

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

DIGITALDOORS, INC.
Patent Owner

Case IPR2023-00973
U.S. Patent 8,468,244

**PATENT OWNER DIGITALDOORS, INC.'S
RESPONSE TO THE PETITION**

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I. Introduction and Summary of Arguments

Patent Owner DigitalDoors, Inc. submits its Response to the Board's decision to institute *inter partes* review of challenged claim 1 of U.S. Patent No. 8,468,244 (EX1001, "the '244 Patent") based upon alleged obviousness in view of US 2003/0182435 (EX1005, "Redlich") alone and in combination with US 8,601,598 (EX1006, "Ozzie"). Paper 10.

Facing seven IBM IPR petitions on different patents simultaneously, DigitalDoors limited its argument at the institution phase on this patent to the fact that the same or substantially the same art and arguments were before the Patent Office during examination of the '244 Patent as IBM is now raising. Paper 6 at 12. In instituting the *inter partes* review, the Panel concluded that, although the patent that ultimately issued from Redlich and an application related to Redlich were both before the examiner, they were not presented or considered as §§ 102-103 art at that time. Paper 10 at 9-11.

At this point, therefore, DigitalDoors will focus on the absence of one of the claim elements in the asserted prior art. That art fails to establish the "means for parsing remainder data not extracted from said data...." IBM's petition spends very little time attempting unsuccessfully to establish the function of this means-plus-function element. While IBM can point to the prior art's description of a structure, a parsing algorithm, nowhere does IBM demonstrate the function, using that parsing

algorithm on remainder data. And nothing in the prior art or IBM's expert declaration suggests a reason for doing so.

II. '244 Patent Overview

Two decades ago, the private sector did not generate or keep the massive amounts of data it now does. Nor did it have the same concerns about data security or data recovery after a disaster. There was not much private-sector activity directed at addressing these issues.

The U.S. government was different. It, particularly the military and national security sectors, was starting to generate and use lots of data at that time. And it was grappling with how to maintain the secrecy of all this stored data. Another concern was data recovery in the event of loss, such as destruction of a data center.

Ron Redlich and Martin Nemzow founded DigitalDoors in 2001 to develop data-security and survivability solutions for the U.S. Government, primarily the military and intelligence agencies. Core features of what DigitalDoors first developed involved extracting some content from files, documents, and data objects and then dispersing both the extracted and the less-security-sensitive remainder data separately in pieces to different storage locations. *See e.g.*, EX1001, 3:19-4:14. DigitalDoors presented these core features as part of several military and government-agency processes seeking data-security solutions in the early 2000s. Its innovations were unique and well-received. William H. Webster, a former director of both the CIA and

