

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS INC.,  
Petitioner,

v.

WILLIAM GRECIA,  
Patent Owner.

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Case IPR2016-00789  
Patent 8,402,555 B2

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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 9, “Req. Reh’g”) of our Decision Denying Institution of *Inter Partes* Review (Paper 8, “Institution Decision” or “Inst. Dec.”) of U.S. Patent No. 8,402,555 B2 (“the ’555 patent”). Petitioner seeks rehearing of our determination not to institute *inter partes* review of the ’555 patent over grounds based on DeMello<sup>1</sup> as well as grounds based on Pestoni.<sup>2</sup> Req. Reh’g 2. In our decision, we determined that Petitioner had not explained sufficiently its arguments that DeMello teaches the recited “membership verification token . . . corresponding to the encrypted digital media,” (Inst. Dec. 9–10), or that Pestoni teaches the recited “GUI” or “API,” (*id.* at 15–16). Petitioner asserts that we “overlooked discussion in the Petition of how the verification token corresponds to the digital content.”<sup>3</sup> Req. Reh’g 3 (emphasis omitted). Petitioner also asserts that we “overlooked the obviousness argument for the claimed ‘GUI’ and ‘API.’” *Id.* at 10 (emphasis omitted). For the reasons that follow, Petitioner’s request for rehearing is *denied*.

## I. BACKGROUND

The Petition challenged claims 1–26 of the ’555 patent on the following grounds. Pet. 4, 14–59.

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<sup>1</sup> DeMello, U.S. Patent No. 6,891,953 B1, issued May 10, 2005 (Ex. 1005).

<sup>2</sup> Pestoni, U.S. Publ’n No. US 2008/0313264 A1, published Dec. 18, 2008 (Ex. 1006).

<sup>3</sup> Throughout its Request for Rehearing, Petitioner refers to “digital content,” while the claims recite “encrypted digital media.” We treat Petitioner’s reference to digital content as a reference to the recited “encrypted digital media.”

| Reference(s)                                                         | Basis | Claims Challenged      |
|----------------------------------------------------------------------|-------|------------------------|
| DeMello                                                              | § 102 | 1–6, 8–22, 24, and 25  |
| DeMello, Wieder, <sup>4</sup> and<br>“the admitted prior art”        | § 103 | 1–10, 12–15, and 17–24 |
| Pestoni                                                              | § 102 | 1–10, 12–15, and 17–24 |
| Pestoni, Wieder, and<br>“the admitted prior art”                     | § 103 | 1–10, 12–15, and 17–24 |
| DeMello, Wieder, Wiser, <sup>5</sup> and<br>“the admitted prior art” | § 103 | 11, 16, 25, and 26     |
| Pestoni, Wieder, Wiser, and<br>“the admitted prior art”              | § 103 | 11, 16, 25, and 26     |

For the asserted grounds based on DeMello, Petitioner relied on either DeMello or the admitted prior art as teaching the recited “membership verification token . . . corresponding to the encrypted digital media.” Pet. 17–21, 52. For the asserted grounds based on Pestoni, Petitioner relied on either Pestoni or the admitted prior art as teaching the recited “GUI” and “API.” *Id.* at 33; *see id.* at 29 (citing Ex. 1009, Exhibit D). We denied institution of these asserted grounds because we were not persuaded by Petitioner’s arguments regarding the teachings of DeMello or Pestoni, 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.

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<sup>4</sup> Wieder, U.S. Patent No. 8,001,612 B1, issued Aug. 16, 2011 (Ex. 1007).

<sup>5</sup> Wiser, U.S. Patent No. 6,385,596 B1, issued May 7, 2002 (Ex. 1008).

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 that it “requests a rehearing of the Decision and institution of an *inter partes* review (‘IPR’) based on anticipation and/or obviousness in view of *DeMello* and/or *Pestoni*.” Req. Reh’g 2; *see also id.* at 3 (“IV. MATTERS OVERLOOKED – ANTICIPATED BY AND/OR OBVIOUS IN VIEW OF *DEMELLO*”) (emphasis omitted); *id.* at 10 (“V. MATTERS OVERLOOKED – OBVIOUS IN VIEW OF *PESTONI*”) (emphasis omitted). By contrast, Petitioner later presents arguments about the recited “membership verification token . . . corresponding to the encrypted digital media,” which our Institution Decision addressed specifically with respect to anticipation by *DeMello*. *Id.* at 3–9; Inst. Dec. 9–10. Petitioner also presents arguments about the recited “GUI” and “API,” which our Institution Decision addressed specifically with respect to anticipation by *Pestoni*. Req. Reh’g 10–13; Inst. Dec. 15–16. In addition, Petitioner presents arguments about the recited “token database” in relation to anticipation by *DeMello* and

Pestoni. Req. Reh’g 9–10, 13–14. Given the substance of Petitioner’s arguments, we address only the anticipation grounds based on DeMello and Pestoni.

A. “*membership verification token . . . corresponding to the encrypted digital media*”

With respect to the anticipation ground based on DeMello, Petitioner argues that “the Decision misapprehends the discussion in the Petition for ‘a membership verification token . . . corresponding to the digital content,’” pointing out 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 4; *see also id.* at 6 (noting that claim 2 lists a password as satisfying the recited membership verification token). 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.* at 5. 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 7. We are unpersuaded by Petitioner’s argument.

