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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April 24, 2015

PATENT OWNER'S REQUEST FOR REHEARING

UNDER 37 C.F.R. § 42.71(d)

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I. INTRODUCTION

The Board on March 25, 2015 issued a Final Written Decision ("FWD") regarding this IPR of the expired '310 patent. Patent owner (PersonalWeb Technologies, LLC) hereby requests rehearing of that decision for at least the reasons herein. Patent owner notes that the Board issued a first FWD (Paper 32) and a second FWD (Paper 33), both on March 25, 2015. The second FWD (Paper 33) corrected formality issues in the first FWD. Citations herein are to the second FWD (Paper 33).

The issues identified by patent owner in this request for rehearing do not limit the objections that patent owner has to the Board's decision. Patent owner expressly reserves the right to argue additional issues on appeal or elsewhere.

II. THE *PHILLIPS* STANDARD SHOULD BE USED TO CONSTRUE THE CLAIMS OF THE EXPIRED '310 PATENT

As explained on pages 10-11 of Patent Owner's Response ("POR") filed June 16, 2014 (Paper 15), the broadest reasonable construction ("BRC" or "BRI") standard should not be used. (POR 10-11.) Instead, claim terms should be construed under the *Phillips* standard applied by district courts. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). The Board appears to have misapprehended this issue on pages 5-6 of the FWD.

As the Board found on page 5 of the FWD, the '310 patent expired on April 11, 2015. (POR 10; and FWD 5.) Note the terminal disclaimer that was filed regarding the '442 patent. (Ex. APL 1016 at 242.) Accordingly, PO had no reasonable ability to amend the '310 patent in this proceeding and no appeal will take place until after expiration of the '310 patent. Indeed, the USPTO still has jurisdiction over this proceeding, and the '310 patent has already expired. No certificate under 35 U.S.C. § 318(b) can issue, or could have issued, before expiration of the '310 patent. Any document (e.g., decision on rehearing, certificate, etc.) authored or generated by the USPTO after the '310 patent has expired cannot use the BRC standard, and instead should use and must rely upon the same claim construction standard as the district court laid out in *Phillips*. (POR 10.) *See In re Rambus, Inc.*, 753 F.3d 1253, 1256 (Fed. Cir. 2014). Thus, the BRC standard should not be used for construing claims.

The Board on page 6 of the FWD states that patent owner had the ability to file a motion to amend in this proceeding. However, this would have been futile at least because the '310 patent has already expired, would have expired prior to any appeal (and has expired prior to any appeal), and any certificate under 35 U.S.C. § 318(b) would have issued after expiration of the '310 patent. Simply put, there was no opportunity for patent owner to amend claims in this proceeding given the expiration of the '310 patent on April 15, 2015. The Board should have used, and should use, the *Phillips* standard to construe the claims.

This is a meaningful distinction. For example and without limitation, the Board construed **"**content-dependent name**"** broadly under the improper BRC standard. (FWD 7-8.) If this term had been construed correctly under the *Phillips* standard, the result would have been different as even the alleged combination would not have met claims 24 and 32. (POR 4-5, 33-36.) Unlike a **"**name,**"** Woodhill**'**s binary object identifiers 74 are not used to access binary objects, search for binary objects, or address binary objects. (POR 34.) When a binary object identification record 58 is provided such as at col. 17:44 in Woodhill, and a binary object is addressed, Woodhill explains how this is done and it does not involve any binary object identifier 74. (POR 34; Woodhill at col. 11:65 to col. 12:7, and col. 9:8-20.) To the contrary, Woodhill's audit procedure initiates a "restore" by accessing a randomly selected binary object. (Woodhill at col. 18:17-18). Then, and as the binary object is being restored —that is, after both the audit and restore functions have been initiated—only then "a Binary Object Identifier 74 is calculated." (Woodhill at col. 18:24-26.) Woodhill teaches using the binary object identifier 74 for comparing, but not for accessing, searching, or addressing because it is not a "name." (POR 34.)

Furthermore, patent owner pointed out that challenged claims require that the data item corresponding to the name or identifier in the **"**request**"** is accessed. (POR 8-10.) The Board erred, under any claim construction standard, by not providing a construction in this respect. (FWD 10.) Claims 24 and 70 require a **"**request**"** that includes a content-dependent name (claim 24) or identifier (claim

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