

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RACKSPACE US, INC. and RACKSPACE HOSTING, INC.,
Petitioners,

v.

PERSONALWEB TECHNOLOGIES, LLC and
LEVEL 3 COMMUNICATIONS,
Patent Owners.

Case IPR2014-00066
Patent 6,928,442

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

CHANG, *Administrative Patent Judge*.

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

I. INTRODUCTION

On October 11, 2013, Rackspace US, Inc. and Rackspace Hosting, Inc. (collectively, “Rackspace”) filed a petition requesting *inter partes* review of claims 1, 2, 4, 7, 23, 27, 28, and 30 of U.S. Patent No. 6,928,442 (“the ’442 patent”). Paper 3 (“Pet.”). PersonalWeb Technologies, LLC and Level 3 Communications (collectively, “PersonalWeb”) filed a patent owner preliminary response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

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

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

Taking into account PersonalWeb’s preliminary response, we conclude that the information presented in the petition demonstrates that there is a reasonable likelihood that Rackspace will prevail in challenging claims 1, 2, 4, 7, 23, 27, 28, and 30 as unpatentable under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to be instituted as to claims 1, 2, 4, 7, 23, 27, 28, and 30 of the ’442 patent.

A. Related Matters

Rackspace indicates that the '442 patent was asserted against it in *PersonalWeb Technologies, LLC v. Rackspace US, Inc.*, No. 6-12-cv-00659 (E.D. Tex). Pet. 1. Rackspace also identifies numerous matters where PersonalWeb asserted claims of the '442 patent against third parties, as well as other petitions for *inter partes* review filed by third parties that are related to this proceeding. *Id.* at 1-3.

B. The '442 patent

The '442 patent relates to a data processing system that identifies data items using substantially unique identifiers, otherwise referred to as True Names, which depend on all the data in the data item and only on the data in the data item. Ex. 1001, 1:14-18; 3:30-33; 6:7-11. According to the '442 patent, the identity of a data item depends only on the data, and is independent of the data item's name, origin, location, address, or other information not directly derivable from the data associated therewith. *Id.* at 3:33-36. The invention of the '442 patent also examines the identities of a plurality of data items in order to determine whether a particular data item is present in the data processing system. *Id.* at 3:37-40.

C. Illustrative Claims

Of the challenged claims, claims 1, 7, and 23 are independent claims. Claims 2 and 4 depend from claim 1, and claims 27, 28, and 30 depend from claim 23. Claims 1, 7, and 23 are illustrative:

1. In a system in which a plurality of files are distributed across a plurality of computers, a method comprising:

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, wherein a copy of the requested file is only provided to licensed parties.

Ex. 1001, 39:42-52.

7. A method, in a system in which a plurality of files are distributed across a plurality of computers, wherein some of the computers communicate with each other using a TCP/IP communication protocol, the method comprising:

obtaining a name for a data file, the contents of said data file representing a digital image, the name having been determined using at least a given function of the data in the data file, 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 data file, the request including at least the name of the data file, providing a copy of the file from a given one of the plurality of computers, wherein a copy of the requested file is not provided to unlicensed parties or to unauthorized parties.

Id. at 40:21-36.

23. A method comprising:

obtaining a list of file names, at least one file name for each of a plurality of files, each of said file names having been determined, at least in part, by applying a function to the contents of the corresponding file; and

using at least said list to determine whether unauthorized or unlicensed copies of some of the plurality of data files are present on a particular computer.

Id. at 42:10-17.

D. Prior Art Relied Upon

Rackspace relies upon the following prior art references:

Woodhill	US 5,649,196	Jul. 15, 1997	(Ex. 1004)
Francisco	US 4,845,715	Jul. 4, 1989	(Ex. 1005)
Kahn	US 6,135,646	Oct. 24, 2000	(Ex. 1006)

Albert Langer, “*Re: dl/describe (File Descriptions)*,” post to the “alt.sources.d” and “comp.archives.admin” Newsgroup on Aug. 7, 1991 (Ex. 1007)(hereinafter “Langer”).