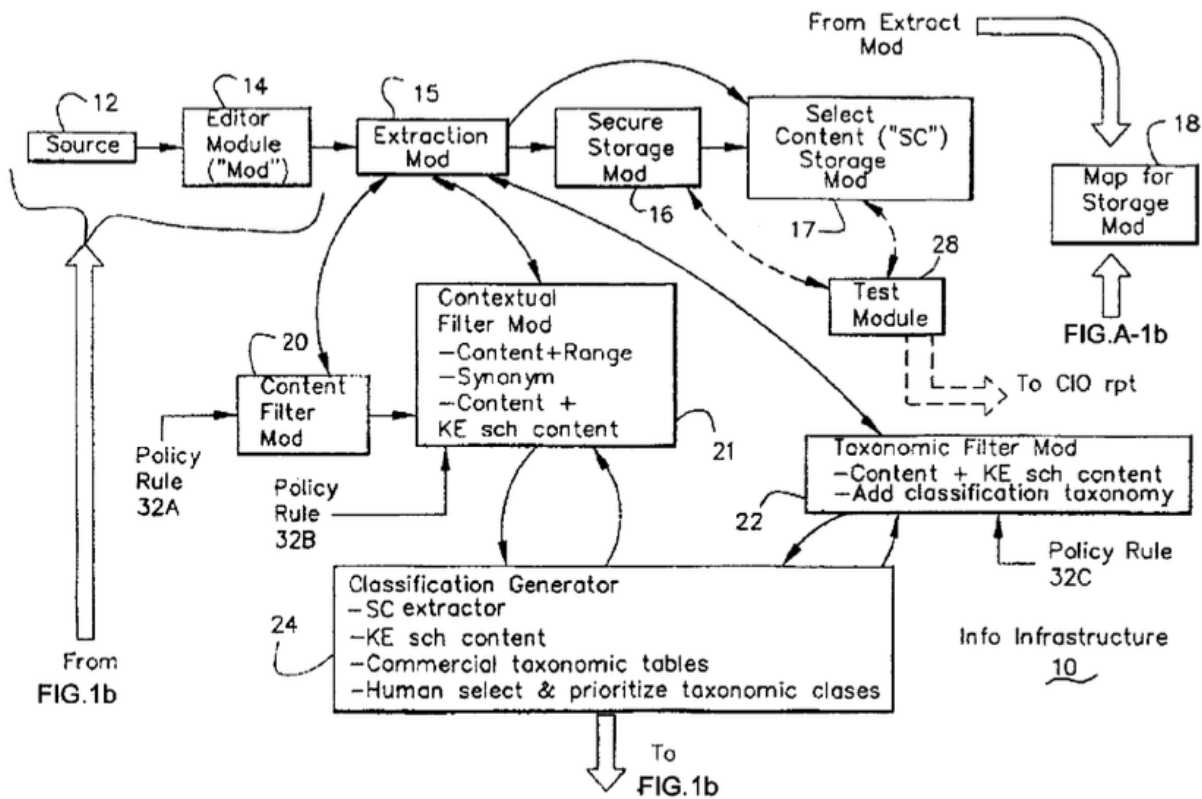
FBI, wrote, “we are impressed by your concepts for multilevel dissemination and collection of data stream information and believe it could have important uses for the security of our country.” EX2010. Ret. Major General Robert Behler, former Commander of the Air Force Command and Control, and Intelligence, Surveillance and Reconnaissance Center, Langley Air Force Base, then affiliated with the Johns Hopkins Applied Physics Laboratory, which was involved in evaluating proposed solutions, wrote, “[w]e are very encouraged about your approach to this critical national challenge...I’ve heard many different approaches to [Information Assurance]...Yours seems to have t[he] most promise.” EX2011. Unfortunately, as a small startup maneuvering the complex and bureaucratic government-contracting process, DigitalDoors was unable to secure a contract to complete development of and implement its solution.

DigitalDoors’s ’244 Patent built upon the foundation of these core features in addressing problems in distributed enterprise systems. *See e.g.*, EX1001, 3:19-4:14. Spanning 524 columns, the ’244 Patent is much longer than, and includes many elements not found in, the first family of patents that DigitalDoors pursued and obtained. EX1001. The ’244 Patent is titled “Digital Information Infrastructure and Method for Security Designated Data and with Granular Data Stores.” *Id.* It has been cited by other patents approximately 3200 times, including almost 200 times by

IBM's own patents, and the patents in this family have been collectively cited approximately 6,000 times. EX2012 and EX2013.

The '244 Patent added numerous features to optimize implementing the company's technologies in a distributed enterprise environment and to make them more robust in several ways. EX1001, 2:65-3:15. Such distributed enterprise systems pose particular risk of "rogue" insiders accessing data they should not and misusing it. *Id.*, 2:10-19. In addition, much of the data in these environments is unstructured or semi-structured, making sifting through it and organizing it more challenging. *Id.*, 1:36-41.

The patent's Figure 1a provides an exemplary illustration of the processing of input data and storage of select content data:



EX1001, Fig. 1a. This figure shows the data-ingestion in the arrow at the far left, and the data passing through various filters and modules to get to storage.

