

**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. and Rackspace Hosting, Inc.

Inventors: David A. Farber and Ronald D. Lachman

For: ENFORCEMENT AND POLICING OF LICENSE CONTENT USING
CONTENT-BASED IDENTIFIERS

* * * * *

January 18, 2014

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

	<u>Page</u>
I. BACKGROUND.....	1
II. ALLEGED GROUNDS.....	1
III. CLAIM CONSTRUCTIONS.....	2
IV. MOST REFERENCES RELIED UPON BY PETITIONER, INCLUDING ALL REFERENCES FOR GROUND 2, WERE PREVIOUSLY CITED DURING THE REEXAMINATION AND/OR ORIGINAL PROSECUTION OF THE '442 PATENT.....	3
V. GROUND 1 BASED ON WOODHILL SHOULD NOT BE INSTITUTED	4
VI. GROUND 2 BASED ON WOODHILL SHOULD NOT BE INSTITUTED	17
VII. LANGER IS NOT A "PRINTED PUBLICATION" – GROUND 3 SHOULD NOT BE INSTITUTED.....	18
VIII. CONCLUSION.....	21
PATENT OWNER'S EXHIBIT LIST	
CERTIFICATE OF SERVICE	

I. BACKGROUND

Pursuant to 37 C.F.R. § 42.107, Patent Owner PersonalWeb (PO) submits this Preliminary Response to the petition seeking *inter partes* review in this matter. U.S. Patent No. 6,928,442 (“the ‘442 patent”) has an effective filing date of April 11, 1995 given its continuity. (Ex. 1001.) While PO reserves the right to establish an earlier date of invention, PO assumes an effective filing date of April 11, 1995 for purposes of this Preliminary Response (i.e., the “critical date” is no later than April 11, 1995 for purposes of this submission).

The ‘442 patent has already been through an *ex parte* reexamination. Woodhill, Langer, and Kahn (all relied upon by petitioner) were already cited during the reexamination and/or original prosecution of the ‘442 patent and the patentability of the challenged claims was confirmed. The *Ex parte Reexamination Certificate*, confirming the patentability of the claims challenged by petitioner, is provided at the end of Ex. 1001. (Ex. 1001, pgs. 58-62.)

II. ALLEGED GROUNDS

Petitioner has challenged claims of the ‘442 patent based on only, and limited to, the following alleged Grounds:

1. Claims 1, 2, 4, 23, 27 and 30 are allegedly obvious under 35 U.S.C. §103 over Woodhill (Ex. 1004) in view of Francisco (Ex. 1005).

2. Claim 7 is allegedly obvious under 35 U.S.C. §103 over Woodhill (Ex. 1004) in view of Kahn (Ex. 1006).
3. Claim 28 is allegedly obvious under 35 U.S.C. §103 over Woodhill (Ex. 1004) in view of Francisco (Ex. 1005) and Langer (Ex. 1007).

III. CLAIM CONSTRUCTIONS

PO reserves its right to provide constructions for the terms identified by petitioner in its response under Rule 42.120 should this proceeding be instituted as to any applicable claim. However, PO notes the following at this stage.

data file

The PTAB previously construed “data file” as “a *named* data item, such as a simple file that includes a single, fixed sequence of data bytes or a compound file that includes multiple, fixed sequences of data bytes.” (See Decision regarding institution dated May 17, 2013 in IPR 2013-00083 [Ex. 1009].)

The district court in related litigations also construed “data file” as a “*named* data item”, and indicated based on the specification that a mere segment of a multi-segment file is not by itself a data file. (Ex. 2002, pgs. 10-12.)

Any interpretation effectively eliminating “named” would be improper. Moreover, any allegation that a mere segment of a multi-segment file is somehow by itself a “data file” would be improper. There is no support for petitioner’s argument that a mere segment, of a multi-segment file, is a “data file.” To the contrary, the specification and common sense dictate that a mere segment of a

multi-segment file is not a “data file.” (‘442 patent, col. 5:47-52; and Ex. 2002, pgs. 10-12.)

Petitioner's alleged Grounds are fundamentally flawed, as will be explained below, at least because they: (a) ignore the “named” requirement for a “data file”, and (b) improperly suggest that a mere segment of a multi-segment file can somehow by itself be a “data file.”

Preamble of claim 7 is limiting

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.

