

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WOWZA MEDIA SYSTEMS, LLC
and COFFEE CUP PARTNERS, INC.
Petitioner

v.

ADOBE SYSTEMS INCORPORATED
Patent Owner

Case IPR2013-00054
Patent 8,051,287 B2

Before HOWARD B. BLANKENSHIP, THOMAS L. GIANNETTI, and
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

INTRODUCTION

Petitioner (Wowza Media Systems, LLC and Coffee Cup Partners, Inc.) requests rehearing (Paper 15, “Req. Reh’g”) of the Decision entered April 8, 2013 (Paper 12, “Decision”) denying Petitioner’s request for *inter partes* review of claims 1-3, 5, 6, 10, 12-14, 16, 17, 21, 23-26, 28, 29, and 33 of U.S. Patent 8,051,287 B2. A request for rehearing must be in the form of a motion. 37 C.F.R. § 42.20(a). The request must specifically identify all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). When rehearing a decision on petition, a panel will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The request for rehearing is denied.

DISCUSSION

1. Incomplete Petition

First, Petitioner argues that because the Board found that some of Petitioner’s allegations in the Petition did not comply with 37 C.F.R. § 42.104(b)(4)¹, we should treat the Petition as incomplete under § 42.106(a)(1), issue a Notice of Incomplete Petition under § 42.106(b), and provide one month to correct the deficiency. Req. Reh’g 1-2. We are not persuaded by the argument that Petitioner, having failed to meet its statutory burden of proof initially, should now be given a second opportunity on the merits based on supposed procedural deficiencies in the petition, as filed. Petitioner’s argument confuses minimum procedural compliance with 35 U.S.C. § 312(a), necessary to obtain a filing date, with the statutory threshold requirements of § 314(a). Under the statute, the

¹ The subsection requires in part that: “The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon.”

Petitioner has the burden of proving unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). However, the USPTO determines whether a petition for *inter partes* review meets the minimum procedural requirements of the statute without regard to the substance or merits of the challenge.

1. *Filing date – Minimum Procedural Compliance:* To obtain a filing date, the petition must meet certain minimum standards. *See, e.g.,* § 42.106. Generally, the standards required for a petition are those set by statute for the proceeding requested. *See, e.g.,* 35 U.S.C. 312(a). For example, an IPR requires that a complete petition be filed with the required fee, and include a certificate of service for the petition, fee, and evidence relied upon. § 42.106. A complete petition for IPR requires that the petitioner certify that the patent is eligible for IPR and that the petitioner is not barred or estopped from requesting the review, and that the petitioner identify the claims being challenged and the specific basis for the challenge. § 42.104.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48763 (Aug. 14, 2012).

Pointing out where each element of a challenged claim is found in the prior art (37 C.F.R. § 41.104(b)(4)) may be necessary to demonstrate that the statutory threshold for *inter partes* review has been met. However, failure to point out where each element is found in the prior art is a deficiency in the substantive requirements of the petition, as opposed to the minimum procedural requirements of a petition for *inter partes* review.

Moreover, Petitioner requests the relief that we treat the Petition as incomplete and provide one month to correct the deficiency, as permitted by 37 C.F.R. § 42.106(b). This rule does not apply to a failure to meet substantive statutory requirements. Under § 42.106(b), where a party files an incomplete petition (i.e., fails to meet the minimum procedural requirements), “no filing date will be accorded, and the Office will dismiss the petition if the deficiency in the petition is not corrected within one month from the notice of an incomplete

petition.” In short, we are not persuaded that it is an abuse of discretion not to permit Petitioner to submit a “corrected” petition.

2. Sherman Declaration

Petitioner also alleges that we “refused to consider” the Sherman Declaration (Ex. 1002) because it was 100 pages in length and because the Petition supposedly referred to the Declaration in general, without pointing to specific testimony in the Declaration that may relate to specific claim limitations. Req. Reh’g 2-3.

Although Petitioner in the Request repeatedly alleges that we “refused to consider” the Declaration, that was not the case, and nowhere in the Decision did we so state or indicate. We did state that we did not find the Declaration helpful as support for Petitioner’s assertions. Decision 12. We are not persuaded that this was an abuse of discretion. As we noted in the Decision, the Declaration appeared, for the most part, simply to track and repeat the arguments for unpatentability presented in the Petition. *Id.*

Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. 37 C.F.R. § 41.65(a). The U.S. Court of Appeals for the Federal Circuit discounts expert testimony that is not based on the underlying facts or data:

The expert failed to explain how specific references could be combined, which combination(s) of elements in specific references would yield a predictable result, or how any specific combination would operate or read on the asserted claims. Rather, the expert’s testimony on obviousness was essentially a conclusory statement that a person of ordinary skill in the art would have known, based on the “modular” nature of the claimed components, how to combine any of a number of references to achieve the claimed inventions. This is not sufficient and is fraught with hindsight bias.

ActiveVideo Networks, Inc. v. Verizon Communications, Inc., 694 F.3d 1312, 1327 (Fed. Cir. 2012) (holding that district court did not err in granting JMOL of no invalidity). The Sherman Declaration likewise failed to meet the minimum requirements for expert testimony. As a consequence, the Board gave it little weight. This was not an abuse of discretion.

