

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SECURITY FIRST INNOVATIONS, LLC,
Patent Owner.

IPR2024-00213
Patent 9,338,140 B2

Before THOMAS L. GIANNETTI, STEPHEN E. BELISLE, and
DANIEL KAZHDAN, *Administrative Patent Judges*.

KAZHDAN, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Google LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–10 (the “challenged claims”) of U.S. Patent No. 9,338,140 B2 (Ex. 1001, the “’140 patent”) based on four different grounds. Paper 2 (“Pet.”). SecurityFirst Innovations, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). The Board denied institution of *inter partes* review as to all challenged claims. Paper 8 (“Decision”).

Petitioner requests reconsideration of the Decision. Paper 9 (“Req. Reh’g”). Petitioner addresses the four grounds in the Petition as two groups: (1) Grounds 1–3 and (2) Ground 4. For Grounds 1–3 (based on Ophir,¹ Takeda,² and additionally, for Grounds 2 and 3, Birrell³ and Dickinson,⁴ respectively), Petitioner argues that “the Board misapprehended claim 1’s scope” and, regardless, “Grounds 1–3 meet the Board’s claim construction.” Req. Reh’g 1, 4 (capitalization altered); *see id.* at 1–12. As for Ground 4 (based on Dickinson and Takeda), Petitioner argues that “[t]he Board misapprehended or overlooked the Petition’s showing” that Dickinson teaches a limitation that the Board had found it had not. *Id.* at 13; *see id.* at 12–15.

For the reasons that follow, Petitioner’s request for rehearing is *denied*.

¹ U.S. Patent Application Publication 2004/0143733 (Ex. 1007).

² U.S. Patent Application Publication 2001/0053221 (Ex. 1008).

³ U.S. Patent No. 7,529,834 (Ex. 1033).

⁴ International Application Publication WO 2001/022322 (Ex. 1005).

II. ANALYSIS

A. Applicable Standard

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The Board abuses its discretion if its decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *CyWee Grp. Ltd. v. ZTE (USA), Inc.*, 90 F.4th 1358, 1364 (Fed. Cir. 2024) (citations omitted). By regulation, “[t]he burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). “The request 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, a reply, or a sur-reply.” *Id.*

B. Representative Claim

Claim 1 is illustrative of the claimed subject matter and is reproduced below—with petitioner’s limitation labels added for convenience⁵:

1. [PRE] A secure storage network comprising:
 - [1A] a plurality of physical storage devices storing thereon a plurality of shares, the plurality of shares being associated with at least one session key used to secure a dataset; and
 - [1B] a secure storage system configured to:
 - [1B-1] present to a client device a virtual disk, the virtual disk comprising a directory mapped to the plurality of

⁵ Patent Owner uses the same limitation labels. *See generally* Prelim. Resp.

physical storage devices such that physical locations of the shares are hidden from the client device;

[1B-2] generate the plurality of shares for storage on the plurality of physical storage devices by performing a securing operation on the dataset received from the client device and distributing the dataset in the shares;

[1B-3] include with each of the plurality of shares data indicative of the at least one session key used to secure the dataset; and

[1B-4] reconstitute the dataset from at least a portion of the plurality of shares stored on the physical storage devices in response to a request from the client device for information in the dataset.

Ex. 1001, 98:2–22; Pet. 83.

C. Grounds 1–3

1. The Decision did not overlook or misapprehend the proper claim construction

Petitioner contends that “[t]he Board misapprehended the scope of claim 1 in finding that Limitations [1A] and [1B-2] ‘require storing two shares among at least two physical storage devices.’” Req. Reh’g 1–2. The Decision construed limitations [1A] and [1B-2] as requiring “storing the shares among at least two physical storage devices and those two devices need to be physically separable—e.g., two or more magnetic or optical disks or two or more USB key drives.” Decision 10. Petitioner argues that “this purported requirement is not supported by the plain language of claim 1, the specification, or anything else.” Req. Reh’g 2.

Petitioner begins by arguing that the claims “*could* have expressly required that the plurality of shares be stored ‘among’ multiple storage devices.” *See id.* at 2–3. Maybe. But the relevant question is not what the

claims *could* have said, but, rather, the meaning those claims “would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). The claims do not need to “expressly” recite a requirement for a skilled artisan to understand that the requirement exists.