Claim 1 is the '244 Patent's only independent claim, and the only claim challenged in this *inter partes* review. With the critical element bolded, it reads:

1. A distributed computer system for organizing and processing data, the data to be processed having select content represented by one or more predetermined words, characters, images, data elements or data objects, said distributed computing system having (a) a plurality of select content data stores in a server cloud for respective ones of a plurality of security designated data and (b) a plurality of granular

data stores, each said select content data store and granular data store having respective access controls thereat, said plurality of data stores and said server cloud operatively coupled over a communications network, comprising:

means for identifying plurality of select content data stores for respective ones of a plurality of security designated data in said server cloud,

an extractor for extracting and storing said security designated data in respective select content data stores of said server cloud;

a processor activating at least one of said select content data stores in said server cloud thereby permitting access to said select content data stores and respective security designated data based upon an application of one or more of said access controls thereat;

means for parsing remainder data not extracted from said data to be processed and storing the parsed data as data segments in respective granular data stores;

said processor having means for applying a reconstruction data process employing said respective access controls to combine one or more of said security designated data and remainder data.

III. Level of Ordinary Skill in the Art

The Institution Decision adopted Petitioner's definition of the level of skill in the art. For purposes of this review, we neither adopt nor oppose that definition. The prior art lacks one of the elements, and the Petition fails to point to any suggestion to

one of skill in the art to develop that element. For that reason, this determination is unnecessary in this proceeding.

IV. Claim Construction

In its institution decision, the Board also applied the constructions IBM proposed in its petition. Paper 10 at 19-20. DigitalDoors neither concedes to nor disputes those constructions at this stage. Claim construction would not impact the absent element in the prior art.

It is important to understand what IBM contends is the function and structure for the “parsing remainder data...” claim element. The function is “parsing remainder data not extracted from said data to be processed and storing the parsed data as data segments in respective granular data stores.” Pet., 12. IBM contends the structure is “a filter, such as the filter labeled as box 45 in Figure 3, performing the algorithm as set forth in the box labeled as 556 in EX1001, Figure 41 and described in EX1001, 506:63- 507:8 and 442:55-67, and structural equivalents thereof.” Pet., 12-13. That “algorithm” is a “parsing” algorithm. *See* Pet., 13, citing and quoting EX1001, 506:63-507:8 (“A parsing algorithm function 554 is utilized...”) and 442:55-67 (“Algorithms may be implemented to parse the plain text document.”).

V. Summary of References Cited in the Petition

Petitioner's primary reference is US 2003/0182435 A1, (EX1005 “Redlich”), a publication of an application that issued as a member of the first patent family

DigitalDoors pursued. Its disclosure comprises 65 columns, significantly shorter than the '244 Patent's disclosure. In part, it teaches a data security system and method used with a portable computing device. EX1005, Abstract, ¶ 2. It details extracting security-sensitive data and storing it in multiple storage locations separately from the remainder data. *Id.*, Abstract, ¶ 34. That extraction can be accomplished with a filter/parsing algorithm. *Id.*, ¶¶ 26, 35, 37. The focus of Redlich is protecting the security sensitive content via distributed storage and different security clearances for the extracted data, which is not required for remainder data. *Id.*, ¶ 35. Indeed, the remainder data may remain in its original location, and multiple storage locations for it is not required. *See* EX1005, ¶ 35 (“the remainder data is also stored in the network *if necessary*) (emphasis added); ¶ 36 ([a] storage system stores extracted data and remainder data (*if necessary*).”) (emphasis added). Reconstruction of the original data is permitted only in the presence of predetermined security clearance and within certain geographic territories. EX1005, Abstract.

Petitioner's secondary reference is U.S. Patent No. 8,601,598 (EX1006, “Ozzie”). Petitioner relies on Ozzie for only one element of the challenged claim: “... a plurality of select content data stores in a server cloud....” Pet., 39-42. For purposes of this response, we do not challenge the presence of that element.

VI. Legal Standard for Obviousness

The IPR petitioner has the burden of proving unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e); *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016). Its petition must identify with particularity all evidence and arguments supporting the challenge to each claim. 35 U.S.C. § 312(a)(3). The petition “must specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4).

A patent claim is obvious under 35 U.S.C. § 103(a) only “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a) (pre-AIA).

Petitioner must “explain *why* a person of ordinary skill in the art would have combined elements from specific references in the way the claimed invention does.” *Active Video Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012). “[R]easoned analysis and evidentiary support” are needed to establish missing claim limitations. *Arendi S.A.R.L. v. Apple*, 832 F.3d 1355, 1361–62 (Fed. Cir. 2016). That evidentiary support must be “clear and particular.” *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334 (Fed. Cir. 2002).

