

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

Trial No.: IPR 2013-00596

In re: U.S. Patent No. 7,802,310

Patent Owners: PersonalWeb Technologies, LLC & Level 3 Communications

Petitioner: Apple, Inc.

Inventors: David A. Farber and Ronald D. Lachman

For: CONTROLLING ACCESS TO DATA IN A DATA PROCESSING SYSTEM

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July 12, 2017

PATENT OWNER'S BRIEF FOLLOWING REMAND FROM THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Pursuant to the Board’s June 22, 2017 Order, PersonalWeb Technologies, LLC (“patent owner” or “PO”) submits this brief following the remand from the Federal Circuit, which vacated the Final Written Decision (FWD) dated March 25, 2015. For at least the reasons explained herein and in PO’s Response dated June 16, 2014 and Preliminary Response dated December 26, 2013, it is respectfully submitted that Apple did not make out a proper case of obviousness at least because Apple: (1) failed to meet its burden of establishing that the prior art discloses all elements of the challenged claims, and (2) failed to meet its burden of establishing that a skilled artisan would have been motivated to combine Woodhill and Stefik in the way the ‘310 patent claims and reasonably expect success.

Because PO did not appeal claim 70, the Board need not address claim 70. The claim limitations discussed herein are *not* present in claim 70. This brief is limited to claims 24, 32, 81, 82 and 86 of the ‘310 patent.

I. WOODHILL AND STEFIK FAIL TO DISCLOSE COMPARING AN ALLEGED DATA ITEM IDENTIFIER TO A PLURALITY OF VALUES TO DETERMINE WHETHER ACCESS IS UNAUTHORIZED.

Claim 24 is representative, requiring “(i) *causing the content-dependent name of the particular data item [that was in the request] to be compared to a plurality of values*; (ii) . . . *determining whether or not access to the particular data item is unauthorized based on whether the content dependent name of the particular data item corresponds to at least one of said plurality of values.*” The claim expressly requires determining whether access to the data item is

unauthorized based on the result of a comparison between the content-dependent name for that data item against a plurality of values. Independent claims 81 and 86 contain similar language regarding comparing a content-based identifier/name to a “plurality of values.” Woodhill and Stefik fail to disclose this subject matter. The Petition focused on claim 70, which does *not* include these limitations. The Petition neither addresses these limitations nor provides any guidance as to where they are allegedly found in the prior art.

(a) The Petition and institution decision are fatally flawed.

The institution decision relies on Woodhill's binary object identifiers 74 as the claimed content-dependent name. [Paper 9 at 15.] However, the institution decision does not contend that Woodhill discloses the feature at issue here -- comparing a binary object identifier to a plurality of values for determining whether access is unauthorized -- and instead relies on Stefik for this claimed subject matter. (Paper 9 at 16.) In particular, the institution decision states “[a]s discussed by Apple, the process [in Stefik] of matching the identifier for the work would involve comparing it with a plurality of values, and providing for selective access. Pet. 42.” *Id.* The institution decision relies on no source other than Stefik as discussed at page 42 of the Petition for the “comparison against a plurality of values to provide selective access.”

Neither Stefik nor page 42 of the Petition can support the institution decision. First, nothing in Stefik describes comparing an identifier against a

plurality of values to determine unauthorization or selective access – a point Apple conceded on appeal. Second, nothing at page 42 of the Petition mentions comparing a content-dependent name against a *plurality of values*. Third, neither Stefik nor page 42 of the Petition discloses any process for determining whether access is *unauthorized* based on such a *comparison to a plurality of values*.

The Petition argues the ground at issue on pages 41-43. However, nowhere does the Petition allege that Stefik (or Woodhill, or the alleged combination) discloses comparing the binary object identifier (alleged content-dependent name) to a *plurality of values*, and nowhere does the Petition allege that Stefik (or Woodhill, or the alleged combination) discloses determining that access is *unauthorized* based on such a comparison to a *plurality of values*. To the contrary, the Petition on page 41 merely refers to “*another value*” (not a “plurality of values” as claimed). Moreover, the Petition’s discussion of Woodhill with respect to claim 24, on page 38, also does not allege any prior art disclosure of comparing a binary object identifier to a plurality of values, or any disclosure of determining that access is unauthorized based on such a comparison to a plurality of values. Indeed, the Petition contains no claim chart or analysis of the prior art with respect to claim 24. Thus, even the alleged combination fails to meet claim 24.

The Goldberg Declaration accompanying the Petition is similarly flawed. [Ex. 1007.] The Goldberg Declaration refers to the ground at issue on pages 40-41. Again, nowhere does Dr. Goldberg allege that Stefik, Woodhill, or the alleged

combination disclose comparing a binary object identifier (the alleged content-dependent name) to a *plurality of values*, and nowhere does he allege that Stefik (or Woodhill, or the alleged combination) discloses determining *unauthorization* based on such a comparison to a *plurality of values*. The Petition and accompanying Goldberg Declaration are silent regarding this claimed subject matter. Dr. Goldberg, on page 40 of his Declaration, merely refers to “*another value*” (not a “*plurality of values*” as claimed).

The Petition's failure to allege such a disclosure in the prior art is not surprising, given that the prior art contains no such disclosure. Both Woodhill and Stefik disclose identifiers. However, neither Woodhill nor Stefik use an identifier to determine unauthorization, and neither discloses any comparison to a plurality of values for determining access unauthorization as claimed.

Stefik describes unique identifiers 701 for respective digital works. (Ex. 1013, col. 9:48-49, and Fig. 7.) However, it is undisputed that (a) Stefik does NOT use these unique identifiers 701 for determining whether access to anything is unauthorized, (b) Stefik does NOT compare these unique identifiers to a plurality of values, much less to determine unauthorization, and (c) Stefik's unique identifiers 701 are NOT content-based. (Goldberg Dep. 147-151, 153-54 [Ex. 2015]; Dewar Decl., ¶ 40 [Ex. 2020]; Dewar Dep. 74 [Ex. 1035].)

During an authorization determination, instead of using unique identifiers 701, Stefik utilizes so called “usage rights” that are *not* calculated based on file

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