

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON WEB SERVICES, INC.,
Petitioner,

v.

KOVE IO, INC.,
Patent Owner.

IPR2020-00276
Patent 7,233,978 B2

Before BRYAN A. MOORE, BARBARA A. PARVIS, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Amazon Web Services, Inc.¹ requested an *inter partes* review of claims 1, 3, 6, 10, 14, 17, 23, 24, 30, and 31 of U.S. Patent No. 7,233,978 (Ex. 1001 “the ’978 patent”). Paper 2 (“Pet.” or “Petition”). Patent Owner Kove IO, Inc. filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). We denied the Petition and did not institute an *inter partes* review of any of the challenged claims. Paper 23 (“Dec. on Inst.”).

Petitioner requests rehearing of our Decision not to institute review. Paper 24 (“Reh’g Req.”). Having considered the Request for Rehearing, we determine that Petitioner has not shown that we abused our discretion in denying institution. We deny Petitioner’s request for the following reasons.

II. STANDARD OF REVIEW

37 C.F.R. § 42.71(d) provides that:

A party dissatisfied with a decision may file a request for rehearing. The burden of showing a decision should be modified lies with the party challenging the decision. *The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and where each matter was previously addressed in a motion, opposition, or a reply.*

See Office Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)) (emphasis added). Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of

¹ Petitioner identifies Amazon.com, Inc., Amazon.com Services, Inc., Amazon Digital Services, LLC, and AWSHC, Inc. as additional real parties-in-interest for this proceeding. Paper 2, 61.

judgment.” *PPG Indus., Inc. v. Celanese Polymer Specialties Co., Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

III. ANALYSIS

In its Request for Rehearing, Petitioner contends that we erred for three reasons. First, Petitioner contends Patent Owner did not dispute the hosts of RFC1034 (Ex. 1003) constitute the claimed “entities,” and that the Board erred by finding “the Petition and Declaration did not detail[] what is described by RFC1034’s use of host.” Reh’g Req. 1–2 (internal quotations omitted). Second, Petitioner contends the “Board misapprehended RFC1034’s teachings and overlooked the portion of Dr. Weissman’s declaration specifically explaining how RFC1034 ensures that the same domain name is not assigned to multiple host computers.” *Id.* at 2–5. Third, Petitioner contends the Board misunderstood Petitioner’s argument regarding the mail exchanges in RFC1034: “[Petitioner] AWS does not contend that ISI.EDU is a domain name that maps to ‘identifier.’ Rather, AWS contends that VENERA.ISI.EDU and VAXA.ISI.EDU are domain names that map to ‘identifier.’” *Id.* at 6–8. We address each of these arguments below.

A. *Petitioner’s arguments regarding the claimed “entity”*

In its Request for Rehearing, Petitioner contends “[Patent Owner] Kove’s Preliminary Response did not dispute that RFC1034’s ‘hosts’ are ‘entities.’” Reh’g Req. 1 (citing Pet. 19, Ex. 1002 ¶ 74; Prelim. Resp. 32–33). According to Petitioner, Patent Owner did not argue that Petitioner provided insufficient detail on what a “host” means, and thus, the Board erred by finding “the Petition and Declaration did not detail[] what is

described by RFC1034's use of host.” *Id.* at 1–2 (internal quotations omitted).

Petitioner's argument is misguided. When determining whether to institute a requested review, our inquiry seeks to ascertain whether Petitioner has demonstrated a reasonable likelihood of success on the challenges set forth in the Petition. 35 U.S.C. § 314(a); *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). That inquiry is not limited to disputes presented in a Patent Owner Preliminary Response. Indeed, filing of a Patent Owner Preliminary Response is optional and does not impact our statutory obligation to review the Petition for a reasonable likelihood of success. 35 U.S.C. § 313; 37 C.F.R. § 42.107(a).

Additionally, Petitioner contends in its Request for Rehearing that we misapprehended its argument regarding the claimed “entity.” Reh’g Req. 2. In our Decision Denying Institution, we found Petitioner failed to explain sufficiently what is described by RFC1034's use of “host.” Dec. on Inst. 20. We stated:

Absent from Petitioner's arguments is clear explanation of how a “host” as disclosed in RFC1034 meets the claimed entity and how a domain name (i.e., the “identifier”) identifies a single host. The Petition's cursory treatment of these claim elements refers only to a “host” without detailing what is described by RFC1034's use of “host.”

Id. (citing Pet. 19–20, 22–23). Petitioner now contends:

Dr. Weissman did state what a ‘host’ means: ‘A host may be a computer connected to other computers to which it provides data, services, or applications over a network.’ Indeed, ‘host’ is the standard term for a computer that is accessible over a network, appearing in hundreds of patents and PTAB decisions.

Reh’g Req. 2 (citing Ex. 1002, ¶ 23).

