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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner

v.

PERSONALWEB TECHNOLOGIES, LLC, and
LEVEL 3 COMMUNICATIONS, LLC,
Patent Owners.

Case IPR2013-00596
Patent 7,802,310 B2

Before KEVIN F. TURNER, JONI Y. CHANG, and
MICHAEL R. ZECHER, *Administrative Patent Judges*

TURNER, *Administrative Patent Judge.*

DECISION ON REMAND
35 U.S.C. § 144 and 37 C.F.R. § 42.5(a)

I. INTRODUCTION

We address this case on remand after a decision by the U.S. Court of Appeals for the Federal Circuit in *Personal Web Technologies, LLC v. Apple, Inc.*, 848 F.3d 987, 987–94 (Fed. Cir. 2017) ("*Personal Web Tech.*").

As background, Petitioner, Apple, Inc. ("Apple"), filed a Petition requesting an *inter partes* review of claims 24, 32, 70, 81, 82, and 86 of U.S. Patent No. 7,802,310 B2 ("the '310 Patent," Ex. 1001). Paper 1 ("Pet."). Patent Owners, PersonalWeb Technologies LLC and Level 3 Communications, LLC (collectively "PersonalWeb"), filed a Preliminary Response (Paper 8). We determined that the information presented in the Petition demonstrated that there was a reasonable likelihood that Apple would prevail in challenging of claims 24, 32, 70, 81, 82, and 86 as unpatentable under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we instituted trial on March 26, 2014, on the ground that the challenged claims are unpatentable under § 103(a) over Woodhill[1] and Stefik[2]. Paper 9 ("Dec. on Inst.").

During the course of trial, PersonalWeb filed a Patent Owner Response (Paper 15, "PO Resp."), to which Apple filed a Reply to the Patent Owner Response (Paper 22, "Reply"). We held an oral hearing on November 17, 2014, with a transcript of that hearing appearing in the record. *See* Paper 31 ("Tr.").

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[1] Woodhill, U.S. Patent No. 5,649,196, issued July 15, 1997 (Ex. 1014).

[2] Stefik, U.S. Patent No. 7,359,881 B2, issued Apr. 15, 2008 (Ex. 1013).

On March 25, 2015, we issued a Final Written Decision in this proceeding in accordance with 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Paper 33 ("Final Dec."). We concluded that Apple had demonstrated by a preponderance of the evidence that claims 24, 32, 70, 81, 82, and 86 of the '310 patent were unpatentable under § 103(a) over the combination of Woodhill and Stefik. Final Dec. 25. Subsequently, PersonalWeb requested rehearing under 37 C.F.R. § 42.71(d), where that request for rehearing was denied. Papers 34, 35. PersonalWeb appealed the Final Written Decision, except as to claim 70, to the Federal Circuit. Paper 36.

The Federal Circuit affirmed the Board's claim construction of the claim terms "content-dependent name," "content-based identifier," and "digital identifier," also concluding that PersonalWeb "does not deny that Woodhill discloses the required content-based identifier under the Board's construction." *Personal Web Tech.*, 848 F.3d at 991.

The Federal Circuit also determined the Board did not sufficiently explain and support the following conclusions: (1) Woodhill and Stefik disclose all of the elements recited in the challenged claims of the '310 Patent; and (2) a relevant skilled artisan would have been motivated to combine Woodhill and Stefik in the way the '310 Patent claims and reasonably expected success. *Personal Web Tech.*, 848 F.3d at 991–94. Consequently, the Federal Circuit vacated our determination of obviousness as to claims 24, 32, 81, 82, and 86 of the '310 Patent and remanded this case to us for further proceedings. *Id.* at 994. The Federal Circuit's mandate issued on April 7, 2017.

On June 22, 2017, we issued an Order instructing the parties to file briefs specifically pointing out where Petitioner made out a proper case of obviousness on the instituted ground, or where Petitioner failed to make out such a case. Paper 39, 2. In accordance with this Order, the parties filed briefs on July 12, 2017. Papers 42, 43. PersonalWeb makes clear that it did not appeal claim 70, such that we need not address claim 70. Paper 43, 1. *See also Personal Web Tech.*, 848 F.3d at 990.

We have reconsidered the record developed during trial anew by reviewing the parties' positions in light of the Federal Circuit's guidance regarding the patentability under 35 U.S.C. § 103(a) over Woodhill and Stefik of claims 24, 32, 81, 82, and 86, as well as the parties' newly-filed briefs. For the reasons that follow, we maintain that Apple has demonstrated by a preponderance of the evidence that claims 24, 32, 81, 82, and 86 of the '310 Patent are unpatentable under § 103(a) over the combination of Woodhill and Stefik.

A. The '310 Patent (Ex. 1001)

The '310 Patent relates to a data processing system that identifies data items using substantially unique identifiers, otherwise referred to as True Names, which depend on all the data in the data item and only on the data in the data item. Ex. 1001, 1:44–48, 3:52–55, 6:20–24. According to the '310 Patent, the identity of a data item depends only on the data and is independent of the data item's name, origin, location, address, or other information not derivable directly from the data associated therewith. *Id*. at 3:55–58. The invention of the '310 Patent also provides that the system can

publish data items, allowing other, possibly anonymous, systems in a network to gain access to the data items. *Id*. at 4:32–34.

B. Illustrative Claim

The ’310 Patent includes claims 1–87, of which a trial was instituted on claims 24, 32, 70, 81, 82, and 86. Of those the challenged claims, claims 24, 70, 81, and 86 are independent claims. Independent claim 24 is reproduced below:

> 24. A computer-implemented method implemented at least in part by hardware comprising one or more processors, the method comprising:
>
> (a) using a processor, receiving at a first computer from a second computer, a request regarding a particular data item, said request including at least a content-dependent name for the particular data item, the content-dependent name being based, at least in part, on at least a function of the data in the particular data item, wherein the data used by the function to determine the content-dependent name comprises at least some of the contents of the particular data item, wherein the function that was used comprises a message digest function or a hash function, and wherein two identical data items will have the same content-dependent name; and
>
> (b) in response to said request:
>
> (i) causing the content-dependent name of the particular data item to be compared to a plurality of values;
>
> (ii) hardware in combination with software 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, and

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