

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE SYSTEMS INCORPORATED,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case IPR2018-00419
Patent 8,533,860 B1

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

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Adobe Systems Incorporated (“Petitioner”) filed a Request for Rehearing (Paper 8, “Req. Reh’g”) of our Decision Denying Institution of *Inter Partes* Review (Paper 7, “Institution Decision” or “Inst. Dec.”) of U.S. Patent No. 8,533,860 B1 (Ex. 1001, “the ’860 patent”). Petitioner seeks rehearing of our determination not to institute *inter partes* review of the ’860 patent over the two asserted grounds, each of which is based on Venkataramu.¹ Req. Reh’g 1, 3, 15. In our Institution Decision, we determined that Petitioner had not shown sufficiently that Venkataramu qualifies as a printed publication. Inst. Dec. 13. According to Petitioner, our decision was an abuse of discretion because we ignored Federal Circuit law, as well as misapprehended or overlooked several of Petitioner’s arguments and evidence regarding Venkataramu and other asserted references. Req. Reh’g 2–15. For the reasons that follow, Petitioner’s request for rehearing is *denied*.

II. BACKGROUND

The Petition (Paper 2, “Pet.”) challenged claims 9, 10, and 21–30 of the ’860 patent on the following two grounds. Pet. 1, 50–76.

¹ Ramya Venkataramu, Analysis and Enhancement of Apple’s Fairplay Digital Rights Management (May 2007) (Project Report, San Jose State University) (Ex. 1007).

References	Basis	Claims Challenged
Ameerally, ² Gautier, ³ Frakes, ⁴ Zweig, ⁵ and Venkataramu	§ 103	9 and 10
Ameerally, Gautier, Frakes, Zweig, Venkataramu, Suitts, ⁶ and Kondrk ⁷	§ 103	21–30

Petitioner asserted in its Petition that “all proposed grounds in this petition rely on the *Venkataramu* reference.” Pet. 4. We denied institution of review on both asserted grounds because we were not persuaded that Petitioner had adequately shown that Venkataramu qualifies as a printed publication. Inst. Dec. 7–13. In particular, we were not persuaded that Petitioner had adequately shown that Venkataramu was publicly accessible prior to the earliest possible effective filing date for the ’860 patent. *Id.*

III. STANDARD OF REVIEW

When considering a request for rehearing of a decision on petition, 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

² Ameerally, U.S. Publ’n No. 2006/0212401 A1, published Sept. 21, 2006 (Ex. 1004).

³ Gautier, U.S. Publ’n No. 2005/0021478 A1, published Jan. 27, 2005 (Ex. 1005).

⁴ 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).

⁵ Zweig, U.S. Publ’n No. 2007/0233606 A1, published Oct. 4, 2007 (Ex. 1008).

⁶ Suitts, U.S. Publ’n No. 2008/0040379 A1, published Feb. 14, 2008 (Ex. 1009).

⁷ Kondrk, U.S. Publ’n No. 2004/0254883 A1, published Dec. 16, 2004 (Ex. 1010).

clear error of judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 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.

IV. ANALYSIS

Petitioner contends that we abused our discretion because: (1) we overlooked Petitioner’s alternative obviousness arguments that rely on references other than Venkataramu; (2) we analyzed Petitioner’s arguments over the wrong timeframe; (3) we applied the wrong standard for public accessibility in considering whether Venkataramu was sufficiently indexed or cataloged; (4) we overlooked the fact that merely archiving Venkataramu using the Internet Archive Wayback Machine is evidence of public accessibility; and (5) we ignored Federal Circuit law on the dissemination of electronic references using research aids, and overlooked Petitioner’s arguments and evidence that a book providing a link to Venkataramu was a research aid leading an ordinarily skilled artisan to Venkataramu. Req. Reh’g 2–15. We address Petitioner’s contentions in turn.

