

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE SYSTEMS INCORPORATED,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case IPR2018-00418
Patent 8,402,555 B2

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

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Adobe Systems Incorporated (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–26 of U.S. Patent No. 8,402,555 B2 (Ex. 1001, “the ’555 patent”). William Grecia (“Patent Owner”) filed a Preliminary Response (Paper 6, “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 of the challenged claims.

II. BACKGROUND

A. *Related Proceedings*

The parties identify several federal district court cases relating to the ’555 patent. Pet. 2; Ex. 1012; Paper 4. The parties also identify several other petitions for *inter partes* review relating to the ’555 patent. Pet. 2–3; Paper 4.

B. *The ’555 Patent*

The ’555 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, 1:19–26; 4:47–48. Figure 3 of the ’555 patent, which illustrates how an example of such a system works, is reproduced below.

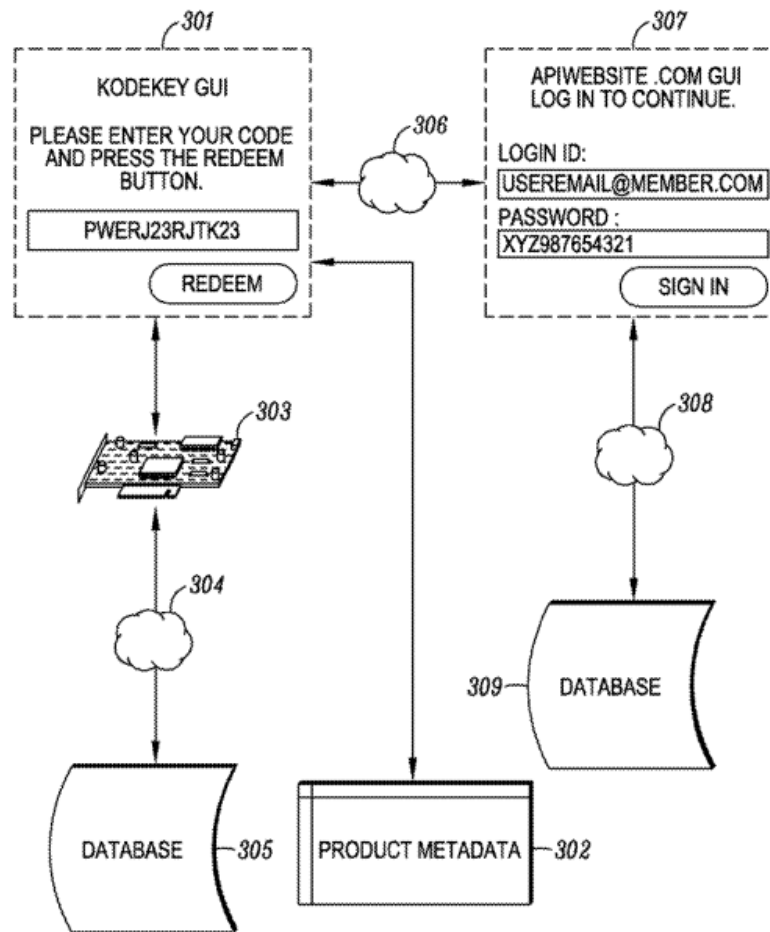


FIG. 3

In particular, Figure 3 provides a flow chart of a digital media personalization process. *Id.* at 4:23–25. A user who wishes to access certain digital media posts a branding request via Kodekey GUI 301, which prompts the user to enter a token and press the redeem button. *Id.* at 6:65–7:3. The branding request is a request to read or write metadata of the digital media, and includes a membership verification token corresponding to the digital media. *Id.* at 5:47–50. The token represents the digital media provider’s permission to grant access rights. *Id.* at 9:20–21. Kodekey GUI 301 is connected to token database 305, which is used to authenticate the token. *Id.* at 7:6–7, 8:19–21. 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 7:10–11, 14–17. 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 7:10–14, 10:40–43. 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 7:3–4. Product metadata 302 is branded by writing the token and the user’s electronic identification reference into the metadata. *Id.* at 8:27–30. For a subsequent access request, the user’s electronic identification reference is compared against the electronic identification reference in metadata 302. *Id.* at 13:57–61. If there is a match, access rights are granted to the user. *Id.* at 13:61–62.

