

Filed on behalf of Google LLC by:

Paper No. ____

Elisabeth H. Hunt, Reg. No. 67,336
Gregory S. Nieberg, Reg. No. 57,063
Nathan R. Speed (admitted *pro hac vice*)
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210
(617) 646-8000 Phone
(617) 646-8646 Fax

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SECURITY FIRST INNOVATIONS, LLC
Patent Owner.

Case No. IPR2024-00215
Patent No. 10,452,854

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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¹ All emphases in this paper are added, and internal citations omitted, unless otherwise indicated.

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SFI's Request (Paper 44) provides no valid reason to disturb the FWD's (Paper 43) thorough and well-reasoned findings on the Foster-Hayhurst combination.

I. HAYHURST IS ANALOGOUS ART

The FWD is correct: Hayhurst (EX1007) is analogous art for either of two independent reasons: (a) "Hayhurst and the '854 patent share the same field of endeavor: securing data" (FWD, 12) and (b) "Hayhurst is reasonably pertinent to the particular problems with which the ['854 patent] is involved: (1) user-independent security, (2) network security, and (3) distributed storage" (FWD, 16).

Field of Endeavor: SFI argues that "Hayhurst's field is 'decentralized media delivery'" and "has nothing to do with" the '854 patent's field of "securing data." Request, 4-5. The Board properly rejected that argument for several reasons. *First*, SFI's "arguments contradict Hayhurst's *Technical Field* section" (FWD, 11), which states that Hayhurst "relates to the field of electronic media delivery, such as video-on-demand, including *the secure handling and storage* of such media" (EX1007, [0002]). SFI argues that, by crediting Hayhurst's *Technical Field*, the Board "unduly focused on a single clause in the specification, taken out of context." Request, 5. But the Board did look to the context in which the clause occurs—it is literally the section that sets forth Hayhurst's "*field*." It is hard to imagine how any other clause in the specification could be more probative of what is in Hayhurst's field than the "*Technical Field*" statement. SFI's request that the Director reverse the Board and

find that Hayhurst inaccurately characterized its own “*Field*” strains credulity.

Further, the Board expressly considered “all the parts of Hayhurst identified in [SFI’s] table” and correctly found that they “describe features that secure data.” FWD, 12. SFI’s allegation that the Board “ignored the totality of” Hayhurst (Request, 5) is untrue. Hayhurst discusses securing data as summarized below:

Hayhurst Shares the ’854 Patent’s Field of Securing Data (FWD at 11-12)	
Technical Field	“This application relates to the field of electronic media delivery, such as video-on-demand, including <i>the secure handling and storage</i> of such media.” EX1007, [0002]; <i>see</i> FWD, 11
Summary of the Invention	“The segments are each <i>encrypted or otherwise encoded to prevent unauthorized viewing</i> of individual segments.” “The segmented and distributed storage of the media file <i>provides a high level of security and a deterrence to piracy.</i> ” EX1007, [0007]-[0008]; <i>see</i> FWD, 11
Title, Abstract, Specification	Title: “ <i>Decentralized</i> Media Delivery” Abstract: “A <i>decentralized</i> approach...comprises... <i>segmenting</i> the media file...and distributing the segments....” [0021]: “This approach to <i>segmenting</i> the movie <i>provides increased security from piracy....</i> ” <i>See</i> FWD, 11-12 (explaining “Hayhurst’s repeated discussion of anti-piracy measures” for “security” include the “decentralized approach” and “segmentation” in the title and abstract)
Claims	Cl. 1: “ <i>segmenting</i> the...file”; Cl. 12: “ <i>encrypting</i> ...segments”

Reasonable Pertinence: Given the Board’s finding that Hayhurst is analogous art by sharing the ’854 patent’s field, the Board did not need to apply the reasonable-pertinence test, but did anyway and correctly found Hayhurst reasonably pertinent to no less than three problems that the ’854 patent tries to solve. FWD, 13-16. SFI’s allegation that the Board and Petitioner did not “identify and compare Hayhurst’s problem” (Request, 5-6) is untrue. The Board expressly “identif[ied] the

problems that *Hayhurst and* '854 patent relate to” and enumerated not just one but *three* “*Problems Identified by Petitioner*” that *both* Hayhurst and the '854 patent address. FWD, 13-15; Petitioner’s Reply (Paper 24), 5-9. SFI’s assertion that the “problem of prohibitive bandwidth” discussed in EX1007, [0005] is the only “actual problem Hayhurst was directed towards” (Request, 5-6) is meritless. Just because one sentence uses the word “problem” does not mean that no other sentences in Hayhurst discuss problems to which Hayhurst relates. *See Wyers v. Master Lock Co.*, 616 F.3d 1231, 1238 (Fed. Cir. 2010) (explaining that Supreme Court law “directs us to construe the scope of analogous art broadly”). In the *Donner* case that SFI cites (Request, 5), the Federal Circuit said the Board should compare the patent’s problem “with *any problems* [plural] addressed by” the prior art. *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1360 (Fed. Cir. 2020).

