

BEFORE THE PATENT TRIAL AND APPEAL BOARD IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Trial No.: IPR 2013-00083
In re: U.S. Patent No. 6,415,280
Patent Owners: PersonalWeb Technologies, LLC & Level 3 Communications
Petitioner: EMC Corp. and VMware, Inc.
Inventors: David A. Farber and Ronald D. Lachman

For: IDENTIFYING AND REQUESTING DATA IN NETWORK USING IDENTIFIERS WHICH ARE BASED ON CONTENTS OF DATA

* * * * *

July 24, 2013

PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120

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Pursuant to 37 C.F.R. § 42.120, PersonalWeb Technologies, LLC (“patent owner”) submits this response to the petition. Petitioner has the burden of proving unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). Petitioner has not met its burden for the reasons explained below.

I. INSTITUTED GROUNDS

The Board, on May 17, 2013, instituted a trial regarding U.S. Patent No. 6,415,280 (the ‘280 patent) for only the following:

1. Whether claims 36 and 38 are anticipated under 35 U.S.C. §102(e) by Woodhill (Ex. EMC 1005).
2. Whether claims 36 and 38 are unpatentable as obvious under 35 U.S.C. §103(a) over Woodhill.

II. THE BOARD’S CLAIM CONSTRUCTIONS ASSUMED AND USED BY PATENT OWNER HEREIN

The Board construed, *inter alia*, the following in its Decision dated May 17, 2013. The Board’s constructions in the chart immediately below have been assumed to be correct by patent owner for purposes of this IPR proceeding and have been used by patent owner herein (without prejudice to argue otherwise in other proceedings).

| Claim Term | Board's Construction |
|--------------------------------|--|
| Preamble of claims 36 and 38 | Preambles of claims 36 and 38 are entitled to patentable weight. |
| "data file" (claims 36 and 38) | <i>A <u>named</u> data item, such as a simple file that includes a single, fixed sequence of data bytes or a compound file that includes multiple, fixed sequences of data bytes.</i> ('280 patent, col. 5:47-50) (May 17, 2013 Dec. 10-11). |

III. LAW REGARDING ANTICIPATION

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A feature is “inherent” in a reference only if that feature is “necessarily present” in the reference, “not merely probably or possibly present.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). Furthermore, in order to anticipate, a prior art reference must not only disclose all elements of the claim, but must also disclose those elements “arranged or combined in the same way as in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369-71 (Fed. Cir. 2008).

Woodhill represents prior art under 35 U.S.C. § 102(e). Woodhill was “filed” before April 11, 1995 (the effective filing date of the ‘280 patent), but was not published until after April 11, 1995. Therefore, the only content in Woodhill

that can be relied upon in this proceeding is the content that was included at the time of Woodhill's July 1, 1993 filing date. And any material added to Woodhill after April 11, 1995 cannot be relied upon for prior art purposes in this IPR proceeding. Excerpts from Woodhill's file history have been provided herewith to evidence the content in Woodhill that can be relied on in this respect. (Ex. 2007.)

IV. WOODHILL DOES NOT ANTICIPATE CLAIM 36

Claim 36 of the '280 patent recites, *inter alia*,

“responsive to a client request for the data file, the *request including* a hash of the contents of the data file, causing the data file to be provided to the client.”

Woodhill, for several reasons, fails to anticipate this subject matter of claim 36. (Dewar Decl., ¶¶ 100-109 [Ex. 2013].)

First, claim 36 requires *a request for the data file from a client, where the request includes a hash of the contents of the data file*. Woodhill fails to disclose a “request” for a data file including “a hash of the contents of the data file.” (Dewar Decl., ¶¶ 102-104 [Ex. 2013].)

Petitioner relies on the self-auditing procedure described by Woodhill at col. 18:10-38 for this feature. (Pet. 43-44; and Ex. EMCVMW 1009 at ¶ 26.)

Petitioner contends that the “data file” in claim 36 corresponds to a “binary object” in Woodhill. (Pet. 44; and Ex. EMCVMW 1032 at 3-4.) For the self-auditing procedure, Woodhill explains that “Distributed Storage Manager program 24 initiates a restore of a randomly selected binary object *identified by a Binary*

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