

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

Trial No.: IPR 2014-00066

In re: U.S. Patent No. 6,928,442

Patent Owners: PersonalWeb Technologies, LLC & Level 3 Communications

Petitioner: Rackspace US, Inc. & Rackspace Hosting, Inc.

Inventors: David A. Farber and Ronald D. Lachman

For: CONTROLLING ACCESS TO DATA IN A DATA PROCESSING SYSTEM

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July 16, 2014

PATENT OWNER'S RESPONSE PURSUANT TO 37 C.F.R. § 42.120

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PATENT OWNER’S EXHIBIT LIST

CERTIFICATE OF SERVICE

PersonalWeb Technologies, LLC (“patent owner” or “PO”) submits this response to the petition. Petitioner has the burden of proving unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). Petitioner has not met its burden for the reasons explained below. *See also* Dewar Decl. at ¶¶ 21-82 (Ex. 2012).

U.S. Patent No. 6,928,442 (“the ‘442 patent”), including its reexamination certificate, has an effective filing date of April 11, 1995 given its continuity. (Ex. 1001.) While patent owner (PO) reserves the right to establish an earlier date of invention, an effective filing date of April 11, 1995 is assumed for purposes of this Response (i.e., the “critical date” is no later than April 11, 1995 for purposes of this submission). Petitioner does NOT allege a later effective filing date in connection with the instituted grounds. Thus, the April 11, 1995 effective filing date is applicable in this proceeding.

The patentability of claims 1-12, 14-21, 23-35, 37, 39 and 42-55 was previously confirmed in the *Ex parte* Reexamination Certificate issued July 13, 2010. (Ex. 1001 at “62 of 62.”)

I. INSTITUTED GROUNDS

The Board, on April 15, 2014, instituted a trial in this proceeding regarding the ‘442 patent for only the following:

1. Whether claims 1, 2, 4, 23, 27 and 30 are unpatentable as obvious under 35 U.S.C. §103(a) over Woodhill (Ex. 1004 – U.S. Patent No. 5,649,196) and Francisco (Ex. 1005).
2. Whether claim 7 is unpatentable as obvious under 35 U.S.C. §103(a) over Woodhill and Kahn (Ex. 1006 - U.S. Patent No. 6,135,646).
3. Whether claim 28 is unpatentable under §103(a) over Woodhill, Francisco, and Langer (Ex. 1007).

II. 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). However, one may rebut that presumption by providing a definition of the term in the specification with reasonable clarity, deliberateness, and precision.

A. Preamble of claim 7 is limiting.

The Contrary to petitioner's allegation, the preamble of claim 7 is limiting and is entitled to patentable weight. The body of claim 7 refers back to the preamble, with the preamble being needed for completeness of the claim. For example, the main body of claim 7 refers to “*the* plurality of computers” from the preamble. The preamble breathes life into the body of the claim.

The Board correctly found that the preamble of claim 7 is limiting, and entitled to patentable weight, in its institution decision. (Paper 9 at 6-8.)

B. “file” and “data file” (claims 1, 2, 4, 7, 23, and 30).

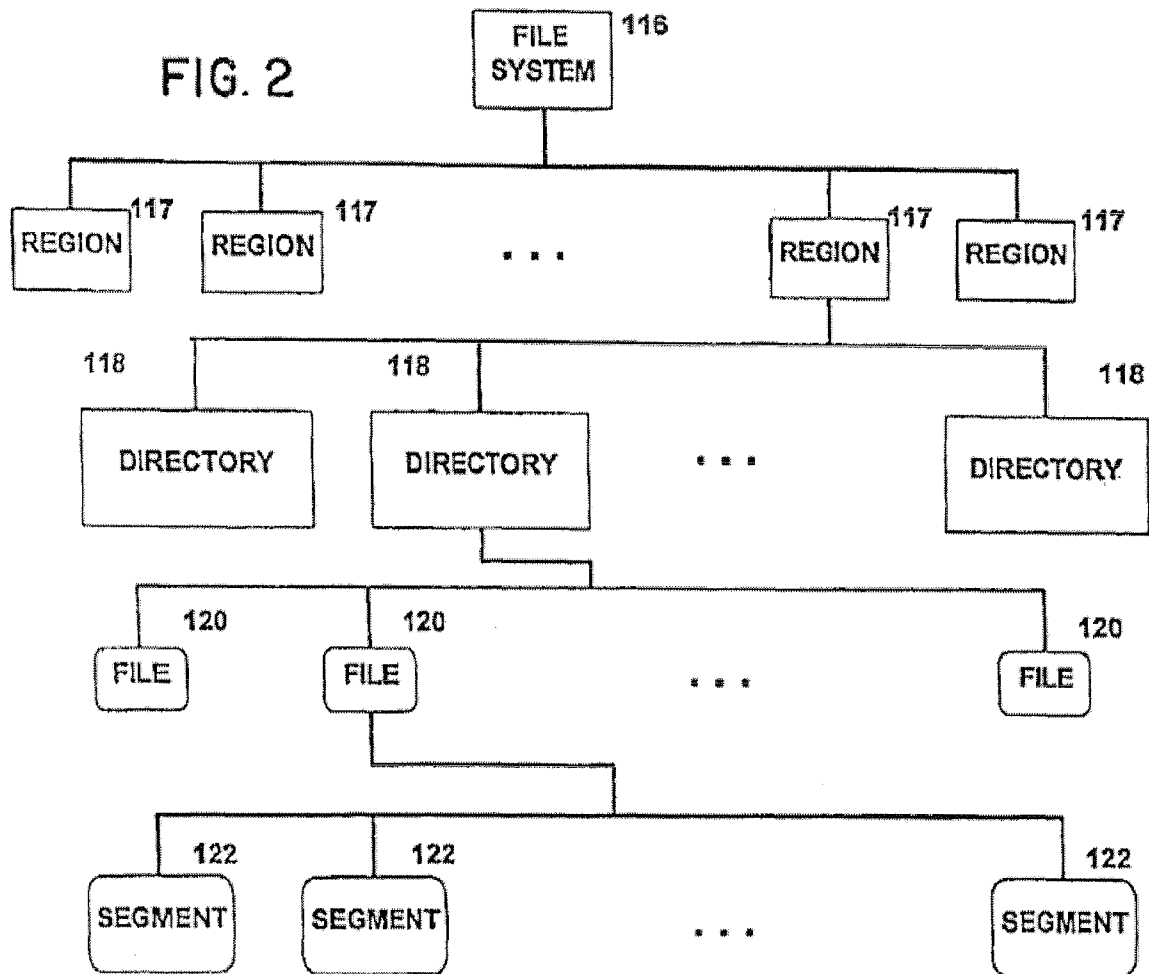
The ordinary meaning of “file” in this art at the time of the invention was the following definition given in the 1994 Microsoft Computer Dictionary:

“file A complete, named collection of information, such as a program, a set of data used by a program, or a user-created document. A file is the basic unit of storage that enables a computer to distinguish one set of information from another. A file might or might not be stored in human-readable form, but it is still the ‘glue’ that binds a conglomeration of instructions, numbers, words or images into a coherent unit that a user can retrieve, change, delete, save, or send to an output device.” (emphasis added)

(Microsoft Press Computer Dictionary, Second Edition (1994) – Ex. 2011.) This is consistent with a “named” data item referred to at col. 5:48-49 of the ‘442 patent. (Dewar Decl. at ¶¶ 22-27 [Ex. 2012].) A “named” data item as described in the ‘442 patent means that the data item is a coherent unit that is individually manipulatable by a user so that a user can selectively retrieve, change, delete, save, or send it to an output device. (Dewar Decl. at ¶ 22 [Ex. 2012].) In other words, one of skill in the art would have understood that a “named” data item is one that is necessarily a complete coherent unit that a user can selectively retrieve, change, delete, save, or send to an output device. *Id.* Thus, the ordinary meaning of “file”

as described in the 1994 Microsoft Computer Dictionary is both proper and consistent with the description of “file” in the ‘442 patent.

Importantly, a mere *segment* of a basic file is NOT a “file.” (Dewar Decl. at ¶ 23 [Ex. 2012].) Both the specification of the ‘442 patent and the 1994 Microsoft Computer Dictionary are clear in this respect. The specification of the ‘442 patent expressly *differentiates* between a “file” and a mere “segment” of a file, making clear that they are different and that a mere “segment” is not a “file.” (Dewar Decl. at ¶ 23 [Ex. 2012].) Fig. 2 of the ‘442 patent is set forth below:



As illustrated in Fig. 2 above, the '442 patent differentiates between a "file" 120 and a mere "segment" 122 of a basic file. ('442 patent, Fig. 2; col 5:25-35.) The specification of the '442 patent explains, as illustrated in Fig. 2, that a "file" is at a different position in the hierarchy than a mere "segment" of a file. ('442 patent, col. 5:25-30.) The '442 patent also explains that while a "file" can be named by a user, a mere "segment" of a file cannot be so named. ('442 patent, col. 5:44-45; col. 8:25.) Regardless of how "file" is construed, the specification (which includes the drawings) of the '442 patent makes clear that a mere "segment" cannot be a "file." (Dewar Decl. at ¶ 23 [Ex. 2012].) Indeed, petitioner's expert admits that the '442 patent "clearly" differentiates between "files" and mere "segments."

