

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

**Trial No.:** IPR 2014-00062

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

**Patent Owners:** PersonalWeb Technologies, LLC & Level 3 Communications

**Petitioner:** Rackspace US, Inc. and Rackspace Hosting, Inc.

**Inventors:** David A. Farber and Ronald D. Lachman

**For:** CONTROLLING ACCESS TO DATA IN A DATA PROCESSING SYSTEM

\* \* \* \* \*

January 18, 2014

**PATENT OWNER'S PRELIMINARY RESPONSE**

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**I. MULTIPLE OVERLAPPING PETITIONS WITH DIFFERENT WITNESSES SHOULD NOT BE INSTITUTED FOR THE SAME '310 PATENT**

Another earlier-filed petition for IPR is also pending regarding U.S. Patent No. 7,802,310 (“the ‘310 patent”). (*See* IPR 2013-00596.) Patent Owner PersonalWeb (PO) would be highly prejudiced if two IPRs regarding the same ‘310 patent were to proceed at the same time with different witnesses and largely overlapping art and arguments. For example, this would result in significant expenses and costs to PO, overall duplication of efforts, and overlapping depositions/discovery/testimony from different technical experts from multiple petitioners for the same ‘310 patent which would be unduly burdensome and very expensive. Like the other petition regarding the ‘310 patent (IPR 2013-00596), the instant petition (IPR 2014-00062) improperly relies on Section 112/120 arguments and the alleged Grounds rely on the same base references to Farber (Kinotech) and Woodhill. While additional claims are challenged in this petition, the various petitioners’ transparent attempt to conceal the duplicative nature of the two petitions by calling the same base reference WO 96/32685 “Farber” in one IPR (IPR 2013-00596) and “Kinotech” in this IPR (IPR 2014-00062) should be seen for what it is. Petitioner also inexplicably left off the ‘310 patent number when identifying earlier-filed IPR 2013-00596 on page 3 of its petition. Petitioners’ attempts to conceal the duplicative nature of the two petitions evidence their

concern about presenting overlapping petitions with different witnesses and conflicting claim constructions, and should not be rewarded.

Two IPRs on the same patent, with overlapping arguments and different technical witnesses from different petitioners, should not be instituted and should not be permitted to proceed together. Institution of this IPR (the second petition filed regarding the '310 patent) should be denied for these reasons alone, as duplicative and highly prejudicial to PO.

## **II. BACKGROUND**

Pursuant to 37 C.F.R. § 42.107, PO submits this Preliminary Response to the petition seeking *inter partes* review in this matter. The '310 patent has an effective filing date of April 11, 1995 given its continuity. (Ex. 1001.) While PO reserves the right to establish an earlier date of invention, PO assumes an effective filing date of April 11, 1995 for purposes of this Preliminary Response (i.e., the “critical date” is no later than April 11, 1995 for purposes of this submission).

Petitioner alleges that the challenged claims are not entitled to the claimed April 11, 1995 priority date. PO disagrees, and responds to petitioner's arguments under 35 U.S.C. §§ 112 and 120 in connection with Grounds 1-2. Moreover, petitioner's arguments under 35 U.S.C. §§ 112 and 120 (Grounds 1-2) are improper as they are contrary to 35 U.S.C. § 311(b) which states that an IPR can be based “*only* on a ground that could be raised under section 102 or 103” (emphasis

added). The statute precludes grounds, such as Grounds 1-2 here, which are based on § 112 written description arguments.

### **III. ALLEGED GROUNDS**

Petitioner has challenged claims of the '310 patent based on only, and limited to, the following alleged "Grounds:"

1. Claims 1, 2, 5-8, 10, 12, 14, and 16-19 are allegedly obvious under 35 U.S.C. §103 over Kinetech [a/k/a Farber; WO 96/32685 at Ex. 1005 which is allegedly a publication of the priority application of the '310 patent] in view of Brunk (Ex. 1006).
2. Claims 16-19, 24, 29, 70, 81, 82 and 86 are allegedly obvious under 35 U.S.C. §103 over Kinetech (Ex. 1005) in view of Francisco (Ex. 1004) and Brunk (Ex. 1006).
3. Claims 1, 2, 5-8, 10-11, 14, 16-19, 24, 29, 32, 70, 81, 82 and 86 are allegedly obvious under 35 U.S.C. §103 over Woodhill (Ex. 1003) in view of Francisco (Ex. 1004).
4. Claim 12 is allegedly obvious under 35 U.S.C. §103 over Woodhill (Ex. 1003) in view of Francisco (Ex. 1004) and Langer (Ex. 1007).

### **IV. CLAIM CONSTRUCTIONS**

Claim terms are presumed to be given their ordinary and customary meaning as would be understood by one of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc).

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