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Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORP.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

Case IPR2014-01516
Patent 7,757,298 B2

Before BENJAMIN D. M. WOOD, HYUN J. JUNG, and GREGG I. ANDERSON, *Administrative Patent Judges.*

JUNG, *Administrative Patent Judge.*

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

I. INTRODUCTION

International Business Machines Corp. ("Petitioner") requests rehearing of our decision denying institution of an *inter partes* review (Paper 7, "Dec.") of claims 1–16 of U.S. Patent No. 7,757,298 B2 (Ex. 1004, "the '298 patent"). Paper 8 ("Reh'g Req.").

The applicable standard for a request for rehearing of an institution decision is abuse of discretion. 37 C.F.R. § 42.71(c). The requirements are set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

> A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request 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.

We grant Petitioner's request insofar as we have reconsidered our interpretation of the challenged claim terms, but we decline to modify our previous decision.

II. DISCUSSION

Petitioner contends that the Board incorrectly concluded that: (1) U.S. Patent No. 5,951,698 to Chen, iss. Sept. 14, 1999 (Ex. 1005) ("Chen") does not disclose "selecting the file based on whether content of the file matches a file type indicated by a name of the file," and (2) U.S. Patent No. 5,848,418 to de Souza, iss. Dec. 8, 1998 (Ex. 1009) ("de Souza") does not disclose "comparing the generated identification value to one or more identification values associated with one or more of a plurality of unauthorized files."

Reh'g Req. 1–13. Petitioner contends that the "Board's errors are rooted in its apparent adoption of erroneous claim interpretations proposed by Patent Owner." *Id.* at 1. Petitioner presents arguments that the Board implicitly construed the terms "selecting" and "comparing" narrower than the broadest reasonable interpretation. *Id.* at 3, 10.

Before moving on to the merits of Petitioner's arguments, we point out that Petitioner did not set forth an explicit proposed interpretation of "selecting" or "comparing" in its petition, and therefore, cannot identify where this matter was addressed in the petition. *See* Paper 1 ("Pet.") 1, 4–6 (proposing interpretations for "unauthorized files," "sequentially-ordered files," and "checksum"); Dec. 6. We, therefore, could not have misapprehended or overlooked something not adequately explained in the initial petition.

As noted by Petitioner, however, "[a]fter the Board renders its decision whether or not to institute trial, if Petitioner believes there are errors in the decision, including the Board's claim construction, Petitioner can request rehearing." Reh'g Req. 15 (quoting *Invensense, Inc. v. STMicroelectronics, Inc.*, Case IPR2013-00241, slip op. at 3 (PTAB Sept. 5, 2013) (Paper 10)). After considering Petitioner's proposed constructions, we are not persuaded that our Decision was incorrect.

A. Chen (Ex. 1005)

Claim 1 of the '298 patent recites "selecting a file . . . wherein selecting the file is performed according to at least one of . . . selecting the file based on whether content of the file matches a file type indicated by a name of the file." Ex. 1004, 12:31–32. Independent claims 10 and 16 also each recite "selecting the file based on whether content of the file matches a

file type indicated by a name of the file" ("the 'selecting' step"). *Id.* at 13:21–22, 14:29–30.

1. Proposed Interpretation of the "Selecting" Step

Petitioner contends that the "Board implicitly construed this 'selecting' step far narrower than its broadest reasonable interpretation, resulting in its erroneous ruling that Chen does not disclose this step." Reh'g Req. 3. Specifically, Petitioner contends that:

> [u]nder the broadest reasonable interpretation standard, a selection based on whether file content matches the file type indicated by the file name may be accomplished by a direct comparison between the two items, a sequence of linked examinations of the indicated file type and file content that demonstrates a mismatch, or some other form of comparison.

Id. at 4. Petitioner also argues that the independent claims do not require "that the system must make an express recognition that it looked for and found a mismatch" or "that all files selected for review are selected based on such a mismatch (i.e., files may be selected for review based on other criteria too)." *Id.* at 4–5 (citing Ex. 1004, claims 1, 10, 16). Petitioner further contends that "content" includes file formatting. *Id.* at 5 (citing Paper 5 ("Prelim. Resp.") 5; Ex. 1004, 7:4–8).

We do not agree that the broadest, reasonable interpretation in view of the Specification of the '298 patent of "selecting the file based on whether content of the file matches a file type indicated by a name of the file" includes selecting based on "a sequence of linked examinations of the indicated file type and file content that demonstrates a mismatch," as argued by Petitioner. First, Petitioner cites to no express definition or disclaimer in the Specification. Reh'g Req. 3–4 (describing Ex. 1004, 7:5–14). Petitioner

instead cites the claims and argues that "the precise process for selecting a file based on a file type mismatch is neither specified in the claim language nor integral to the step" and that the "claims do not require an express 'determination,' merely that the file be selected for further review based on whether or not content of the file matches the indicated file type." *Id.* at 4 (citing Ex. 1004, claims 1, 10, 16). We are mindful that the claims themselves provide substantial guidance as to the particular meaning of the claims, but we also must determine if the Specification of the '298 patent is consistent with Petitioner's proposed interpretation.