IV. MOST REFERENCES RELIED UPON BY PETITIONER, INCLUDING ALL REFERENCES FOR GROUND 2, WERE PREVIOUSLY CITED DURING THE REEXAMINATION AND/OR ORIGINAL PROSECUTION OF THE ‘442 PATENT

The ‘442 patent has already been through an *ex parte* reexamination, and most of the art relied upon by petitioner (Woodhill, Langer, and Kahn) was already cited during the reexamination and/or original prosecution of the ‘442 patent and the patentability of the challenged claims was confirmed. (Ex. 1001, pgs. 3, 59; and Ex. 1003, pgs. 1-2, 5, 9-10, 13, 308-309.) Langer was cited during the original prosecution. (Ex. 1001, pg. 3.) And the *Ex parte Reexamination Certificate* confirming the patentability of the claims challenged by petitioner lists Woodhill

and Kahn as cited references. (Ex. 1001, pgs. 58-62; and Ex. 1003, pgs. 1-2, 5, 9-10, 13, 308-309.) The patentability of the challenged claims was properly confirmed during reexamination and is reflected in the *Ex parte Reexamination Certificate*. Petitioner's second-guessing of the Reexamination Certificate, and the original issuance of the challenged claims, lacks merit.

As part of its consideration of whether to institute, the Board may take into account that three (3) of the four (4) references relied upon by petitioner (including all references for Ground 2) were already cited during the reexamination procedure and/or original prosecution, and patentability of the challenged claims was confirmed. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765 (Aug. 14, 2012).

V. GROUND 1 BASED ON WOODHILL SHOULD NOT BE INSTITUTED

The Examiners were correct in allowing the challenged claims over the cited art during the reexamination of the '442 patent.

Claim 1

Claim 1 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)

Woodhill fails to disclose or suggest at least the above-italicized subject matter of claim 1 for numerous reasons.

First, in Woodhill's granularization embodiment upon which petitioner relies, a binary object identifier 74 cannot be a "*name*" for a "data file."

Moreover, Woodhill's granularization embodiment does not even mention a binary object identifier 74.

It cannot reasonably be said that all "identifiers" are "names." For example, while a fingerprint is an identifier for a person, it is not a "name" for that person. Thus, contrary to petitioner's allegation, something is not a "name" simply because it is an "identifier." Petitioner's attempt to replace "name" with "identifier" is clearly wrong and would be both unreasonable and illogical – as many "identifiers" are not "names" (*e.g.*, fingerprint). Woodhill does not use binary object identifiers 74 or contents identifiers as names for data files. Woodhill does use "names" for files (see file name 40 in Fig. 3 of Woodhill, and file name 80 in Fig. 4 of Woodhill), but does *not* provide names for binary objects or granules.¹ The file names 40 and 80 in Woodhill cannot meet the challenged

¹As PO explained in IPR 2013-00082 and IPR 2013-00083, 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

claims because the file names 40 and 80 in Woodhill are unrelated to contents of respective files.

Petitioner relies largely on Woodhill's granularization embodiment. (Pet. 25; Ex. 1010, pgs. 32-34; Woodhill, col. 14:52 to col. 18:9.) However, Woodhill's granularization embodiment relates only 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). The many granules and many binary objects of such a large database file are not individually "named" in Woodhill's granularization embodiment (or any other embodiment), and there would have been no logical reason to have "named" them. Woodhill has file names 40 and 80 for files as shown in Figs. 3-4; but not for mere binary objects or granules. A binary object identifier 74 cannot be a "name" for a large database file. Petitioner cites to the "update request" described by Woodhill at col. 17:42. However, Woodhill does not expressly state that that "update request" contains any file name 40 or file name 80 - and it would not matter if it did because such file names 40 and 80 in Woodhill are not determined using the contents of the file as required by claim 1. And petitioner does not contend that it would have been obvious to have modified Woodhill to have met claim 1 in the above respects. Ground 1, regarding claim 1, is fundamentally flawed for at least this first set of reasons.

not "prior art" to the '442 patent (see prosecution history of Woodhill at Ex. 2007).

Woodhill's BOIs 74 are not names. Many identifiers are not names.

