

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
Request for Rehearing
37 C.F.R. §§ 42.71(c) and (d)

INTRODUCTION

PersonalWeb Technologies, LLC and Level 3 Communications, LLC (collectively “PersonalWeb”) filed a Request for Rehearing (Paper 34, “Req.”) of the Final Written Decision (Paper 33, “Dec.”), which found that Apple, Inc. (“Apple”) had shown by a preponderance of the evidence that all challenged claims in the instituted proceeding, claims 24, 32, 70, 81, 82, and 86 of U.S. Patent No. 7,802,310 B2 (“the ’310 Patent,” Ex. 1001), are unpatentable. In its request, PersonalWeb contends that we applied the wrong claim construction standard to the challenged claims, that we overlooked and misapprehended the legal significance of PersonalWeb’s nonobviousness arguments, and that we failed to address all of the factors considered in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966) (“*Graham*”). Req. 1–9.

The Request for Rehearing is *denied*.

ANALYSIS

A request for rehearing must identify specifically all matters the party believes we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d); *see also* 37 C.F.R. § 42.120(a) (stating that a patent owner response is filed as an opposition). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005);

Arnold P'ship v. Dudas, 362 F.3d 1338, 1340 (Fed. Cir. 2004); and *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000).

PersonalWeb alleges that we applied the wrong claim construction standard to the challenged claims, arguing that we misapprehended the issue in our Final Written Decision. Req. 1, citing Dec. 5–6. We disagree.

A Request for Rehearing naturally must evaluate the priority of a decision at the time it was issued. We concluded that we “construe the challenged claims according to the broadest reasonable claim construction standard.” Dec. 6. The fact that the '310 Patent expired on April 11, 2015, does not alter whether the correct standard was applied at the time that Final Written Decision was issued, on March 25, 2015. We agree with PersonalWeb that any document “authored or generated by the USPTO after the '310 Patent has expired cannot use the [Broadest Reasonable Construction] standard,” Req. 2, but the Final Written Decision in this proceeding was not such a document.

PersonalWeb also argues that we should have used the *Phillips* (*Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*)) standard because “there was no opportunity for patent owner to amend claims in this proceeding.” Req. 2. However, it is uncontroverted that PersonalWeb had the opportunity to amend the claims, although PersonalWeb has claimed and continues to claim that it “would have been futile.” *Id.* We are not persuaded that a patent owner’s expectations of the likelihood that a motion to amend will be successful should be the proper metric to determine which claim construction standard should be applied. *See also In re Cuozzo Speed Techs., LLC*, No. 2014-1301, 2015 WL 4097949, *7-8 (Fed. Cir. July 8, 2015) (“Congress implicitly approved the broadest

reasonable interpretation standard in enacting the AIA,” and “the standard was properly adopted by PTO regulation.”).

Additionally, we take no position on whether the application of the differing claim construction standards would provide “a meaningful distinction,” Req. 3, as any position we take would be merely dicta in view of the Final Written Decision. To the extent that PersonalWeb is inviting us to reevaluate our adopted claim construction under another standard, we respectfully decline, and we are persuaded that this Decision on Request for Rehearing is not the proper vehicle to perform such a reevaluation.

PersonalWeb also alleges that *KSR* (*KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007)) asserts that “it is the combination of old elements for their intended purpose, with each element performing the same function it had been known to perform, that may be obvious.” Req. 6. PersonalWeb continues that the alleged combination of Woodhill does not use Woodhill’s or Stefik’s identifiers for their intended purposes, or to perform the same function they were known to perform. *Id.* PersonalWeb alleges that “[a]s a matter of law, it would not have been obvious to have used binary object identifiers 74 in an access control system to determine whether access is authorized or unauthorized in view of Woodhill and Stefik.” *Id.* at 6–7. We do not agree.

We addressed this argument in the Final Written Decision (Dec. 20), finding that the claims do not require that claimed identifiers be used *only* to determine access authorization. Certainly, as PersonalWeb argues (Req. 7–8), claim 24 determines access based on the content-dependent name, but the claims do not limit its use to access authorization only. The Specification of the ’310 Patent

provides for the use of identifiers to determine presence of a data item, to allow for redundancy, to provide version control, to verify retrieved data, and to provide tracking. Ex. 1001, 3:52–4:59. As such, PersonalWeb’s arguments take too limited of a view of the functions performed by the identifiers in Woodhill and Stefik, and we continue to be persuaded that the identifiers in Woodhill and Stefik are not being used contrary to their intended purposes in the proffered combination. Dec. 20. Similarly, we also previously considered PersonalWeb’s argument that Woodhill already has an authorization system and there would have been no logical reason to have modified Woodhill (Req. 7; Dec. 17-18), and we are not persuaded that we overlooked or misapprehended that prior argument.

Finally, PersonalWeb also alleges that the Final Written Decision failed to address all of the factors provided in *Graham*. Req. 8–9. More specifically, PersonalWeb argues that we overlooked factors (2) and (3), namely: (2) differences between the claimed subject matter and the prior art and (3) the level of skill in the art. PersonalWeb is mistaken, however, in that a final written decision is not an office action containing a rejection that must provide a complete evaluation of the *Graham* factors to conclude obviousness. A final written decision determines if a petitioner has shown by a preponderance of the evidence that subject claims are unpatentable. Thus, the Final Written Decision need not make findings as to all of the *Graham* factors, as long as Petitioner has provided such consideration in the Petition.

In any event, the Final Written Decision provided such considerations (Dec. 15, citing Pet. 42), stating that “a person of ordinary skill in the art reading Woodhill and Stefik would have understood that the combination of Woodhill and

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