Mere conclusory statements cannot sustain an obviousness contention. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). “The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil*, 829 F.3d at 1380.

In attempting to establish the motivation to provide missing claim limitations, it is “inappropriate to use the template provided by the inventor, to render the inventor’s contribution obvious.” *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1271 (Fed. Cir. 2018). “The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.” *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985); see also *Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 n.3 (Fed. Cir. 2008) (“We must still be careful not to allow hindsight reconstruction of references to reach the claimed invention without any explanation as to how or why the references would be combined to produce the claimed invention”). “The inventor’s own path itself never leads to a conclusion of obviousness; that is hindsight. What matters is the path that the person of ordinary skill in the art would have followed, as evidenced by the pertinent prior art.” *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012).

VII. IBM Has Not Shown “Means for Parsing Remainder Data...”

IBM's petition raises two obviousness grounds. Ground 1 depends solely on Redlich, while Ground 2 combines Redlich and Ozzie. Pet., 15. Ozzie, however, has nothing to do with the “means for parsing remainder data” element, and so both grounds rise and fall based on Redlich alone. Pet., 57-61.

IBM's petition fails to establish the claimed function (“parsing remainder data”) in Redlich. The question is not whether Redlich discloses a filter/parsing algorithm. It does. But IBM's petition needed to do more than that, because that's what the claim requires: a “means for *parsing remainder data*.”

To invalidate the '244 Patent's Claim 1, IBM had to establish the prior art teaching not just the claimed means-plus-function structure, but also that structure performing the *claimed function*. In *Deere & Co. v. Gramm*, 842 Fed. Appx. 628, 634 (Fed. Cir. 2021), for example, the challenger demonstrated the existence of a spring which matched the structure of a means-plus-function element in the claim. The challenger, however, “failed to show that [the] spring performs the [] function of the biasing means” in the claim. *Id.* For that reason, the claim was found valid. *Id.*

IBM focuses its efforts on showing a parsing algorithm in Redlich and ignores its obligation to demonstrate the function, applying that parsing algorithm to remainder data. All the parsing-algorithm examples IBM points to are for parsing the original data, not data after it has been processed.

IBM first points to the filter in Redlich's ¶ 35 and Figure 10. But as ¶ 35 explains, that filter is designed to apply to the original input data, before remainder data ever exists:

...**filtering** data from the data input computer, extracting security sensitive words, phrases, characters, icons, or data objects and **forming subsets of** extracted data and **remainder data**.... The information processing system which secures data per the community of interest security level in the [sic] includes **a data filter for the data input from the data input computer** which extracts the security sensitive words, phrases, icons or data objects.

EX1005, ¶ 35 (emphasis added); EX2014, Easttom Decl. ¶ 21. Redlich's discussion of Figure 10 then reinforces this point, emphasizing that the filter's parsing algorithm is designed to be used on input data at the start of the process, not on remainder data. In fact, the remainder data is what the parsing algorithm leaves behind, and the system immediately shunts that remainder data to storage facilities that Redlich never describes as utilizing a filter/parsing algorithm:

Document or data object 100, in function element 550, is created or obtained by the **input computer device**. The document is stored in a normal manner in customary data store 552. A parsing algorithm function 554 is utilized in parsing step 556. **The parsing algorithm, as stated earlier, targets the plaintext document or data object 100** and splits, cuts and segments (that is, parses) the document by bit count, word, word count, page, line count, paragraph count, any identifiable

document or icon characteristic, or other identifiable feature such as capital letters, italics, underline, etc. Hence, ***the parsed document 100 constitutes at least remainder data and data which is extracted or parsed or segmented out.*** A plurality of data extracts maybe obtained. The ***parsed data (which is both the extract data and remainder data) is then dispersed into storage facilities*** data store DS 1, 2, 3, 4, etc.

EX1005, ¶ 231 (emphasis added); EX2014, ¶¶ 22-25.

IBM tries to bolster its argument by showing Redlich's Fig. 10 and the '244 Patent's Fig. 41 side-by-side on page 58 but doing so only undermines its position. The '244 Patent's description of Figure 41 is identical to the one quoted immediately above from Redlich about Redlich's Figure 10, explaining that the filter/parsing algorithm in that figure is applied only to input data, not to remainder data. EX1001, 506:62-507:9.