Petitioner in the Request (at 10-11) points to the following portion of the “KSR” section of the Sherman Declaration as supporting obviousness, which we provide as one example of conclusory statements:

The design need and market pressure here was adding encryption to communications, such as RTMP communications, in a way that avoided reverse engineering of the protocol and was backward compatible. Only a few options, at best, could meet this need; one predictable solution was putting cryptographic keys in the preexisting random data section of a network communications. (*See supra* Section III.A.1.d.) A person of ordinary skill in the art would have anticipated success with this approach, and doing so would have been obvious to try.

Sherman Decl. 51. Notably absent from the testimony is an explanation of how specific references might be combined to arrive at the claimed invention; e.g., by combining and applying specific teachings in the references to a claim. *See ActiveVideo Networks*, 694 F.3d at 1328 (“This testimony is generic and bears no relation to any specific combination of prior art elements. It also fails to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*”).

Further, Petitioner refers to exemplary testimony in the Sherman Declaration (Section III.B) that supposedly established the obviousness of the claimed invention in view of Hellman and the so-called RTMP references (Edelman and Toth). Req. Reh’g 4-6. We are not persuaded that anything was misapprehended

or overlooked in considering this testimony. Even assuming, as alleged, that design considerations and demands known in the marketplace would prompt a person of ordinary skill to modify the RTMP references in light of the teachings of Hellman, more is required to show obviousness. As we indicated, the conclusory statements fail to identify any teaching in the applied prior art of establishing an encrypted RTMP session by inserting cryptographic information in a pre-defined, or even preexisting, random data section of the RTMP handshake. Nor do the conclusory statements provide any convincing rationale as to why one of ordinary skill in the art would have chosen to do so. Decision 15.

Petitioner also faults the Board for not quoting accurately from the Petition, omitting some text and a citation to the Sherman Declaration. Req. Reh’g 3, 6. We reproduce below the omitted text, which consists of general allegations relating to the proffered combination of Edelman, Toth, and Hellman.

Also, the teachings of the references described above, as well as design considerations and the demands known in the marketplace would prompt a person of ordinary skill to modify RTMP, as set forth in the RTMP References, when combined with Hellman in the fashion claimed. Doing so would have eliminated the need for additional handshake messages — which slow the process and expend processing power — and would have the additional benefit of obfuscating the cryptographic information, all of which were known design objectives and goals for computer systems and encryption systems. (*See* Ex. 1002, Sherman Declaration, Section III.B.)

Pet. 34-35. We remain of the view, as indicated in the Decision (at 12), that the Petition does not refer to any specific testimony set forth in the Declaration that may relate to specific claim limitations. “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5).

3. Meaning of “Pre-Defined”

Further, as noted in the Decision (at 13), the Petition consistently refers to placing cryptographic information in a “preexisting” portion of a handshake network communication, while the challenged claims specify a “pre-defined” portion of the handshake. In that regard, the Request misquotes the Sherman Declaration as stating that the SSL protocol ““places cryptographic information in the *predefined* portion of the handshake reserved for the random data.”” Req. Reh’g 12 (emphasis added).² The Declaration refers to placing such information in a “header field” that is padded by randomly generated bytes. Sherman Decl. 18. There is no reference there to a “predefined” handshake portion as in Petitioner’s quote. Petitioner now asserts, however, that the Petition uses the term “preexisting” interchangeably for the term “pre-defined,” even though acknowledging that “preexisting” has a broader meaning than “pre-defined.” Req. Reh’g 13. In any event, Petitioner does not appear to challenge our interpretation of “pre-defined” in accordance with its plain and ordinary meaning (Decision 6-7). It is thus unclear why Petitioner requests rehearing on the matter, or why it did not use the term that appears in the claim if they are equivalent.

4. Information Hiding References

Petitioner further alleges that, contrary to the Decision (at 10-11), the Petition provided sufficient analysis of the so-called Information Hiding References (Cole, Giffin, Lucena, Rowland, and Zander). Petitioner points to pages 45 through 46 of the Petition. Req. Reh’g 12-13.

On those two pages of the Petition, in two paragraphs under the heading “Additional Combinations,” Petitioner alleges existence of isolated teachings in ten

² Petitioner also relies on non-existent Sections IV.A1.c and IV.A.1.d of the Sherman Declaration. *Id.*

different references. *See also* Req. Reh’g 8-9, quoting Sherman Decl. at 45-46. As we indicated in the Decision (at 11), there is insufficient analysis in the Petition of Cole, Giffin, Lucena, Rowland, and Zander *as applied to the specific limitations of the claims*. There was nothing misapprehended or overlooked by the Board in evaluating these assertions. In reaching our decision not to institute, we concluded that a combination of two or more of the ten references that might establish a reasonable likelihood of prevailing on the issue of unpatentability was not properly set forth in the Petition. The arguments duly were considered. The threshold question for instituting *inter partes* review does not relate to whether the Board would have known something was obvious to one of ordinary skill in the art (*see* Req. Reh’g 13), or whether the Board can show that some invention would have been obvious based on evidence submitted by a challenger. Rather, the threshold question is whether the information presented in the petition filed under 35 U.S.C. § 311 and any response filed under § 313 shows that there is “a reasonable likelihood that *the petitioner* would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (emphasis added).

CONCLUSION

In view of the foregoing, Petitioner has not carried its burden of demonstrating that the Board’s Decision misapprehended or overlooked any matters. 37 C.F.R. § 42.71(d). The Motion is DENIED.

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