C. Challenged Claims

Petitioner challenges claims 1–26 of the ’555 patent. Claims 1, 12, and 15 are independent. Claim 1 is illustrative of the claims under challenge:

1. A method for monitoring access to an encrypted digital media, the method facilitating interoperability between a plurality of data processing devices, the method comprising:
 - receiving an encrypted digital media access branding request from at least one communications console of the plurality of data processing devices, the branding request being a read or write request of metadata of the encrypted digital media, the request comprising a membership verification token provided by a first user, corresponding to the encrypted digital media;

authenticating the membership verification token, the authentication being performed in connection with a token database;

establishing connection with the at least one communications console wherein the communications console is a combination of a graphic user interface (GUI) and an Applications Programmable Interface (API) protocol, wherein the API is obtained from a verified web service, the verified web service capable of facilitating a two way data exchange to complete a verification process;

requesting at least one electronic identification reference from the at least one communications console wherein the electronic identification reference comprises a verified web service account identifier of the first user;

receiving the at least one electronic identification reference from the at least one communications console; and

branding metadata of the encrypted digital media by writing the membership verification token and the electronic identification reference into the metadata.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–26 of the '555 patent on the following grounds. Pet. 1, 38–73.

References	Basis	Claims Challenged
Ameerally, ¹ Gautier, ² Frakes, ³ Zweig, ⁴ and Venkataramu ⁵	§ 103	1–6, 8–22, 24 and 25
Ameerally, Gautier, Frakes, Zweig, Venkataramu, and Linking to iTunes ⁶	§ 103	7 and 23
Ameerally, Gautier, Frakes, Zweig, Venkataramu, Kondrk, ⁷ and Modifying Content in iTunes ⁸	§ 103	26

In support of its arguments, Petitioner relies on a Declaration of Dr. Aviel Rubin (Ex. 1002), a Declaration of Amisha Manek (Ex. 1026), and an Affidavit of Christopher Butler (Ex. 1027).

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*,

¹ Ameerally, U.S. Publ’n No. 2006/0212401 A1, published Sept. 21, 2006 (Ex. 1004).

² Gautier, U.S. Publ’n No. 2005/0021478 A1, published Jan. 27, 2005 (Ex. 1005).

³ Dan Frakes, *First Look: iTunes Digital Copy*, Macworld, <http://www.macworld.com/article/131751/2008/01/digitalcopy.html>, last visited Jan. 10, 2017 (Ex. 1006).

⁴ Zweig, U.S. Publ’n No. 2007/0233606 A1, published Oct. 4, 2007 (Ex. 1008).

⁵ Ramya Venkataramu, *Analysis and Enhancement of Apple’s Fairplay Digital Rights Management* (May 2007) (Project Report, San Jose State University) (Ex. 1007).

⁶ Linking to the iTunes Music Store, iTunes Store External Documentation (v. 1.2) (Dec. 7, 2009) (Ex. 1010, “Linking to iTunes”).

⁷ Kondrk, U.S. Publ’n No. 2004/0254883 A1, published Dec. 16, 2004 (Ex. 1009).

⁸ Tony Bove & Cheryl Rhodes, *iPod & iTunes for DUMMIES* 310–312 (4th ed. 2006) (Ex. 1011, “Modifying Content in iTunes”).

136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard). Under this standard, claim terms 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 argues proposed constructions for various limitations of the claims. Pet. 13–24. Patent Owner does not respond. *See generally* Prelim. Resp. For purposes of this Decision, we conclude that no claim term requires express interpretation at this time to resolve any 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.”).

III. ANALYSIS

Petitioner relies on Venkataramu as a printed publication for each of its asserted grounds. Pet. 1; *see also id.* at 24 (referring to Venkataramu as a “prior art publication[]”); 37 C.F.R. §42.104(b)(2) (the petition “must identify . . . the patents or printed publications relied upon for each ground”). Patent Owner contends that Petitioner has failed to establish that

Venkataramu was publicly accessible before the “critical date”⁹ for the ’555 patent, and that Petitioner has thus failed to establish that Venkataramu qualifies as a printed publication. Prelim. Resp. 2, 4–8.¹⁰ For the reasons explained below, we agree with Patent Owner.

