Paper No. 14

Filed: September 5, 2019

## UNITED STATES PATENT AND TRADEMARK OFFICE

### BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAYPAL, INC.
UPWORK GLOBAL INC.
SHOPIFY, INC.
SHOPIFY (USA), INC.
STRAVA, INC.
VALASSIS COMMUNICATIONS, INC.
RETAILMENOT, INC.
DOLLAR SHAVE CLUB, INC.
Petitioners

v.

PERSONALWEB TECHNOLOGIES LLC LEVEL 3 COMMUNICATIONS, LLC Patent Owners

Case IPR2019-01111 Patent No. 7,802,310

\_\_\_\_\_

#### PATENT OWNERS' PRELIMINARY RESPONSE



## **TABLE OF CONTENTS**

I.	INTF	TRODUCTION1				
II.	BAC	BACKGROUND1				
	A.	The '310 Patent				
	В.	The Challenged Claims				
	<b>C.</b>	Prior Post-Grant Proceedings				
	D.	The Cited References				
		1. Francisco	10			
		2. Grube	14			
III.	REVIEW SHOULD NOT BE INSTITUTED BECAUSE THE PETITION IS TIME-BARRED					
	<b>A.</b>	PersonalWeb Sued Amazon Years Ago	15			
	В.	Amazon Is an RPI and Is in Privity with Its Customers— Including Petitioners				
	<b>C.</b>	The District Court Concluded that Amazon and Its Customers Are in Privity—Just As Amazon Argued	18			
	D.	The District Court's Privity Determination Comports with Binding Precedent and PTAB Practice	22			
	E.	The District Court's Analysis Confirms that Amazon Is an RPI	23			
IV.		BOARD SHOULD DISCRETIONARILY DENY TITUTION UNDER § 314	26			
V.	CLA	IM CONSTRUCTION	29			
	<b>A.</b>	Legal Standard	29			
	В.	Response to Petitioners' Proposed Constructions	29			
	<b>C.</b>	Patent Owners' Proposed Constructions				
		1. "message digest function or a hash function" (claims 20, 69)	30			
		a. Patent Owners' Construction Is Correct				
		b. Petitioners' Implicit Construction Is Incorrect	36			



VI.	REVIEW SHOULD NOT BE INSTITUTED ON GROUND 137					
	<b>A.</b>	Petitioners Have Not Shown that All Elements of Claims 20 and 69 Are Present in, or Obvious Over, Francisco				
		1.	"Message Digest Function or a Hash Function."	38		
		2.	Allowing Access Based on a "Content-Dependent Name" Computed from a "Message Digest Function or Hash Function"	44		
		3.	"Wherein Two Identical Data Items Will Have the Same Content-Dependent Name"	45		
		4.	"Controlling Distribution of Content From a First Computer to at Least One Other Computer" (Claim 20)	46		
		5.	"Permitting the Content to be Provided to or Accessed by the at Least One Other Computer" (Claim 20)	48		
		6.	Limitation 69(b)(i) (Claim 69)	49		
		7.	Limitation 69(b)(ii) (Claim 69)	53		
	В.	Petitioners Have Not Established a Logical Reason for Modifying Francisco, or a Reasonable Expectation of Successin Doing So		54		
VII.						
	A.	The Alleged Combination of Grube and Francisco Does Not Disclose All Elements of Any Challenged Claim				
	В.	Petitioners Have Not Established a Logical Reason for Combining Francisco and Grube, or a Reasonable Expectation of Success in Doing So				
<b>1/111</b>	CON			61		



## **LISTING OF EXHIBITS**

EX. #	Exhibit Description
2001	Declaration of Lawrence M. Hadley in Support of Patent Owner's
	Motion for Pro Hac Vice Admission
2002	Declaration of Samuel H. Russ, Ph.D.
2003	Request for <i>Ex Parte</i> Reexamination in Rexam No. 90/014,368
2004	U.S. Pat. No. 7,802,310
2005	Markman decision from In re PersonalWeb Technologies, LLC et al.
	Patent Litigation, 18-md-02834, Dkt. No. 485 (N.D. Cal. 2019)
2006	10/26/2017 Samuel Russ Declaration, submitted by Patent Owners in
	Reexamination Control No. 90/013,487 of U.S. Pat. No. 6,415,280
2007	July 22, 2019 Appeal Brief in Reexamination Control No. 90/013,764
2008	Complaint from PersonalWeb Technologies LLC v. Amazon Web
	Services LLC et al, 6-11-cv-00658 (E.D. Tex.)
2009	Order of Dismissal from PersonalWeb Technologies LLC v. Amazon
	Web Services LLC et al, 6-11-cv-00658 (E.D. Tex.)
2010	Complaint from PersonalWeb Technologies, LLC et al. v. Venmo, Inc.,
	3:18-cv-177 (N.D. Cal.)
2011	Complaint from Amazon.com, Inc. et al. v. PersonalWeb Technologies,
	LLC et al., 5-18-cv-00767 (N.D. Cal.)
2012	Order Granting in Part and Denying in Part Amazon's Motion for
	Summary Judgment from In re: PersonalWeb Technologies, LLC et al.
	Patent Litigation, 5:18-md-02834-BLF, Dkt. 394 (N.D. Cal. 3/13/2019)
2013	Stipulation Re Remaining Customer Cases from In re: PersonalWeb
	Technologies, LLC et al., Patent Litigation, Case Nos. 5:18-md-02834-
	BLF and 5:18-cv-00767-BLF, Dkt. 417 (N.D. Cal. April 26, 2019)



2014	Amazon's Motion for Summary Judgment from In re: PersonalWeb
	Technologies, LLC et al., Patent Litigation, Case Nos. 5:18-md-02834-
	BLF and 5:18-cv-00767-BLF, Dkt. 315, (N.D. Cal. November 28, 2018)
2015	Public excerpts from Amazon's Interrogatory Responses from <i>In re:</i>
	PersonalWeb Technologies, LLC et al., Patent Litigation, Case Nos.
	5:18-md-02834-BLF and 5:18-cv-00767-BLF, (N.D. Cal. November 1,
	2018)
2016	Certificate of Service for Dollar Shave Club, Inc.



# DOCKET

## Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## **Real-Time Litigation Alerts**



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## **Advanced Docket Research**



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## **Analytics At Your Fingertips**



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

#### API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

#### **LAW FIRMS**

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

#### **FINANCIAL INSTITUTIONS**

Litigation and bankruptcy checks for companies and debtors.

#### **E-DISCOVERY AND LEGAL VENDORS**

Sync your system to PACER to automate legal marketing.

