

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DISH NETWORK L.L.C.,  
Petitioner,

v.

WILLIAM GRECIA,  
Patent Owner.

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Case IPR2016-01519  
Patent 8,887,308 B2

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Before RAMA G. ELLURU, JAMES B. ARPIN, and  
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

DISH Network L.L.C. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claim 1 of U.S. Patent No. 8,887,308 B2 (Ex. 1001, “the ’308 patent”). William Grecia (“Patent Owner”) filed a Preliminary Response (Paper 5, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we decline to institute an *inter partes* review.

## I. BACKGROUND

### A. *Related Proceedings*

The parties identify nine federal district court cases involving the ’308 patent. Pet. 2; Paper 4. The parties also identify four related petitions for *inter partes* review. Pet. 2; Paper 4.

### B. *The ’308 Patent*

The ’308 patent describes a digital rights management system that manages access rights across a plurality of devices via digital media personalization to protect digital media subject to illegal copying. Ex. 1001, 1:20–27, 4:48–49. The system includes a first receipt module, an authentication module, a connection module, a request module, a second receipt module, and a branding module. *See id.* at Fig. 1. The first receipt module receives a branding request from a user (content acquirer). *Id.* at 5:46–48. The branding request is a read and write request of metadata of the digital media and includes a membership verification token corresponding to

the digital media. *Id.* at 5:48–51. The authentication module authenticates the membership verification token. *Id.* at 5:57–58. The connection module establishes communication with a communication console. *Id.* at 5:59–61. The request module requests an electronic identification reference from the communication console. *Id.* at 6:5–7. The second receipt module receives the electronic identification reference. *Id.* at 6:7–9. The branding module brands metadata of the digital media by writing the membership verification token and the electronic identification reference into the metadata. *Id.* at 6:9–12.

Figure 3 of the '308 patent, which illustrates this process, is reproduced below.

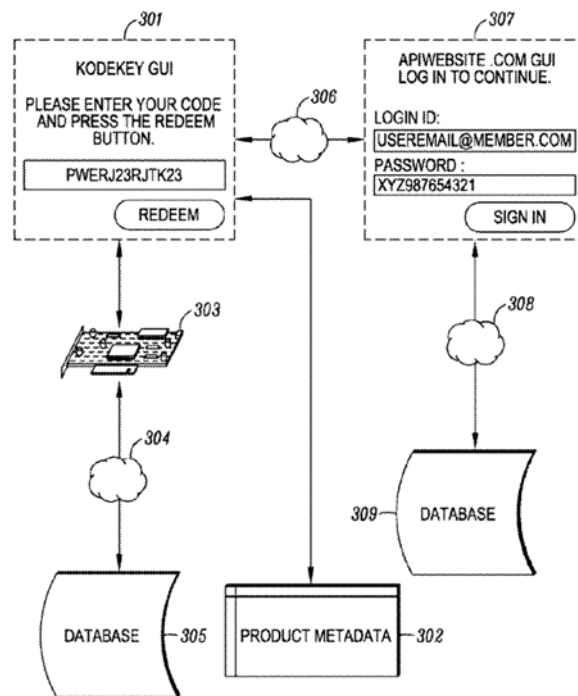


FIG. 3

Figure 3 is a flow chart of a digital media personalization process. *Id.* at 4:24–26. A user (i.e., content acquirer) posts a branding request via Kodekey GUI 301, which prompts the user to enter a token and press the

redeem button. *Id.* at 6:66–7:4. Kodekey GUI 301 is connected to token database 305, which is used to authenticate the token. *Id.* at 7:7–8, 8:20–22. After authentication, the user is redirected to APIwebsite.com GUI 307, which prompts the user to enter a login ID and password to access the digital media from database 309. *Id.* at 7:11–12, 15–18. The APIwebsite.com GUI interfaces to a web service membership (e.g., Facebook), where an electronic identification for the user is collected and sent to Kodekey GUI 301. *Id.* at 7:11–15, 10:41–44. Kodekey GUI 301 also is connected to product metadata 302, which is readable/writable metadata associated with the digital media to be acquired. *Id.* at 7:4–5. Product metadata 302 is branded by writing the token and the user’s electronic identification reference into the metadata. *Id.* at 8:28–31, 11:24–27. For a subsequent access request, the user’s electronic identification reference is compared against the electronic identification reference in metadata 302. *Id.* at 13:54–56. If there is a match, access rights are granted to the user. *Id.* at 13:56–58.

