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Paper No. 38
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPICOR SOFTWARE CORPORATION,[1]
Petitioner,

v.

PROTEGRITY CORPORATION,
Patent Owner.

CBM2015-00002
CBM2015-00030
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 REQUESTS FOR REHEARING
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Epicor Software Corporation ("Petitioner") filed a Petition (Paper 1, CBM2015-00002 or "'02 Proceeding") requesting a review under the

[1] During the course of the proceeding, Petitioner separated one of its business units from Epicor Software Corporation to APTOS, Inc., where both entities are indicated as being real parties-in-interest *See* Paper 26.

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 12, '02 Proceeding). Subsequently, Petitioner filed another Petition (Paper 1, CBM2015-00030 or "'30 Proceeding") requesting a review under the transitional program for covered business method patents of an additional claim of the '201 Patent, specifically claim 8. Patent Owner filed a Preliminary Response (Paper 8, '30 Proceeding).

The Board instituted covered business method patent review of the '201 Patent based upon the following ground, combined from both proceedings:

Ground	**Prior Art**	**Challenged Claims**
§ 101	n/a	1, 5, 8, 19, 20, and 27–31

Papers 17 and 13 ('02 Decision and '30 Decision, respectively). The Board did not institute covered business method patent review upon any prior art grounds. *See* '02 Decision 6 and '30 Decision 4–5 (listing grounds proffered by Petitioner).

Patent Owner filed a Request for Rehearing asking the Board to expand the panel and reconsider its Decision. Paper 20, '02 Proceeding ("PO '02 Req."). Patent Owner filed a similar Request for Rehearing in the '30 Proceeding. Paper 16, '30 Proceeding ("PO '30 Req."). Petitioner also filed a Request for Rehearing asking the Board to reconsider its Decision in the '02 Proceeding. Paper 19 ("Pet. Req."). We have considered each of the parties' requests, but decline to modify our Decision in view of either 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 Requests for Rehearing

i. Expanded Panel Request

Patent Owner requests that the panel be expanded to at least five administrative patent judges because, according to Patent Owner, our Decision conflicts with other non-precedential decisions regarding the issue of standing to institute covered business method patent review. *See* PO '02 Req. 1–2.

Discretion to expand a panel rests with the Chief Judge, who, on behalf of the Director, may act to expand a panel on a suggestion from a

judge or panel. *AOL Inc. v. Coho Licensing LLC*, Case IPR2014-00771, slip op. at 2 (PTAB Mar. 24, 2015) (Paper 12) (informative). "[P]arties are not permitted to request, and panels do not authorize, panel expansion." *Id.* The Chief Judge was informed of Patent Owner's request, and the Chief Judge declined to expand the panel.

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. PO '02 Req. 2–5. 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.* According to Patent Owner, "CBM review is not intended for patents that may be relevant to the financial industry but which do not claim activities involved in a financial activity." *Id.* at 2.

We did not overlook Patent Owner's argument. *See* '02 Decision 11. 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 10–12 (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. '02 Decision 10.

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.

Patent Owner also argues that "it is an abuse of discretion to take an excerpt of the Background Art discussion and impose it as a purported limitation of the claims." PO '02 Req. 3. As noted above, however, multiple portions of the Specification of the '201 Patent discuss financial processes, and not merely one specific section. Patent Owner also argues that Figure 5 and its accompanying discussion are drawn to "*personal* data of an identifiable person," and not "incidental or complementary to the practice, administration, or management of a financial product or service." *Id.* We are not persuaded that discussion of "Housing allowance" and "Social Allowance" (Ex. 1001, 11:6–7), are somehow divorced from a financial product or service.

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). PO '02 Req. 4–5. 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. CBM Standing — Technological Invention

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. PO '02 Req. 5–7. 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* '02 Decision 12–13. 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 claim 1 (and its dependent claims) requires 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.

'02 Prelim. Resp. 18–19 (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 ('02 Decision 9), and we determined at least claim 1 does not recite a technological feature that is novel or unobvious over the prior art (*id.* at 12–13). 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* '02 Decision 12–13 (citing Ex. 1001, col. 1, ll. 20–31); *see* Ex. 1002 ¶¶ 16–18. 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. '02 Decision 11 (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. '02 Decision 13.

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. Specifically, 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.

'02 Prelim. Resp. 19.

