

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case IPR2016-00602
Patent 8,887,308 B2

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 12, “Req. Reh’g”) of our Decision Denying Institution of *Inter Partes* Review (Paper 11, “Institution Decision” or “Inst. Dec.”) of U.S. Patent No. 8,887,308 B2 (“the ’308 patent”). Petitioner seeks rehearing of our determination not to institute *inter partes* review of the ’308 patent over grounds based on DeMello¹ as well as grounds based on Pestoni.² See Req. Reh’g 1–2. In our Institution Decision, we determined that Petitioner had not explained sufficiently its arguments that DeMello teaches the recited “credential assigned to the apparatus of (a),” (Inst. Dec. 9–10), or that Pestoni teaches the recited step of “requesting the query data, from the apparatus of (a),” (*id.* at 12–15). Petitioner asserts that we “overlooked and misapprehended” the meaning of “credential.” Req. Reh’g 4 (emphasis omitted). Petitioner also asserts that we overlooked its obviousness argument with respect to the recited “requesting” step. *Id.* at 8. For the reasons that follow, Petitioner’s request for rehearing is *denied*.

I. BACKGROUND

The Petition challenged claim 1 of the ’308 patent on the following grounds. Pet. 3, 19–52.

Reference(s)	Basis
DeMello	§ 102
DeMello, Wieder, ³ and “the admitted prior art”	§ 103
Pestoni	§ 102
Pestoni, Wieder, and “the admitted prior art”	§ 103

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).

³ Wieder, U.S. Patent No. 8,001,612 B1, issued Aug. 16, 2011 (Ex. 1008).

For the asserted grounds based on DeMello, Petitioner relied solely on DeMello as teaching the recited “credential assigned to the apparatus of (a).” Pet. 30–33. Similarly, for the asserted grounds based on Pestoni, Petitioner relied solely on Pestoni as teaching the recited step of “requesting the query data, from the apparatus of (a).” *Id.* at 48–49. We denied institution of these asserted grounds because we were not persuaded by Petitioner’s arguments regarding the teachings of DeMello or Pestoni.

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 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, in the “Relief Requested” section of Petitioner’s Request for Rehearing, Petitioner submits only that it “requests

rehearing of the Decision and institution of an *inter partes* review (‘IPR’) based on obviousness over *Pestoni* in view of *Wieder*.” Req. Reh’g 2. By contrast, Petitioner later presents arguments about the recited “credential,” which our Institution Decision addressed specifically with respect to DeMello. *Id.* at 3–8; Inst. Dec. 9–10. Petitioner also presents arguments about the recited step of “requesting the query data,” which our Decision addressed specifically with respect to *Pestoni*. Req. Reh’g 12; Inst. Dec. 12–15. It is not clear whether Petitioner requests rehearing as to only grounds based on *Pestoni*. We give Petitioner the benefit of the doubt, however, and assume that Petitioner intended to request rehearing on both the grounds based on DeMello and the grounds based on *Pestoni*. Accordingly, we address grounds based on both DeMello and *Pestoni*.

A. “*credential assigned to the apparatus of (a)*”

In our Institution Decision, we agreed with Patent Owner that the specification of the ’308 patent describes the recited “credential” as an API Key that “[is] usually embedded in the source code of the apparatus,” which “uses the API Key to establish a data exchange session with the API.” Inst. Dec. 9 (citing Ex. 1003, 10:51–66); Prelim. Resp. 28–29.

Petitioner now contends that we “overlooked and misapprehended the meaning of ‘credential.’” Req. Reh’g 3 (emphasis omitted). In particular, Petitioner points out that the portion of the ’308 patent on which we relied “nowhere uses the term ‘credential.’” *Id.* Petitioner further points out that “[t]he term ‘credential’ . . . is everywhere consistently used in the ’308 *Patent* to refer to ‘membership credentials’ or ‘password credentials’ which are provided by the ‘excelsior enabler’ (user).” *Id.* We are unpersuaded by

Petitioner's contention. While the portion of the '308 patent on which we relied does not use the term "credential," it describes the API Key as a part of an "access authentication system." Ex. 1003, 10:52–53. Given this description, the API Key may satisfy the recited credential, even though it is not expressly referred to as a "credential" in the specification of the '308 patent.

