

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case IPR2017-00793
Patent 8,887,308

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

KIM, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

MasterCard International Incorporated (“Petitioner”) filed a Petition requesting *inter partes* review of claim 1 of U.S. Patent No. 8,887,308 (Ex. 1001, “the ’308 Patent”). Paper 1 (“Pet.”). William Grecia (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). The Board issued a Decision denying institution of *inter partes* review. Paper 7 (“Dec.”; “Decision”). On August 2, 2017, Petitioner filed a Request for Rehearing of the Decision. Paper 8 (“Req.”). For the reasons that follow, the Request for Rehearing is *denied*.

II. ANALYSIS

A request for rehearing must identify specifically all matters the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

Independent claim 1 recites “creating a computer readable authorization object by writing into the data store of (a) . . .” and “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.”

Petitioner argues that the Board “misapprehended Petitioner’s argument in the Petition as to what in Muller corresponded to the claimed ‘computer readable authorization object.’” Req. 2. In particular, Petitioner asserts that the Board “misapprehended or overlooked Petitioner’s explanation of how the stored media access response information of Muller corresponds to the claimed ‘computer readable authorization object.’” Req.

4. According to Petitioner, it did not assert that each of the items listed by the Board corresponds to the claimed “computer readable authorization object.” Req. 5. Rather, argues Petitioner, “the Petition clearly states that the media access response of Muller (a single item, which comprises multiple pieces of information) becomes the claimed ‘computer readable authorization object,’ when the information in the media access response is ‘written into the memory of the client computer.’” Req. 5 (citing Pet. 47–48) (emphasis in original); *see also* Req. 6–8, 11–12.

We are unpersuaded that we misapprehended or overlooked Petitioner’s above position. Indeed, our Decision addresses expressly Petitioner’s position as follows:

To the extent Petitioner actually regards the entirety of Muller’s “media access response” as the recited “computer readable authorization object,” and believes a limitation with regard to the “computer readable authorization object” is met if at least a part of the identified object satisfies the limitation, that position has not been clearly articulated. Neither Patent Owner nor the Board has been provided with sufficient notice of that position. We decline to make that assumption.

Dec. 15. Our re-evaluation of that analysis, in view of the portions of the Petition cited by Petitioner, does not lead us to a different conclusion.

As an initial matter, we remain unpersuaded that the Petition even sets forth this position with sufficient particularity to provide adequate notice to Patent Owner and the Board. In the Request, Petitioner asserts that “the media access response of Muller . . . *becomes* the claimed ‘computer readable authorization object’” when the information in it is written into memory. Req. 5 (emphasis added). The Petition states, however, that the “computer readable authorization object” is “*provide[d]*” when Muller’s

“query data response from the media commerce server” is written into memory (Pet. 47), “*created*” when Muller’s “received media access information *and* digital media item components 115” are written into memory (Pet. 48), “*satisfied*” when Muller’s “digital media item components” are stored on the client (Pet. 48–49), and “*represented*” by the “stored media access response information” (Pet. 50, 53) (all emphases added). Even when focusing on just the verbs, neither the Petition, nor even the Request, for that matter, explains, with particularity, how any of the above words used in the Petition, “provided,” “created,” “satisfied,” and “represented,” are equivalent to the word “becomes.” The Board cannot misapprehend or overlook a position that was not made. Relatedly, a similar issue exists with respect to the various nouns used as well. Nor should the Board speculate on what Petitioner had in mind. In short, a petition should be written clearly.

Moreover, even if the Petition did set forth such a position with particularity, we are unpersuaded that our denial of institution was an abuse of discretion, because the Petition also sets forth a plethora of other items in Muller that purportedly correspond to the recited “computer readable authorization object,” and not expressed in the alternative. As noted in our Decision:

In summary, Petitioner asserts, at various points in the Petition, that each of the following items in Muller corresponds to the recited “computer readable authorization object”: query data response from the media commerce server; media commerce server response; media access response; media content URL; a download key; a security token; digital media item components 115; license keys; user account information; media access information; media access response information; licensing information; DRM data; media storage access pointers;

media information response; various combinations of these items; and various combinations of these items when “written into the memory of the client computer.”

Dec. 10. For example, although some parts of the Petition may map Muller’s stored media access response information to the claimed “computer readable authorization object” (*see, e.g.*, Pet. 50, 53), other discussions of the limitation diverge from that mapping (*see, e.g.*, Pet. 47, 48–49).

Essentially, Petitioner is now asserting that the Board should have given more weight to the portions of the Petition that support their current mapping of “computer readable authorization object,” and should have read the Petition portions that, at first glance, appeared to diverge, in a manner consistent with their current mapping. Petitioner, however, does not explain the basis for why we should have done so, and, indeed, we addressed this position already in the Decision.

