

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case IPR2016-00600
Patent 8,533,860 B1

Before GLENN J. PERRY, RAMA G. ELLURU, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

Unified Patents Inc. (“Petitioner”) filed a Request for Rehearing (Paper 14, “Req. Reh’g”) of our Decision Denying Institution of *Inter Partes* Review (Paper 12, “Institution Decision” or “Inst. Dec.”) of U.S. Patent No. 8,533,860 B1 (“the ’860 patent”). Petitioner seeks rehearing of our determination not to institute *inter partes* review of the ’860 patent over several grounds based on DeMello.¹ Req. Reh’g 2. In our decision, we found that Petitioner had not explained sufficiently its arguments that DeMello, either alone or in view of the admitted prior art, teaches the recited “verification token . . . corresponding to the digital content.” Inst. Dec. 9–14, 20–21. Petitioner asserts that we erred as to our factual findings regarding DeMello and improperly required “something more” to make a password or e-mail “correspond” to the digital content. Req. Reh’g 4. Petitioner also asserts that we overlooked its argument that the challenged claims are obvious over DeMello alone. For the reasons that follow, Petitioner’s request for rehearing is *denied*.

I. BACKGROUND

The Petition challenged claims 1–30 of the ’860 patent on the following grounds. Pet. 4, 15–59.

Reference(s)	Basis	Claims Challenged
DeMello	§ 102	1–30
DeMello and “the admitted prior art”	§ 103	1–20
Pestoni ²	§ 102	1–30
Pestoni and “the admitted prior art”	§ 103	1–20

¹ DeMello, U.S. Patent No. 6,891,953 B1, issued May 10, 2005 (Ex. 1006).

² Pestoni, U.S. Publ’n No. US 2008/0313264 A1, published Dec. 18, 2008 (Ex. 1007).

Reference(s)	Basis	Claims Challenged
DeMello and Wiser ³	§ 103	21–30
Pestoni and Wiser	§ 103	21–30
DeMello, Wiser, and Cooper ⁴	§ 103	17 and 30

For the asserted grounds based on DeMello, Petitioner relied on either DeMello or the admitted prior art as teaching the recited “verification token . . . corresponding to the digital content.” Pet. 17–21, 52. We denied institution of these asserted grounds because we were not persuaded by Petitioner’s arguments regarding the teachings of DeMello, either alone or in combination with the admitted prior art.

II. STANDARD OF REVIEW

When rehearing a decision, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). “The burden of showing that a decision should be modified lies with the party challenging the decision.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In its request for rehearing, the dissatisfied party must (1) “specifically identify all matters the party believes the Board misapprehended or overlooked” and (2) identify the place “where each matter was previously addressed.” 37 C.F.R. § 42.71(d); Office Patent

³ Wiser, U.S. Patent No. 6,385,596 B1, issued May 7, 2002 (Ex. 1008).

⁴ Cooper, U.S. Publ’n No. US 2009/0037388 A1, published Feb. 5, 2009 (Ex. 1009).

Trial Practice Guide, 77 Fed. Reg. at 48,768. We address Petitioner’s arguments with these principles in mind.

III. ANALYSIS

As an initial matter, we note that Petitioner argues in the “Introduction” section of its Request for Rehearing that “[b]ecause the Petition shows that *DeMello* discloses this [verification token] limitation, review should have been instituted on at least the reasonable likelihood of prevailing based on anticipation with respect to the independent claims.” Req. Reh’g 2. By contrast, in the “Relief Requested” section, Petitioner submits only that it “requests a rehearing of the Decision and institution of an *inter partes* review (‘IPR’) based on obviousness over *DeMello*.” *Id.* It is not clear whether Petitioner requests rehearing as to the anticipation ground or the obviousness grounds based on *DeMello*. We give Petitioner the benefit of the doubt, however, and assume that Petitioner intended to request rehearing on both anticipation and obviousness grounds. Accordingly, we address both types of grounds below.

Petitioner makes several arguments regarding the teachings of *DeMello*. *DeMello* describes a digital rights management system that distributes and protects rights in content, such as electronic books (eBooks). Ex. 1006, at [57], 4:43–45.

A. “*verification token . . . corresponding to the digital content*”

With respect to anticipation of the challenged claims based on *DeMello*, Petitioner contends that we overlooked “the claim construction discussion in the Petition for a ‘verification token . . . *corresponding to the*

digital content.” Req. Reh’g 4. We disagree with Petitioner’s contention. Although we considered the entirety of the record, we are not obligated to respond in writing to every unpersuasive argument made before us. In its Petition, Petitioner argued that “the construction is the list in *the claim*: one or more of a password, e-mail address, payment system, credit card, authorize ready device, rights token, or one or more redeemable instruments of trade.” Pet. 14 (emphasis added). Petitioner did not identify to which claim it referred. While independent claims 1, 9, and 11 include a listing of these items in defining the recited verification token, independent claim 21 does not. Moreover, claim 11 additionally lists a “key” and a “file.” Petitioner did not explain persuasively why we should have adopted its proposed construction of the recited verification token.