Petitioner further contends that the passage "following immediately after the API discussion [in the '308 patent] quoted by Patent Owner, makes it clear that the API key is different from the credential." Req. Reh'g 4 (citing Ex. 1003, 11:8–14). We are unpersuaded by Petitioner's contention. As Petitioner points out, this passage, as well as several other passages throughout the '308 patent, refers to "membership credentials." *Id.* at 3–6. That does not mean, however, that these membership credentials describe the recited credential. Indeed, the membership credentials in the '308 patent are assigned to a *user*. *See id.* The recited credential, on the other hand, must be assigned to an *apparatus*.

Petitioner further contends that "[t]he claim language, interpreted in view of the specification, refers to a 'credential assigned to the apparatus of (a)' as a *user* membership credential submitted through the user device (apparatus), and thereby 'assigned' to the apparatus." *Id.* at 6. We are unpersuaded by Petitioner's contention. As discussed above, the '308 patent describes both credentials assigned to a user and credentials assigned to an apparatus. Claim 1 expressly requires the recited credential to be assigned to an apparatus, not a user. This is supported by the specification of the '308 patent, which describes an API Key that "[is] usually embedded in the

source code of the apparatus,” which “uses the API Key to establish a data exchange session with the API.” Ex. 1003, 10:51–66.

Petitioner further contends that the Petition defined the claim term “credential” as “*any information or data that permits access to a service, such as a user name, phrase, e-mail address, certificate, other login or password.*” Req. Reh’g 6; Pet. 17–18. We are not persuaded by Petitioner’s contention. As Patent Owner argued in its Preliminary Response, Petitioner’s proposed construction “include[s] credentials assigned to a user when the claim term language itself specifically limits the credential as one assigned to the apparatus.” Prelim. Resp. 20–21. Given that claim 1 requires the “credential” to be assigned to an apparatus, rather than a user, Petitioner has not explained persuasively why we should have adopted its proposed construction of the recited credential.

Petitioner further contends that Patent Owner’s discussion of the prosecution history for the ’308 patent is misleading. We are not persuaded by Petitioner’s contention, however, because we did not rely on Patent Owner’s discussion of the prosecution history in our Institution Decision.

Lastly, Petitioner contends that:

[C]laim 1 must be interpreted, as was done in the claim construction in the Petition, to consider the whole point of the ’308 Patent – an existing (unmodified) password, e-mail, etc. is used to verify the user by a 3rd party (e.g., an Amazon or Facebook login), and then a verification token or “query data” (e.g., Facebook ID) is written to an “authorization object” (e.g., media metadata) to restrict the digital content to the users with such password, e-mail, etc.

Req. Reh’g 8. We are unpersuaded by Petitioner’s contention. Using a password or e-mail to verify a *user* is only a part of the claimed invention of

the '308 patent. See Ex. 1003, 14:42–43 (claim 1 reciting “verification data provided by at least one user”). As discussed above, claim 1, which defines the invention of the '308 patent, further recites a “credential assigned to the apparatus of (a).” Petitioner does not give sufficient weight to this part of the invention, which uses a credential (e.g., API Key) to verify an *apparatus*.

B. “requesting the query data, from the apparatus of (a)”

In our Institution Decision, we determined that Petitioner did not demonstrate a reasonable likelihood of prevailing on its assertion that claim 1 would have been obvious over Pestoni, Wieder, and the admitted prior art because “we [we]re not persuaded that Petitioner ha[d] provided adequately articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” as to the recited step of “requesting the query data, from the apparatus (a).” Inst. Dec. 14–15. We noted that Petitioner did not, for example, proffer any reason for combining Pestoni and any other patent or printed publication to arrive at the claimed invention. *Id.* at 14.

Petitioner now contends that we “overlooked the obviousness argument for ‘requesting the query data.’” Req. Reh’g 8 (emphasis omitted). According to Petitioner, “[t]he Petition certainly offers reasons to combine with *Wieder* for the token database . . . , but [the requesting step] doesn’t require combination because it is obvious from *Pestoni* alone.” *Id.* at 9. We disagree with Petitioner’s contention. 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. 14 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Even if the recited requesting step “doesn’t require

combination” with another patent or printed publication, Petitioner did not explain sufficiently *why* one of ordinary skill in the art would have considered modifying Pestoni to arrive at the claimed invention. *See id.* For instance, Petitioner merely asserted, without further explanation, that “it would be obvious to one of skill in the art to implement *Pestoni* with a request and corresponding reception.” Pet. 49. Accordingly, we are not persuaded that Petitioner has provided adequately articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as to the recited requesting step. *See Kahn*, 441 F.3d at 988.