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 ('02 Decision 12–13). 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. State of the Art

Patent Owner argues that the Board relied on a portion of the Specification of the '201 Patent that talked about the *need* for computers having multiple databases that prevent unauthorized access, but the cited section does not support the Board's conclusion that "[d]ata processing computers having databases, which store the data . . . were known at the time of filing the '201 Patent." PO '02 Req. 7–8 (citing '02 Decision 13). We are not persuaded, however, that the factual finding, made in the Decision, is not supported by substantial evidence. Although Patent Owner suggests that the citation does not support the conclusion, Patent Owner does not argue that the conclusion is incorrect. The conclusion is directed to the use of computers to access databases, and not, as Patent Owner argues, "that existing database architectures at the time of the invention could not implement the invention." PO '02 Req. 8. The conclusion reached in the Decision, i.e., that data processing computers having databases, which store data, were known at the time of filing the '201 Patent, is not incorrect, and Patent Owner has not argued otherwise. We, thus, are not persuaded by Patent Owner that we abused our discretion in discussing the state of the art at the time of filing the '201 Patent.

v. Data Element Type and Encryption Requirements

Patent Owner points out that the claims of the ’201 Patent expressly require both encryption and protection at the data element level, and that our statement that “claim 1 does not require data element types or encryption elements” is clearly erroneous. PO ’02 Req. 8–11 (citing ’02 Decision 13). *See also* PO ’30 Req. 3–6. We agree with Patent Owner that the statement is incorrect, but that single statement does not negate the other analyses provided in the Decision.

In the Decision, we discussed the proper construction of the claim term “data element type,” as well as data processing rules related to encryption. ’02 Decision 15–17. As such, the Decision evidences that the challenged claims recite both encryption and data element types. Additionally, we chose not to institute on any prior art grounds, in part, because of the recitations that the processing rules are based on the data element type. *See* ’02 Decision 25, 28. Thus, we agree that our statement that “claim 1 does not require data element types or encryption elements” is incorrect. The statement was made in the context of determining whether claim 1 solves a technical problem using a technical solution, where we remain persuaded that it does not. We remain persuaded, as discussed above, 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, notwithstanding the errant statement.

We further note that Patent Owner did not present evidence that showed that “databases of the time could ***not*** call out to a second database because such functionality was believed to not be possible.” PO ’02 Req. 10, n.1. Patent Owner does argue that associating each data element type

with one or more protection attributes and making compelling calls to the data element protection catalogue when data are requested, was thought impossible, but that is not necessarily the same as calling out to a second database generally. *See* '02 Prelim. Resp. 19. Similarly, Patent Owner argues that "such an approach was not possible," and "[t]his separation was previously not possible," but does not provide facts or evidence supporting the more general assertion made in the rehearing request. *Id.* at 19–20.

Thus, although we acknowledge the error in our statement made in the Decision, that error was *de minimis*, and we are not persuaded by Patent Owner that we abused our discretion in ultimately determining that claim 1 of the '201 Patent fails to recite a technological feature that is novel and unobvious over the prior art or solves a technological problem with a technological solution.

vi. 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 "provides a solution to a problem necessarily rooted in computer technology." PO '02 Req. 11–12 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014)). *See also* PO '30 Req. 6–10. Patent Owner states that "[t]he Board ignored that Denning expressly states that data protection must be done at the record-level, and not at the data element level." *Id.* at 12 (citing Ex. 1005, 148).

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. '02 Decision 19–20 (citing Prelim. Resp. 25–28). 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. 27 ("the '201 Patent is not directed to some abstract idea, but rather a specific improvement in computing technologies to protect data in a database at the date element level"). 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." '02 Decision 20. *See also* Pet. 20. As such, the abstract idea goes directly to the concept of protecting data at the data element level.

We also could not have ignored Patent Owner's argument regarding the cited disclosure of Denning, i.e., "Denning expressly states that data protection must be done at the record-level." PO '02 Req. 12. Although, Denning is evidence included in the record of this proceeding, Patent Owner does not identify where it was raised in its Preliminary Response with regards to Patent Owner's abstract idea argument, and we can find no such argument in its Preliminary Response. *See* Prelim. Resp. 25–28. We could not have overlooked or ignored an argument that was not raised in the Preliminary Response. Nonetheless, Patent Owner's argument regarding Denning's alleged disclosure that "data protection must be done at the record-level, and not at the data element level" (PO '02 Req. 12) is unpersuasive because that argument mischaracterizes Denning. Denning discloses that there may be problems with doing encryption on a data element level but does not say that it *must* not be done. Ex. 1005, 148 ("enciphering each field of a record as a separate block is not usually

satisfactory"). As such, we are not persuaded that we overlooked or misapprehended Patent Owner's arguments.

Patent Owner also argues that Petitioner identified the claims as being drawn to methods of "shell protection," which is not commensurate with the disclosure of the '201 Patent, and the Petitioner failed to properly analyze the '201 Patent, unnecessarily undercutting the complexity disclosed therein. PO '02 Req. 12–13. We did not overlook Patent Owner's argument that Petitioner failed to provide sufficient analysis and evidence, but rather found it to be unpersuasive. *See* '02 Decision 20. The analysis and evidence provided in a petition must be sufficient to make and support the arguments therein, and we remain persuaded that the claims of the '201 Patent are directed to determining whether access to a given data element value in a database should be granted based on whether one or more rules are satisfied. *Id*.