### *C. Challenged Claim*

Petitioner challenges claim 1 of the ’308 patent, which recites:

1. A process for transforming a user access request for cloud digital content into a computer readable authorization object, the process for transforming comprising:
  - a) receiving an access request for cloud digital content through an apparatus in process with at least one CPU, the access request being a write request to a data store, wherein the data store is at least one of:
    - a memory connected to the at least one CPU;
    - a storage connected to the at least one CPU; and

a database connected to the at least one CPU through the Internet; wherein

the access request further comprises verification data provided by at least one user, wherein the verification data is recognized by the apparatus as a verification token; then

b) authenticating the verification token of (a) using a database recognized by the apparatus of (a) as a verification token database; then

c) establishing an API communication between the apparatus of (a) and a database apparatus, the database apparatus being a different database from the verification token database of (b) wherein the API is related to a verified web service, wherein the verified web service is a part of the database apparatus, wherein establishing the API communication requires a credential assigned to the apparatus of (a), wherein the apparatus assigned credential is recognized as a permission to conduct a data exchange session between the apparatus of (a) and the database apparatus to complete the verification process, 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; then

d) requesting the query data, from the apparatus of (a), from the API communication data exchange session of (c), wherein the query data request is a request for the at least one verified web service identifier; then

e) receiving the query data requested in (d) from the API communication data exchange session of (c); and

f) creating a computer readable authorization object by writing into the data store of (a) at least one of:

the received verification data of (a); and

the received query data of (e); wherein

the created computer readable authorization object is recognized by the apparatus of (a) as user access rights associated to the cloud digital content, wherein the computer readable authorization object is processed by the apparatus of (a) using a cross-referencing action during subsequent user access requests

to determine one or more of a user access permission for the cloud digital content.

*Id.* at 14:31–15:14.

#### *D. Asserted Grounds of Unpatentability*

Petitioner challenges claim 1 of the '308 patent on the following ground: obviousness over Tiu,<sup>1</sup> Fetterman,<sup>2</sup> and the knowledge of a person of ordinary skill in the art (“POSITA”) under 35 U.S.C. § 103.<sup>3</sup> Pet. 5, 34–67. In support of its arguments, Petitioner proffers the declaration of Dr. Benjamin Goldberg, Ph.D. (Ex. 1011). *See id.*

#### *E. Claim Construction*

We construe claims in an unexpired patent by applying the broadest reasonable interpretation in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard). Under this standard, claim terms

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<sup>1</sup> Tiu, U.S. Publ’n No. 2008/0222199 A1, published Sept. 11, 2008 (Ex. 1004).

<sup>2</sup> Fetterman, U.S. Publ’n No. US 2008/0313714 A1, published Dec. 18, 2008 (Ex. 1006).

<sup>3</sup> Because grounds in an *inter partes* review must be based on “patents or printed publications” (35 U.S.C. § 311(b); 37 C.F.R. § 42.104(b)(2)), we understand Petitioner’s reference to “the knowledge of the Person of Ordinary Skill in the Art (‘POSITA’)” (Pet. 5) here to refer to a person of skill in the art’s understanding of the applied reference or combined references and not to supply missing limitations or as shorthand to incorporate an unspecified disclosure by reference to supply missing limitations (37 C.F.R. § 42.6(a)(3)).

generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). A “claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer,” however, and clearly set forth a definition of the claim term in the specification. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

Petitioner provides proposed interpretations for various limitations of the claims. Pet. 15–20. Patent Owner responds. Prelim. Resp. 17–23. For purposes of this Decision, we conclude that no term requires express construction to resolve a controversy in this proceeding. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

## II. DISCUSSION

Petitioner argues that claim 1 of the ’308 patent would have been obvious over Tiu, Fetterman, and the knowledge of a POSITA. Pet. 5, 34–67. For the reasons explained below, we are not persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its asserted ground.

### A. Tiu

Tiu describes a system for managing multimedia content appearing on user pages of an online social network (e.g., Friendster). Ex. 1004 ¶ 8. For example, the system lets a Friendster user display a video from a third party

website (e.g., YouTube) on his or her Friendster user page (landing page).  
*See id.* ¶ 28.

Figure 5 of Tiu, which illustrates how to display such a video on a landing page, is reproduced below.