According to the Federal Circuit, “[b]ecause there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’” under Section 102. *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). A reference is publicly accessible “upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising

⁹ The parties disagree as to the invention date to which Patent Owner is entitled for the challenged claims. The earliest possible effective filing date for the ’555 patent is March 21, 2010. Ex. 1001, at [63]. Petitioner notes that Patent Owner swore behind this date during prosecution for the ’555 patent, alleging a conception date of February 10, 2010, and “daily diligence” until March 21, 2010. Pet. 9; Ex. 1028, 1. Petitioner further asserts that it will assume for purposes of its Petition that the ’555 patent is entitled to an invention date of February 10, 2010. Pet. 9. Patent Owner, however, asserts an invention date of March 21, 2009. Prelim. Resp. 4, 6. Because we find that Petitioner does not show sufficiently that Venkataramu was publicly accessible prior to the earliest possible effective filing date for the ’555 patent, as explained in this section, we need not evaluate further for purposes of this Decision the possibility of an earlier date of invention for the ’555 patent.

¹⁰ Patent Owner did not number the pages in its Preliminary Response. For purposes of this Decision, we have assigned a page number, starting with 1, to each of the pages in the Preliminary Response, starting with the caption page. Thus, the caption page is considered to be at page 1.

reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008). We assess public accessibility on a case-by-case basis. *See Kyocera*, 545 F.3d at 1350.

In instances of references stored in libraries, for example, “competent evidence of the general library practice may be relied upon to establish an approximate time when a thesis became accessible.” *In re Hall*, 781 F.2d at 899. “In these cases, we generally inquire whether the reference was sufficiently indexed or cataloged.” *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1348 (Fed. Cir. 2016); *see also Medtronic, Inc. v. Barry*, --F.3d--, 2018 WL 2769092, at *8 (Fed. Cir. Jun. 11, 2018) (“The issue of a reference’s public accessibility often arises in the context of references stored in libraries. In such cases, we generally inquire whether the reference was sufficiently indexed or cataloged.”); *accord Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012) (“indexing is a relevant factor in determining accessibility of potential prior art, particularly library-based references”). In *Hall*, the Federal Circuit found sufficient “a declaration from the university librarian which detailed the library’s procedures for receiving, cataloging, and shelving of theses and attested to the relevant dates that [a certain] thesis was processed.” 781 F.2d at 899. By contrast, in *SRI International*, a document on an FTP server was not shown to have been sufficiently publicly available, in part, because “the FTP server did not contain an index or catalogue or other tools for customary and meaningful research.” 511 F.3d at 1196. In another example, theses deposited at a library “were not accessible to the public because they had not been either cataloged or indexed in a meaningful way.” *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989). In *Cronyn*, the theses

were cataloged in alphabetical order, by title, and “the student’s name, which, of course, bears no relationship to the subject of the student’s thesis.” *Id.*

Here, Venkataramu states on its face that it is a “Project Report” presented to the faculty of the computer science department at San Jose State University (SJSU). Ex. 1007 (cover page). Petitioner alleges that Venkataramu “was available and indexed as a Masters’ Thesis by San Jose State University and made available on the University’s website at least as of October 2, 2008, as evidenced by its record in the Internet Archive.” Pet. 30. As support, Petitioner relies on the Affidavit of Christopher Butler. *Id.* (citing Ex. 1027 ¶¶ 1, 4–5). According to his Affidavit, Mr. Butler is an office manager at the Internet Archive, which is located in San Francisco, California, rather than a staff member of the SJSU library where Petitioner alleges Venkataramu is located. Ex. 1027 ¶ 1. Mr. Butler testifies that the Internet Archive provides a service called the Wayback Machine, which allows users to access web pages stored in the Internet Archive’s web archive. *Id.* ¶ 3. The archived data is compiled using software programs that surf the web and automatically store copies of web files, preserving the files as they exist at the time of capture. *Id.* ¶ 4. The Internet Archive assigns a URL on its site to each archived file in the following format: [http://web.archive.org/web/\[yyyy\]\[mm\]\[dd\]\[hh:mm:ss\]/\[Archived URL\]](http://web.archive.org/web/[yyyy][mm][dd][hh:mm:ss]/[Archived URL]). *Id.* ¶ 5.

Attached to Mr. Butler’s Affidavit is an Exhibit A, which Mr. Butler testifies comprises “true and accurate copies of printouts of the Internet Archive’s records of the HTML files or PDF files for the URLs and the dates specified in the footer of the printout (HTML) or attached coversheet

(PDF).” *Id.* ¶ 6, Ex. A. We note that Exhibit A includes a cover sheet, as well as what appears to be a copy of Venkataramu. *Id.*, Ex. A. The cover sheet displays the following URL:

https://web.archive.org/web/20081002140457/http://www.cs.sjsu.edu/faculty/stamp/students/RamyaVenkataramu_CS298Report.pdf. *Id.* Thus, according to Mr. Butler, the Internet Archive captured and archived a copy of Venkataramu on October 2, 2008, at 2:04 pm.