Patent Owner also continues that the "'201 Patent recites tangible steps," where those tangible steps are not abstract ideas, and are not directed to a fundamental economic practice. PO '02 Req. 13–14. However, the tangibility of the steps may be immaterial if the overall process is directed to an abstract idea, such that those steps attempt to limit their use to a particular technological environment or merely add insignificant post-solution activity. *See Bilski v. Kappos*, 130 S. Ct. 3218, 3230 (2010) (quoting *Diamond v. Diehr*, 450 U.S. 175, 191–92 (1981)). Patent Owner also argues that the claims are directed to more than a generic computing device. PO '02 Req. 13–14. "Computers do not come with the ability to have field-level or data portion-level encryption." *Id*. at 14. 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.*), nothing in the subject claims themselves explicitly recite or suggest 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.

vii. Consideration of Claim 8 in CBM2015-00030

Patent Owner argues that we failed to analyze claim 8 in the CBM2015-00030 proceeding, and merely incorporated our analysis from the CBM2015-00002 proceeding. PO '30 Req. 1–2. Patent Owner continues that we should have analyzed claim 8 to determine whether it was directed to a "technical invention." We disagree. As stated in the '02 Decision and incorporated into the '30 Decision, "[a] *patent* need have only one claim directed to a covered business method to be eligible for review." '02 Decision 9 (citations omitted; emphasis added). Whether the patent can be the subject of a covered business method patent review can be based solely on a single claim, where the instant decision was made based on a review of claim 1. The eligibility of the patent does not change because different claims are being considered, only the viability of specific grounds of unpatentability raised are reviewed on a claim-by-claim basis. As such, we are not persuaded by Patent Owner that we abused our discretion in determining the '201 Patent to be a covered business method patent.

C. Petitioner's Request for Rehearing

Petitioner requests rehearing of our decision not to institute covered business method patent review of specific claims found in grounds of unpatentability denominated as Grounds 4 and 6–8. Pet. Req. 1. Petitioner largely argues that we misperceived the disclosure of Atalla (U.S. Patent No. 4,588,991, and also argues that latter grounds proffered in the Petition, reciting claims charts for various cited references, should have been "considered as merged (but were not considered so merged during the Board's Decision)." *Id*. at 1–2, 9. Although we consider all of Petitioner's arguments below, we are not persuaded that we abused our discretion.

i. Anticipation by Atalla

Petitioner requests rehearing of our decision not to institute covered business method patent review of claims 1, 5, 19, 20, and 27–31, on the ground of anticipation by Atalla. Pet. Req. 3–9. Petitioner asserts that in Atalla, access to a file is based on attributes stored in the authorized files, and that "access is based on individual data element types with associated protection attributes (stating processing rules) in a data element protection catalogue." *Id*. at 5. We do not agree.

Although Atalla discloses authorization to a file based on information about the file, Ex. 1007, 3:27–58, Petitioner has not shown that the information about the file is individual data element types. Overall, Atalla addresses accessing files, in part, based on whether the files were previously accessed, but a file in not the same as an individual data element value. The section of Atalla cited in Petitioner's Rehearing Request discloses the need for a correct key code, but that key code is for the entire file and not specific to the data element type. Pet. Req. 6 (citing Ex. 1007, 3:27–58). Although

"information about the file" could include information about individual data element types, Petitioner has not demonstrated any such teaching or suggestion in Atalla. As stated in the '02 Decision, Atalla "does not describe that access authorization file 15 comprises 'a data element protection catalogue (DPC), which contains each individual data element type (DT) and one or more protection attributes stating processing rules for data element values' as requires by claim 1." '02 Decision 28.

Thus, we are not persuaded by Petitioner that we abused our discretion in denying institution of covered business method patent review of claims 1, 5, 19, 20, and 27–31 over the anticipation ground of Atalla provided in the Petition.

ii. Consideration of "Merged" Grounds 6–8

Petitioner argues that teachings in the corresponding claim charts for Denning, Lang, Atalla, and Hwang should have been considered as merged. Pet. Req. 9. Petitioner continues that it provided the "requisite motivation to combine such teachings as described in the text of the Petition as well as by citation to the Schneier Declaration." *Id*. at 10–11. We do not agree.

As stated in the Decision: "Petitioner's approach of offering a plurality of prior art references for consideration, with the particular and necessary combination to be selected or chosen by the Board is improper." '02 Decision 31. The fact that the group of references might teach every feature of a claim is not persuasive to demonstrate the combination of those references. Similarly, the assertion of Petitioner's declarant, Bruce Schneier, that the aspects could have been combined as "common-sense application of known systems in a known manner with expected outcome," Ex. 1002 ¶ 54, is conclusory and generic. As stated in the Decision: "Petitioner must

identify and articulate clearly each prior art combination relied on to support an assertion of unpatentability based on obviousness." '02 Decision 31. The bare assertions made in the Petition and by Petitioner's declarant do not rise to that standard.

We, thus, are not persuaded by Petitioner that we abused our discretion in denying institution of covered business method patent review of the challenged claims over the "merged" grounds of obviousness provided in the Petition.

D. Conclusion

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

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that each Request for Rehearing is *denied*.

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