E. Asserted Grounds of Unpatentability

Rackspace asserts the following grounds of unpatentability:

Claims	Basis	References
1, 2, 4, 23, 27, and 30	§ 103(a)	Woodhill and Francisco
7	§ 103(a)	Woodhill and Kahn
28	§ 103(a)	Woodhill, Francisco, and Langer

III. ANALYSIS

A. Claim Construction

We begin our analysis by determining the meaning of the claims. In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may rebut that presumption by providing a definition of the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

1. Preamble of claim 7

The preamble of claim 7 recites “a plurality of files are distributed across a plurality of computers, wherein some of the computers communicate with each other using a TCP/IP communication protocol.” Rackspace asserts that the preamble of claim 7 should not be entitled to patentable weight, because “the feature set forth in the preamble of claim 7 does not add essential structure or steps to the claim and these terms are not necessary to give life, meaning, or vitality to the claim.” Pet. 15 (citing Ex. 1010 ¶ 46). Rackspace alleges that the body of claim 7 does not indicate

“how the plurality of computers communicate with each other and does not specify any features unique to using a TCP/IP communication protocol.” *Id.* PersonalWeb counters that the preamble of claim 7 is limiting and is entitled to patentable weight, because the body of claim 7 refers back to the preamble, and the preamble is needed for completeness of the claim. Prelim. Resp. 3. We agree with PersonalWeb.

In general, a preamble is construed as a limitation “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). When the limitations in the body of the claim “rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003).

Here, the body of claim 7 includes the claim language “providing a copy of the file from a given one of *the plurality of computers*,” which relies upon and derives antecedent basis from the preamble language “*a plurality of computers*, wherein *some of the computers* communicate with each other using a TCP/IP communication protocol” (emphases added). We also observe that the preamble is not stating merely the purpose or intended use of the invention, and the body of claim 7 depends on the preamble for completeness (e.g., “some of the computers communicate with each other using a TCP/IP communication protocol”).

Accordingly, we conclude that the preamble of claim 7 is entitled to patentable weight.

2. “data file”

In *EMC Corporation v. PersonalWeb Technologies LLC*, IPR2013-00083, we construed the claim term “data file” in U.S. Patent No. 6,415,280 (“the ’280 patent”), which issued from an application for which the ’442 patent claims the benefit under 35 U.S.C. § 120. *See EMC Corp. v. PersonalWeb Tech. LLC*, IPR2013-00083, slip op. at 10-11 (PTAB May 17, 2013) (Paper 19); Ex. 1009, 10-11. Rackspace urges us to adopt our construction in IPR2013-00083 for the claim term “data file” in the instant proceeding. Pet. 14-15.

The specification of the ’442 patent provides that a file is “a *named data item*[,] which is either *a data file* (which may be simple or compound) or a directory file.” Ex. 1001, 5:48-50 (emphasis added). That disclosure also appears in the ’280 patent (IPR2013-00083, Ex. 1001, 1:47-54, fig. 2). Based on our review of the specifications of the ’442 patent and the ’280 patent, we note that the claim term “data file” is used similarly in both patent disclosures. We also discern no reason to deviate from our claim construction for the claim term “data file” in IPR2013-00083. *See NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005) (When construing claim terms in patents that derive from the same parent application and share common terms, “we must interpret the claims consistently across all asserted patents.”). Therefore, consistent with our claim construction set forth in IPR2013-00083, we construe the claim term

“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.

PersonalWeb does not dispute that construction but, through its arguments, it attempts to limit the claim term “data file” to a preferred embodiment disclosed in the specification of the ’442 patent. Prelim. Resp. 2-3. In particular, PersonalWeb asserts that a mere segment of a multi-segment file is not a “data file.” *Id.* We do not agree with PersonalWeb’s assertion. Rather, we determine that the claim term “data file”—“a named data item”—does not preclude a “data file” from including smaller “data files” (e.g., data files in a zipfile or binary objects in a data file).

We recognize that the embodiment illustrated in Figure 2 of the ’442 patent provides a hierarchy of data items stored in a system that distinguishes a “file” from a “segment.” However, the specification of the ’442 patent clearly indicates that the hierarchy of data items illustrated in Figure 2 of the ’442 patent is merely *an example*. Ex. 1001, 5:26-36. PersonalWeb improperly attempts to import a limitation from a preferred embodiment disclosed in the specification of the ’442 patent into the claims to preclude a “data file” from including smaller “data files.” *Gemstar-TV Guide Int’l, Inc. v. ITC*, 383 F.3d 1352, 1366 (Fed. Cir. 2004) (rejecting expressly the contention that claims must be construed as limited to an embodiment disclosed in the patent).