II. THE FOSTER-HAYHURST COMBINATION IN THE PETITION AND FWD IS NOT A “REPLY-STAGE THEORY”

SFI’s allegation that “[t]he FWD...invalidated the claims based upon a new theory presented only in reply” (Request, 6) is meritless. The Foster-Hayhurst combination is the same in the Petition, the Reply, and the FWD. The Petition did not make an “across-the-board combination” (Request, 2)—whatever that means—that was “not...justified by any particular application, context, or embodiment of Foster” (*id.*, 8-9). As the Board correctly explained, “the Petition relies on Foster’s teaching of storing encrypted content” and “does not rely entirely on Hayhurst

for...storing content at the receiver, as [SFI] argues.” FWD, 23-25.

As the Petition explained, “Foster discloses...securing digital content” for “transmission to, or **storage** by, a recipient.” Paper 2 (“Pet.”), 55, 57 (content “can be ‘**stored** by a recipient’ (e.g., in a consumer’s set-top box)”). Foster’s techniques are usable not just for live broadcasts, but also for pre-stored video-on demand, e.g., “**movies**.” *Id.*, 57-59 (explaining Foster’s “customers [can] **rent digital movies**”) (citing EX1006, [0038]). “**Like Foster**, Hayhurst concerns ‘electronic media delivery, such as video-on-demand’ and how the data is ‘secure[ly] handl[ed] **and stor[ed]**.” Pet., 59. Hayhurst’s “conventional set-top box” is “just like ‘set-top box’ receivers at **Foster’s** recipients” which include storage devices “**for storing**” media files. *Id.*, 60. In the combination, Hayhurst’s teachings motivate POSAs “to **store** Foster’s encrypted content units on multiple storage devices (e.g., consumer set-top boxes like Hayhurst’s subscriber units **and Foster’s recipients 430**).” *Id.*, 61. Foster-Hayhurst thus “performs Foster’s method for securing digital content...for ‘**storage by a receiver**’” (*id.*, 65), with each content unit “**stored**...at a different ‘recipient 430’” (*id.*, 80). See FWD, 24-27 (citing Pet., 56-61, 65, 80).

SFI’s allegation that applying Hayhurst’s teachings to a “storage context” in Foster was “argued for the first time” in the Reply (Request, 11-12) is thus plainly untrue and the Board correctly rejected it. FWD, 23-28, 26 (“Petitioner’s position has always been that Foster stores content, such as movies, at the receiver.”). It was

SFI who first alleged that Foster is so “directed towards...random access to content” that the combination with Hayhurst would be “unsuitable” if it had drawbacks in the limited context of “streaming live television.” POR, 41-42, 45 (alleging Foster “seeks to improve upon...providing real-time television”), 47 (alleging Hayhurst “Does Not Allow For Real-Time Streaming”), 49 (alleging combination “Precludes Real-Time Streaming”). As the Board correctly explained, Petitioner properly presented reply evidence “[i]n response to [SFI]’s characterization of Foster”—*e.g.*, to respond to SFI’s assertion that Foster seeks to improve upon real-time TV by citing where Foster *also* discusses improving “a Digital Rights Management System (DRMS) that streams *or stores* content.” FWD, 27-28. Petitioners “may introduce new evidence...[that] is a legitimate reply to evidence introduced by the patent owner.” *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380 (Fed. Cir. 2018).

SFI’s further assertions that Foster-Hayhurst has “drawbacks” outweighing its benefits (Request, 13-14) were also thoroughly considered and correctly rejected. As the Board correctly found, “Foster’s system also deals with video-on-demand” like Hayhurst, and thus benefits from Hayhurst’s bandwidth-saving techniques; and Hayhurst increases security via other techniques that counterbalance any “concerns” alleged by SFI. FWD, 28-32. SFI’s assertion that the Board’s “reasoning fails” (Request, 14) is attorney argument unsupported by record evidence.

SFI’s request should be denied.

/Elisabeth Hunt/ June 25, 2025
Elisabeth Hunt, Reg. No. 67,336

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on June 25, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

Stephen J. Elliott
Kenneth Weatherwax
Nathan Lowenstein
Colette Woo
Dustin F. Guzior
Andrei Iancu
Haley M. Sanders

elliotts@sullcrom.com
Weatherwax@lowensteinweatherwax.com
Lowenstein@lowensteinweatherwax.com
Woo@lowensteinweatherwax.com
guziord@sullcrom.com
iancua@sullcrom.com
sandersh@sullcrom.com
SFI_PTAB@sullcrom.com

Date: June 25, 2025

/Dara Del Rosario/
Dara Del Rosario
Paralegal
WOLF, GREENFIELD & SACKS, P.C.