

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Cases IPR2017-00791
Patent 8,533,860 B1

Before JAMESON LEE, MICHAEL W. KIM, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

I. BACKGROUND

On July 5, 2017, we instituted trial in a Decision with respect to claims 1–8 and 11–20 of U.S. Patent No. 8,533,860 B1 (“the ’860 patent”) on the sole ground of alleged obviousness under 35 U.S.C. § 103 over Ameerrally, Zweig, Gautier, Frakes, Taylor, Anderson, iPod User Guide, and iMac User Guide. Paper 7, 49. We declined to include for trial alleged

anticipation of claims 1–4, 9–14, and 21 of the '860 patent by Ameerrally.
Id.

On July 19, 2017, Petitioner¹ filed a Request for Rehearing (“Request” or “Req. Reh’g”) (Paper 9). Req. Reh’g. Petitioner requests that we include, for trial, claims 1–4 and 11–21 as anticipated by Ameerrally. *Id.* at 12.

On request for rehearing, the burden of showing a decision on whether to institute trial should be modified lies with the party challenging the decision. 37 C.F.R. § 42.71(d). “When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “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.” 37 C.F.R. § 42.71(d). For reasons discussed below, Petitioner’s Request is *denied*.

II. DISCUSSION

First, we note that the Petition (Paper 2, “Pet.”) alleged only that claims 1–4, 9–14, and 21 are anticipated by Ameerrally. Pet. 31. Petitioner may not, in a rehearing request, seek to expand the scope of its anticipation assertion to include claims 15–20. Petitioner has not pointed out where in the Petition anticipation of claims 15–20 was alleged. Nothing could have been misapprehended or overlooked about a ground not asserted in the Petition.

¹ Mastercard International Incorporated.

Next, we address Petitioner’s statement that “the Board incorrectly determined that Petitioner’s assertion that the indicia includes the login e-mail address was not supported by the record. (Decision, pp. 32–33).” Req. Reh’g 5–6. The statement relates to the last step of claims 1, 11, and 21, about writing at least one of the verification token or the identification reference into the metadata. Ex. 1001, 15:3–4, 17:13–14, 18:33–34. The identification reference referred to in that last step of claims 1, 11, and 21 refers back to the login information identified by Petitioner in the context of the establishing step, the requesting step, and the receiving step of those claims.

Petitioner’s statement is inaccurate and misplaced. In the Decision, we did not state or find that Petitioner’s assertion was not supported by the record evidence. Instead, we determined that why the last step of claim 1 is met by Ameerrally was not adequately explained by Petitioner. For instance, with respect to Petitioner’s discussion of Frakes, we stated:

The Figure illustrates detailed information kept by Frakes’s iTunes® system for a digital movie file. *Id.* at 4. Petitioner asserts: “*Frakes* illustrates ‘Purchased By’ and ‘Account Name’ in the metadata of the iTunes® media file (grayed out in image for privacy, but field illustrated), such that the claimed ‘electronic identification reference’ was necessarily written into the metadata as saved by iTunes®. (Cherukuri Decl. ¶ 139).” Pet. 46. However, neither Petitioner nor Mr. Cherukuri explains why the “Purchased By” or “Account Name” field is necessarily the login information, e.g., the user’s e-mail address, that the iTunes® system had requested and received, as had been explained by Petitioner and Mr. Cherukuri above when accounting for requesting an electronic identification reference and receiving the electronic identification reference. It is not explained why the fields cannot be another identification reference other than the user’s e-mail address.

Paper 7, 32. With respect to Petitioner's discussion of Zweig, we stated:

The argument [about Zweig] establishes that, in the metadata for the digital content purchased or downloaded by a user there is an identifier, an electronic identification reference, that identifies that user. However, neither Petitioner nor Mr. Cherukuri explains why that identifier in the metadata is necessarily the login information, e.g., the user's e-mail address, that the iTunes® system had requested and received, as had been explained by Petitioner and Mr. Cherukuri above when accounting for requesting an electronic identification reference and receiving the electronic identification reference. It is not explained why the fields cannot be another identification reference.

Id. at 32–33. With respect to independent claims 11 and 21, we stated that for the same reasons discussed in the context of claim 1, the same operation as is required by claims 11 and 21 is not sufficiently accounted for by Petitioner. *Id.* at 33.

Petitioner in the Request identifies various other portions of prior art, **not** identified and explained in the Petition in connection with the last step of claims 1, 11, and 21, as supporting its alleged anticipation of claims by Ameeraly. Req. Reh'g, 5–10. Notably, Petitioner points to Figure 5 of Ameeraly and Figure 7B of Gautier, each of which shows in the upper right-hand corner of a screen shot of an iTunes display an email address in a box named "Account." *Id.* at 6–7. Petitioner does not point out where in the Petition such specific identification *and* corresponding explanation exist in connection with the last step of claims 1, 11, and 21. Also notably, Petitioner cites to and reproduces the text of Gautier's Paragraph 83, and asserts that that paragraph is set forth on page 24 of the Petition. *Id.* at 7–8. That is incorrect. Page 24 of the Petition does not contain any discussion or

explanation with regard to Paragraph 83 of Gautier, especially with regard to the last step of claims 1, 11, and 21.