The portion of Dr. Weissman’s testimony that Petitioner now relies upon does not remedy the deficiencies we identified in the Petition. As we stated, Dr. Weissman’s testimony “does not resolve the failure of Petitioner to account for *the required relationship* between a host computer (i.e., entity) and a domain name (i.e., identifier).” Dec. on Inst. 20–21 (citing Pet. 19–20, 22–23; Ex. 1002 ¶¶ 75, 88) (emphasis added). Thus, Petitioner fails to show that we misapprehended or overlooked arguments or evidence regarding the claimed “entity” because Petitioner did not clearly explain how a “host” as disclosed in RFC1034 meets the claimed entity and how a domain name (i.e., the “identifier”) identifies a single host. A rehearing request is not an opportunity to argue what should have been addressed in the Petition.

Accordingly, we are not persuaded that we misapprehended or overlooked arguments or evidence regarding the claimed “entity.”

B. Petitioner’s argument that RFC1034’s domain name is an identifier that uniquely identifies a host

Petitioner contends we erred by finding, “Petitioner and Dr. Weissman fail to explain how a given domain name identifies only one host computer of RFC1034.” Reh’g Req. 2 (citing Dec. on Inst. 21). According to Petitioner, “[t]he Board misapprehended RFC1034’s teachings and overlooked the portion of Dr. Weissman’s declaration specifically explaining how RFC1034 ensures that the same domain name is not assigned to multiple host computers.” *Id.* at 3. Petitioner contends:

RFC1034 recites that a “domain name *identifies* a node” in the “domain name space tree.” Ex. 1002, App’x B, at 3. “For example, the Internet uses some of its domain names to identify hosts.” *Id.* (emphasis added). A domain name could not identify a host if it corresponded to multiple hosts. RFC1034’s disclosure

that “the Internet uses some of its domain names to identify hosts” maps, almost word-for-word, onto the claim language: “the identifier identifies an entity.”

Reh’g Req. 3.

Petitioner further contends that, “[b]y stating that each host computer was identified by a *unique* domain name, Dr. Weissman made clear that no two host computers shared a domain name, i.e., a domain name corresponds to only one host.” Reh’g Req. 4 (citing Ex. 1002 ¶ 75). Petitioner cites Dr. Weissman’s testimony regarding RFC1034’s unique domain names:

The domain name space arranges its identifiers in a tree structure. The domain name is the list of labels (nodes) on the path from the node to the root of the tree. DNS states that “brother nodes” in the tree cannot have the same label. The concatenation of nodes using the dotted quad notation to form domain names in this fashion guarantees that each fully qualified domain name will be unique.

Reh’g Req. 4 (citing Ex. 1002 ¶ 75). According to Petitioner,

because ‘each fully qualified domain name will be unique,’ any new host will receive a new, unique domain name that has not already been assigned to a different host. The Board overlooked Dr. Weissman’s technical explanation of RFC1034’s mechanism of ensuring that a domain name corresponds to only one host.

Id. (internal citation omitted).

According to Petitioner, we overlooked Dr. Weissman’s explanation that a single identifier can have multiple IP addresses associated with it.

Reh’g Req. 5. Petitioner contends, “[a]n identifier may have any number of IP addresses (which are location strings) associated with it. For example, the identifier “vaxa.isi.edu” has two IP addresses or location strings:

(1) “10.2.0.27”; and (2) “128.9.0.33” as shown below.” *Id.* (citing Ex. 1002 ¶ 92). Petitioner concludes (*id.*):

Thus, the fact that there are two IP addresses does not mean there are two hosts. Rather, one host is associated with multiple IP addresses. This conforms perfectly to the claim language, which contemplates that a single entity can be associated with multiple location strings: “an identifier and at least one location string associated with the identifier.”

Tellingly, Petitioner fails to provide any citation to where the arguments it now advances were previously presented in the Petition. *See id.* at 3–5. Rather, Petitioner advances new attorney argument relying upon passing citations to claim charts provided as an appendix to Dr. Weissman’s declaration submitted as an exhibit in support of the Petition. *E.g. id.* (citing Ex. 1002, App’x B, at 3). We do not consider arguments and evidence not previously presented *in the Petition*. 35 U.S.C. § 312(a)(3) (A petition “may be considered only if . . . it identifies, . . . with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim”). A request for rehearing is not an opportunity to present new arguments and evidence. *See* 37 C.F.R. § 42.71(d) (A request for rehearing “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.”). Rather, the task at hand is to determine whether we misapprehended or overlooked an argument or evidence presented previously presented.

As we stated in our Decision, Petitioner failed to adequately address in its Petition how RFC1034’s disclosure of domain names allegedly meets the claimed identifier. In our Decision Denying Institution, we construed the claim term “identifier” to mean “a unique encoding that identifies *an individual entity*, and with which zero or more data location specifiers are

associated in a location server.” Dec. on Inst. 9–13 (emphasis added). Our inclusion of the phrase “identifies an individual entity” within our construction was based on the ’978 patent’s disclosure that the claimed identifier “is assumed to be unique to a particular entity” and reinforced by the examples of identifiers set forth in the Specification, namely, a unique customer identifier such as a Social Security Number (SSN), a vehicle identification number (VIN), and an electronic serial number (ESN) of a cellular phone. *Id.* at 11–12 (citing Ex. 1001, 7:62–64, 7:66–8:3, 22:48–52, 24:16–21). We further found that the “recitation of the singular term ‘an identifier’ in the claim language supports the foregoing understanding, particularly where the recitation relates to the relationship between an identifier and the entity it identifies.” *Id.* at 12 (citing Ex. 1001, 25:28–30, 28:51–52, 28:55). In light of our construction based on intrinsic evidence, Petitioner was reasonably required to explain how the applied art demonstrated the claimed identifier is a unique encoding that identifies *an individual entity* (i.e., *one* host computer). *See id.* at 21 (citing Prelim. Resp. 35) (finding “Petitioner and Dr. Weissman fail to explain how a given domain name identifies only one host computer of RFC1034”).