Q. So here does the '442 patent differentiate between files and segments? And again, I'm referring to Column 5, Lines 28 to 31, and Figure 2 of the '442 patent.

A. Well, clearly, Figure 2 is probably the easiest way to see this. The next-to-the-bottom level in the hierarchy has the label File 120, or a collection of Files 120. The lowest level has a collection of Segments 122.

Q. So the '442 patent uses Reference No. 120 to refer to files and Reference No. 122 to refer to segments?

A. I believe that's true.

(Mercer Dep. 96 [Ex. 2015].) This further demonstrates that one of ordinary skill in the art, upon reviewing the specification of the '442 patent, would have understood that files are different than segments – *i.e.*, a mere segment cannot qualify as a "file." Petitioner's expert also testified that Woodhill's binary objects

are “equivalent” to the “segments” in the ‘442 patent, which makes clear that Woodhill’s binary objects (and granules) are not “files.” (Mercer Dep. 102 [Ex. 2015].)

Moreover, according to the 1994 Microsoft Computer Dictionary, a mere segment of a file cannot be a “file” at least because: (a) a mere segment of a file is not a “complete” collection of information, (b) a mere segment of a file is not a coherent unit that a user can retrieve, change, delete, save or send to an output device, (c) a segment typically has no file header, and (d) a mere segment of a file is not named. (Microsoft Press Computer Dictionary, Second Edition (1994) – Ex. 2011) (Dewar Decl. at ¶ 24 [Ex. 2012]).

Contrary to the statement on page 9 of the institution decision (Paper 9), this construction would NOT “preclude a data file from including smaller data files” in all cases. For example, a *package* such as a ZIP file may include a plurality of inner files – these would ALL be “files” under PO’s construction because each of these files would satisfy the limitations of a “file” discussed above. (Dewar Decl. at ¶ 25 [Ex. 2012].) Each inner file would be individually named and each would satisfy the definition of a “file” in the 1994 Microsoft Computer Dictionary discussed above. Both before formation of the ZIP file and after unpacking the ZIP file, each of the inner files thereof would have a file header and each would be individually manipulatable by users, with each being a coherent unit that a user can retrieve, change, delete, save or send to an output device. (Dewar Decl. at ¶ 25

[Ex. 2012].) In contrast, that is *not* the case with the binary objects and granules in Woodhill. *Id.* Binary objects and granules in Woodhill do not have headers, are not individually manipulatable as files by users, are not inner files of a package file (e.g., ZIP file), and do not satisfy the definition of a “file” in the 1994 Microsoft Computer Dictionary. *Id.* A binary object or granule in Woodhill: (a) is determined solely based on size (number of bits) and is NOT based on the extent of any coherent unit that is named or individually manipulatable; (b) has no header because it is based solely on size (Mercer Dep. 105 [Ex. 2015]), (c) is NOT a coherent unit that a user can retrieve, change, delete, save or send to an output device, (d) is NOT a “complete” collection of information, and (e) is not named. (Dewar Decl. at ¶ 25 [Ex. 2012].) The binary objects and granules in Woodhill, for example, are mere portions of a basic file, do not have headers, cannot be named, and are not complete coherent units that a user can selectively change, delete, save or send to an output device. *Id.* Petitioner’s expert admits, for instance, that a user cannot access a granule in Woodhill and then delete only that granule. (Mercer Dep. 110 [Ex. 2015].)

One of ordinary skill in the art at the time of the invention would have understood that a “file” has a file header. (Dewar Decl. at ¶ 26 [Ex. 2012].) The 1994 Microsoft Computer Dictionary explains the ordinary meaning that “*a file header identifies a data file by name, size, and time and date of creation or revision; it might also identify the program with which the file was created.*”

(Microsoft Press Computer Dictionary, Second Edition (1994) – Ex. 2011.)

Accordingly, a “file” at the time of the invention, and in the ‘442 patent, must also be construed as including a file header. (Dewar Decl. at ¶ 26 [Ex. 2012].) This is important because binary objects and granules in Woodhill do not have file headers, and thus cannot be “files” or “data files” for this additional reason. (*Id.*; and Mercer Dep. 105 [Ex. 2015].)

It would unreasonable to allege that an arbitrary portion of a file constitutes its own “file.” In a similar manner, any allegation that a mere binary object or granule in Woodhill constitutes its own “file” is unreasonable, contrary to the ordinary meaning of “file” at the time of the invention, and contrary to the specification of the ‘442 patent which differentiates between files and segments. (Dewar Decl. at ¶¶ 22-27 [Ex. 2012].)

Additionally, claim 7 requires a “data file representing a digital image.” A mere segment of a basic file cannot represent a digital image. Thus, for instance, *binary objects and granules in Woodhill, as mere portions of basic files, cannot themselves represent a digital image.* This further confirms that they are not files.

The proper construction for a “data file” is the same as the construction for a “file” discussed above, except that a “data file” includes data. (Dewar Decl. at ¶ 27 [Ex. 2012].)

C. “determining, using at least the name, whether a copy of the data file is present on a particular one of said computers” (claim 2).

The ordinary meaning of “determine” is “to decide or settle conclusively and authoritatively.” *The American Heritage Dictionary* (1975). (Ex. 2020.) And the ordinary meaning of “whether” is “if it is so that; if the case is that.” *The American Heritage Dictionary* (1975). (Ex. 2020.) Accordingly, this clause in claim 2 requires *deciding or settling conclusively and authoritatively, using at least the name, if it is so that a copy of the data file is present on a particular one of said computers*. This is the proper construction for claim 2. (Dewar Decl. at ¶ 28 [Ex. 2012].) In order to be capable of *determining whether* a particular binary object is present on a given computer, there must be both (a) a capability to determine that the object is present on that computer if that is the case, and (b) a capability to determine that the object is not present on that computer if that is the case.

D. “determine whether unauthorized or unlicensed copies of some of the plurality of data files are present on a particular computer” (claim 23).

As mentioned above, the ordinary meaning of “determine” is “to decide or settle conclusively and authoritatively”, and the ordinary meaning of “whether” is “if it is so that; if the case is that.” *The American Heritage Dictionary* (1975). (Ex. 2020.) Accordingly, this clause in claim 23 requires *decide or settle conclusively and authoritatively [using the list of file names] if it is so that unauthorized or unlicensed copies of some of the plurality of data files are present*

on a particular computer. This is the proper construction for this language in claim 23. Petitioner improperly tries to read “determining whether” out of the claim and replace it with “determining that” – this would be improper as the claim language cannot be ignored. In order to be capable of *determining whether* a particular file, binary object, or granule is present on a given computer, there must be both (a) a capability to determine that it is present on that computer if that is the case, and (b) a capability to determine that it is not present on that computer if that is the case. (Dewar Decl. at ¶ 29 [Ex. 2012].)

E. “file name” & “name for a data file” (claims 1, 2, 7, 23).

A “file name” and “name for a data file” in this art are more than simply an identifier. (Dewar Decl. at ¶ 30 [Ex. 2012].) It cannot reasonably be said that all identifiers are file names. *Id.* For example, while a fingerprint is an identifier for a person, it is not a “name” for that person. *Id.* Something is not a “file name” simply because it identifies a file. *Id.* Any attempt to simply replace “file name” with “file identifier” (or “name” with “identifier”) in a construction would be incorrect and contrary to the claim language itself. Even Woodhill contrasts the difference between a file “name” and a binary object “identifier” (*see e.g.*, file name 40 and file name 80 in Figs. 3-4 of Woodhill, compared to binary object identifier 74 in Fig. 3 of Woodhill), evidencing that they are not necessarily the same thing in this art.

One of ordinary skill in the art at the time of the invention would have understood that there can be a significant difference between a “file name” (or “name for a data file”) and a mere “identifier.” (Dewar Decl. at ¶ 30 [Ex. 2012].) “Name” should not be simply replaced with “identifier.” One of ordinary skill in the art would have recognized that a “file name” (or “name for a data file”) is used to both (a) identify a particular file so that the name can be used to differentiate the file from other files, and (b) refer to that file, access that file, search for that file, and address that file so that a user can use the name to selectively retrieve, change, delete, save or send the file to an output device. (E.g., ‘442 patent, col. 16:13-16; col. 17:15-50; col. 19:1-27; col. 23:61-67; col. 24:56-67; col. 34:35-49; Ex. 2011; and Dewar Decl. at ¶ 30 [Ex. 2012].)

This is relevant at least because identifiers relied upon in the cited art, such as Woodhill’s binary object identifiers 74 and “contents identifiers,” are not “file names” or “names for data files.”

F. The BRC Standard is Not Applicable to this Proceeding.

37 C.F.R. § 42.100(b) states that a claim in an “unexpired patent” shall be given its broadest reasonable construction (“BRC” or “BRI”) in light of the specification. However, the ‘442 patent expires on April 11, 2015. Accordingly, PO has no ability to amend the ‘442 patent in this proceeding and no appeal will take place until after the ‘442 patent expires. Indeed, the USPTO will have jurisdiction over this proceeding after the ‘442 patent expires. No certificate under

35 U.S.C. § 318(b) can issue before the '442 patent expires. At least any document (e.g., final written decision, decision on rehearing, certificate, etc.) authored or generated by the USPTO after the '442 patent expires cannot use BRC, and instead should use and must rely upon the same claim construction standard as the district court laid out in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). Moreover, the USPTO has no authority to change the claim construction standard required by *Phillips* for IPR proceedings because an IPR is not an examination proceeding and the applicable claim construction standard is a substantive issue (not a mere procedural issue). *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1335 (Fed. Cir. 2008). Thus, the BRC standard should not be used in this proceeding for construing claims.