While the recited membership verification token may take the form of a password or e-mail, not just any password or e-mail automatically satisfies the recited membership verification token. To satisfy the recited membership verification token, the password or e-mail must *correspond to the digital media*, as recited in each of independent claims 1, 12 and 15. *See also* Inst. Dec. 7 (construing the claim phrase “the request comprising a membership verification token provided by a first user, corresponding to the

encrypted digital media” such that the language “corresponding to the encrypted digital media” modifies the membership verification token). This is supported by the specification of the ’555 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, 8:52–55 (emphasis added); *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 argues 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 6; *see also id.* at 4 (“[w]hether [the claim phrase ‘corresponding to the encrypted digital media’] modifies the request or the membership verification token, the meaning is the same – ‘corresponding’ refers to the later writing to meta data.”); *id.* at 8 (“The Decision overlooks the above described discussion that ‘corresponding’ refers to the later writing of the ‘digital media’ to the meta data,” giving meaning to ‘digital media.’”). We are unpersuaded by Petitioner’s argument. As discussed above, the membership verification token is associated (or corresponds) with the digital media for verification (or authentication) purposes. Ex. 1001, 8:52–55. Such verification occurs at step 604. *Id.* at 8:19–21. The last element of each of independent claims 1, 12, and 15 recites “branding metadata of the encrypted digital media by writing the membership verification token . . . into the metadata.” The ’555 patent teaches that such branding occurs at a later step 612. *Id.* at 8:27–30,

Fig. 6. Thus, the recited “corresponding” language in the claims does not necessarily refer to “the later writing to meta data,” as Petitioner argues.

Petitioner further argues that “[a]ny password can be used as a verification token; there is no restriction in the claim.” Req. Reh’g 8. Petitioner further explains that “the claim never says that the membership verification token cannot be a ‘retailer’ password,” and that “whether the password belongs to a retailer or not is immaterial.” *Id.* We are unpersuaded by Petitioner’s contention. First, we stated in our Institution Decision that “Petitioner does not provide persuasive explanation as to how a *retailer* password or e-mail corresponds to *digital media*,” not that the recited membership verification token cannot be a retailer password. Inst. Dec. 10. Second, as discussed above, to satisfy the recited membership verification token, a password (including a retailer password) must *correspond to the digital content*, as explicitly recited in claims 1, 12, and 15.

Lastly, Petitioner argues that:

This element must be interpreted to consider the whole point of the ’555 *Patent* – an existing (unmodified) password, e-mail, credit card number, etc. is used as a “verification token” to verify the user by a third party (*e.g.*, Amazon® or Facebook®), and then the verification token (*e.g.*, Amazon® or Facebook® login) or identification reference (*e.g.*, Facebook® ID) is written to metadata to restrict the digital content to the users with such password, e-mail, etc.

Req. Reh’g 5–6. We are unpersuaded by Petitioner’s argument. As discussed above, that a membership verification token (such as a password, e-mail, or credit card number) corresponds to digital media is not inconsistent with using the membership verification token to verify a user

and then writing the membership verification token to metadata to restrict digital content to users with such membership verification token. *See* Ex. 1001, 8:19–21, 8:27–30, 8:52–55.

*B. “GUI” and “API”*

With respect to the anticipation ground based on Pestoni, Petitioner argues that we overlooked its obviousness argument regarding the recited “GUI” and “API.” Req. Reh’g 10. We are unpersuaded by Petitioner’s argument in this regard because arguments directed to obviousness are inapposite in a ground based on anticipation.

Petitioner further argues that, “[i]n a space-limited petition, where PTAB wants concise arguments, no extensive explanation of such a basic claim element [i.e., a GUI or an API,] should be needed to show obviousness or inherency in a prior art publication.” *Id.* at 11. We are unpersuaded by Petitioner’s argument. Under 35 U.S.C. § 312(a)(3), a petition must identify, “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” Our rules further require that a petition must identify “[h]ow the construed claim is unpatentable under the statutory grounds identified” and “where each element of the claim is found in the prior art,” and must explain the “relevance of the evidence to the challenge raised.” 37 C.F.R. § 42.104(b); *see also* 37 C.F.R. § 42.22(a)(2) (requiring a petition to include a “full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence”). The Petition failed to meet these requirements sufficiently for the asserted ground of anticipation based on Pestoni. *See* Inst. Dec. 15–16

(explaining that Petitioner’s “reliance on Mr. Cherukuri’s declaration testimony is an improper incorporation by reference of arguments asserted in a declaration”).

Petitioner further argues that Patent Owner’s discussion of the prosecution history for the ’555 patent is misleading. Req. Reh’g 12. We are unpersuaded by Petitioner’s argument, however, because we did not rely on Patent Owner’s discussion of the prosecution history in our Institution Decision.

Lastly, Petitioner argues that:

Element c) of claim 1 must be interpreted, as was done in the Petition, to consider the whole point of the ’555 Patent – an existing (unmodified) password, e-mail, etc. is used to verify the user by a 3<sup>rd</sup> 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 13. We are unpersuaded by Petitioner’s argument because what Petitioner refers to as element c) does not include the recited GUI or API. See Pet. 31–32. In addition, Petitioner has not discussed how either of the terms “GUI” and “API” should be interpreted.

### *C. “token database”*

Petitioner argues that all the elements of claim 1 are shown by each of DeMello and Pestoni, pointing out that, “[w]hile the Decision says the Petition has not shown the obviousness to combine Wieder (token database) with DeMello [or Pestoni], the Decision does not dispute that such a database is inherent in DeMello [and Pestoni].” Req. Reh’g 9, 13 (emphasis omitted). Even if each of DeMello and Pestoni discloses a “token database,”

as recited in claim 1, we are unpersuaded by Petitioner's argument that all the elements of claim 1 are shown by each of these references. As discussed above, we are not persuaded that DeMello discloses the recited "membership verification token . . . corresponding to the encrypted digital media," or that Pestoni discloses the recited "GUI" and "API."

#### 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 '555 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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