Second, Petitioner describes column 7, lines 5–14, of the '298 patent. *Id.* at 3. In the cited portion, the '298 patent states that "the retrieved file is examined to determine whether the file structure is as expected for a file of the indicated type." Ex. 1004, 7:5–7. The '298 patent also states that "[a]lternatively, files can be checked to ensure that they actually contain the type of data described by the file type marker." *Id.* 7:9–10. The '298 patent, thus, supports Petitioner's interpretation that "a selection based on whether a file content matches the file type indicated by the file name may be accomplished by a direct comparison between two items," because it describes a direct comparison. The same portions of the '298 patent, however, do not support Petitioner's interpretation that the "selecting" step also includes "a sequence of linked examinations of the indicated file type and file content that demonstrates a mismatch" because it does not describe an examination of file type and a separate examination of file content that, when linked, demonstrate a mismatch. We determine that, in view of the Specification of the '298 patent, one of ordinary skill in the art would interpret the "selecting" step of independent claims 1, 10, and 16 to include

examining files "to determine whether the file structure is as expected for a file of the type indicated," checking files "to ensure that they actually contain the type of data described by the file type marker," and other, similar alternatives. Petitioner provides no reasoning that the Specification of the '298 patent further describes separate examinations that demonstrate a mismatch. Petitioner's arguments, therefore, do not persuade us that the broadest, reasonable interpretation of the "selecting" step in view of the Specification of the '298 patent further includes "a sequence of linked examinations of the indicated file type and file content that demonstrates a mismatch."

Finally, an interpretation of the "selecting" step that includes "a sequence of linked examinations of the indicated file type and file content that demonstrates a mismatch" would render meaningless, or superfluous, the term "matches" as recited by independent claims 1, 10, and 16. Separate examinations of file type and file content that demonstrate a mismatch allows for no matching at all. Thus, Petitioner does not persuade us to adopt this particular interpretation of the "selecting" step.

2. Chen and the "Selecting" Step

Petitioner contends that Board did not find that Chen discloses "comparing the file content to the file extension" because "the Board applied an unduly narrow construction of the 'selecting' step . . . or the Board failed to recognize the relatedness of Chen's sequence of steps examining the file type indicated by the file name, and file content, to ultimately select certain files for virus scanning based on an indicated file type-file content mismatch." Reh'g Req. 8. Petitioner states that:

> Chen breaks down the comparison process into multiple connected steps—examining the file name to determine if it is a purported .DOC document file (steps 505, 510); then if the file name indicates a .DOC file type, examining file content to determine if it is actually a .DOT template file (steps 515, 520); and then if there is a mismatch, proceeding to select the file for virus scanning (step 525 *et seq.*).

Id. at 9. Petitioner argues that "[b]ecause the previous steps (steps 505, 510) already determined the alleged file type is not a template file, the detection of an embedded macro (steps 515, 520) logically means that there is a mismatch." Reh'g Req. 7 (citing Pet. 13–14, 17–18; Ex. 1005 at 12:23–35, Fig. 5). Petitioner also argues that "Chen further explains that it performs these sequential steps to compare the indicated file type (e.g., a document file) and actual file content (e.g., a template file)." *Id.*

For the reasons discussed above, we do not agree that the broadest, reasonable interpretation of "selecting the file based on whether content of the file matches a file type indicated by a name of the file" in view of the Specification of the '298 patent includes "a sequence of linked examinations of the indicated file type and file content that demonstrates a mismatch." Also, as we determined previously, the portions of Chen relied on in the Petition describe examining the file content and file extension, but not comparing the file content to the file extension. Dec. 11. Thus, after considering our previous analysis in view of Petitioner's proposed interpretation, we determine that Petitioner has not demonstrated Chen discloses "selecting the file based on whether content of the file matches a file type indicated by a name of the file," as recited by independent claims 1, 10, and 16.

Accordingly, we are not persuaded to modify our decision denying institution based on Petitioner's challenge of claims 1, 2, 6, 7, 9–11, and 16 as anticipated by Chen and Petitioner's challenge of claims 3–5, 8, and 12–15 as obvious over Chen and either Ji, Korn, Kim, or admitted prior art, which do not address the deficiency regarding the "selecting" step.

B. de Souza (Ex. 1009)

Independent claims 1 and 10 of the '298 patent recite "comparing the generated identification value to one or more identification values associated with one or more of a plurality of unauthorized files" ("the 'comparing' step"). Ex. 1004, 12:39–41, 13:29–31. Independent claim 16 recites "categorizing the selected file as an unauthorized file based on a comparison of an identification value associated with the selected file with one or more identification values associated with one or more of a plurality of unauthorized files." *Id.* at 14:33–37.