While PO's claim constructions set forth herein are submitted to be correct under either the BRC standard or the *Phillips* standard, the Board should use the *Phillips* standard to construe claims in this proceeding.

It is noted that further claim construction issues may be reflected in the arguments below.

III. LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A feature is "inherent" in a reference only if that feature is

“necessarily present” in the reference, “not merely probably or possibly present.”

Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295 (Fed. Cir. 2002).

Furthermore, in order to anticipate, a prior art reference must not only disclose all elements of the claim, but must also disclose those elements “arranged as in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008).

Moreover, a patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) secondary considerations such as commercial success, long felt need, copying by others, etc. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). A court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR*, 550 U.S. at 418. “A prior art reference may be considered to teach away [from the claimed invention] when ‘a person of ordinary skill, upon reading the reference, . . . would be led in a direction divergent from the path that was taken by the applicant’.” *Monarch Knitting Mach. V. Sulzer Morat*, 139 F.3d 877, 885 (Fed. Cir. 1998) (citation omitted). The “general rule” is that references that

teach away “cannot serve to create a prima facie case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001).

IV. WOODHILL AND FRANCISCO BOTH FAIL TO DISCLOSE USING A LIST OF CONTENT-BASED FILE NAMES TO DETERMINE WHETHER UNAUTHORIZED OR UNLICENSED COPIES OF SOME FILES ARE PRESENT ON A PARTICULAR COMPUTER AS IN CLAIM 23

Claim 23 of the ‘442 patent requires:

“using at least said list [of content-based file names] to determine whether unauthorized or unlicensed copies of some of the plurality of data files are present on a particular computer.”

Both Woodhill and Francisco fail to disclose this subject matter. (Dewar Decl. at ¶¶ 31-42 [Ex. 2012].) Thus, even the alleged combination (which patent owner does not agree with in any event) fails to meet the claimed subject matter of claim 23.

The decision on institution indicates that Woodhill does not disclose this subject matter, and that Francisco is relied upon in this respect. (Paper 9 at 17-18.) Indeed, Woodhill fails to disclose deciding or settling conclusively and authoritatively, using a list of binary object identifiers or contents identifiers (alleged file names), if it is so that unauthorized or unlicensed copies of a plurality of data files are present on a particular computer.¹ Recognizing this deficiency in

¹ With respect to Woodhill’s granularization restore procedure for example, Woodhill is only analyzing whether a given granule is present in one particular large

Woodhill, the decision on institution states that “implementing Francisco’s authorization check mechanism in Woodhill’s distribution computer network system would have been an obvious improvement.” (Paper 9 at 29.) However, Francisco also fails to disclose this claimed subject matter. Even the alleged combination fails to meet claim 23 for at least the following reasons.

First, petitioner’s allegation on page 31 of the Petition that “Francisco discloses that a copy of a program residing on a computer being requested *can be determined to be unauthorized if there have been any modifications or changes in the software program*” is incorrect. Francisco’s *authenticity* check at comparator 36 determines whether there have been any changes to the program – this is not an authorization check. (Dewar Decl. at ¶ 35 [Ex. 2012].) Francisco’s *authorization* check is performed later at comparator 40 *after* the authenticity check, and does not use a list of content based names. *Id.* Francisco makes very clear that determining whether changes have been made in Francisco is *not* an “authorization” check – it is an “authenticity check. *Id.*

Francisco first performs an “authentication” check at comparator 36 to determine whether the requested program has changed relative to the base version. Then, “subsequent” to the authentication check, Francisco determines at

database file. Woodhill does not and cannot figure out if that granule is present in any of the other files on the local computer 20 or any other computer. The same applies to binary objects in Woodhill.

comparator 40 whether the requesting user is authorized to access the program. (Francisco at Fig. 2; col. 1:40-42; and col. 2:65 to col. 3:35; and Dewar Decl. at ¶ 36 [Ex. 2012].) The program identifier is compared with only a single value in comparator 36 during the “*authentication*” check, and is not compared with anything in comparator 40 during the “*authorization*” check. *Id.*

Francisco's *authentication* check at comparator 36 merely compares a program identifier (electronic identification indicia) 34 from generator 32 with a single program identifier 12. (Francisco at Fig. 2; col. 1:40-42; col. 2:65 to col. 3:20; and col. 4:12-28; Mercer Dep. 60 [Ex. 2015]; and Dewar Decl. at ¶ 37 [Ex. 2012].) Thus, there is no comparison of an identifier (12 or 34) to a list of content-based names in the authentication check at comparator 36. *Id.* Moreover, comparator 36 merely performs an authentication check to make sure that the requested program has not changed (Mercer Dep. 63 [Ex. 2015]) – this is *not* an authorization check and does *not* determine whether the requested program is unauthorized or unlicensed. (Dewar Decl. at ¶ 37 [Ex. 2012].)

If there is a match between identifiers 12 and 34 in comparator 36, then the requested program has not changed and it is only then that Francisco moves on to comparator 40 for determining whether the requesting user is authorized to access the program. (Francisco at Fig. 2; col. 3:17-36; and col. 4:30-51; and Dewar Decl. at ¶ 38 [Ex. 2012].) Francisco clearly explains that the *authorization* check is performed “subsequent” to the *authentication* check. (Francisco at Fig. 2; and col.

1:40-42; and Dewar Decl. at ¶ 38 [Ex. 2012].) Because the authorization check at comparator 40 is “subsequent” to the authentication check, they are not the same and are different checks. (Dewar Decl. at ¶ 38 [Ex. 2012].) In making the authorization check at comparator 40, Francisco compares an identification indicia of the requesting user with a user profile 42. (Francisco at Fig. 2; col. 3:20-36; col. 4:30-33; and col. 4:40-51; Mercer Dep. 61 [Ex. 2015].) Comparator 40 compares these two user indicia with each other in order to determine whether access is authorized. *Id.* See also Francisco at col. 4:48-51. Importantly, Francisco’s comparator 40 does *not* compare program identifier 34 with anything – it merely forwards identifier 34 in a “program release” signal if the two user indicia match each other. (Dewar Decl. at ¶ 38 [Ex. 2012].) No list of content-based file names is used at comparator 40 for any reason. *Id.*

Accordingly, Francisco compares the program identifier (12 or 34) with a single value in comparator 36 to make sure that the file is *authentic* (*i.e.*, that it has not changed), and if the file is found to be authentic then Francisco later compares *user information* in another comparator 40 to determine if access is authorized. (Dewar Decl. at ¶ 39 [Ex. 2012].) Thus, Francisco’s program identifier 34 (or 12): (i) is only compared to a single value for determining whether the program has changed, and (ii) is not compared to anything for determining whether access by a particular user is authorized. *Id.* No list of content-based file names is used during Francisco’s authorization check at comparator 40. *Id.* The only possible alleged

“list” of content-based file names in Francisco could be argued to be in the “electronic identification inicia library” in the upper right corner of Fig. 2 of Francisco according to the PTAB’s constructions – however, *nothing from this library is used during Francisco’s authorization check at comparator 40*. (Dewar Decl. at ¶ 40 [Ex. 2012].) Accordingly, even providing Francisco’s system in Woodhill fails to meet the subject matter of claim 23. If Francisco’s system were provided in Woodhill (with Woodhill’s binary object identifiers 74 or records 58 possibly taking the place of Francisco’s program identifiers), the invention of claim 23 still would not be met because the combination would NOT use a list of content-based file names to determine whether unauthorized or unlicensed copies of a plurality of data files are present on a particular computer. *Id.*

Second, as explained above in the claim construction section, claim 23 requires deciding or settling conclusively and authoritatively, using a list of content-based file names, if it is so that unauthorized or unlicensed copies of a plurality of data files are present on a particular computer. Given that both parties agree that Woodhill fails to disclose this, petitioner and the decision on institution rely on Francisco for this feature.

In order to be capable of *determining whether* a particular file, binary object, or granule is present on a given computer, there must be both (a) a capability to determine that it is present on that computer if that is the case, and (b) a capability to determine that it is NOT PRESENT on that computer if that is the case.

Woodhill and Francisco are both incapable of at least the latter, because for a given file, binary object or granule they are only capable of analyzing information relating to *one file* on a given computer. (Dewar Decl. at ¶ 41 [Ex. 2012].) They are blind regarding other files on that computer and elsewhere in the system. In Francisco (relied upon in this respect by petitioner and the PTAB), a single program (presumably on some server) is “selected” and requested to be released. (Francisco at col. 2:66-69 and Fig. 2.) Francisco then generates an identification signal 34 for that particular program and sends it to comparator 36. (Francisco at col. 2:66 to col. 3:3, and Fig. 2.) *Importantly, Francisco does not analyze or generate any identification signal for any other programs on the server on which the selected program is presumably located.* (Dewar Decl. at ¶ 41 [Ex. 2012].) Therefore, Francisco cannot determine whether a duplicate of that program, or a different and unlicensed version of that program, is located at a different location on that server. *Id.* Because Francisco’s Fig. 2 procedure is blind to all programs on a given computer except for the one that is selected, Francisco is incapable of determining that a given program is *not present* on that particular server if that is indeed the case. *Id.* Unlike the ‘442 patent, Francisco (and Woodhill) does not search a list of content-based names for determining whether unauthorized or unlicensed files are present at a particular computer.