Second, there is no “request” for a “data file” in Woodhill’s granularization embodiments. A binary object is not a “data file.” 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). Each of the many granules and binary objects of such a large database file are not individually “named” in Woodhill’s granularization embodiment (or any other embodiment), and there would have been no logical reason to have “named” them. Petitioner cites to 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.” An alleged request for granules or parts of a binary object is not the same as a request for a large database file. Accordingly, there is not even a “request” for a “data file” in Woodhill’s granularization embodiment. Woodhill’s granularization restore at column 17 sends particular granules (not an entire large database file) to a local computer. (Woodhill, col. 17:50-64.) Indeed, a purpose of Woodhill’s granularization embodiment is to avoid transmitting entire large database files, which teaches directly away from petitioner’s allegations regarding claim 1.

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.) Woodhill, in this respect, strongly suggests that binary object identifiers 74 are *not* used in any “request” for a binary object. (Woodhill, col. 11:65 to col. 12:5.) Woodhill indicates that binary object identifiers 74 are certainly *not* used for accessing binary objects. *Id.*

And petitioner does not contend that it would have been obvious to have modified Woodhill in these respects. Ground 1, regarding claim 1, is fundamentally flawed for at least this second set of reasons.

Third, petitioner improperly relies on Woodhill's transmission of a mere granule from the remote backup server 12 to a local computer 20 regarding claim 1's requirement of “in response to . . . 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.*” (Ex. 1010, pg. 34.) Woodhill's granularization embodiment cannot meet the above-italicized subject matter of claim 1. A mere granule is not a “copy of the file” – it is only a very tiny portion of a very large database file. In Woodhill's granularization embodiment, the backup file server 12 only sends particular “granules” of a large database file to a local computer. (Woodhill, col. 17:60-65.) Binary object identifiers 74 do not identify granules, and certainly are not names for granules. And a granule is not a named “data file.” Woodhill's granularization restore at column 17 sends particular *granules* (not a copy of an entire large database file, and not even a binary object) to the local computer. (Woodhill, col. 17:50-64.) Indeed, as mentioned above, a purpose of

Woodhill's granularization embodiment is to avoid transmitting large database files, which teaches directly away from petitioner's allegations regarding claim 1. Thus, Woodhill's granularization embodiment upon which petitioner relies fail to disclose or suggest, in response to the claimed request, "causing a copy of the file to be provided from a given one of the plurality of computers" as required by claim 1. And petitioner does not contend that it would have been obvious to have modified Woodhill to have met claim 1 in these respects. Ground 1, regarding claim 1, is fundamentally flawed for at least this third set of reasons.

Fourth, 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 claim 1. (Woodhill, col. 18:10-38.) As explained in IPRs 2013-00082 and 2013-00083, there is no "request" in Woodhill's self-audit procedure that includes a binary object identifier 74, and petitioner does not contend that it would have been obvious to have modified Woodhill in this respect. 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.) 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.) 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. To the contrary, Woodhill strongly suggests that any such "request" would NOT include a binary object identifier 74. (*E.g.*, Woodhill, col. 11:65 to col. 12:5.)

Additionally, there is no request for a "data file" in Woodhill's self-audit procedure. Woodhill restores a randomly selected binary object – not a "data file." (Woodhill, col. 18:25.) A binary object is not a "data file." And neither a binary object identifier 74 nor a binary object identification record 58 is a "name" for a data file. 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 requirement of claim 1 that "a copy of the requested file is only provided to licensed parties." 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. 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 function separately on different bases. 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.

Woodhill fails to meet numerous features in claim 1 for the reasons explained above. And petitioner's obviousness allegations cannot cure the above-discussed flaws in Woodhill. Institution regarding claim 1 should be denied.

Claim 2

Claim 2 requires:

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

Woodhill fails to disclose or suggest this claimed subject matter.

Petitioner appears to rely on a granule in Woodhill as the alleged “data file” for claim 2. (Ex. 1010, pg. 38.) Contrary to petitioner's allegation, a “granule” is not a “data file.” A granule is a very small part of a large database file. And Woodhill does not “name” granules. Woodhill has names 40 and 80 for files as shown in Figs. 3-4; but *not* for granules. And “contents identifiers” in Woodhill are certainly not “names” for “data files.” Furthermore, petitioner's attempt to switch back-and-forth between “granules” and “binary objects” as an alleged “file” is also clear error. (Pet. 29.)