As we found in our Decision, Petitioner’s arguments, as presented in the Petition, do not explain how the domain *venera.isi.edu* allegedly identifies only a single host. *Id.* at 21. Dr. Weissman’s testimony that “no two host computers shared a domain name, i.e., a domain name corresponds to only one host” is conclusory. Ex. 1002 ¶ 75; Reh’g Req. 4. Regarding this testimony, we stated, “Dr. Weissman’s clarification does not resolve the failure of Petitioner to account for the required relationship between a host

computer (i.e., entity) and a domain name (i.e., identifier).” Dec. on Inst. 21 (citing Pet. 19–20, 22–23; Ex. 1002 ¶¶ 75, 88). We elaborated:

To the contrary, the resource record for the domain name on which Petitioner and Dr. Weissman rely, venera.isi.edu, describes only that the domain resolves to two IP addresses, namely 128.9.0.32 and 10.1.0.52, which Petitioner cites as meeting the claimed “at least one location string,” not the claimed “entity.” Petitioner’s brief discussion of this disclosure does not explain how the domain venera.isi.edu allegedly identifies only a single host.

Id. (citing Ex. 1003, 14; Pet. 20, 28).

Accordingly, Petitioner does not persuade us of any argument or evidence we misapprehended or overlooked in the Petition with regard to Petitioner’s failure to demonstrate that RFC1034’s domain name meets the claimed identifier as properly construed.

C. Petitioner’s argument that RFC1034’s domain name is an identifier that uniquely identifies a mailbox

Petitioner contends we misapprehended Petitioner’s argument regarding RFC1034’s mail exchanges: “[Petitioner] AWS does not contend that ISI.EDU is a domain name that maps to ‘identifier.’ Rather, AWS contends that VENERA.ISI.EDU and VAXA.ISI.EDU are domain names that map to ‘identifier.’” Reh’g Req. 6–7 (citing Dec. on Inst. 22; Ex. 1002 ¶¶ 94–95). Petitioner further argues, “RFC 1034 shows that a single institution (*i.e.*, the institution associated with ISI.EDU) has multiple mail exchanges (VENERA.ISI.EDU and VAXA.ISI.EDU) to handle mail requests. It is not a surprise that one institution would need more than a single mail exchange to handle all mail requests.” *Id.* at 7–8.

We are not persuaded by Petitioner’s arguments. Our Decision addressed the failure of Petitioner’s mailbox theory to account for the

required relationship between a mailbox (i.e., entity) and a domain name (i.e., identifier). Dec. on Inst. 21. We explained that Petitioner and Dr. Weissman did not account for the identifier recited in claim 1. *Id.* at 22. In particular, we considered Petitioner’s arguments and evidence and found:

The disclosure of RFC1034, however, does not support Petitioner’s assertion. RFC1034 describes returning the record reproduced below in response to a “mailer trying to send mail to Mockapetris@ISI.EDU [by asking] the resolver for mail information about ISI.EDU, resulting in a query for QNAME=ISI.EDU, QTYPE=MX, QCLASS=IN” (Ex. 1003, 17):

ISI.EDU.	MX	10 VENERA.ISI.EDU.
	MX	10 VAXA.ISI.EDU.

The response record reproduced above shows the domain name ISI.EDU to be associated with two mail exchanges, namely venera.isi.edu and vaxa.isi.edu. *Id.* Thus, contrary to Petitioner’s argument, RFC1034 describes that in response to requesting “mail information about ISI.EDU . . . [t]he response’s answer section would be” both venera.isi.edu and vaxa.isi.edu, not only venera.isi.edu, as Petitioner contends. *Id.* Petitioner’s theory fails to account for vaxa.isi.edu and explain how the entity/identifier relationship is allegedly disclosed in light thereof.

Dec. on Inst. 21–22.

As to Petitioner’s additional arguments regarding the mail exchange needs of any one institution, Petitioner fails to cite any portion of the Petition setting forth this argument. *See* Reh’g Req. 7–8. Again, we do not consider arguments and evidence not previously presented *in the Petition* and a rehearing request is not an opportunity to argue what should have been addressed therein. 37 C.F.R. § 42.71(d); 35 U.S.C. § 312(a)(3).

IV. CONCLUSION

Having considered Petitioner's arguments and the evidence of record, Petitioner fails to show that we misapprehended or overlooked arguments or evidence in our Decision. Petitioner, therefore, has not demonstrated that we abused our discretion in denying institution.

V. ORDER

Accordingly, it is hereby:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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