Next, Petitioner asserts that “[t]he Board’s construction also is not supported by the ’140 patent’s specification.” Req. Reh’g 3. Petitioner notes that the Specification discloses that data can be stored on only “one” storage device. *See id.* at 3–4. We find that this argument does not demonstrate that the Board abused its discretion in construing the claims. To begin with, Petitioner’s argument based on “one” storage device is a new argument that was not presented in the Petition. Therefore, the Decision could not have overlooked or misapprehended it. In any event, the claims require “a plurality of physical storage devices,” not “among one or more storage devices” as the Specification states. Ex. 1001, 67:1–13. And, as the Patent Owner’s expert, Dr. Rubin, explained, the Specification of the ’140 patent expressly discloses benefits to dividing the data among multiple devices. *See* Prelim. Resp. 5–6 (quoting Ex. 2003 ¶¶ 43–44 (itself citing various sections of the Specification)). Petitioner notes this testimony, *see* Req. Reh’g 4 (noting “Patent Owner’s assertion, which the Board seemingly credited, that storing shares among at least two storage devices was “a central feature” of the invention”), but does not address Dr. Rubin’s analysis of the Specification.

Lastly, Petitioner disputes the Decision’s finding that the Petition itself seemed to understand the claims as requiring storage on multiple devices. *See* Req. Reh’g 4. According to Petitioner, the Petition was

explaining how the prior art combination would work but was not explaining what was required by the claims. To be clear, the Petition's implicit understanding of the claims is largely irrelevant. *See Phillips*, 415 F.3d at 1313. The Decision was not relying on the Petition as evidence of the proper construction but was instead merely noting that the Petition's exposition of Ground 4 seemed to assume the correct construction of the claims. Maybe Petitioner is correct that the Petition's presentation of Ground 4 was also based on a misconstruction of the claims. That, ultimately, does not matter.

In sum, we find that Petitioner has not met its burden of showing that the Decision overlooked or misapprehended anything in construing the claims as requiring storage on multiple devices.

2. The Decision did not overlook or misapprehend Petitioner's reliance on the Ophir-Takeda combination

Petitioner contends that the Decision "overlooked or misapprehended the Petition's showing that the Ophir-Takeda Combination in Grounds 1-3 meets the Board's construction." Req. Reh'g 5. Petitioner continues that "[t]he Board misapprehended the Petition's showing. The Petition never alleges that '*Takeda* teaches limitations [1A] and [1B-2].'" *Id.* According to Petitioner, "*Ophir* is the primary reference." *Id.*

We find that the Decision did not misapprehend or overlook Petitioner's arguments. The Decision addresses the combination of Takeda and Ophir in relation to claim 1. Decision 14–16. The Decision concludes that Petitioner fails to show sufficiently that Takeda alone "discloses or suggests storing data on physically separable storage devices." Decision 15. Petitioner does not dispute this finding. The Decision goes on to state "[t]he

Petition does not suggest that Ophir teaches storing shares among different storage devices.” *Id.*

The Decision relies on Ophir’s Abstract, which describes the function of Ophir’s mediator and the storage of encrypted data but not does not describe storage of segments of the encrypted data on separate storage devices. Decision 15. Dr. Rubin’s testimony confirms that “[n]othing in Ophir indicates that ‘the mediator divides the datasets into shares, or stores a particular dataset on more than one storage device.’” Ex. 2003 ¶ 40.

Dr. Rubin continues that “Ophir does *not* disclose or suggest, at all, dividing a dataset into pieces or anything else that might correspond to the ‘shares’ of claim 1, much less storing those pieces on two or more physical storage devices.” *Id.* ¶ 56. The Decision concludes that, “[u]ltimately, the Petition’s Grounds 1–3 do not address the limitation of storing on multiple storage devices.” Decision 15.

Petitioner and its expert, Dr. Bhattacharjee, disagree with this conclusion. The problem for Petitioner is that Petitioner then (as now) assumed that the claims do not require storing the shares among at least two physical storage devices—at least in presenting Grounds 1–3. Correspondingly, the Petition’s analysis of the claims never addresses whether or how the Ophir-Takeda combination teaches or suggests storing the shares among at least two physical storage devices. To try and find such an argument, Petitioner argues that the various sections incorporate one another in convoluted ways and there are major inferences that can be drawn from the Petition’s use of the plural form in certain sections. *See* Req. Reh’g 5–12. It is not our burden to try and divine such arguments from the petition. *See* 35 U.S.C. § 312 (a)(3); 37 C.F.R. § 42.22(a); 37 C.F.R. § 42.104(b)(4).

At bottom, Petitioner fails to demonstrate that the Decision overlooked or misapprehended Petitioner's arguments about how the prior art renders obvious storing the shares among at least two physical storage devices. Thus, we reject this argument.

