UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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EMC CORPORATION AND VMWARE, INC.
Petitioner

v.

PERSONALWEB TECHNOLOGIES LLC
Patent Owner
_____

Case IPR2013-00082 (JYC)
U.S. Patent No. 5,978,791
_____

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

ZECHER, *Administrative Patent Judge*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

EMC Corporation and VMware, Inc. ("EMC") filed a petition ("Pet.")
requesting *inter partes* review of claims 1-4, 29-33, and 41 of U.S. Patent
5,978,791 ("the '791 patent"). Paper No. 8. Patent owner, PersonalWeb
Technologies LLC ("PersonalWeb"), filed a preliminary response ("Prelim.
Resp."). Paper No. 15. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35
U.S.C. § 314(a), which provides:

> THRESHOLD --The Director may not authorize an inter partes
> review to be instituted unless the Director determines that the
> information presented in the petition filed under section 311
> and any response filed under section 313 shows that there is a
> reasonable likelihood that the petitioner would prevail with
> respect to at least 1 of the claims challenged in the petition.

Taking into account PersonalWeb's preliminary response, we
conclude that the information presented in the petition demonstrates that
there is a reasonable likelihood that EMC will prevail in challenging claims
1-4, 29-33, and 41 as unpatentable under 35 U.S.C. §§ 102 and 103.
Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to
be instituted as to claims 1-4, 29-33, and 41 of the '791 patent.

A. *Related Matters*

EMC indicates that the '791 patent was asserted against it in
PersonalWeb Technologies LLC v. EMC Corporation and VMware, Inc.,
Case No. 6:11-cv-00660-LED, pending in the U.S. District Court for the
Eastern District of Texas. Pet. 1. EMC also filed five other petitions

seeking *inter partes* review of the following patents: U.S. Patent No.
6,415,280 (IPR2013-00083), U.S. Patent No. 7,945,544 (IPR2013-00084),
U.S. Patent No. 7,945,539 (IPR2013-00085), U.S. Patent No. 7,949,662
(IPR2013-00086), and U.S. Patent No. 8,001,096 (IPR2013-00087). *Id.*

B. The Invention of the '791 Patent (Ex. 1001)

The invention of the '791 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, Spec. 1:14-18, 3:29-32, and 6:6-
10. According to the '791 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 directly derivable from the data associated
therewith. Ex. 1001, Spec. 3:33-35. The invention of the '791 patent also
examines the identities of a plurality of data items in order to determine
whether a particular data item is present in the data processing system. Ex.
1001, Spec. 3:36-39.

C. Illustrative Claims

Independent claims 1, 30, and 33 are illustrative:

> 1.   In a data processing system, an apparatus
> comprising:
>   identity means for *determining, for any of a plurality of*
> *data items present in the system, a substantially unique*
> *identifier, the identifier being determined using and depending*
> *on all the data in the data item and only the data in the data*

item, whereby two identical data items in the system will have the same identifier; and

existence means for *determining whether a particular data item is present in the system, by examining the identifiers of the plurality of data items.*

Ex. 1001, claims—Spec. 39:14-23 (emphasis added).

30.   A method of identifying a data item present in a data processing system for subsequent access to the data item, the method comprising:

determining a substantial unique identifier for the data item, the identifier depending on and being determined using all of the data in the data item and only the data in the data item, whereby two identical data items in the system will have the same identifier; and

accessing a data item in the system using the identifier of the data item.

Ex. 1001, claims—Spec. 42:58-67 (emphasis added).

33.   A method of duplicating a given data item present at a source location to a destination location in a data processing system, the method comprising:

determining a substantially unique identifier for the given data item, the identifier depending on and being determined using all of the data in the data item and only the data in the data item, whereby two identical data items in the system will have the same identifier;

determining, using the data identifier, whether the data item is present at the destination location; and

based on the determining whether the data item is present, providing the destination location with the data item only if the data item is not present at the destination.

Ex. 1001, claims—Spec. 43:11-23 (emphasis added).

D. Prior Art Relied Upon

EMC relies upon the following prior art references:

Woodhill   US 5,649,196   July 15, 1997   Ex. 1005

Shirley Browne et al., "*Location-Independent Naming of Virtual Distributed Software Repositories,*" University of Tennessee Technical Report CS-95-278 (Feb. 1995)(Ex. 1002)(hereinafter "Browne").

Albert Langer, "*Re: dl/describe (File Descriptions),*" post to the "alt.sources" newsgroup on Aug. 7, 1991 (Ex. 1003)(hereinafter "Langer").

Frederick W. Kantor, "*FWKCS™ Contents_Signature System Version 1.22,*" Zipfile FWKCS122.ZIP (Aug. 10, 1993)(Ex. 1004)(hereinafter "Kantor").

E. Alleged Grounds of Unpatentability

EMC seeks to have claims 1-4, 29-33, and 41 of the '791 patent cancelled based on the following alleged grounds of unpatentability:

1.   Claim 1-4, 29-33, and 41 as anticipated under 35 U.S.C. § 102(a) by Browne. Pet. 26-35.

2.   Claims 1-4, 29-33, and 41 as unpatentable under 35 U.S.C. § 103(a) over Browne. *Id*. at 35.

3.   Claims 1-4, 29-33, and 41 as unpatentable under 35 U.S.C. § 103(a) over the combination of Browne and Langer. *Id*. at 35-36.

4.   Claims 1-4 and 29 as unpatentable under 35 U.S.C. § 103(a) over the combination of Browne and Woodhill. *Id*. at 36-37.

5.   Claims 1-4, 29-33, and 41 as anticipated under U.S.C. § 102(b) by Langer. *Id*. at 37-43.

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