Additionally, we observe that a zipfile is a named data item, which normally contains multiple individual data files, and that each individual data file within the zipfile also is a named data item. One with ordinary skill in the art reasonably would equate an individual data file within a zipfile to be a “segment” of the zipfile. Under PersonalWeb’s proposed interpretation, the claim term “data file” would exclude all of the data files within a zipfile. Therefore, PersonalWeb’s proposed interpretation would be inconsistent with the ordinary and customary meaning of the claim term “data file” as would be understood by one with ordinary skill in the art in light of the ’442 patent. *See, e.g.*, Ex. 1001, 1:55-61 (The term “‘data item’ as used herein refer to sequences of bits” and “a data item may be the contents of a file [or] a portion of a file.”).

PersonalWeb does not allege that the inventors of the ’442 patent acted as their own lexicographer and provided a special definition in the specification for the claim term “data file” that is different from its recognized meaning to one with ordinary skill in the art. We decline to import a limitation into the claims that precludes a “data file” from having smaller “data files,” in the absence of a special definition set forth in the specification. It is well established that if a feature is not necessary to give meaning to what the inventor means by a claim term, it would be “extraneous” and should not be read into the claim. *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988).

B. Principles of Law

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, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said 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) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). The level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

We analyze the asserted grounds of unpatentability in accordance with the above-stated principles. We also recognize that prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *Paulsen*, 30 F.3d at 1480. Moreover, “it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). That is because an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for 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; *see also Translogic*, 504 F.3d at 1259.

C. Obviousness

Rackspace asserts that claims 1, 2, 4, 23, 27, and 30 of the ’442 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Woodhill and Francisco. Pet. 16-34. Rackspace also asserts that claim 7 is unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Woodhill and Kahn, and that claim 28 is unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Woodhill, Francisco, and Langer. *Id.* at 34-42. In support of the asserted grounds of unpatentability, Rackspace proffers a declaration of Dr. Melvin Ray Mercer. Ex. 1010. Rackspace also provides detailed explanations as to how each claim limitation is met by the cited references, and rationales for combining the references. *Id.* at 21-42.

PersonalWeb opposes and argues that Woodhill does not disclose or suggest certain limitations recited in the claims. Prelim. Resp. 4-13. PersonalWeb also advances several arguments under the premise that there is insufficient reason to combine the teachings of Woodhill and Francisco. *Id.* at 13-17. PersonalWeb further submits that Langer is not a prior art “printed publication” under 35 U.S.C. § 102(b). *Id.* at 18-21.

We have reviewed Rackspace’s arguments and supporting evidence, as well as PersonalWeb’s arguments submitted in its preliminary response.

Based on the evidence before us, we are not persuaded by PersonalWeb's arguments. Rather, we determine that Rackspace has demonstrated a reasonable likelihood of prevailing on its assertion that the challenged claims are unpatentable under 35 U.S.C. § 103(a) over the combinations of Woodhill, Francisco, Kahn, and Langer. Our analysis will focus on the deficiencies alleged by PersonalWeb in its patent owner preliminary response with regard to the challenged claims.

Woodhill

Woodhill discloses a system for distributed storage management on a computer network system using binary object identifiers. Ex. 1004, 1:11-17. The system includes a remote backup file server and a plurality of local area networks in communication with the remote backup file server. *Id.*

Figure 1 of Woodhill, reproduced below, depicts a computer network system that includes a distributed storage management system.