Assume a situation in Francisco where two versions of a given program are on a given server, where version A is licensed but version B is unlicensed. If a

user selects version A of the program, then as explained above Francisco would do no analysis of version B and is incapable of figuring out that unlicensed version B is present on the server. (Dewar Decl. at ¶ 42 [Ex. 2012].) Again, Francisco does not use a list of content-based names to determine whether unlicensed or unauthorized programs are on a particular server/computer. *Id.*

For at least the foregoing reasons, even the alleged combination of Woodhill and Francisco fails to meet claim 23 of the '442 patent. And there would have been no logical reason to have further modified the alleged combination to have met the claim in these respects, and petitioner alleges no such further modification.

**V. ONE SKILLED IN THE ART WOULD NOT HAVE MODIFIED
WOODHILL TO ADD FRANCISCO'S OR KAHN'S SYSTEM BECAUSE
WOODHILL ALREADY HAS ACCESS CONTROL THAT IS
UNRELATED TO BINARY OBJECT IDENTIFIERS**

Petitioner admits that Woodhill already has an access control technique for controlling access. (Mercer Dep. 112-113 [Ex. 2015].) Petitioner's expert admits that Woodhill's access control determines whether access is authorized. (Mercer Dep. 113, 115 [Ex. 2015].) Given that Woodhill already has access control, there would have been no logical reason to have modified Woodhill to have provided further access control with Francisco or Kahn. (Dewar Decl. at ¶¶ 43-44 [Ex. 2012].) One skill in the art, as a matter of common sense and logic which a person of ordinary skill in the art is presumed to have, would not ever think to layer additional and unnecessary access control onto the existing access control of Woodhill. *Id.* Thus, there would have been no motivation or logical reason for the

alleged modification. *Id.* Claims 1, 2, 4, 7, 23, 27, 28 and 30 define over the cited art, and are nonobvious, in this respect.

During the backup procedure, Woodhill separates each file being backed up into multiple data streams. (Woodhill, col. 7:41-43.) “These data streams may represent regular data, extended attribute data, *access control list data*, etc.” (Woodhill, col. 7:44-47.) Petitioner acknowledges that this “access control list data” relates to authorization checking in Woodhill. (Mercer Dep. 113, 115 [Ex. 2015]; and Dewar Decl. at ¶ 44 [Ex. 2012].) Referring to Fig. 5A of Woodhill, it can be seen that this “access control list data” exists in step 132 *before* binary object identifiers 74 are even calculated in step 138. (Woodhill, Fig. 5A, col. 7:40-67; Mercer Dep. 114 [Ex. 2015].) Indeed, binary objects in Woodhill include such extended attribute data and access control list data, and Woodhill creates binary object identifiers 74 in part by hashing such extended attribute data and access control list data. (Woodhill, col. 7:41-67 and Fig. 5A.) Given that Woodhill’s “access control list data” exists *prior* to binary object identifiers 74 being created, it would be illogical and non-sensical to modify Woodhill as alleged by petitioner to use the binary object identifiers 74 for checking authorization/unauthorization. (Dewar Decl. at ¶ 44 [Ex. 2012].) Moreover, if Woodhill already had an authorization/unauthorization system based on this “access control list data” (which is unrelated to binary object identifiers 74), there would have been no logical reason to have modified Woodhill as alleged by petitioner to add another

authorization/unauthorization checking feature to Woodhill. *Id. See also Ex Parte Rinkevich et al*, Appeal 20071317, decided May 29, 2007 (explaining that one of ordinary skill in the art having common sense would not have provided a component to address a problem that did not exist or was already solved).

**VI. ONE WOULD NOT HAVE MODIFIED WOODHILL TO CHECK
WHETHER ACCESS TO A FILE BY A COMPUTER WAS AUTHORIZED
WHEN THE COMPUTER ALREADY HAD THE CURRENT VERSION OF
THAT FILE**

Petitioner alleges that it would have been obvious to have incorporated Francisco's or Kahn's system into Woodhill's granularization restore procedure for large database files described from column 17:18 to col. 18:9 and in Figs. 5H-5I. In Woodhill as allegedly modified by Francisco or Kahn, petitioner contends that the "request" of claims 1 and 7 is the "update request" described in Woodhill at column 17:42-46.

In Woodhill's restore procedure, the local computer 20 *already has* the most recent (current) version of the large database file at issue. (Woodhill at col. 17:39-40, col. 17:59-60; Mercer Dep. 136-137 [Ex. 2015]; and Dewar Decl. at ¶ 45 [Ex. 2012].) Because the local computer 20 already has the most recent (current) version of the large database file at issue, there is no logical reason to have modified Woodhill to implement a system for checking whether that same local computer 20 is authorized to access a previous version of that same file (*i.e.*, petitioner's alleged modification makes no sense). (Dewar Decl. at ¶ 45 [Ex. 2012].) One would have assumed that the local computer 20 is permitted to access

a prior version of a file if that computer already has the current version of that file. The alleged modification is illogical and would not have been made by one of ordinary skill in the art. Given that the local computer 20 already has the most recent version of the file, as a matter of common sense there would have been no logical reason to have checked whether that same computer is authorized to access the previous version of that same file. (Dewar Decl. at ¶ 45 [Ex. 2012].) And hindsight is not permitted – especially here where it is contrary to common sense which one of ordinary skill in the art is assumed to have. Claims 1, 2, 4, 7, 23, 27, 28 and 30 define over the cited art, and are nonobvious, in this respect.

Petitioner's alleged reason for making the alleged modification is also fundamentally flawed. Petitioner's rationale for the alleged modification is “to only provide copies of the requested file to an authorized party identified in a table as set forth in Francisco and not provide copies of files to unauthorized parties as set forth in Francisco.” (*E.g.*, Ex. 1010, ¶ 62.) However, the local computer in Woodhill's granularization restore procedure already has the most recent version of this file, so there would be no concern of that computer/user not having authorization. (Dewar Decl. at ¶ 46 [Ex. 2012].) Moreover, Woodhill already has an access control system. (Woodhill, col. 7:44-47.) If Woodhill already has an access control system, there would have been no logical reason to have added another one. Indeed, the fact that Woodhill already had an access control system

would NOT have motivated one of ordinary skill in the art to have added another one to Woodhill as alleged by petitioner. (Dewar Decl. at ¶ 46 [Ex. 2012].)

Woodhill also describes a “self-audit” procedure at col. 18:10-38. There also would have been no logical reason to have modified that procedure. Woodhill’s auditing procedure is for performing “self-audits” of the system. (Woodhill at col. 18:10-12.) Given that the system already has the binary object, as a matter of common sense there would have been no logical reason in a “self” auditing system to have checked whether the system is authorized to access that binary object. (Dewar Decl. at ¶ 47 [Ex. 2012].) Moreover, there are no potential unauthorized users involved in Woodhill’s self-audit procedure. Still further, there is no “request” in the self-auditing procedure that includes a binary object identifier 74 or a contents identifier – so claims 1 and 7 would not be met in any event. *Id.*

VII. FRANCISCO AND WOODHILL BOTH TEACH AWAY FROM CLAIM 23

“A prior art reference may be considered to *teach away* when ‘a person of ordinary skill, upon reading the reference, . . . *would be led in a direction divergent from the path that was taken by the applicant*’.” *Monarch Knitting Mach. V. Sulzer Morat*, 139 F.3d 877, 885 (Fed. Cir. 1998) (citation omitted) (emphasis added). Here, Francisco and Woodhill both would have led one of ordinary skill in the art away from the path taken by the inventors in the challenged claims. While both Woodhill and Francisco have content-based identifiers and both have access

control systems, neither Woodhill nor Francisco compares their content-based identifiers to anything for determining whether access is authorized. (Dewar Decl. at ¶ 48 [Ex. 2012].) And neither Woodhill nor Francisco uses a list of content-based names for determining whether unauthorized or unlicensed copies of files exist on a particular computer. *Id.*

Francisco's identification indicia 12 and 34 are content-based. (Francisco at Fig. 2; col. 2:29-42; and col. 3:49 to col. 4:17.) Francisco's *authentication* check at comparator 36 compares a program identifier (electronic identification indicia) 34 from generator 32 with a single program identifier 12. (Francisco at Fig. 2; col. 1:40-42; col. 2:65 to col. 3:20; and col. 4:12-28; and Dewar Decl. at ¶ 49 [Ex. 2012].) Comparator 36 merely performs an authentication check to make sure that the requested program has not changed – this is not a determination of whether a particular user is authorized to access the program. (Dewar Decl. at ¶ 49 [Ex. 2012].) If there is a match between 12 and 34 in comparator 36, then the requested program has not changed and it is only then that Francisco moves on to comparator 40 for determining whether the requesting user is authorized to access the program. (Francisco at Fig. 2; col. 3:17-36; and col. 4:30-51.) Francisco clearly explains that the *authorization* check is performed “subsequent” to the *authentication* check. (Francisco at Fig. 2; and col. 1:40-42; and Dewar Decl. at ¶ 49 [Ex. 2012].) In making the authorization check at comparator 40, Francisco compares an identification indicia of the requesting user with a user profile 42. (Francisco at

Fig. 2; col. 3:20-36; col. 4:30-33; and col. 4:40-51.) Comparator 40 compares these two user indicia with each other in order to determine whether the requesting user is authorized to access the program. *Id.* See also Francisco at col. 4:48-51. Importantly, Francisco's comparator 40 does *not* compare program identifier 34 (or 12) with anything in making the authorization check. (Dewar Decl. at ¶ 49 [Ex. 2012].) There is no list of alleged content-based names used in Francisco's authorization check at comparator 40 – directly contrary to claim 23. (Dewar Decl. at ¶ 49 [Ex. 2012].)