A. Arguments Relying on References Other Than Venkataramu

Petitioner asserts that, in a different case involving the '860 patent, namely, IPR2017-00791, we “partially granted institution, finding that the ‘branding’ limitations . . . were disclosed or rendered obvious by the teachings of certain references, including ‘Ameerally’ (Ex. 1004), ‘Gautier’ (Ex. 1005), and ‘Frakes’ (Ex. 1006).” Req. Reh’g 13–14. Petitioner further asserts that Patent Owner then “took adverse judgment against all instituted claims” in that case, namely, claims 1–8 and 11–20 of the '860 patent. *Id.* at 14; Pet. 3–4. As to the instant case, Petitioner asserts that its Petition “cured various deficiencies in [the other] petition, and cited *Venkataramu* merely to further ‘confirm[]’ that the PTAB had already found in partially instituting [the other] petition . . . that *Ameerally*, *Gautier*, and *Frakes* disclosed Patent Owner’s ‘branding’ limitations.” Req. Reh’g 14. According to Petitioner, it thus “presented independent and alternative arguments regarding the ‘branding’ limitation in Patent Owner’s remaining claims [9, 10, and 21–30], of which only one such argument used *Venkataramu*,” and we “wholly overlooked” the alternative arguments, thereby “allow[ing] Patent Owner to take an ‘action inconsistent with [an] adverse judgment’ in contravention of 37 C.F.R. 42.73(d)(3).” *Id.* Thus, Petitioner contends, our “overlooking of [Petitioner’s] alternative arguments was separate legal error.” *Id.*

We disagree. Petitioner stated in its Petition:

While this petition relies on some prior art references already presented to the Board in . . . IPR2017-00791, all proposed grounds in this petition rely on the *Venkataramu* reference, which has not been presented to the Board as prior art for the '860 patent. . . . The key reason the Board denied institution on Claims 9 and 21 of the '860 patent [in IPR2017-00791] was [the other petitioner’s] failure to properly address the means-plus-

function limitations recited as “modules” in those claims. . . . The Board also found that [the other petitioner] failed in its attempt to show “writing . . . the identification reference into the metadata,” as required in all claims challenged in the instant petition. The Board found that [the other petitioner] had failed to make a connection between the “electronic identification reference” of the branding operation and the “electronic identification reference” of the already recited requesting and receiving operations. . . . [T]his petition cures [the other petitioner’s] error by *inter alia* relying on *Venkataramu* as prior art. *Venkataramu* shows that the “electronic identification reference,” in this case the iTunes user ID, is written or “branded” into the metadata of the encrypted digital file.

Pet. 3–5 (internal citations omitted). Given Petitioner’s explicit statement that “*all proposed grounds* in this petition rely on the *Venkataramu* reference,” (*id.* at 4 (first emphasis added)), and the explanation that *Venkataramu* cures the deficiencies of a previous petition that did not rely on *Venkataramu*, Petitioner cannot now argue, in a rehearing request, that *Venkataramu* is not necessary for some of its alleged grounds of unpatentability. We could not have overlooked alternative arguments that the Petition indicates do not exist.

B. Timeframe

Petitioner further contends that we “conducted [our] analysis within the incorrect timeframe.” Req. Reh’g 12. According to Petitioner, we “follow[ed] Patent[] Owner’s misdirection and reache[d] conclusions based on the March 21, **2009** ‘critical date,’” rather than the “earliest effective filing date of March 21, **2010**.” *Id.* at 12–13. As support, Petitioner points to portions of our Institution Decision where we agree with Patent Owner’s statements that Petitioner did not sufficiently show that *Venkataramu* was

publicly accessible before the “critical date,” which Patent Owner asserted is March 21, 2009. *Id.* at 13.

We disagree. In our Institution Decision, we noted the parties’ dispute as to the invention date for the challenged claims. Inst. Dec. 8 n.8. In particular, we recognized that the earliest effective filing date for the ’860 patent is March 21, 2010; that Petitioner assumed for purposes of its Petition that the ’860 patent is entitled to an invention date of February 10, 2010; and that Patent Owner asserted an invention date of March 21, 2009. *Id.* In addressing the parties’ dispute, we stated that “[b]ecause we find that Petitioner does not show sufficiently that Venkataramu was publicly accessible prior to the *earliest possible effective filing date* for the ’860 patent, . . . we need not evaluate further for purposes of this Decision the possibility of an earlier date of invention for the ’860 patent.” *Id.* (emphasis added); *see also id.* at 13 (“we determine that Petitioner has not shown sufficiently that Venkataramu was publicly accessible prior to the earliest possible effective filing date for the ’860 patent”). Thus, our agreement with Patent Owner’s statements regarding the public accessibility of Venkataramu was based on March 21, 2010, as the earliest possible effective filing date, the appropriate time for making that assessment, and not a time earlier than that.