Thus, based on evidence not adequately explained in the Petition, Petitioner asserts that:

[T]he Board either 1) misapprehended or overlooked evidence presented in the petition; or 2) misapprehended how a person of ordinary skill in the art, at the time of the alleged invention claimed in the '860 Patent, would reasonably infer and understand the invention disclosed in Ameerally given his [or] her own common knowledge regarding the art at that time, particularly how digital rights management (“DRM”) was implemented and used in Apple’s well-known iTunes® system. (*See, e.g.*, Decision, pp. 24, 31).

Req. Reh’g, 2–3. But the Board could not have overlooked or misapprehended arguments or evidence that were not specifically identified **and** explained in the Petition. It is too late for Petitioner to add further explanation in a Request for Rehearing. As noted above, Petitioner failed to identify the place in the Petition where the matter allegedly misapprehended or overlooked by the Board was addressed in the Petition, as is required by 37 C.F.R. § 42.71(d).

In any event, the reproduced text of Paragraph 83 of Gautier modifies “account identifier” with the parenthetical “(such as an email address).” Ex. 1011 ¶ 83. The parenthetical is exemplary in nature and indicates only that an email address can be an account identifier, and **not** that in iTunes the Account Name necessarily is a user’s email address.

Petitioner, in the Request for Rehearing, also seeks to introduce evidence not in the record. That is inappropriate. Specifically, with its Petition, Petitioner provided a copy of Frakes (Ex. 1008) having the Figure on page 5 thereof, which is said by Petitioner to be “grayed out” where the

entry appears for “Purchased By” and “Account Name.” Pet. 45, 46. In the Request, however, Petitioner states “*Frakes* actually shows that the ‘Account Name’ *is the user’s e-mail address*,” and provides what it alleges to be an enlarged and contrast-enhanced portion of the screen shot of *Frakes* showing the “Account Name” field. Req. Reh’g, 8. We decline to consider this new evidence, i.e., an enlarged and contrast-enhanced version of the screen shot from *Frakes*, which was not provided by the Petition. The Request is not an opportunity for a party to start afresh with the arguments it desires to make and the evidence it desires to submit. In the Petition, Petitioner already took the approach that the entries for “Account Name” and “Purchased By” in the screen shot from *Frakes* are “grayed out,” and did not assert that they are visible in the screen shot provided. Pet. 46. Here, in the context of the Request for Rehearing, Petitioner’s argument that the entry as actually shown is the user’s email address, and the supporting evidence in the form of an enlarged and contrast-enhanced copy of the screen shot in *Frakes*, are both new. We decline to consider them. Based on the copy of *Frakes* provided when the Petition was filed, we do not see an email address in the entry for “Account Name,” and the Petition nowhere asserts that an email address is visible in the entry on the copy provided with the Petition.

Petitioner notes that Patent Owner, in its Preliminary Response, introduced the term “Apple ID,” and recognized that “Apple ID” refers to the iTunes® account identification and login information. Req. Reh’g, 8–9. However, that information does not provide meaningful assistance to Petitioner. Even assuming that Apple ID, as login information, may serve as an identifier for a user account, that does not mean only the user’s login information, i.e., email address, may be used as Account Name. Patent

Owner has not admitted that the reference in Frakes to “Account Name” refers to the user’s email address.

Finally, Petitioner asks the Board to draw an inference, based on all the portions of prior art that it has identified in the Request with regard to a user’s email address serving as an iTunes account identifier, that the “Account Name” in Frakes refers to the user’s email address. Req. Reh’g, 11. However, such an argument was not made in the Petition, and the portions of prior art discussed by the Petitioner in the Request were not similarly explained in the Petition. It is inappropriate to include such a request in the Request. That request is denied.

III. CONCLUSION

For the foregoing reasons, Petitioner has not met its burden of demonstrating that the Decision instituting trial (Paper 7) should be modified.

IV. ORDER

For the reasons given, it is ORDERED that Petitioner’s Request is *denied*.

IPR2017-00791
Patent 8,533,860 B1

PETITIONER:

Joseph Lanser
David Klein
Joseph Walker
Brian Michaelis
SEYFARTH SHAW LLP
jlanser@seyfarth.com
daklein@seyfarth.com
jmwalker@seyfarth.com
bmichaelis@seyfarth.com

PATENT OWNER:

Isaac Rabicoff
RABICOFF LAW LLC
isaac@rabilaw.com