1. Proposed Interpretation of the "Comparing" Step

Petitioner argues that, under the broadest reasonable construction, "generated identification value is 'compared' to one or more identification values associated with an unauthorized file when even a **portion** of the generated identification value is compared to an identification value associated with an unauthorized file." Reh'g Req. 11. Petitioner contends that "there is no requirement that this 'comparing' requires the **entire** generated identification value to be compared to an unauthorized file identification value all at one time." *Id.* We agree with Petitioner's asserted construction of the "comparing" step.

2. de Souza and the "Comparing" Step

Petitioner contends that de Souza discloses the comparing step. Reh'g Req. 12. Petitioner asserts that "at least a portion of the text is copied to buffer memory, the copied portion representing a generated identification value associated with the selected file" and "then compared to words in dictionaries corresponding to objectionable content." *Id.* (citing Pet. 41–42, 44–46; Ex. 1001 ¶¶ 127–129, 131–132; Ex. 1009, 6:48–7:1). Petitioner also argues "that the Board is requiring the **entire** generated value to be compared to words in the dictionaries all at one time." *Id.* at 13.

After reconsidering our analysis in view of Petitioner's asserted construction of "comparing" in claims 1 and 10, we remain unpersuaded that the Petition shows a reasonable likelihood that Petitioner would prevail with respect to its challenged of claims 1, 2, 7, 9–11, and 16 as anticipated by de Souza. *See* Dec. 16–18. Although we agree with Petitioner's asserted construction of the "comparing" step, we do not agree with the arguments as presented in the Petition. A request for rehearing is not an opportunity to supplement the initial petition. *See* 37 C.F.R. § 42.71(d).

As stated in our Decision, we understood Petitioner to be arguing that the extracted, copied words are compared to the words of de Souza's dictionaries. Dec. 17–18 (citing Pet. 41–42). The Petition states that "[o]ne having ordinary skill in the art would have understood that by extracting characters from the selected file and creating a separate copy of those characters for analysis, De Souza generates an identification value representative of at least a portion of the content of the file" and that a "copy of words extracted from the file (i.e., the generated identification value) is then compared to the words in a series of dictionaries." Pet. 41–42 (citing

Ex. 1001 ¶¶ 127–136; Ex. 1009, 6:62–7:19); *see also* Prelim. Resp. 23 (stating "Patent Owner does not agree with Petitioner that 'the first 132 8-byte characters' or 'the entire file' represent an 'identification value' associated with a selected file"). We did not agree with the argument in the Petition because it was not supported by the disclosure of de Souza. Dec. 18 (citing Ex. 1009, 6:62–64). We determined de Souza did not disclose that Petitioner's asserted "generated identification value" was compared. *Id.* Petitioner asserts that we misapprehended its previous arguments based on an unduly narrow interpretation of "comparing" but does not present any persuasive reasons that we misapprehended the Petition's arguments regarding what Petitioner considered the "generated identification value" to be, which we determined was not disclosed in de Souza as being compared.

Accordingly, we are not persuaded to modify our decision denying institution based on Petitioner's challenge of claims 1, 2, 7, 9–11, and 16 as anticipated by de Souza and Petitioner's challenge of claims 3–6, 8, and 12–15 as obvious over de Souza and Farber, which does not address the deficiency regarding the "comparing" step.

C. Opportunity to Respond to Patent Owner's Preliminary Response

Petitioner argues that Patent Owner's Preliminary Response "contained **additional** claim construction arguments, for example, . . . "selecting" and "comparing" . . . passing them off as non-claim construction issues." Reh'g Req. 13 (citing Paper 5, 8–12, 23–25). Petitioner asserts that it, "as the party bearing the burden to show a reasonable likelihood that at least one claim is unpatentable, should have been entitled to the last word on claim construction" and the sequence of events "was fundamentally unfair to [Petitioner], as [Petitioner] never had an opportunity to be heard on these

claim construction disputes [Patent Owner] raised **for the first time** in its preliminary response." *Id.* at 14.

As quoted by Petitioner, we agree that "[a]fter the Board renders its decision whether or not to institute trial, if Petitioner believes there are errors in the decision, including the Board's claim construction, Petitioner can request rehearing." Reh'g Req. 15 (quoting *Invensense*). Having considered Petitioner's arguments regarding the construction of "selecting" and "comparing" limitations as discussed above and our analysis in view of those claim constructions, we are not persuaded to modify our decision denying institution.

III. CONCLUSION

Petitioner's Request for Rehearing is *granted* to the extent that we reconsider our claim construction of the "selecting" and "comparing" limitations of the challenged independent claims, but *denied* in all other respects.

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