C. Applying an “Indexing or Cataloging” Standard

Petitioner further contends that we “improperly fault[ed] [Petitioner] for failing to establish that *Venkataramu* was ‘sufficiently indexed or cataloged’ as a Masters’ Thesis by the San Jose State University library.” Req. Reh’g 11. Petitioner asserts that it did not allege that Venkataramu was

indexed or cataloged by a *library*, but instead “alleged and demonstrated that *Venkataramu* was indexed and made available on the University’s **website**, and then **disseminated** by Mr. Venkataramu via a textbook article to the public audience relevant of the ’860 patent.” *Id.* Petitioner further asserts that, “[u]nder *Blue Calypso*, a showing of dissemination independently establishes *Venkataramu* as a ‘printed publication’ without needing to show library indexing or cataloging, regardless of *Venkataramu*’s classification as a ‘thesis.’” *Id.* (citing *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1350 (Fed. Cir. 2016)).

The Petition was not entirely clear as to whether Petitioner also relies on physical location of a thesis at a library. Out of an abundance of caution, we addressed that possibility. If, as Petitioner now clearly indicates, Petitioner is not relying on physical location of a thesis at a library, then our application of the law applicable to the required indexing in that circumstance is inapplicable. The other deficiencies of Petitioner’s showings, however, are unchanged.

D. Public Accessibility Based on Internet Archiving

Petitioner further contends that we “overlooked that the mere archiving of *Venkataramu* by the Internet Archive Wayback Machine provides evidence of public accessibility.” Req. Reh’g 10. As support, Petitioner cites three Board decisions: *Mipox Corp. v. Int’l Test Sol’ns, Inc.*, Case IPR2017-00937, slip op. at 12 (PTAB Sept. 11, 2017) (Paper 9); *Elec. Arts Inc. v. White Knuckle IP, LLC*, Case IPR2015-01595, slip op. at 11–12 (PTAB Jan. 12, 2017) (Paper 38); and *Creston Elecs., Inc. v. Intuitive Bldg.*

Controls, Inc., Case IPR2015-01379, slip op. at 14 (PTAB Dec. 15, 2015) (Paper 16).

Although electronic archiving may provide evidence of public accessibility, we note that the Federal Circuit in *Blue Calypso*, which was decided after these Board decisions, explains that “[j]ust as indexing plays a significant role in evaluating whether a reference in a library is publicly accessible, . . . indexing, ‘[w]hether . . . through search engines or otherwise,’ is also an important question for determining if a reference stored on a given webpage in cyberspace is publicly accessible.” 815 F.3d at 1349 (internal citations omitted). The Federal Circuit further explains that the “absence of evidence demonstrating that the website at which the article was located was indexed and thereby findable by an internet search engine” can be overcome, however, by a showing that an ordinarily skilled artisan “would have been independently aware of the website as a prominent forum for discussing [the pertinent] technologies.” *Id.*

In this case, that the Internet Archive electronically archived a copy of Venkataramu does not, by itself, mean that Venkataramu was sufficiently indexed on the San Jose State University (SJSU) website or the Internet Archive. Nor does it reveal anything about the search capabilities of the SJSU website or the Internet Archive, or why one with ordinary skill in the art would have even visited either website to find anything. With respect to the SJSU website, Mr. Christopher Butler does not claim to have personal knowledge of the general practices regarding the university website, or the search capabilities of the website. For example, he does not testify as to the procedures, if any, the university uses to index project reports, or the manner, if at all, in which project reports are indexed (e.g., by author, title,

subject). He also does not testify as to the search capabilities of the SJSU website, or why an ordinarily skilled artisan would have visited the website to locate Venkataramu. We note Petitioner's assertion in its Petition that Venkataramu was "indexed as a Masters' Thesis," (Pet. 30), which, of course, bears no relationship to the subject of Venkataramu. *See In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989). As for the Internet Archive, we note that Mr. Butler testifies that "[v]isitors to the Wayback Machine can search archives by URL (i.e., a website address)," (Ex. 1024 ¶ 3), which, similarly, bears no relationship to the subject of Venkataramu. Mr. Butler does not testify as to any other way to locate Venkataramu on the Wayback Machine, or as to why a visitor would have visited the Wayback Machine to locate Venkataramu.