Referring still to its claim construction discussion, Petitioner further contends that “the Petition sets forth that either a password or e-mail satisfies this claim language, which element includes the phrase ‘corresponding to the digital content.’” Req. Reh’g at 4. Petitioner asserts that our Institution Decision “appears to imply something more is needed to make the password or e-mail ‘correspond’ to the digital content,” but that “nothing more is required.” *Id.* According to Petitioner, “[r]equiring anything more would read something into the claim element that was not intended and would vitiate the intent of the claim.” *Id.* at 6. We disagree with Petitioner’s contention. While the recited verification token may take the form of a password or e-mail, not just any password or e-mail automatically satisfies the recited verification token. To satisfy the recited verification token, the password or e-mail must *correspond to the digital content*, as recited in each of claims 1, 9, 11, and 21. This is supported by

the specification of the '860 patent, which teaches that “an *identifier for the digital media* is stored in a database with another database of a list of *associated tokens* for cross-reference identification for verification.” Ex. 1001, 8:53–55; *see also id.* at 8:19–21 (“Subsequently, the membership verification token is authenticated at step 604. The authentication is performed in connection with a token database.”).

Petitioner further contends that “[t]he ‘corresponding to the digital content’ language is clearly a reference to the simple fact that the password, e-mail etc. is to be used to tag the content metadata (the last element of the claim), not that something more is required.” Req. Reh’g 5. We disagree with Petitioner’s contention. The last element of each of claims 1, 9, 11, and 21 recites “writing at least one of the verification token or the identification reference into the metadata.” This claim language does not require the verification token to be written into the metadata, or “to be used to tag the content metadata.”

Lastly, Petitioner contends that “[a]ny password can be used as a verification token; there is no restriction in the claim.” *Id.* at 7. Petitioner further explains that “the claim never says that the password cannot be a ‘retailer’ password,” and that “whether the password belongs to a retailer or not is immaterial.” *Id.* We disagree with Petitioner’s contention. First, we stated in our Institution Decision that “Petitioner does not identify specifically how a retailer password or e-mail in DeMello corresponds to digital content,” not that the recited verification token cannot be a retailer password. Inst. Dec. 10. Second, as discussed above, to satisfy the recited verification token, a password (including a retailer password) must

correspond to the digital content, as explicitly recited in claims 1, 9, 11, and 21.

B. Obviousness over DeMello Alone

With respect to obviousness of the challenged claims based on DeMello, Petitioner contends that we “overlooked the Petition’s argument that the claims are obvious in view of *DeMello* alone, without any of the additional, admitted prior art.” Req. Reh’g 7 (emphasis omitted). According to Petitioner, “the admitted prior art was added, as background information,” and the Petition showed that claim elements [C], [D], and [G] are obvious over DeMello alone. *Id.* at 8, 10, 12. This is a new argument, which does not address what was overlooked or misapprehended in our Decision, and is not appropriate in a request for rehearing. *See* 37 C.F.R. § 42.71(d). For instance, the heading at page 15 of the Petition reads “Ground 1: Claims 1–20 are unpatentable as obvious over *DeMello* (EX1006) in view of the admitted prior art” (emphasis omitted). None of the other headings in the Petition alleges that any of the claims are unpatentable as obvious over DeMello alone. Nor has Petitioner directed us to any portion of the Petition presenting such argument.

We, nonetheless, find Petitioner’s contention unpersuasive. As we noted in our Institution Decision, an obviousness analysis requires “‘some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’” Inst. Dec. 12. With respect to claim elements [C], [D], and [G], Petitioner did not explain sufficiently why one of ordinary skill in the art would have considered modifying DeMello to arrive at the claimed invention. *See id.* at 13; *see also* Req. Reh’g 8 (“A claim can be

rejected as obvious over a single reference by identifying a teaching, suggestion, or motivation (TSM) to modify the single reference to fall within the scope of the claim.”). For example, with respect to claim element [D], Petitioner merely asserts that “*DeMello* describes a browser, which clearly implies or suggests a GUI.” Req. Reh’g 8; *see also id.* at 12 (“one of skill in the art, analyzing the ‘browser’ in *DeMello*, would understand that these browsers obviously have a GUI”); Pet. 23 (“it is obvious that the browser of the reader mentioned in *DeMello* includes a GUI, since browsers provide a GUI”). We are not persuaded that Petitioner has provided adequately articulated reasoning with some rational underpinning to support the legal conclusion of obviousness over *DeMello* alone as to claim element [D]. Similarly, we are not persuaded that Petitioner has provided adequately articulated reasoning with some rational underpinning to support the legal conclusion of obviousness over *DeMello* alone as to claim elements [C] and [G]. *See* Req. Reh’g 10–11; Pet. 20–21, 26–28.

Noting that our Institution Decision addressed claim element [B] with respect to the combination of *DeMello* and the admitted prior art, but not with respect to *DeMello* alone, Petitioner further argues that “[t]he Petition establishes [element [B]] in *DeMello* alone, without the need for additional prior art.” Req. Reh’g 8–9. Element [B] includes the limitation “a verification token . . . corresponding to the digital content.” For the reasons discussed above, we disagree with Petitioner’s contention.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we abused our discretion by not instituting *inter partes* review of the challenged claims of the '860 patent on grounds that were based on DeMello.

V. ORDER

Accordingly, it is ORDERED that Petitioner's request for rehearing is *denied*.

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