The fact that both Redlich and the '244 Patent discuss the same type of parsing algorithm, as IBM points out (Pet., 58-59), doesn't help IBM. IBM still bears the burden of showing the prior art applying that structure (the filter/parsing algorithm) to perform the '244 Patent's claimed function: "parsing remainder data..." IBM's quotes about how the parsing algorithm works don't do that.

IBM really spends just three paragraphs starting in the middle of the Petition's page 59 and running to page 60 trying to establish the claimed function, "parsing remainder data...." In the first, it colors "remainder data" and the evidence

purportedly showing parsing of that remainder data purple, which actually illustrates the absence of that function in Redlich:

IBM "Evidence" from Redlich	Response
"... For example, financial data maintained by an institute in its original state, and a copy thereof <i>can be parsed with an algorithm</i> , the <i>parsed segments</i> dispersed off-site, (that is, separated and stored in extract and remainder stores or computer memories)" EX1005, ¶37 (emphasis from IBM Petition).	This statement makes clear that the parsing is done to the "financial data" in its original state. The "parsed segments" that include remainder data are the <i>result</i> of the parsing algorithm, not what that algorithm is applied to. And those segments are sent to storage, where no further parsing occurs.
"The parsing occurs with the filtering of the plain text source document 100 and the subsequent storage of extracted data apart from remainder data." EX1005, ¶106.	Parsing is done to the "source document," <i>not</i> remainder data. That remainder data goes to storage rather than additional parsing.
" <i>Granular extraction of data elements</i> in a data object may be permitted." EX1005, ¶143 (emphasis from IBM Petition).	This statement doesn't say much, but what it does say is that extraction (the parsing) is done to the original "data object."
"The process involves <i>parsing the documents or content into granular data groups</i>" EX1005, ¶238 (emphasis from IBM Petition).	This statement describes parsing "the documents," not segments of remainder data. Instead, the paragraph that precedes the one IBM cites explains that these "granular data groups" are "dispersed to different storage locations"

IBM "Evidence" from Redlich	Response
	after the one and only parsing step of the original input content. EX1005, ¶ 237.

See, also, EX2014, ¶ 28.

IBM concludes that first paragraph with a cite to ¶¶ 230-32 of the Zadok declaration. That part of the expert report, however, is merely a word-for-word copy of this part of IBM's petition. *Compare, for example*, EX1003, ¶¶ 230-32 with Pet., 59. As such, this part of the report is entitled to no weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (August 24, 2022) (holding that expert declarations that are merely exact restatements of the petition's arguments are disregarded). Moreover, because that part of the Zadok report is an exact copy of the Petition, the report cites the exact same evidence as the Petition, which we've addressed above.

IBM's second paragraph merely notes that the parsing algorithms in the '244 Patent and Redlich operate in the same manner, parsing by "bit count, word, word count, page count, line count, paragraph count and parsing based upon any identifiable document characteristic, capital letters, italics, underline ..." Pet., 59-60 (comparing EX1005, ¶ 106 to EX1001, 442:55-62).¹ But that fact has nothing to do

¹ IBM's brief also cites ¶ 233 of the Dr. Zadok declaration at the end of this paragraph. That paragraph is another word-for-word copy of what is in the brief and cites exactly the same evidence as the brief. *Compare* EX1003, ¶ 233 with Pet., 59-60. And because that declaration says the same thing and cites the same evidence as what's in the brief, our response to the brief applies to the declaration as well.

with *the function* to which the parsing algorithms in each patent are applied. The question is whether Redlich teaches using that parsing algorithm for the claimed function, parsing remainder data. This paragraph from the Petition and the evidence it cites don't address that question. EX2014, ¶ 30.

IBM's third paragraph trying to establish parsing of remainder data begins on page 60, but that effort is also unsuccessful. IBM first states, without any evidentiary support, that "one way to store the remainder data is by further dividing the remainder data and dispersing the divided remainder data to available granular data stores." Pet., 60. This attorney argument is not evidence and could not support a finding of parsing remainder data. Even if it were evidence, however, it still would fail; that sentence merely contends that it *would have been possible* to parse remainder data prior to dispersal. Establishing mere possibility, *what could have been done*, is legally insufficient. *Personal Web Technologies, LLC v. Apple, Inc.*, 848 F.3d, 993-994 (Fed. Cir. 2107).