D. Ground 4

The Decision found that the Petition's Ground 4 failed to explain how the Dickinson-Takeda combination teaches or suggests the claim limitation that the "physical locations of the shares are hidden from the client device." *See* Decision 16–20. Although the Petition *cited* to certain sections of Dickinson as being purportedly relevant to this limitation, *see* Pet. 72, the Decision found that "the Petition does not explain the relevance of [the cited] sections." Decision 17; *see id.* at 17–20.

Petitioner now suggests that the Decision's reasoning was based on the fact "[t]hat the words 'hidden from the user' do not appear verbatim in Dickinson." Req. Reh'g 13. That misrepresents the Decision's analysis. The Decision found that the Petition failed to explain how Dickinson discloses or suggests this limitation—it did not just ask whether the words appeared *in haec verba* in Dickinson.

In disputing the Decision's actual findings, Petitioner notes that "Dr. Bhattacharjee [in his declaration (Ex. 1003)] was unequivocal that POSAs knew Dickinson's logical memory hides the physical location of the shares from the user." Req. Reh'g 14. A conclusory statement by an expert, even if "unequivocal," is insufficient proof. An expert needs to show how the evidence shows the limitation was met. *See* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight."). As the

Director has explained, “the Board [i]s correct in giving little weight to Petitioner’s expert [where] the expert declaration merely offer[s] conclusory assertions without underlying factual support and repeat[s], *verbatim*, Petitioner’s conclusory arguments.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 12 at 5 (PTAB Feb. 10, 2023) (citing *In re Ethicon, Inc.*, 844 F.3d 1344, 1348, 1352 (Fed. Cir. 2017); *TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019)). An expert’s declaration needs to provide “technical detail, explanation, or statements supporting *why* the expert determines that the feature in question was required or would have been obvious based on the prior art disclosure.” *Id.* Those kinds of details, explanations, and statements are absent in the Petition and Dr. Bhattacharjee’s accompanying testimony.

Petitioner additionally argues that “the Examiner found that Dickinson’s exact same logical memory meets Limitation [1B-1] because the physical locations of the shares on Dickinson’s storage devices are hidden.” Req. Reh’g 15. That is insufficient. Petitioner has the burden of showing that the claim would have been obvious. It cannot merely rely on the fact that an examiner—whose decision is not on appeal before us—assumed some limitation was met. *See Floodbarrier, Inc. v. ILC Dover, LP*, IPR2019-01543, Paper 12 at 15, 2020 WL 1185257, at *5–6 (PTAB Mar. 11, 2020) (holding that a petitioner must do more than merely cite to the prosecution history to show that a claim limitation is taught or suggested by the prior art).

Moreover, that a patent applicant amended claims in response to a rejection does not mean that the rejection is necessarily proper. *See Woods v. DeAngelo Marine Exhaust, Inc.*, 692 F.3d 1272, 1286–87 (Fed. Cir. 2012);

TorPharm, Inc. v. Ranbaxy Pharms., Inc., 336 F.3d 1322, 1329 (Fed. Cir. 2003). As the Federal Circuit has explained in the context of terminal disclaimers:

There are many reasons to file a terminal disclaimer, and it is not up to us to say, in this case where no reason was given, that [an applicant] filed such a disclaimer because he concluded that the patent would not otherwise issue, rather than because he was in financial difficulty . . . , and could not afford to argue further with the Patent Office, or wait longer for his patent.

Wooster Brush Co. v. Newell Operating Co., 250 F.3d 756 (Fed. Cir. 2000) (Table); *see also Paperless Acct., Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 664 (Fed. Cir. 1986) (“[T]he mere filing of a continuation-in-part with additional matter or revised claims is not of itself an admission that the matter is ‘new’ or that the original application was legally insufficient to support the claims.”). Here, too, we cannot assume that Patent Owner’s decision to amend the claims reflected an admission that Dickinson taught the relevant limitations. We note that just because the panel was not persuaded by Petitioner’s arguments and evidence does not mean that it overlooked or misapprehended Petitioner’s arguments and evidence, and importantly, a request for rehearing is not an opportunity merely to reargue one’s case or to express disagreement with the Board’s decision. We thus find that the Decision neither overlooked nor misapprehended any persuasive evidence that Dickinson’s storage device hides the physical locations of the data.

III. CONCLUSION

Petitioner has not carried its burden of demonstrating that the Decision denying institution of *inter partes* review of challenged

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claims 1–10 of the '140 patent misapprehended or overlooked any relevant matters or that the Board abused its discretion. 37 C.F.R. § 42.71(c), (d).

IV. ORDER

For the foregoing reasons, Petitioner's Request for Rehearing is *denied*.

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