Moreover, Woodhill cannot possibly *determine whether* a particular granule or binary object is present on a particular computer. To be capable of “determining whether” a particular binary object is present on a particular computer, the system must be able to *both* (1) determine that the binary object is present on that computer when that is the case, and (2) determine that the binary object is NOT present on that computer when that is the case. It is indisputable that Woodhill is incapable of the latter because Woodhill can only look at one binary object in one file. When Woodhill backs up a given binary object, Woodhill looks at only one binary object in only one file. (Woodhill, col. 9:7-27.) Woodhill *cannot* figure out if the contents of a given binary object exist in the *other* files on a particular computer. Likewise, Woodhill cannot figure out if the contents of a given granule exist in other binary objects or other files on a particular computer. Thus, in addition to neither a granule nor a binary object being a “data file”, Woodhill is incapable of “determining whether” a given granule or binary object is present on a particular computer.

Petitioner makes no obviousness allegations in its petition regarding claim 2. (Pet. 29.) And while petitioner cites to Francisco at page 39 of the Mercer declaration, there is no discussion by Mercer of any alleged modifications to Woodhill or any logical reasons to modify Woodhill to meet claim 2 in the above-respects.

Institution regarding claim 2 should be denied for at least the foregoing reasons.

Claim 23

See the reasons explained above in connection with claims 1-2. As explained above, binary object identifiers 74 in Woodhill are not file “names”, and binary objects and granules in Woodhill are not “data files.”

Moreover, as explained above regarding claim 2, Woodhill is incapable of determining whether a given binary object is present on a particular computer. Indeed, neither Woodhill nor Francisco disclose or suggest “using at least said list [of file names] to determine whether unauthorized or unlicensed copies of some of the plurality of data files are present on a particular computer.” Woodhill is incapable of this as explained above, regardless of whether it is modified by Francisco. Thus, even an alleged modification of Woodhill based on Francisco fails to meet claim 23 in this respect.

In addition, petitioner provides *no explanation regarding how* Woodhill could allegedly be modified by Francisco to meet claim 23, and provides *no logical reason* for any such modification. The alleged combination is fundamentally flawed for these reasons as well.

While petitioner never explains *how* Woodhill could be allegedly modified based on Francisco to meet claim 23, and never provides any logical reason for any such modification, PO points out that it would not have been obvious to have

modified Woodhill's granularization procedure based on Francisco to have used binary object identifiers 74 to determine whether alleged access to each binary object was authorized/unauthorized. Such a modification would have been both illogical and unreasonable, and would not have been tried, for at least the following reasons.

Woodhill's granularization process upon which petitioner relies relates only to "*large*" database files that each have many binary objects and many granules. (Woodhill, col. 14:52-67; col. 15:11-17; col. 17:18-22; col. 17:31-35.) Meanwhile, Francisco discloses checking to see if a user is authorized to access an entire "program" – not for checking authorization regarding each of many tiny parts of that program. For the "large" database files used in Woodhill's granularization procedure, one of ordinary skill in the art would never have checked authorization/unauthorization for each of the many binary objects or each of the many granules in that large database file. One would not have checked authorization/unauthorization on a granule-by-granule basis, or on a binary object-by-binary object basis – this would have been highly inefficient, wasteful, illogical, and would have significantly slowed down the system. Francisco simply discloses checking authorization/unauthorization for an entire program on a program-by-program basis, and does not disclose or suggest checking authorization/unauthorization for each of many tiny portions of a program on a portion-by-portion basis – indeed, no cited reference discloses this.

Modifying Woodhill to have checked authorization/unauthorization on a file-by-file basis cannot meet claim 23, because each large database file in Woodhill's granularization procedure has many binary objects and many granules so that binary object identifiers 74 could not reasonably have been used for file authorization checks. And petitioner has provided no logical reason as to why one of ordinary skill in the art would have ever checked authorization/unauthorization on a granule-by-granule basis or on a binary object-by-binary object basis in Woodhill's granularization procedure (as opposed to on a file-by-file basis).

Moreover, during the backup procedure, Woodhill separates each "file" being backed up into multiple data streams – thus, each file being backed up has more than one binary object. (Woodhill, col. 7:41-43.) Petitioner admits Woodhill's statement that "these data streams may represent regular data, extended attribute data, *access control list data*, etc." (Woodhill, col. 7:44-47.) Petitioner alleges that this "access control list data" relates to authorization checking in Woodhill. (Ex. 1010, pg. 35.) However, 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.) 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, it would be illogical and non-sensical to modify Woodhill to use the binary object identifiers 74 for checking authorization/unauthorization. Moreover, if Woodhill already had an authorization/unauthorization system based on this “access control list data” as alleged by petitioner, there would have been no logical reason to have modified Woodhill as alleged by petitioner to add another authorization/unauthorization checking system to Woodhill. *See 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).