Woodhill's binary object identifiers 74 are also content based. (Woodhill at col. 8:22-31.) But Woodhill does not use the binary object identifiers 74 in its access control system. (Dewar Decl. at ¶ 50 [Ex. 2012].) During the backup procedure, Woodhill separates each file being backed up into multiple data streams. (Woodhill, col. 7:41-43.) "These data streams may represent regular data, extended attribute data, *access control list data*, etc." (Woodhill, col. 7:44-47.) Petitioner acknowledges that this "access control list data" relates to authorization checking in Woodhill. Referring to Fig. 5A of Woodhill, it can be seen that this "access control list data" exists in step 132 *before* binary object identifiers 74 are even calculated in step 138. (Woodhill, Fig. 5A, col. 7:40-67; and Dewar Decl. at ¶ 50 [Ex. 2012].) Indeed, binary objects in Woodhill include such extended attribute data and access control list data, and Woodhill creates binary object identifiers 74 in part by hashing such extended attribute data and

access control list data. (Woodhill, col. 7:41-67 and Fig. 5A.) Given that Woodhill's "access control list data" exists *prior* to binary object identifiers 74 even being created, Woodhill cannot use the binary object identifiers 74 in its access control system and teaches away from doing so. (Dewar Decl. at ¶ 50 [Ex. 2012].) Again, there is no list of alleged content-based names used in any authorization check in Woodhill. *Id.*

Accordingly, while both Woodhill and Francisco have content-based identifiers and both have access control features, neither Woodhill nor Francisco compares their content-based identifiers to anything for determining whether access is authorized, or for determining whether unauthorized or unlicensed copies of files exist on a particular computer. (Dewar Decl. at ¶ 51 [Ex. 2012].) These references thus teach away from claim 23. *Id.* The "general rule" is that references that teach away "cannot serve to create a prima facie case of obviousness." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (citing *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

**VIII. KSR DEMONSTRATES NONOBVIOUSNESS BECAUSE PRIOR
ART ELEMENTS ARE NOT USED FOR THEIR INTENDED PURPOSE
AND DO NOT SERVE THEIR INTENDED FUNCTION IN THE ALLEGED
COMBINATION REGARDING CLAIM 23**

As explained by the Federal Circuit:

Although predictability is a touchstone of obviousness, the "predictable result" discussed in KSR refers not only to the expectation that prior art elements are capable of being physically combined, but *also that the combination would have worked for its*

intended purpose. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 127 S.Ct. 1727, 1739–40, 167 L.Ed.2d 705 (2007). As the Supreme Court explained, “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 1739 (emphasis added). The Supreme Court went on to state that “when a patent ‘simply arranges *old elements with each performing the same function it had been known to perform*’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 1740 (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532, 47 L.Ed.2d 784 (1976)) (emphasis added).

Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 567 F.3d 1314, 1326 (Fed. Cir. 2009) (emphasis added).

Woodhill’s binary object identifiers 74 and “contents identifiers”, and Francisco’s identifiers 12 and 34, are NOT used for comparisons to determine whether access is authorized. (Dewar Decl. at ¶ 52 [Ex. 2012].) And, unlike claim 23, there is no list of such content-based identifiers in either Woodhill or Francisco that is used to determine whether unauthorized or unlicensed copies of files exist on a particular computer. *Id.* Thus, any modification to meet the challenged claims would result in these identifiers NOT performing the same functions that they are known to perform in Woodhill and Francisco. *Id.* This is strong evidence of nonobviousness. *Id.* While both Woodhill and Francisco disclose and utilize content-based identifiers for various purposes, neither compares such identifiers to determine whether access to a file is authorized. And neither uses a list of such

content-based identifiers to determine whether unauthorized or unlicensed copies of files exist on a particular computer. *Id.* The inventors of claim 23, contrary to the cited art, conceived of a new and nonobvious use for substantially unique content-based identifiers which is not disclosed or suggested in the relied upon art.

As explained above, the Supreme Court in *KSR* and the Federal Circuit in *Depuy* explained 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. Here, we have the opposite. Any alleged modification to Woodhill to allegedly meet the challenged claims cannot use Woodhill's or Francisco's identifiers for their intended purpose, or to perform the same function they are known to perform, thereby indicating nonobviousness.

As petitioner's expert testified:

“it seems like to me *the purpose of binary object identifiers* is to determine uniquely what this particular binary object is and whether two of them are equivalent for whatever reason. So in that case, you're comparing one binary object identifier to another binary object identifier.”

(Mercer Dep. 129 [Ex. 2015]) (emphasis added). This is indeed the purpose of the binary object identifiers 74 in Woodhill and of the program identifiers in Francisco. This is their intended purpose – which has nothing to do with using a list of content-based identifiers to determine whether unauthorized or unlicensed copies of files exist on a particular computer. The invention of claim 23 uses

content-based identifiers for a purpose very different than their known intended purpose, thereby evidencing the patentable nature of the claimed invention.

IX. GRANULES CORRESPONDING TO “CONTENTS IDENTIFIERS” IN THE ALLEGED REQUEST IN WOODHILL ARE NEVER PROVIDED TO THE REQUESTING COMPUTER IN RESPONSE TO THE REQUEST (CLAIMS 1 AND 7)

Claims 1 and 7 each require a “request” for a data file, which request includes the name of that particular data file. Claims 1 and 7 further require that, in response to the request, a copy of the requested file is provided from a given one of the computers and (a) only to licensed parties (claim 1), or (b) is not provided to unlicensed or unauthorized parties (claim 7). This subject matter cannot possibly be met if it is alleged that “files” are granules and “names” are “contents identifiers” with respect to Woodhill’s granularization restore procedure (regardless of whether it is modified). (Dewar Decl. at ¶¶ 53-56 [Ex. 2012].)

Both parties agree that in the alleged Woodhill combination, with Francisco or Kahn, granules corresponding to “contents identifiers” in the alleged request (“update request”) are NEVER provided from the remote backup server 12 to the requesting computer in response to the “update request.” (Woodhill at col. 17:18-67; Mercer Dep. 136-137 [Ex. 2015]; and Dewar Decl. at ¶ 54 [Ex. 2012].) Thus, Woodhill/Francisco and Woodhill/Kahn cannot meet claims 1 and 7 if the claimed data files are alleged to be are granules and the names are alleged to be “contents identifiers.” Moreover, no name of the large database file at issue is included in

the “update request,” so that the claimed data file in claims 1 and 7 cannot be considered to be the large database file. (Dewar Decl. at ¶¶ 53-55 [Ex. 2012].)

In Woodhill, and in any modification of Woodhill/Francisco or Woodhill/Kahn, granules corresponding to “contents identifiers” in the alleged request (“update request”) are NEVER provided to the requesting computer in response to the update request. (Woodhill at Fig. 5I and col. 17:18-67; and Dewar Decl. at ¶¶ 54-55 [Ex. 2012].) In the relied upon restore procedure, no granule having an identifier in the “update request” is ever provided to the requesting local computer 20 (alleged licensed party). (*Id.*; and Mercer Dep. 136-137 [Ex. 2015].) The “contents identifiers” in the alleged “request” were calculated in step 444 and thus are NOT for granules that are being requested – the requesting local computer 20 already has the granules corresponding to the “contents identifiers” calculated in step 444 and therefore they are never provided to the local computer even in the allegedly modified system. (Mercer Dep. 136-137 [Ex. 2015]; and Dewar Decl. at ¶ 55 [Ex. 2012].) And because granules identified in the request are never sent from remote server 12 to the local computer in the restore procedure (the local computer already has them), it would be non-sensical and contrary to logic to use identifiers for such granules to determine whether the system is authorized to provide such granules to the local computer. (Dewar Decl. at ¶ 55 [Ex. 2012].) Thus, in addition to all other reasons set forth above, such combinations (which PO

disagrees with in any event, and which petitioner does not even allege) fail to meet claims 1 and 7.

Turning to the “contents identifiers” for the reconstituted granules in Woodhill, the “contents identifiers” for the granules reconstituted at col. 17:48-50 are only used for comparison in box 450 of Fig. 5i *after* the Fig. 5h reconstitution of those granules, and are *never* included in any “request” regarding a data item. (Dewar Decl. at ¶ 56 [Ex. 2012].) And petitioner does not allege that it would have been obvious to have modified Woodhill to provide such contents identifiers in any “request.”

Accordingly, claims 1 and 7 cannot be met if it is alleged that “files” are granules and “names” are “contents identifiers” with respect to Woodhill’s granularization restore procedure (regardless of whether it is modified by Francisco or Kahn). And claims 1 and 7 also cannot be met if it is alleged that the claimed data file is the large database file at issue in Woodhill’s granularization procedure, because the “update request” does not contain a name for that file.