FIG. 5

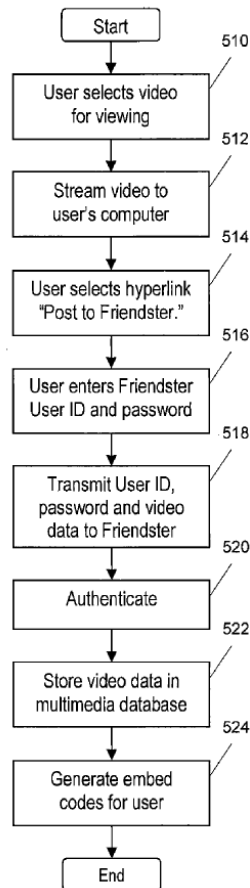


Figure 5 is a flow diagram of the steps for generating a webpage with embed codes for multimedia content (e.g., the video). *Id.* ¶¶ 18, 34. Steps 510–518 are carried out by the server computer of the external video site, while steps 520–524 are carried out by the server computer of the online social network. *Id.* ¶ 34. In step 510, the user navigates to an external video site (e.g., YouTube), where the user selects a video for viewing. *Id.* ¶ 35. In step 512,

the video is streamed to the user's computer where it is displayed. *Id.* In step 514, the user may select the hyperlink "Post to Friendster," which allows the user to feature the video on the user's landing page. *Id.* If the user selects the hyperlink, the user is prompted for his or her Friendster user ID and password in step 516. *Id.* In step 518, the external video site transmits this information along with information about the video to the online social network. *Id.* In step 520, the online social network authenticates the user ID against the password using its user database. *Id.* ¶ 36. After authentication, the information about the video is stored in a multimedia content database of the online social network along with the user ID in step 522. *Id.* Finally, in step 524, embed codes corresponding to the video are generated and inserted into the HTML file corresponding to the user's landing page.

### *B. Fetterman*

Fetterman describes a system for accessing data from a web-based social network via a third-party application. Ex. 1006 ¶ 26. As shown in Figure 1 of Fetterman, which is reproduced below, the system includes third-party application 115, network device 140, and a web-based social network (e.g., Facebook) comprising application program interface 105, cache memory 130, and distributed database 135. *Id.* ¶ 18.

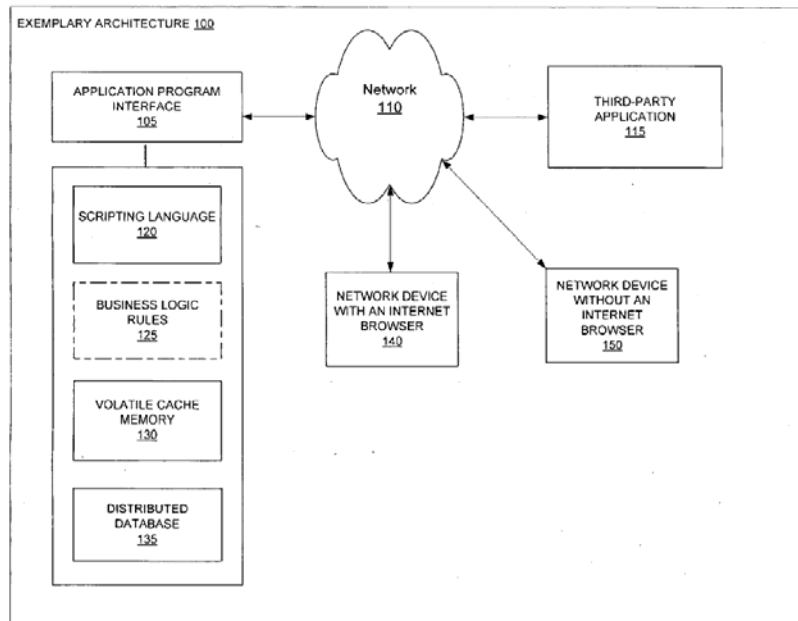


FIG. 1

Figure 1 illustrates an architecture for network authentication. *Id.* ¶ 6.

Third-party application 115 may be a program for generating an electronic birthday card. *Id.* ¶ 19. A user of device 140 may use third-party application 115 to access data from memory 130 or database 135 through application program interface 105. *Id.* ¶¶ 23, 26. To gain such access, the user first logs into the third-party application. *Id.* ¶¶ 27–28. If the user is logging into the third-party application for the first time, the user will be asked to log into the social network (if not already logged in) to accept the terms of service for using the third-party application. *Id.* ¶ 27. After accepting the terms of service, the user will be directed to return to the third-party application, where the user will be able to access data from the social network. *Id.* Alternatively, the user may complete the login process (including logging into the social network and accepting the terms of service) via the third-party application. *Id.* ¶ 28, Figs. 3A–3B.