Additionally, Woodhill teaches away from any such modification. Woodhill repeatedly teaches goals of minimizing human intervention and costs. (Woodhill, col. 1:61-64; and col. 2:45-46.) In contrast, Francisco's system requires that each of many users has an authorized user profile and electronic identification, and that all of this must be stored in the system. (*E.g.*, Francisco, col. 2:53-64.) One of ordinary skill in the art would have recognized that requiring each such user profile to reflect each and every binary object and/or granule in each large database file would have been unreasonable, illogical, inefficient, very costly, and would have required an enormous amount of effort. One of ordinary skill in the art would not have attempted such a modification, especially given Woodhill's teaching that

human intervention and costs needs to be minimized. Again, there is simply no logical reason to have done this.

Still further, Francisco's system would have rendered Woodhill's backup system inoperative. Francisco states that "the algorithm would be periodically varied to enhance system security." (Francisco, col. 2:43-44.) If this were done in Woodhill regarding binary object identifiers 74, the backup system would be inoperable because a binary object identifier 74 for one version of a binary object would be calculated via one algorithm and a binary object identifier 74 for the next version of that binary object would be calculated via another algorithm, which would render Woodhill's comparisons in the backup procedure unable to achieve their intended goal of detecting change. This is yet another reason why one of ordinary skill in the art would not have tried to modify Woodhill based on Francisco. And this is another reason why one would not have used Woodhill's binary object identifiers 74 for authorization/unauthorization purposes.

Institution of Ground 1, regarding claim 23, should be denied for at least the reasons explained above.

VI. GROUND 2 BASED ON WOODHILL SHOULD NOT BE INSTITUTED

Ground 2 relates to claim 7. Regarding claim 7, see the discussion above regarding claim 1. Woodhill's flaws discussed above cannot be cured by Kahn.

Furthermore, as explained above, both Woodhill and Kahn were cited in the prior reexamination of the '442 patent. The Examiners properly confirmed the patentability of the challenged claims during the reexamination.

Institution of Ground 2, regarding claim 7, should be denied.

**VII. LANGER IS NOT A “PRINTED PUBLICATION” – GROUND 3
SHOULD NOT BE INSTITUTED**

There is no evidence establishing that Langer 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”, institution of Ground 3 should be denied (a) for the reasons explained above regarding claim 23, and (b) because the ground relies upon Langer. *Synopsys, Inc. v. Mentor Graphics Corp.*, IPR2012-00042 (Paper No. 16), at *35-36 (PTAB Feb. 22, 2013) (denying institution based on a document where petitioner did not establish that it was a “printed publication”). *See also 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”).

The statute precludes institution based on a document which has not been established as a patent or printed publication. 35 U.S.C. § 311(b). Langer certainly is not a patent. And because it has not been established as a prior art “printed publication”, the petition should be denied as to Ground 3.

“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.*

As in *Synopsys*, *SRI Int'l* and *ResQNet*, petitioner has presented no testimony, declaration, or other 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.

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. Tellingly, Rackspace now uses a different Langer document than that relied upon by EMC, which raises still further suspicions about Langer. 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 years after the critical date is of no moment. The fact that Langer was inexplicably missing the Usenet “path” header (required by the standard) in the EMC IPR raises further suspicions about the document. 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.

Accordingly, the petition should also be denied as to Ground 3 because Langer has not been established as a “printed publication.”

VIII. CONCLUSION

For the foregoing reasons, *inter partes* review should not be instituted regarding the ‘442 patent. Petitioner has failed to demonstrate a reasonable likelihood of prevailing with respect to the challenged claims for the reasons discussed above.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /Joseph A. Rhoa/
Joseph A. Rhoa
Reg. No. 37,515
Updeep (Mickey) S. Gill
Reg. No. 37,334
Counsel for Patent Owner PersonalWeb

JAR:caj
Nixon & Vanderhye, PC
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

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.

CERTIFICATE OF SERVICE

I hereby certify service of the foregoing Preliminary Response of Patent Owner, and exhibits, to the following lead counsel for petitioner on January 18, 2014 via email (pursuant to agreement between the parties):

David W. O'Brien
Haynes and Boone, LLP
2323 Victory Avenue, Ste. 700
Dallas, TX 75219
(david.obrien.ipr@haynesboone.com)

By: /Joseph A. Rhoa/
Joseph A. Rhoa
Reg. No. 37,515