The only other thing IBM does is quote the same statement about how the parsing algorithm works ("by bit count, word, word count, page count...") that it quoted previously and that we addressed two paragraphs earlier. Pet., 60 (citing EX1005, ¶106). Again, that statement concerns *how* the parsing algorithm works, not the *function* to which it is applied. So IBM's quotation fails to establish use of the parsing algorithm for the claimed function. Its concluding citation to ¶¶ 234-35

of the Dr. Zadok declaration doesn't help either, because those paragraphs make further unsupported statements and then quotes just a single piece of evidence, the exact same statement about how the parsing algorithm works rather than something about what it is applied to. *See* EX2014, Easttom Decl., ¶¶ 31-34 (explaining why this portion of the Zadok declaration fails to establish parsing of remainder data).

The last paragraph in this section of IBM's petition, beginning "Redlich further discloses," focuses on the second claimed function, "means ... for storing" and therefore is irrelevant to the parsing-remainder-data function. Pet., 60-61.

Because IBM never concedes that "parsing remainder data" is absent in Redlich, neither its Petition nor the Dr. Zadok declaration make any effort to argue that applying the parsing algorithm to this function would have been obvious, let alone try to meet the legal requirements to make that argument with "reasoned analysis and evidentiary support" that is "clear and particular."

IBM had an obligation to establish the function of "parsing remainder data" in its petition. A petitioner that fails to present arguments and evidence in its petition cannot later rely on them. In *SAS Inst., Inc. v. Iancu*, the Supreme Court explained that "the petitioner is master of its complaint" and the petition is "the centerpiece of the proceeding both before and after institution." 138 S. Ct. 1348, 1355, 1358 (2018). The petition binds the petitioner. *Henny Penny Corp. v. Frymaster, LLC*, 938 F.3d 1324, 1330-31 (Fed. Cir. 2019). And "[i]t is of the utmost importance" that "the

initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). The PTAB, therefore, must limit its review to arguments raised in the petition for both fairness and efficiency. *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1368 (Fed. Cir. 2015).

For these reasons, IBM cannot go back now and try to correct that absence with a supplemental expert declaration or by raising new arguments or evidence.

VIII. The IPR Process Denies DigitalDoors Constitutional Rights, Including Due Process.

Patent Owner preserves its Constitutional and due process issues for appeal, including the issues in *Celgene Corp. v. Peter*, 931 F.3d 1342 (Fed. Cir. 2019) (retroactive application of IPRs to pre-AIA patents is an unconstitutional taking under the Fifth Amendment).

The application of the PTAB’s rules and procedures in this IPR has denied DigitalDoors due process and constitutional protection. The Supreme Court expressly reserved due process challenges to AIA proceedings. *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1379 (2018).

The Due Process clause guarantees “fundamental fairness” before the government deprives a person of property. *Lassiter v. Dep’t of Soc. Servs. of Durham*

Cty., N. C., 452 U.S. 18, 24 (1981). But IPR proceedings lower the Petitioner's burden of proof to the preponderance standard.

Further, retroactive application of IPRs to pre-AIA patents is an *ex post facto* taking. The reviewed patent's effective filing date pre-dates the AIA. For example, the IPR process provides patent owner no opportunity to amend its claims.

IX. Conclusion

Challenged claim 1 of the '244 Patent is not obvious.

Dated: March 11, 2024

Respectfully submitted,

/Ragnar Olson/

Ragnar Olson

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CERTIFICATE UNDER 37 CFR § 42.24(d)

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Response totals 4,106 which is less than the 14,000 words allowed under 37 CFR § 42.24(b)(1).

Dated: March 11, 2024

/Ragnar Olson/
Ragnar Olson
Reg. No. 58,684

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 11, 2024, a complete and correct copy of the foregoing PATENT OWNER'S RESPONSE AND EXHIBITS was served via electronic mail on the following counsel of record for Petitioner:

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