Petitioner further contends that the recited requesting step “is certainly obvious because it is explicitly mentioned as an option in *Pestoni*.” Req. Reh’g 9. In support of this contention, Petitioner points out that “[t]he Federal Circuit has held that trying one of multiple options mentioned in a reference is obvious.” *Id.* (citing *Bayer Schering Pharam A.G. v. Barr Labs., Inc.*, 575 F.3d 1341 (Fed. Cir. 2009)). This is a new argument, however, which does not address what was overlooked or misapprehended in our Institution Decision, and is not appropriate in a request for rehearing. *See* 37 C.F.R. § 42.71(d).

We, nonetheless, find Petitioner’s contention unpersuasive. Claim 1 recites “requesting the query data, from the apparatus of (a), . . . wherein the query data request is a request for the at least one verified web service [account] identifier.” As explained in our Institution Decision, “the device (apparatus of (a)) in Pestoni sends to the license server a content license request (query data), which includes various parameters such as a domain ID (web service account identifier).” Inst. Dec. 12–13 (citing Ex. 1007 ¶ 72). That is, Pestoni describes *receiving* the domain ID from the device.

Petitioner asserts that the recited requesting step “is explicitly mentioned as an option in *Pestoni*,” but Petitioner does not direct us to any portion of *Pestoni* that discusses *requesting* the domain ID from the device. See Req. Reh’g 9. Instead, Petitioner points out that we noted in our Institution Decision that “*Pestoni* describes the content license request (query data) from the device as ‘optionally’ including the domain ID (web service account identifier).” See Req. Reh’g 9; Inst. Dec. 13. That the content license request optionally includes the domain ID does not suggest that the license server may *request* the domain ID; rather, it suggests that the license server may *receive* the domain ID.

Petitioner further contends that “the Petition articulates that the generated content license of *Pestoni* has the domain ID, which would make it obvious to obtain the domain ID from the ‘apparatus of (a),’ which is the apparatus providing the request for digital content.” Req. Reh’g 9. We are unpersuaded by Petitioner’s contention. As discussed above, Petitioner has not directed us to any portion of *Pestoni* that teaches or suggests requesting the domain ID from the device. Moreover, for the reasons discussed above, we are not persuaded that Petitioner has provided adequately articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as to the recited requesting step. See *Kahn*, 441 F.3d at 988.

Petitioner further contends that our Institution Decision “also overlooks the discussion of element c), which is somewhat redundant with element d).” Req. Reh’g 10. Element c) recites, in part, “wherein the data exchange session is also capable of an exchange of query data, wherein the query data comprises at least one verified web service account identifier,” while element d) refers to the recited requesting step (i.e., “requesting the

query data, from the apparatus of (a), . . . wherein the query data request is a request for the at least one verified web service [account] identifier”). See Pet. 48–49. According to Petitioner, “to the extent the request isn’t explicit, it is certainly obvious” based on the cited portions of Pestoni on which Petitioner relies for element c). Req. Reh’g 11. We disagree with Petitioner’s contention. As with element d), the cited portions of Pestoni on which Petitioner relies for element c) teach *receiving* the domain ID, not *requesting* the domain ID. See *id.*; Req. Reh’g 10–11. Moreover, we are not persuaded that Petitioner has provided adequately articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as to element c). See *Kahn*, 441 F.3d at 988.

We note that Petitioner asserts that “[t]he opinion of expert Mr. Cherukuri is that, upon reading *Pestoni*, one of skill in the art would understand that the content license generator 260 [of the license server] requests and receives the domain ID before generating the content license.” Req. Reh’g 11. Petitioner further contends that “[t]his demonstrates that one of skill in the art would find such a request to be obvious from *Pestoni*.” *Id.* (citing Ex. 1009 ¶¶ 98–101). Again, we are not persuaded that Petitioner or Mr. Cherukuri has provided adequately articulated reasoning with some rational underpinning to support the legal conclusion of obviousness as to the recited requesting step. See *Kahn*, 441 F.3d at 988.

Lastly, Petitioner contends that, “[a]s presented in the Petition, each element is shown by, and obvious in light of, *Pestoni* alone.” Req. Reh’g 12. For the reasons discussed above with respect to the recited requesting step, 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 claim of the '308 patent on grounds that were based on DeMello or Pestoni.

V. ORDER

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

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