**X. BINARY OBJECTS CORRESPONDING TO RECORDS 58
ALLEGEDLY IN THE “REQUEST” ARE NOT PROVIDED TO THE
REQUESTING COMPUTER IN RESPONSE TO THE REQUEST (CLAIMS
1 AND 7)**

Both parties agree that in the alleged Woodhill/Francisco and Woodhill/Kahn combinations binary objects corresponding to the binary object identification records 58 allegedly in the request (“update request”) are NOT provided to the requesting computer in response to the update request. (Woodhill

at col. 17:18 to col. 18:9.) The granularization restore procedure in Woodhill as allegedly modified by Francisco or Kahn transmits select granules – not binary objects. (Mercer Dep. 56, 137, 163-164 [Ex. 2015]; and Dewar Decl. at ¶¶ 57-60 [Ex. 2012].) And record 58 and binary object identifier 74 do not identify particular granules. *Id.* Thus, Woodhill/Francisco and Woodhill/Kahn cannot meet claims 1 and 7 if, as alleged by petitioner, the claimed data items are binary objects and the identifiers are considered binary object identifiers 74 or binary object identification records 58. *Id.*

As explained above, claims 1 and 7 each require a “request” for a data file, which request includes the name of that particular data file. Claims 1 and 7 further require that, in response to the request, a copy of the requested file is provided from a given one of the computers and (a) only to licensed parties (claim 1), or (b) is not provided to unlicensed or unauthorized parties (claim 7). This subject matter cannot be met if the claimed files are considered to be Woodhill's binary objects and the identifiers to be Woodhill's binary object identifiers 74 or records 58 as alleged by petitioner, because the binary objects corresponding to the identifier allegedly in the “request” are not disclosed as being transmitted to the local computer 20 in response to the request in Woodhill's granularization restore procedure. (Dewar Decl. at ¶¶ 58-60 [Ex. 2012].)

In Woodhill, and in any modification of Woodhill, binary objects corresponding to binary object identification records 58 allegedly in the request

(“update request”) are NOT provided to the requesting computer in response to the request. (Woodhill at Fig. 5I and col. 17:18-67; and Dewar Decl. at ¶ 59 [Ex. 2012].) Woodhill never discloses such an occurrence, and instead indicates to the contrary. *Id.* The restore procedure transmits only particular granules based on whether they have changed – NOT binary objects. *Id.* As explained by petitioner's expert:

Q. Woodhill's granularization restore procedure transmits granules; is that a fair statement?

A. Well, yes, the objective is to transmit granules rather than to transmit binary objects.

(Mercer Dep. 56 [Ex. 2015].) Petitioner's expert went on to explain that the granularization restore procedure in Woodhill is different than the self-audit procedure in that the different procedures transmit different items, use different comparisons, and so forth. (Mercer Dep. 55-56 [Ex. 2015].) The two procedures cannot be combined, and petitioner does not allege that they can be combined. (Dewar Decl. at ¶ 59 [Ex. 2012].)

Thus, in the granularization process upon which petitioner relies, Woodhill is not designed to provide, and *never* provides, any binary object to the local computer 20 in response to the “update request.” (Dewar Decl. at ¶¶ 57-60 [Ex. 2012].) No binary object sequence of bits is ever sent from the backup file server 12 to a local computer 20 in the restore procedure of Woodhill's granularization feature (regardless of whether modified by Francisco/Kahn). *Id.* In Woodhill's

granularization process, the backup file server 12 sporadically sends only select “granules” of a large database file to the local computer. (*Id.*; and Woodhill, col. 17:60-65.) Binary object identifiers 74 and records 58 do not identify granules, and certainly are not names for granules. Woodhill’s granularization embodiment does *not* send large database files or binary objects from server 12 to the local computer – just select granules. *Id.*

XI. BINARY OBJECTS AND GRANULES ARE NOT “DATA FILES” AS REQUIRED BY THE CHALLENGED CLAIMS.

The binary objects and granules in Woodhill are not “files” or “data files” for the reasons explained above in the claim construction section. Accordingly, the challenged claims cannot be met by the cited art for this reason as well. (Dewar Decl. at ¶¶ 22-27, 61-67 [Ex. 2012].)

Petitioner relies on a “granule” or “binary object” from Woodhill as the alleged “data file” with respect to all challenged claims. Because these are not data files as explained above in the claim construction section, petitioner’s allegations regarding all challenged claims are fundamentally flawed and necessarily fail. *Id.*

Claim 1 for example states as follows, *inter alia*:

“obtaining a *name for a data file*, the name being based at least in part on a given function of the data, wherein *the data used by the given function to determine the name comprises the contents of the data file*; and in response to a request for the [a] data file, the request including at least the name of the particular file, causing a copy of the file to be provided from a given one of the plurality of computers . . .” (emphasis added)

There is no “request” for a “data file” in Woodhill’s granularization restore procedure relied upon by petitioner. (Dewar Decl. at ¶ 63 [Ex. 2012].) Neither a binary object nor a granule is a “data file.” Woodhill’s “update request,” relied upon by petitioner, does not contain name for a requested “data file” as required by claims 1 and 7.

Woodhill’s granularization embodiment relates to *large* database files each of which contains *many* binary objects and *many* granules (Woodhill, col. 14:52-67; col. 15:11-17; col. 17:18-22; col. 17:31-35; Mercer Dep. 134-135 [Ex. 2015]; and Dewar Decl. at ¶ 64 [Ex. 2012].) Petitioner relies upon the “update request” described by Woodhill at col. 17:42. However, that “update request” does not request a large database file (the only type of file handled by Woodhill’s granularization embodiment) or any other “data file,” and does not contain any name for a large database file. (Dewar Decl. at ¶¶ 64 [Ex. 2012].) An alleged request for a binary object is not the same as a request for a large database file. *Id.* Accordingly, there is not even a “request” for a “data file” in Woodhill’s granularization restore procedure, and there is no such request that includes a name for a requested “data file.” *Id.* Woodhill’s granularization restore at column 17 sends particular granules (not binary objects, and not an entire large database file) to a local computer. (*Id.*; and Woodhill, col. 17:50-64.) Indeed, a purpose of Woodhill’s granularization embodiment is to avoid transmitting an entire large

database file, which teaches directly away from petitioner's allegations regarding claims 1 and 7. *Id.* Accordingly, even the alleged combinations fail to meet claims 1 and 7.

Furthermore, while Woodhill mentions Binary Object Identification Record 58 at col. 17:44, Woodhill indicates that portions (62 and 72) of the Record 58 other than the binary object identifier 74 are used to identify a given binary object in a message. (Woodhill, col. 11:65 to col. 12:5; and Dewar Decl. at ¶ 65 [Ex. 2012].) Woodhill indicates in this respect that binary object identifiers 74 are *not* used in any alleged “request” for a binary object. (Woodhill, col. 11:65 to col. 12:5; and Dewar Decl. at ¶ 65 [Ex. 2012].) Woodhill indicates that binary object identifiers 74 are certainly *not* used for accessing binary objects. *Id.*

Petitioner briefly mentions Woodhill's “self-audit” embodiment described at col. 18:10-38. (Ex. 1010, pg. 32.) However, Woodhill's self-audit embodiment also fails to disclose or suggest the subject matter of claims 1 and 7, regardless of whether modified by Francisco or Kahn. (Woodhill, col. 18:10-38.) There is no “request” in Woodhill's self-audit procedure that includes a binary object identifier 74 (let alone a name for a “data file”), and petitioner does not contend that it would have been obvious to have modified Woodhill in this respect. (Dewar Decl. at ¶ 66 [Ex. 2012].) Woodhill explains in the description of the self-auditing procedure that the Record 58 is “stored in File Database 25.” (Woodhill, col. 18:16-19.) While Woodhill states that the Record 58 is “stored in File Database 25”, the

Record 58 is never described as part of a “request” for the binary object. (Woodhill, col. 18:16-19; and Dewar Decl. at ¶ 66 [Ex. 2012].) Moreover, Woodhill elsewhere indicates that, in a message, portions of the Record 58 other than the binary object identifier 74 are used to identify a binary object. (Woodhill, col. 11:65 to col. 12:5; and Dewar Decl. at ¶ 66 [Ex. 2012].) Accordingly, in Woodhill’s self-auditing procedure there is no description of a “request” for a binary object or anything else that includes a binary object identifier 74. *Id.* To the contrary, Woodhill indicates that any such “request” would NOT include a binary object identifier 74. (*E.g.*, Woodhill, col. 11:65 to col. 12:5; and Dewar Decl. at ¶ 66 [Ex. 2012].) Additionally, there is no request for a “data file” in Woodhill’s self-audit procedure as explained above. (Dewar Decl. at ¶¶ 66 [Ex. 2012].) Woodhill restores a randomly selected binary object – not a “data file.” (Woodhill, col. 18:25.) A binary object is not a “data file.” (Dewar Decl. at ¶ 66 [Ex. 2012].) And neither a binary object identifier 74 nor a binary object identification record 58 is a “name” for a data file. *Id.* Moreover, because Woodhill’s “self-audit” embodiment is an automatic procedure performed by the system on a periodic basis to check itself, it is entirely unrelated to the final lines of claims 1 and 7 (*e.g.*, “a copy of the requested file is only provided to licensed parties”). *Id.* Since Woodhill’s “self-audit” embodiment is an automatic procedure for checking itself, there would have been no logical reason to have implemented an authorization checking system in Woodhill’s “self-audit” procedure. *Id.* And

petitioner does not contend that it would have been obvious to have modified Woodhill's self-audit embodiment in any of the above-respects.