Further, as we mentioned in our Institution Decision, (Inst. Dec. 12), and explain in other parts of the analysis, neither Petitioner nor Mr. Butler introduces any evidence that Venkataramu was actually disseminated to any interested ordinarily skilled artisans prior to the earliest possible effective filing date for the '860 patent. Petitioner also does not point to any evidence that Venkataramu was viewed or downloaded.

Lastly, Petitioner does not point to any evidence that an ordinarily skilled artisan would have considered either the SJSU website or the Internet Archive website to be a prominent forum for discussing secure multimedia distribution systems.

E. Public Accessibility Based on Dissemination Using Research Aids

Relying on *Blue Calypso*, Petitioner further contends that we "failed to acknowledge or apply" Federal Circuit law on the dissemination of

electronic references using research aids. Req. Reh’g 4–5 (citing *Blue Calypso*, 815 F.3d at 1350). In *Blue Calypso*, the court recognized that the presence of a “research aid” may establish public accessibility. 815 F.3d at 1350. For example, the court explained, “a published article with an express citation to the potentially invalidating reference would . . . provide the necessary guidance,” that is, “a sufficiently definite roadmap leading to [the potentially invalidating reference].” *Id.*

According to Petitioner, it had “established that *Venkataramu* was disseminated to interested parties via a ‘research aid,’ specifically, ‘a published article with an express citation to the potentially invalidating reference.’” Req. Reh’g 4. As support, Petitioner asserts that it “provided a web address for *Venkataramu* along with a declaration from a custodian at the Internet Archive to show that *Venkataramu* was publicly posted, available via the world wide web, and archived by the Internet Archive’s Wayback Machine by October 2, 2008.” *Id.* at 5 (citing Pet. 36; Ex. 1024). Petitioner also asserts that it “provided evidence that Mr. Venkataramu published an article in 2009 with an express citation to the web address of *Venkataramu* and covering much of the same material.” *Id.* (citing Pet. 36–37). Regarding that article, alleged in the Rehearing Request as a research aid, Petitioner further asserts that it “was disseminated in a textbook with a title redolent of its intended audience: ‘Handbook of Research on Secure Multimedia Distribution.’” *Id.* (citing Pet. 36; Ex. 1015). Additionally, Petitioner asserts that it “provided evidence of [the textbook’s] own dissemination before the 2010 filing date of the ’860 Patent in the form of a Library of Congress Online Catalog record with a 2009 publication/record creation date and a 2009 classification and call number, and via a reprinted

page of [the textbook] displaying a 2009 copyright date.” *Id.* at 6. Petitioner contends that it, therefore, “followed *Blue Calypso* to the letter and identified a quintessential ‘research aid’ for directing [an ordinarily skilled artisan] to the *Venkataramu* reference, namely, [the textbook] . . . containing an article published in the year before the filing of the ’860 Patent and directly citing *Venkataramu*’s web address.” *Id.* at 8.

The entirety of Petitioner’s effort in the Petition relating to use of the later article that refers to *Venkataramu* is a single footnote in the Petition:

Further evidence of public availability of *Venkataramu* before the priority date of the ’860 Patent is the book chapter authored by Ramya Venkataramu for the book “Handbook of Research on Secure Multimedia Distribution,” published on February 26, 2009, which provides a citation to the same internet address archived above: http://www.cs.sjsu.edu/faculty/stamp/students/RamyaVenkataramu_CS298Report.pdf. (Ex. 1015 155; Ex. 1022; Ex. 1023 ¶¶ 2-3.)

Pet. 36–37 n.4.

We are not persuaded that the textbook including a citation to *Venkataramu* was a research aid that is sufficient, without further explanation, to establish the public accessibility of *Venkataramu* prior to the earliest possible effective filing date for the ’860 patent, namely, March 21, 2010. Although a research aid may establish the public accessibility of a potentially invalidating reference, the research aid itself must have been publicly accessible in order to do so. *See Blue Calypso*, 815 F.3d at 1350 (agreeing with the Board, where it “acknowledged that the published article was publicly accessible and that it related to the same research presented in [the potentially invalidating reference]” but “nevertheless found the article insufficient because it did not include any citation to [the potentially invalidating reference]”). Here, Petitioner has not adequately shown that the

textbook including a citation to Venkataramu was publicly accessible before March 21, 2010.