In any event, we disagree with any contention that if the “computer readable authorization object,” as identified by Petitioner, includes numerous items, such as the *fifteen* items identified by Petitioner and additional combinations suggested by Petitioner on pages 46–48 and 53–54 of the Petition, then each limitation of the recited “computer readable authorization object” is considered met if any item of the identified object meets the limitation. Petitioner should not expect the Board to search through every possible permutation of arguments and evidence, scattered in disparate parts of the record and not sufficiently linked by Petitioner’s presentation, and put together, for Petitioner, the one permutation that may support Petitioner’s alleged ground of unpatentability. It is Petitioner who must make out its own case. The Board is not a party in this proceeding and must remain neutral and unbiased.

Dec. 15.¹

The Request then applies the aforementioned reasoning to certain details set forth in the Decision. Req. 8–11. For the same reasons as set forth above, however, we are unpersuaded that we misapprehended or overlooked anything in regards to those details. For example, the Request asserts the following:

The Decision asserted on page 12 that: “[w]hen page 54 of the Petition, as informed by the aforementioned portion of Muller, is read in conjunction with page 48 of the Petition, however, the resulting claim mapping is that digital media item components 115 are used to retrieve . . . themselves, which is illogical, and, thus, digital media item components 115 cannot correspond properly to the recited “computer readable authorization object.””

However, the Petition does not state that digital media item components 115 are used to retrieve themselves. Rather, the Petition explains that the media access response of *Muller* includes multiple pieces of information, such as the media content URL, download key, security token, and one or more digital media item components 115 that include license keys and user account information, as disclosed in *Muller*. (Petition, pp. 53–54). As disclosed in *Muller* and explained in the Petition, data pointers (which are the same as the URL contained in the media access response) (Petition, p. 53; Muller ¶ [0035]) are used to cross-reference the storage locations and retrieve individual

¹ By analogy, assume that page 1 of the Petition reads “the alphabet corresponds to the claimed ‘object,’” and page 4 of the Petition reads “the letter ‘b’ corresponds to the claimed ‘object.’” Petitioner, in the Request, now asserts that the Petition is consistent because the letter “b” is a subset of the “alphabet,” and so, when read in that context, there is no inconsistency in separately identifying each of the letter “b” and the “alphabet” as corresponding to the claimed “object.” Our point is that the Petition was denied because the latter explanation, including the purported “context,” was not set forth in the Petition in a manner sufficient to provide notice to Patent Owner and the Board.

digital media content items. (Petition, pp. 53-54). For example, the Petition states that “[o]ne of ordinary skill in the art would understand that retrieval of the digital media components (content files) would require a “de-referencing” operation, i.e., extracting a pointer from the media information response (such as the XML data structure discussed in *Muller* (Ex. 1005 at [0027]) and forming a cross referenced URL identifying the data file location [such as the URL in the media access response].” (Petition, p. 54); *Alexander Decl.* (Ex. 1007) at ¶177.

Req. 8–9. In providing its analysis, in the second paragraph, as to what the Board misapprehended or overlooked in arriving at our conclusion, in the first paragraph, the Petitioner does address the Board’s citation to page 54 of the Petition. Petitioner’s analysis, however, does not address the Board’s citation to page 48, even though the Decision stated expressly “[w]hen page 54 of the Petition, as informed by the aforementioned portion of *Muller*, is read in conjunction with page 48 of the Petition” Only addressing page 54 does not inform the Board as to how anything was misapprehended or overlooked in coming to our conclusion that was based on our analysis of page 54 *read in conjunction with* page 48.

The Request’s next assertion, with respect to “data pointers,” is even more problematic. Req. 9–11. Specifically, Petitioner asserts that *Muller*’s “data pointers . . . are the same as the URL contained in the media access response” and “are used to cross-reference the storage locations and retrieve individual media content items.” Req. 9 (citing Pet. 53–54; Ex. 1005 ¶ 35). This, however, is a shift from the position taken in the Petition, which, in the discussion of the “cross-referencing action” limitation, does cite an excerpt of *Muller* about data pointers (*see* Pet. 52–54, citing Ex. 1005 ¶ 35), but then names the security token, media storage access pointers, and file pointers as the items in *Muller* performing the claimed “cross-referencing action” (Pet.

54, citing Ex. 1007 ¶¶ 175–176; Ex. 1005 ¶ 35). A shift in position is not something that the Board could have misapprehended or overlooked.

With respect to our conclusion of “Petitioner [not having] explained the difference between ‘media content URL’ and ‘cross referenced URL,’” Petitioner explains that “[t]he media access response may be formatted in . . . Extensible Markup Language (XML)” (Req. 10, quoting Ex. 1005 ¶¶ 13, 27) and that “the XML object (i.e., the media access response) is parsed using a ‘de-referencing’ operation to obtain the URL (also referred to in the Petition as the cross referenced URL identifying the data file location)” (Req. 10–11). Petitioner, however, does not provide any citations to the Petition as to what the Board misapprehended or overlooked in concluding that “Petitioner has not explained the difference between ‘media content URL’ and ‘cross referenced URL.’” See Dec. 13.

III. CONCLUSION

Petitioner’s Request for Rehearing is ***denied***.

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