Furthermore, it would be legal error to switch back and forth between Woodhill's granularization embodiment, and Woodhill's "self-audit" embodiment. These are different embodiments that functional separately on different bases. (Dewar Decl. at ¶ 67 [Ex. 2012].) It is well established that in order to meet a claim a reference must not only disclose the elements of the claim, but must also disclose those elements "arranged or combined in the same way as in the claim." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369-71 (Fed. Cir. 2008). One cannot do this by switching back and forth between different elements in a reference to meet a given element of a claim. *Id.* at 1371.

**XII. BINARY OBJECTS AND GRANULES CANNOT REPRESENT A
"DIGITAL IMAGE" AS REQUIRED BY CLAIM 7**

Claim 7 requires a "request" for a data file, which request includes the name of that particular data file. Claim 7 further requires that, in response to the request, a copy of the requested file is provided from a given one of the computers. Petitioner relies on the "update request" in Woodhill's granularization restore procedure for the alleged "request," and contends that the granules represent "data files" and that the "contents identifiers" represent names for those alleged "files." (Ex. 1010 at 32-33 and 54.)

However, claim 7 expressly recites "the contents of said data file representing a digital image." This cannot occur with a granule (or a binary

object) in Woodhill, because a granule in Woodhill is only a small portion of a large database file and cannot itself represent a digital image. (Dewar Decl. at ¶¶ 68-72 [Ex. 2012].)

Woodhill's granularization restore procedure which petitioner seeks to modify is used for processing *large database files* each of which includes many binary objects and many granules. ('442 patent at col. 14:52-65, col. 17:18-35; and Mercer Dep. 134-135 [Ex. 2015].) In 1995, one of ordinary skill in the art would have expected a "large database file" of the type handled by Woodhill's granularization procedure to be at least 1 to 2 gigabytes in size. (Mercer Dep. 123, 134-135 [Ex. 2015]; and Dewar Decl. at ¶ 70 [Ex. 2012].) Woodhill explains that a binary object is 1 megabyte in size, and that a granule can be 1 kilobyte. (Woodhill, col. 7:54-55, col. 14:58-67.) Given such sizes, a single 1 gigabyte large database file to be processed by Woodhill's granularization restore procedure would include at least 1,024 binary objects and 1,048,576 granules. (Dewar Decl. at ¶ 70 [Ex. 2012].) Thus, each granule is a small portion of a binary object, and each binary object is a small portion of the large database file. *Id.* While a large database file in Woodhill could possibly itself represent a "digital image," a small segment thereof such as a granule or binary object could not. *Id.* Each granule and binary object could possibly represent a small portion of the data of an overall digital image, but could not itself represent a digital image as required by claim 7. *Id.* Accordingly, a granule or binary object in Woodhill cannot be the type of

“file” (a “file” that represents a digital image) called for in claim 7. Accordingly, even the alleged modification to Woodhill’s granularization restore procedure fails to meet claim 7 because a granule or binary object cannot represent a “digital image” as called for in claim 7.

Additionally, any alleged modification to Woodhill’s self-audit procedure also cannot meet claim 7 in this respect, because again a binary object (a portion of an overall file in Woodhill) cannot itself represent a “digital image.” (Dewar Decl. at ¶ 71 [Ex. 2012].) Moreover, there is also no “request” for a data file in Woodhill’s self-audit procedure that includes a binary object identifier 74 of a particular binary object. *Id.* And, as explained above, there are no unlicensed or unauthorized parties involved in Woodhill’s “self” audit procedure, so the claim also cannot be met in this respect and there would have been no logical reason to have provided an authorization check in a “self” audit procedure. *Id.*

Furthermore, no “name” of the large database file is included in Woodhill’s “update request.” (Dewar Decl. at ¶ 72 [Ex. 2012].) Therefore, the claimed data file called for in claim 7 cannot be considered the large database file in Woodhill/Kahn because no name therefor is provided in any alleged “request for the data file” as required by claim 7. *Id.*

XIII. THE ALLEGED IDENTIFIER IN THE ALLEGED COMBINATIONS IS NOT A “FILE NAME” AND IS NOT USED FOR ACCESSING

As explained above in the claim construction section, one of ordinary skill in the art would have recognized that a “file name” and “name for a data file” are

used to both (a) identify a particular data item so that the name can be used to differentiate the data item from other data items, and (b) refer to that data item, access that data item, search for that data item, and address that data item so that a user can use the name to selectively retrieve, change, delete, save or send the item to an output device. (E.g., '442 patent, col. 16:13-16; col. 17:15-50; col. 19:1-27; col. 23:61-67; col. 24:56-67; col. 34:35-49; and Ex. 2011.)

The alleged identifiers in the Woodhill/Francisco and Woodhill/Kahn combinations are NOT “file names” or “names for data files.” (Dewar Decl. at ¶¶ 73-80 [Ex. 2012].) Woodhill’s binary object identifiers 74 are not “names” for binary objects, and Woodhill’s contents identifiers are not “names” for granules. (Mercer Dep. 119, 121-123 [Ex. 2015]; and Dewar Decl. at ¶ 74 [Ex. 2012].) And Francisco’s program identifiers are also not “names” for data files. (Dewar Decl. at ¶ 74 [Ex. 2012].) Because these are not “file names” or “names for data files,” even the alleged modification fails to meet at least claims 1, 11, 24 and 32.

Woodhill uses “names” for files (see name 40 in Fig. 3 of Woodhill), but does *not* provide names for binary objects or granules. (Dewar Decl. at ¶ 75 [Ex. 2012].)

Woodhill merely employs a hash to compare same file components to determine whether there has been a change – Woodhill does not use a hash as a file name, or as a substitute for a name, in a computer network. *Id.* Indeed, Woodhill’s granularization process upon which petitioner relies relates to a large database file that has many binary objects and many granules – these granules and binary

objects of such a large database file are not provided with file names in Woodhill's granularization process and there would have been no logical reason to have done so. *Id.*

Something is not a "file name" simply because it is an "identifier." (Mercer Dep. 120 [Ex. 2015]; and Dewar Decl. at ¶ 76 [Ex. 2012].) For example, while a fingerprint is an identifier for a person, it is not a "name" for that person. One of ordinary skill in the art at the time of the invention would have understood that there is a significant difference between a "file name" and a mere "identifier" as explained above. (Dewar Decl. at ¶ 76 [Ex. 2012].)

Woodhill's "binary object identifiers 74" are not used to access binary objects, search for binary objects, or address binary objects. (Dewar Decl. at ¶ 77 [Ex. 2012].) Binary object identifiers 74 are not even mentioned in columns 16-17 of Woodhill. When a Binary Object Identification Record 58 is provided such as at col. 17:44, and a binary object is accessed, Woodhill expressly explains how this is done and it does NOT involve any binary object identifier 74. (Woodhill at col. 11:65 to col. 12:7, and col. 9:18-20; Mercer Dep. 152-155 [Ex. 2015]; and Dewar Decl. at ¶ 77 [Ex. 2012].) Thus, Woodhill itself describes that fields 62 and 72 of Binary Object Identification Record 58 are used to access binary objects (i.e., the field for binary object identifier 74 is NOT used). (Mercer Dep. 153-154 [Ex. 2015].) Thus, binary object identifiers 74 are not compared to anything or otherwise used in any respect when accessing, searching for, or addressing binary

objects in the allegedly modified system. (Dewar Decl. at ¶ 77 [Ex. 2012].) They are not “file names.”

Likewise, Woodhill's “contents identifiers” are not used to access granules, search for granules, or address granules. (Dewar Decl. at ¶ 78 [Ex. 2012].) For instance, in Woodhill's procedure for reconstituting a binary object on a granule-by-granule basis, “contents identifiers” are not used or even mentioned. (Woodhill at Fig. 5H and col. 16:16 to col. 17:17.) This same procedure is used in the restore procedure. (Woodhill at col. 17:46-50.)

Thus, the “file name” or “name for a data file” aspect of the challenged claims is not disclosed by Woodhill as allegedly modified by Francisco or Kahn. And petitioner does not contend that it would have been obvious to have modified Woodhill in this respect. Even the alleged combination fails to meet the challenged claims.

Moreover, while Woodhill mentions names in its claims (*e.g.*, Woodhill at col. 22:3-9; col. 22:35-50; col. 22:67 to col. 23:2; col. 23:10-19; and col. 24:24-39), this is not “prior art” to the challenged claims. (Dewar Decl. at ¶ 80 [Ex. 2012].) The “name” language in Woodhill's issued claims is not “prior art” to the challenged claims. The subject matter added to Woodhill on January 5, 1996 (including the “name” language in Woodhill's claims) was added after the April 11, 1995 effective filing date of the '442 patent, was not in Woodhill's originally-filed specification, and is not “prior art” to the challenged claims of the '442 patent

(see prosecution history of Woodhill at Ex. 2007). Petitioner's expert admits that he has no opinion on whether Woodhill describes binary object identifiers as names other than in Woodhill's claims which were added after the critical date. (Mercer Dep. 123 [Ex. 2015].) Woodhill's binary object identifiers and "contents identifiers" are not names for binary objects or granules. (Dewar Decl. at ¶ 80 [Ex. 2012].) Binary objects and granules in Woodhill are not files and thus do not have file names. One of ordinary skill in the art reviewing Woodhill's specification as originally filed would have understood that binary object identifiers 74 were not "names" for binary objects, and that "contents identifiers" were not "names" for granules. (Dewar Decl. at ¶ 80 [Ex. 2012].) Many identifiers are not names. *Id.* For example, while a fingerprint is an identifier for a person, it is not a "name" for that person. Petitioner has not met its burden of establishing that binary object identifiers 74 and contents identifiers in Woodhill are "names." Subject matter added to Woodhill after the effective filing date of the challenged claims is not "prior art" and cannot be used against the challenged claims in this proceeding.

