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Paper No. 27
Entered: November 22, 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., and
DOLLAR SHAVE CLUB, INC.,
Petitioner,

v.

PERSONALWEB TECHNOLOGIES, LLC[1]
Patent Owner.

IPR2019-01111
Patent 7,802,310 B2

Before JONI Y. CHANG, MICHAEL R. ZECHER, and DAVID C. McKONE, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

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[1] The caption of the Petition lists Level 3 Communications as a patent owner. Patent Owner's Mandatory Notices indicates that PersonalWeb Technologies, LLC, is the patent owner, while Level 3 Communications, LLC, is a real party in interest. Paper 9, 1.

I. INTRODUCTION

On May 20, 2019, the following Petitioner Entities[2] collectively filed a Petition requesting an *inter partes* review ("IPR") of claims 20 and 69 ("the challenged claims") of U.S. Patent No. 7,802,310 B2 (Ex. 1001, "the '310 patent"): PayPal, Inc. ("PayPal"), Upwork Global Inc. ("Upwork Global"), Shopify, Inc. and Shopify (USA), Inc. (collectively "Shopify"), Strava, Inc. ("Strava"), Valassis Communications, Inc. ("Valassis"), RetailMeNot, Inc. ("RetailMeNot"), and Dollar Shave Club, Inc. ("Dollar Shave Club"). Paper 1 ("Pet.").

PersonalWeb Technologies, LLC ("Patent Owner"[3]) filed a Preliminary Response. Paper 14 ("Prelim. Resp."). Patent Owner argues, among other things, that the Petition is time-barred under 35 U.S.C. § 315(b) because the district court in the related litigation found that Petitioner Entities are in privity with Amazon.com, Inc., and Amazon Web Services, Inc. (collectively "Amazon"), and Amazon was served with a complaint alleging infringement of the '310 patent more than seven years prior to the filing of the Petition. *Id.* at 15–23; Ex. 2008. Pursuant to our Order (Paper 23), Petitioner Entities filed a Reply (Paper 24) to address whether Amazon is a privy of Petitioner Entities, and Patent Owner also filed a Sur-reply (Paper 26).

For the reasons stated below, we determine that Amazon, a time-barred party, is a privy of several Petitioner Entities. As such, we deny the Petition, as it is time-barred under § 315(b), and we do not authorize an *inter partes* review to be instituted.

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[2] The parties' briefs use "Petitioners." *See, e.g.*, Reply 1; Sur-reply 1.

[3] The parties' briefs use "PersonalWeb." *See, e.g.*, Reply 1; Sur-reply 1.

A. Related Proceedings

Petitioner Entities filed four other Petitions, challenging certain subsets of claims of U.S. Patent Nos. 6,928,442 B2 (IPR2019-01092), 7,945,544 B2 (IPR2019-01093), and 8,099,420 B2 (IPR2019-01089 and IPR2019-01091). Paper 9 (Patent Owner's Mandatory Notices), 16. The parties also identify other related proceedings, including those discussed below in the Relevant Facts section. *Id*. at 1–16; Pet. 2–3.

B. The '310 patent

The '310 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 of the data in the data item and only on the data in the data item. Ex. 1001, 1:44–48, 3:52–55, 6:20–24. According to the '310 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 derivable directly from the data associated therewith. *Id*. at 3:55–58. The invention of the '310 patent also provides that the system can publish data items, allowing other, possibly anonymous, systems in a network to gain access to the data items. *Id*. at 4:32–34.

D. Illustrative Claim

Both challenged claims 20 and 69 are independent. Claim 20 is illustrative and is reproduced below:

> 20. A computer-implemented method operable in a system which includes a plurality of computers, the method comprising:
>
> controlling distribution of content from a first computer to at least one other computer, in response to a request obtained by a first device in the system from a second device in the system, the first device comprising hard ware including at least one processor, the request including at least a content-dependent

> name of a particular data item, the content-dependent name being based at least in part on a function of at least some of the data comprising the particular data item, wherein the function comprises a message digest function or a hash function, and wherein two identical data items will have the same content-dependent name,
>
> based at least in part on said content-dependent name of said particular data item, the first device (A) permitting the content to be provided to or accessed by the at least one other computer if it is not determined that the content is unauthorized or unlicensed, otherwise, (B) if it is determined that the content is unauthorized or unlicensed, not permitting the content to be provided to or accessed by the at least one other computer.

Ex. 1001, 39:8–31.

E. Prior Art Relied Upon

Petitioner relies upon the references listed below. Pet. 4–5.

Name	Reference	Date	Exhibit
Francisco	U.S. Patent No. 4,845,715	July 4, 1989	1003
Grube	U.S. Patent No. 5,483,658	Jan. 9, 1996	1004

F. The Asserted Grounds of Unpatentability

Petitioner asserts the grounds listed below. Pet. 5.

Claims Challenged	35 U.S.C. §	Reference(s)
20, 69	103(a)[4]	Francisco
20, 69	103(a)	Francisco, Grube

[4] The Leahy-Smith America Invents Act ("AIA"), which amended 35 U.S.C. § 103, was signed into law in 2011. Changes to § 103 apply to applications filed on or after March 16, 2013. Because the '310 patent's filing date is prior to March 16, 2013, we refer to the pre-AIA version of § 103.

II. ANALYSIS

A. Relevant Facts

In December of 2011, Patent Owner filed a complaint against Amazon and Amazon's customer, DropBox, Inc., in the Eastern District of Texas, alleging infringement of one or more claims of the '310 patent based on Amazon's Simple Storage Service ("S3"), in *PersonalWeb Technologies, LLC v. Amazon Web Services LLC*, No. 6:11-cv-00658 (E.D. Tex. dismissed on June 9, 2014) ("the Texas Action"). Prelim. Resp. 15; Ex. 2008 (Complaint in the Texas Action). None of Petitioner Entities was named expressly as defendant. Ex. 2008. In its complaint, Patent Owner alleged that Amazon was liable for direct and indirect infringement, and that "[f]or PersonalWeb's claims of indirect infringement, Amazon's end-user customers and consultants [were] direct infringers of the Patents-in-Suit," including the '310 patent. *Id*. at 12. The Texas Action was dismissed with prejudice for "all claims" in that action, including the noted infringement claims against Amazon and its end-user customers. Ex. 2009 (Order of Dismissal with Prejudice).

In 2018, Patent Owner filed a number of lawsuits against Amazon's customers, including "the eight Petitioners, alleging infringement [of the '310 patent] based on their use of Amazon S3." Prelim. Resp. 15–17. For instance, the '310 patent is involved in the following proceedings in the Northern District of California (Pet. 2, Paper 9, 1–14):

(1) *PersonalWeb Technologies, LLC v. Venmo, Inc.*, No. 5:18-cv-00177 (N.D. Cal. filed Jan. 8, 2018) ("the *Venmo/PayPal* case")[5];

[5] Petitioner Entities indicate that "[t]he *Venmo* case was refiled naming PayPal, Inc., as the proper defendant." Reply 3 n.1; *see also* Pet. 2 (referring

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