### *C. Analysis*

Claim 1 recites: (1) “establishing an API communication between the apparatus of (a) and a database apparatus,” (2) “establishing the API communication requires a credential assigned to the apparatus of (a),” and (3) “the computer readable authorization object is processed by the apparatus of (a) using a cross-referencing action . . . to determine one or more of a user access permission for the cloud digital content.” We address these limitations in turn.

*1. “establishing an API communication between the apparatus of (a) and a database apparatus”*

For this limitation, Petitioner identifies Tiu’s computer 270 as the “apparatus of (a)” and Tiu’s database 254 of an online social network as a “database apparatus.” Pet. 37 (discussing claim limitation (a), which recites “an apparatus”), 47. Petitioner also identifies Fetterman’s network device 140 as the “apparatus of (a)” and Fetterman’s web-based social network (e.g., Facebook) as a “database apparatus.” See *id.* at 48. As Petitioner notes, Tiu’s database 254 “is in direct communication with the API communications 290 from the *third-party content site 280*,” not computer 270. *Id.* at 47 (emphasis added). On the other hand, according to Petitioner, “Fetterman teaches that the user device . . . itself calls to Facebook’s API from the user’s browser such that the user device communicates directly with Facebook and its databases using a Facebook API call.” *Id.* at 48 (citing Ex. 1006 ¶¶ 23, 28, Fig. 2); see also *id.* at 31 (citing Ex. 1006 ¶¶ 23, 28). Petitioner further argues that “a POSITA would have been motivated to use the simpler login API method provided by the Facebook API described

by Fetterman in place of the more effort-intensive coding process required in Tiu whereby the third party server mediates the API.”<sup>4</sup> *Id.* at 48; *see also id.* at 33 (“[T]he POSITA would be freed from having to program the third-party server to act as an API agent between the user’s device and social network and, instead, the API could simply be called from the user’s device using a few lines of HTML code.”). We are unpersuaded by Petitioner’s argument.

In support of its argument, Petitioner cites disclosures in Fetterman that describe an API communication between a web-based social network and a *third party application*, not a user device. For example, paragraph 23 of Fetterman teaches that “the *third-party application 115* . . . may access a distributed database and/or a volatile cache memory associated with a social network through an application program interface for the social network.” Ex. 1006 ¶ 23 (emphasis added). Similarly, paragraph 28 of Fetterman teaches “logging into the third-party application and the social network from [the same] screen 320,” which illustrates a login procedure for the *third-party application*. *Id.* ¶¶ 8, 28, Fig. 3A.

In addition, Petitioner directs us to Figure 2 of Fetterman, asserting that “the Facebook API documentation explains to the programmer of the third-party application that the web page presented to the user of the third-party application should include HTML code to call to Facebook’s API such that the user’s device itself becomes an ‘API client.’” Pet. 31–32. We note

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<sup>4</sup> Petitioner proposes an assessment of a person of ordinary skill in the art. Pet. 13–14 (citing Ex. 1011 ¶ 10). Patent Owner does not challenge Petitioner’s proposed assessment and does not propose an alternative. To the extent necessary and for purposes of this Decision, we adopt Petitioner’s assessment.

Petitioner's later assertion with respect to Figure 2, however, that "YOUR\_API\_KEY" represents the API key assigned to the vendor of the third-party application that wants to gain access to Facebook on the user's behalf." *Id.* at 53. That the API key is assigned to the vendor of the third-party application implies an API communication between Facebook and the *vendor of the third-party application*, not the user's device itself.

Given the cited disclosures, Petitioner does not explain persuasively why one of ordinary skill in the art would have considered combining Tiu and Fetterman to arrive at the claimed invention, which includes "an API communication between the apparatus of (a) and a database apparatus." Moreover, we note that logging into Facebook from the Facebook site as described in Figure 2 of Fetterman requires switching from the third-party site to the Facebook site to log into Facebook via Facebook's site, rather than at the third-party site, and then switching back to the third-party site to access data from Facebook. Ex. 1006, Fig. 2 ("for a Facebook API client to use the API, the user of the client application must be logged in to Facebook," "the user will be directed to close their browser window and return to the application"). Such a process seems "more effort-intensive" (*see* Pet. 48) than logging into a social network from the third-party site, where the user can stay to exchange data with the social network, as described in Tiu. Accordingly, we are unpersuaded by Petitioner's proffered reasoning for replacing Tiu's API communication with Fetterman's API communication, namely, to *simplify* the coding process. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

Based on the record before us, we are unpersuaded that the recited “API communication” would have been obvious over Tiu, Fetterman, and the knowledge of a POSITA.