As we noted in our Institution Decision, Ms. Amisha Manek testified in her Declaration that the title page of the textbook shows a 2009 copyright date and that a Library of Congress online catalog record shows that the *textbook* was “published or created” in 2009. Inst. Dec. 12 (citing Ex. 1023 ¶¶ 2–3); *see also* Ex. 1015 (textbook title page); Ex. 1022 (Library of Congress record). Even if taken at face value, the online catalog record identifies 2009 as the year in which the book was “published or created.” Ex. 1022. This record item does not sufficiently establish that the book was published in 2009. The book simply could have just been created in 2009. Petitioner also now points out that the online catalog record additionally shows classification and call numbers, each of which contains the value “2009.” *See* Req. Reh’g 6; Ex. 1022. Neither Petitioner nor Ms. Manek provides evidence of what the value “2009” in a classification number or a call number represents. Thus, although Petitioner’s evidence may show that the textbook was cataloged and listed in the Library of Congress online catalog at some point in time, it does not indicate *when* such cataloging or listing took place.

We decline to assume that the Library of Congress always makes available a catalog record for a book in the same year the book was created or written. Petitioner has not explained why the Library of Congress would have been aware of the book in the year of creation of the book, or, even assuming that the Library of Congress would have been aware of the book in 2009, what typical time period it would have taken for the library to prepare and make available an online catalog record for the book. Petitioner has not

addressed these topics. Petitioner also has not explained how one interested in the subject of the book would have located the book at the Library of Congress website.

Petitioner further points to evidence that the textbook including a citation to Venkataramu was published in the United States, and that unauthorized copying of the textbook was prohibited. Req. Reh’g 6 (citing 1015, 2). Relying on *FanDuel, Inc. v. CG Tech. Dev., LLC*, Case IPR2017-00902, slip op. at 15 (PTAB Oct. 18, 2017) (Paper 14), Petitioner contends that such evidence is “separate evidence of the public dissemination and availability of [the textbook].” Req. Reh’g 6. This is a new argument, which does not address what we overlooked or misapprehended in our Institution Decision. Petitioner does not indicate where in the Petition or Ms. Manek’s Declaration this argument was raised.

In any event, we are not persuaded by Petitioner’s new argument. The panel in *FanDuel* explained that “[t]he statutory phrase ‘printed publication’ has been interpreted to mean that *before the critical date* the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was ‘published.’” *FanDuel*, slip op. at 14 (emphasis added). Here, evidence that the textbook was published in the United States and that unauthorized copying of the textbook was prohibited does not establish *when* the textbook became publicly accessible.

Lastly, Petitioner contends that we “faulted [it] for purportedly failing to ‘explain[] the relationship, if any, between’ the textbook . . . and *Venkataramu*,” while “plainly overlook[ing] [Petitioner’s] evidence and related arguments . . . as to why a textbook named *Securing Digital Media*

that cited to *Venkataramu* and purported to explain nonpublic details of the FairPlay DRM system would naturally guide [an ordinarily skilled artisan] to *Venkataramu*.” Req. Reh’g 9.

We disagree. With respect to the textbook, Petitioner provided only one statement in its Petition: “Further evidence of public availability of Venkataramu before the priority date of the ’860 Patent is the book chapter authored by Ramya Venkataramu for the book “Handbook of Research on Secure Multimedia Distribution,” published on February 26, 2009, which provides a citation to the same internet address archived above: http://www.cs.sjsu.edu/faculty/stamp/students/RamyaVenkataramu_CS298Report.pdf.” Pet. 36–37 n.4. The Board must maintain neutrality and may not act or appear to act as an advocate for either party. If Petitioner desires a certain association be made between two documents, it must explain that association in the Petition itself, and not for the first time in a request for rehearing,⁸ much less suggest that the Board could have figured out whatever is not explained on its own without any explanation. Notably, the Petition has not explained why one interested in the subject matter of Venkataramu would have searched and located the textbook named “*Securing Digital Media*.” Petitioner cannot expect the Board to make or complete its case.

⁸ To the extent that there is evidence or analysis in the record that Petitioner believes makes the necessary explanation, we note that incorporation by reference is specifically prohibited. See 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document. Combined motions, oppositions, replies, or other combined documents are not permitted.”).

In any event, Petitioner has not shown *when* the textbook was first made publicly accessible.

V. 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 '860 patent on any of the asserted grounds.

VI. ORDER

Accordingly, it is ORDERED that Petitioner's request for rehearing is *denied*.

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