XIV. MD4, MD5 AND SHA OF CLAIM 28 WOULD NOT HAVE BEEN OBVIOUS

Claim 28 requires an MD4, MD5 or SHA. Petitioner does not contend that MD4 or SHA would have been obvious to have used in Woodhill or Francisco. However, petitioner does contend that it would have been obvious to have

modified Woodhill/Francisco to use the MD5 hashing algorithm based on Langer. (Ex. 1009 at pgs. 57-61.)

Contrary to petitioner's allegation, it would not have been obvious to have calculated Woodhill's Binary Object Identifier 74 (or "contents identifier") using MD5. (Dewar Decl. at ¶¶ 81-82 [Ex. 2012].) Petitioner's expert admits that there were an "infinite" number of hashes known in the art at the time of the invention. (Mercer Dep. 66-67 [Ex. 2015].) There would have been no logical reason to have selected "MD5", out of the "infinite" number of possible hashes, for use in Woodhill. (Dewar Decl. at ¶ 82 [Ex. 2012].) MD5 is a non-reversible cryptographic hash – Woodhill's alleged hashes in column 8 are not. *Id.* Moreover, MD5 produces a 16 byte hash value, whereas Woodhill desires a 4 byte hash value. (*Id.*; and Woodhill, col. 8:1-3.) Thus, MD5 would not be compatible with Woodhill's system (whereas many other available hashes would have been), and there would have been no logical reason to have selected it from the infinite number of possible other hash functions that were available at the time of the invention. Hindsight is impermissible. (Dewar Decl. at ¶ 82 [Ex. 2012].)

XV. LANGER IS NOT A "PRINTED PUBLICATION"

There is no evidence establishing that Langer (Ex. 1007) is a prior art "printed publication." Petitioner has not met its burden of establishing this. 37 C.F.R. §42.1(d).

Because Langer has not been established as a prior art “printed publication”, all grounds involving Langer (*e.g.*, see claim 28) necessarily fail. *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1195-98 (Fed. Cir. 2008) (finding that a paper posted on an open FTP site was not a “printed publication”, *e.g.*, due to insufficient evidence of public accessibility via a customary search and insufficient evidence of cataloguing or indexing in a meaningful way); and *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 865-66 (Fed. Cir. 2010) (finding that a user manual was not a “printed publication”).

An *inter partes* review may only be requested on the basis of prior art consisting of patents or printed publications. 35 U.S.C. § 311(b). Thus, the statute itself precludes institution based on a document which has not been established as a patent or printed publication. Langer certainly is not a patent. And it has also not been established as a prior art “printed publication.”

“Public accessibility” is a touchstone of determining whether a reference constitutes a “printed publication.” *SRI Int’l*, 511 F.3d at 1194. “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Id.* Factors considered in the “printed publication” inquiry include whether the document was catalogued or indexed in a meaningful way, and whether a customary search prior to the critical date would have turned

up the document. *Id.* at 1195-98. In *SRI Int'l*, for example, the Federal Circuit explained that a paper posted on an open FTP site was not a “printed publication” because it was not catalogued or indexed in a meaningful way and there was no evidence that a customary search would have uncovered it prior to the critical date. *Id.*

There is no credible evidence that Langer was catalogued or indexed in a meaningful way prior to the critical date, or that it would have turned up in a customary search prior to the critical date, or that persons interested and ordinarily skilled in the art exercising reasonable diligence would have located it prior to the critical date. There is no evidence of any search engines, server accessibility, or search techniques for searching by subject matter that were even in existence prior to April 11, 1995 or which could have been used to access Langer prior to the critical date. There is no declaration from any alleged author of Langer stating when Langer was created, or to whom it was ever sent. No witness ever saw Langer prior to the critical date.

The Langer document used in this IPR was printed off the Internet in 2013. (Reddy Dep. 16-18 [Ex.2019]; and Ex. 1007.) Moreover, when Langer was printed off the Internet in 2013, it was obtained from the Google Groups site which did not even come into existence until the early 2000s (well after the critical date). (Reddy Dep. 18 [Ex.2019].) The first time petitioner's witness saw Langer was

2013, and has no personal knowledge of Langer prior to that. (Reddy Dep. 18-20, 32-33 [Ex.2019].)

The earliest known version of Langer was allegedly printed off the Internet in 2003 based on the “7/29/2003” date in the lower-right corner of a Langer document in the IPR filed by EMC. (Ex. 2008 [Reddy Dep. Ex. 1]; and Reddy Dep. 20-23 [Ex. 2019].) However, there is no evidence of Langer having been in existence or being publicly accessible prior to the April 11, 1995 effective filing date of the patent. There is no evidence of anyone seeing or receiving Langer prior to its apparent printing on July 29, 2003 from “groups.google.com . . .” The July 29, 2003 date is well after the critical date. Whether a document could have been accessed and printed some seven or more years after the critical date is of no moment. The fact that Langer (Ex. 2008) was inexplicably missing the Usenet “path” header (required by the standard) in the EMC IPR raises further suspicions about the document, especially where the path header mysteriously showed up somehow between 2003 and 2013 as evidenced by its existence on Ex. 1007 which was printed off the Internet in 2013. (Reddy Dep. 21, 24-29 [Ex. 2019]) If a Usenet document lacks a path header (the earliest known version of Langer from 2003 lacks a path header; Ex. 2008), this indicates that the document was never sent. (Reddy Dep. 27, 29 [Ex. 2019].) Moreover, even if Langer was provided to “alt.sources.d” or “comp.archives” (there is no evidence that it was), this does not mean it qualifies as a “printed publication” for the reasons described by the

Federal Circuit. In *SRI Int'l*, the court explained that a document posted on an open site was not a “printed publication” because it was not catalogued or indexed in a meaningful way and there was no evidence that a customary search would have uncovered it prior to the critical date. *SRI Int'l*, 511 F.3d at 1195-98.

For at least the foregoing reasons, petitioner has not met its burden of establishing that Langer is a printed publication.

XVI. SECONDARY CONSIDERATIONS

The fact that others have licensed the patent is evidence of the validity of the patent, and should be considered as evidence of nonobviousness rebutting any alleged *prima facie* case obviousness. *Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.*, 699 F.3d 1340 (Fed. Cir. 2012). This is especially the case where the patent license was not for settling any patent litigation, and the licensee paid amounts that exceed any reasonable litigation cost. *Id.* at 1353. This occurred here. Exhibits 2016, 2017 and 2018 are licenses where the patent was licensed, and these licenses were not for the purpose of settling any patent litigation. (Ex. 2013, ¶¶ 3-9.) The licensees paid amounts that exceed any reasonable litigation cost. *Id.* at ¶ 6. These licenses are for the ‘791 patent and any continuations thereof, which includes the patent at issue in this IPR. Accordingly, this represents evidence of nonobviousness that further rebuts the obviousness allegations of petitioner.

XVII. CONCLUSION

For the foregoing reasons, the Board should confirm patentability of the challenged claims.

Respectfully submitted,

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Brief Description
2001	Claim construction Order by the U.S. District Court for the District of Massachusetts.
2002	Claim Construction Order in Related Litigations (Aug. 5, 2013)
2003	Altnet's Opening Claim Construction Brief, in case styled <i>Altnet Inc. v. Streamcast Networks, Inc.</i> , CV-06-5086, dated March 29, 2007.
2004	CWIS' Opening Markman Brief, CV-02-11430, dated July 25, 2003.
2005	Patent Owner's Opening Claim Construction Brief in litigation, dated June 5, 2013.
2006	Patent Owner's Reply Claim Construction Brief in litigation, dated July 8, 2013.
2007	Excerpts from file history of U.S. 5,649,196 to Woodhill.
2008	Langer document submitted by EMC (Reddy Dep. Ex. 1).
2009	Decision regarding institution in IPR 2013-00082, dated May 17, 2013
2010	U.S. Patent No. 5,978,791 to Farber et al.
2011	Microsoft Press Computer Dictionary, Second Edition (1994)
2012	Declaration of Robert Dewar
2013	Declaration of Kevin Bermeister
2014	Claim Construction Order in related litigations (March 21, 2014)
2015	Deposition Transcript of Melvin R. Mercer
2016	Skype License Agreement
2017	Brilliant Digital/Altnet License Agreement
2018	Sharman License Agreement

2019	Deposition Transcript of Narashimha Reddy
2020	The American Heritage Dictionary of the English Language (1975).

CERTIFICATE OF SERVICE

I hereby certify service of the foregoing Response of Patent Owner, and exhibits, to the following lead counsel for petitioner on July 16, 2014 via email (pursuant to agreement between the parties):

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