We, thus, are not persuaded by Patent Owner that we abused our discretion in determining that the claims of the ’201 Patent are more likely than not directed to a patent-ineligible abstract idea.

vi. Disclosures of Hoffman, IBM DB2, and Du

Patent Owner argues that Hoffman’s formularies, according to its own description, are a set of procedures and cannot be equivalent to a data protection catalogue. Req. 13. Patent Owner continues that formularies are linked to users, whereas the data protection catalogue “requires that protection attributes be linked to data element types independent of the user.” *Id.* at 13. We disagree that we overlooked this argument and/or distinction because we addressed the same in the Decision. *See* Decision 30–31 (discussing that we are persuaded that access rules encompass procedures disclosed in Hoffman). Additionally, challenged claims, like claim 1, do not recite that the protection attributes are independent of the user, only that “protection attributes stat[e] processing rules for data element values (DV).”

Patent Owner also argues that we ignored the inconsistent interpretations of Hoffman provided by Petitioner’s expert, and that we ignored the lack of concrete evidence supporting the contentions made by Petitioner that Hoffman’s formularies satisfy multiple claim limitations. Req. 13–14. We cannot agree, as we addressed Patent Owner’s arguments

in the Decision, and provided a clear description of the portions of Hoffman relied upon in the Petition. *See* Decision 30–32.

Patent Owner also argues that we misapprehended Patent Owner’s arguments that Hoffman lacks a second database. Req. 14–15. Patent Owner continues that even if the blocks “ACCESS” and “CONTROL” in Hoffman are considered databases, they would be two separate databases and that they cannot be a single second database as required by claim 1. *Id.* We do not agree. The “comprising” language found in claim 1 connotes that the claim is not exclusively limited to just the elements recited. *See Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376 (Fed. Cir. 2004). Further, we concur with Petitioner’s argument that “to the extent that the Board does not find that the protection catalog of Hoffman has the claimed protection catalog and data element types stored as data element values, IBM DB2, or the references of the DB2 Documentation, cures this ‘deficiency.’” Pet. 56. Implementing the blocks “ACCESS” and “CONTROL” in Hoffman as a single database would have been motivated to ordinarily skilled artisans for the reasons supplied by Petitioner’s declarant. *Id.*

As such, we are not persuaded by Patent Owner that we abused our discretion in determining that the challenged claims of the ’201 Patent to be more likely than not unpatentable under 35 U.S.C. § 103 over Hoffman, IBM D2, and Du, as proposed by Petitioner.

C. Conclusion

We are not persuaded of an abuse of discretion by Patent Owner.

III. ORDER

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In consideration of the foregoing, it is hereby:
ORDERED that the Request for Rehearing is *denied*.

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