2. *“establishing the API communication requires a credential assigned to the apparatus of (a)”*

For this limitation, Petitioner argues that Fetterman’s API key teaches a “credential assigned to the apparatus of (a).” Pet. 53. According to Petitioner, “Fetterman discloses that when a user is prompted to engage in an API communication with Facebook, it is provisioned an API key that will, in turn, be sent to Facebook as proof that the user is allowed to engage in the API communication.” *Id.* Thus, Petitioner concludes, “a POSITA would find it obvious that an API key would be utilized in calls to the social network site Friendster in Tiu, a social network similar to Facebook, which Patent Owner admits required API keys for utilization of its API services.” *Id.* at 53–54.

We are unpersuaded by Petitioner’s argument. As discussed above, Petitioner identifies Fetterman’s network device 140 as the “apparatus of (a).” *Id.* at 48. With respect to Fetterman’s API key, Petitioner acknowledges that it “represents the API key assigned to the vendor of the third-party that wants to gain access to Facebook on the user’s behalf,” not to device 140. *Id.* at 53; *see also* Ex. 1006, Fig. 2 (“api\_key” is “[u]niquely assigned to the vendor”); Prelim. Resp. 29 (“Because Fetterman teaches that the API key is assigned to the *vendor* application and [Petitioner] maintains that the apparatus of (a) is the *user* device, Fetterman when combined with

Tiu does *not* disclose a credential assigned to the apparatus of (a).”  
(emphases added)).

We note Petitioner’s assertion that “[t]he ’308 Patent itself admits that it was known that APIs used by social network sites, like Facebook, required a credential[] such as an API key, in order to utilize the API,” and that “[s]uch credentials were assigned to the apparatus.” Pet. 51–52 (citing Ex. 1001, 10:51–11:7 (“Facebook API system . . . called from a connected apparatus (which is usually an Internet powered desktop or browser based application) with an API Key”)). Petitioner, however, does not proffer sufficient persuasive reasoning for combining Tiu and Fetterman, in view of the knowledge of a POSITA, in order to obtain an API key assigned to Tiu’s computer 270 or Fetterman’s device 140. *See Kahn*, 441 F.3d at 988 (“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Based on the record before us, we are unpersuaded that the recited “credential assigned to the apparatus of (a)” would have been obvious over Tiu, Fetterman, and the knowledge of a POSITA.

3. *“the computer readable authorization object is processed by the apparatus of (a) using a cross-referencing action . . . to determine one or more of a user access permission for the cloud digital content”*

For this limitation, Petitioner argues that,

[i]n Tiu, the use of the third-party content site username and password located in the EMBED CODE or located in the table of the multimedia content database 257 (in either instance, the claimed ‘authorization object’) to access content on a third-party website, acts as a cross-reference insofar as the username and password are for accessing the third-party content site (e.g.,

Flickr) but are called from the user's social network (e.g., Friendster).

Pet. 65; *see also id.* at 66 (“calling on information in the multimedia content database 257 of the social network account for the HTML landing page code in order to pull information for retrieving content from a third-party site constitutes a cross-referencing action”).

We are unpersuaded by Petitioner's argument. The claim recites that the *apparatus of (a)* uses a cross-referencing action to determine a user access permission for cloud digital content. As discussed above, Petitioner identifies Tiu's computer 270 as “the apparatus of (a).” *See also* Pet. 65. Petitioner does not explain persuasively that Tiu's computer 270 uses a cross-referencing action to determine a user access permission for cloud digital content. For example, using third-party content site Flickr's username and password for accessing content on the Flickr site implies a cross-referencing action at the Flickr site, not at computer 270. *See id.*; *see also id.* at 43 (“the same username and password will be sent to the third-party site every time someone visits the user's landing page (William's Landing Page), thus triggering a call to the third-party site for William's content”); Ex. 1004 ¶ 30 (“The query that is issued to an external web site for content associated with a user includes the user ID and password of that user as proof that access to the user's account maintained by the external web site is authorized.”). Accordingly, based on the record before us, we are unpersuaded that the recited limitation “the apparatus of (a) using a cross-referencing action . . . to determine one or more of a user access permission for the cloud digital content” would have been obvious over Tiu, Fetterman, and the knowledge of a POSITA.

In view of the foregoing, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in showing that claim 1 would have been obvious over Tiu, Fetterman, and the knowledge of a POSITA.

### III. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to challenged claim 1 of the '308 patent.

### IV. ORDER

For the reasons given, it is

ORDERED that the Petition is *denied* and no trial is instituted.

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