Patent Owner responds that Petitioner provides “no evidence in the record regarding the San Jose State University website.” Prelim. Resp. 6. As such, Patent Owner argues that Petitioner “failed to produce evidence sufficient to show that the *Venkataramu* Report was publicly accessible before the critical date” for the ’555 patent, and that Venkataramu therefore “does not qualify as prior art.” *Id.*

We agree with Patent Owner. To determine a date on which Venkataramu was publicly accessible, we look to evidence of the SJSU library’s cataloging and indexing practices, as well as any search capability of the library’s website. *See Blue Calypso*, 815 F.3d at 1348; *Voter Verified*, 698 F.3d at 1380; *SRI*, 511 F.3d at 1196. Neither Petitioner nor Mr. Butler offers sufficient evidence that Venkataramu was sufficiently indexed or catalogued at SJSU for access. That the Internet Archive *captured* and *archived* a copy of Venkataramu does not mean, by itself, that Venkataramu was sufficiently indexed or catalogued at SJSU. Nor does it reveal anything about the search capabilities of the SJSU library website. Mr. Butler does not claim to have personal knowledge of the general library practices of the SJSU library, or the search capabilities of the SJSU library website. For example, he does not testify as to the procedures, if any, the university uses

to index or catalog project reports, or the manner, if at all, in which project reports are indexed or cataloged (e.g., by author, title, subject). He also does not testify as to the search capabilities of the SJSU library website. Further, neither Petitioner nor Mr. Butler introduces any evidence that Venkataramu was actually disseminated to any interested skilled artisans prior to the earliest possible effective filing date for the '555 patent. Additionally, Petitioner has not explained why making a copy of Venkataramu accessible on the Internet Archive constitutes publication of Venkataramu on the Internet Archive as of October 2, 2008. In that regard, we note that Mr. Butler's Affidavit does not indicate that the archived files are searchable through a subject matter index or catalog.

We note Petitioner's additional assertion in a footnote that "[f]urther evidence of public availability of *Venkataramu* before the '555 Patent priority is the book chapter authored by Ramya Venkataramu for 'Handbook of Research on Secure Multimedia Distribution,' published on February 26, 2009, which cites the same archived internet address." Pet. 30 n.3. To support that assertion, Petitioner directs us to where the book cites the internet address for Venkataramu. *Id.* (citing Ex. 1016, 155). Petitioner also directs us to a Library of Congress record that provides some information about the book. *Id.* (citing Ex. 1025). Petitioner relies on the Declaration of Amisha Manek, an attorney at Perkins Coie, LLP. Pet. 30 n.3 (citing Ex. 1026 ¶¶ 4–5); Ex. 1026 ¶ 1. In her Declaration, Ms. Manek observes that both the title page of the book and the first page of the book chapter (which cites the internet address for Venkataramu) have a 2009 copyright date, and that the Library of Congress record shows that the book was "published or

created” in 2009. Ex. 1026 ¶ 4 (citing Ex. 1016 (title page)); *id.* ¶ 5 (citing Ex. 1025).

In response, Patent Owner counters that Petitioner “fail[s] to produce evidence sufficient to show that the *Venkataramu* Report, as cited in the [book], was publicly accessible before the critical date.” Prelim. Resp. 8. We agree. Neither Petitioner nor Ms. Manek explains the relationship, if any, between the book and Venkataramu. For example, Petitioner does not explain, and Ms. Manek does not testify, as to how a member of the public interested in the subject matter of Venkataramu would have located it by first obtaining access to the book.

In view of the foregoing, we determine that Petitioner has not shown sufficiently that Venkataramu was publicly accessible prior to the earliest possible effective filing date for the ’555 patent. Therefore, Petitioner has not shown that Venkataramu qualifies as a printed publication. Because each of Petitioner’s asserted grounds relies on Venkataramu, Petitioner has not demonstrated a reasonable likelihood of showing that any of claims 1–26 would have been obvious over any of the asserted grounds.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated on the record before us a reasonable likelihood that it would prevail in showing the unpatentability of any challenged claim of the ’555 patent.

V. ORDER

For the reasons given, it is

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

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