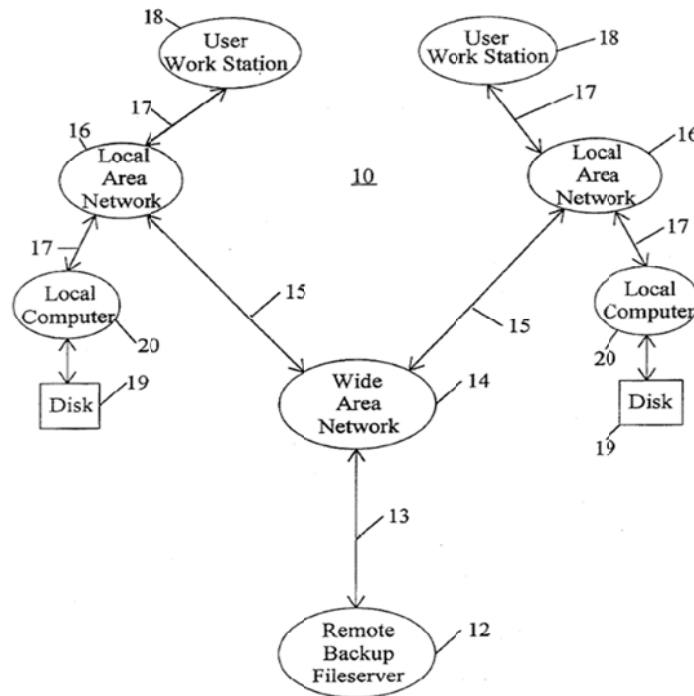
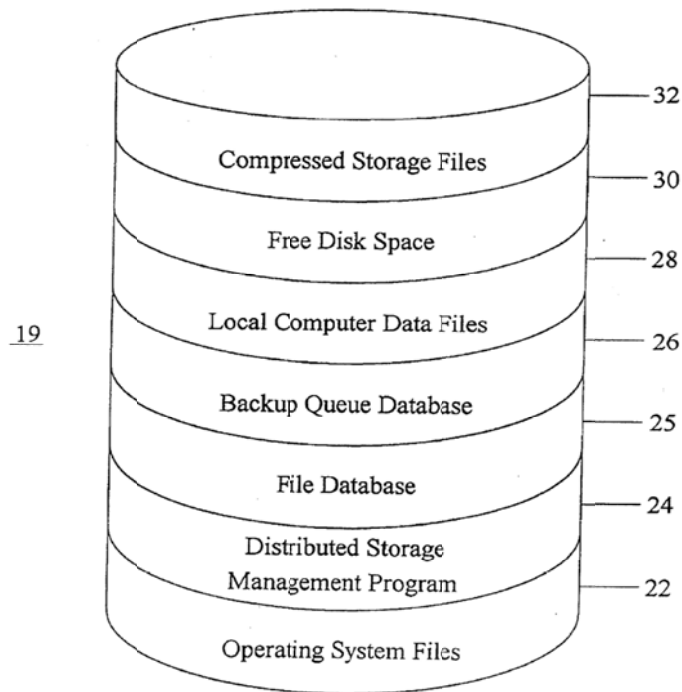


FIG. 1

As illustrated in Figure 1 of Woodhill, remote backup file server 12 communicates with wide area network 14, which communicates with a plurality of local area networks 16. *Id.* at 3:12-30. Each local area network 16 includes multiple user workstations 18 and local computers 20. *Id.* at 3:24-44. The storage space on each disk drive 19 on each local computer 20 is allocated according to the hierarchy illustrated in Figure 2. *Id.* at 3:31-44.

Figure 2 of Woodhill illustrates a Distributed Storage Manager (DSM) program that allocates storage space on each of the storage devices in the

networked computer system. *Id.* at 2:59-62. Figure 2 of Woodhill is reproduced below:



As shown in Figure 2 of Woodhill, DMS program 24 builds and maintains File Database 25. *Id.* at 3:44-49. The DSM program views a file as a collection of data streams, and it may divide each data stream into one or more binary objects depending on the size of the data stream. *Id.* at 4:13-23; 7:40-43; fig. 5A, item 132. More specifically, data streams represent regular data, extended attribute data, access control list data, etc. *Id.* at 7:44-47. For each binary object being backed up, a Binary Object Identification Record is created in a File Database and includes a Binary Object Identifier to identify a particular binary object uniquely. *Id.* at 7:60-8:1; 8:33-34.

Binary Object Identifiers are calculated based on the contents of the data so that the Binary Object Identifier changes when the contents of the

binary object changes. *Id.* at 8:57-62; 8:40-42. Notably, the Binary Object Identifier includes a Binary Object Hash field, which is calculated against the contents of the binary object taken one word (16 bits) at a time using a hash algorithm. *Id.* at 8:22-32. Duplicate binary objects can be recognized from their identical Binary Object Identifiers, even if the objects reside on different types of computers in a heterogeneous network. *Id.* at 8:62-65.

Francisco

Francisco discloses a data processing system that generates electronic identification indicia for authorized software programs. Ex. 1005, 2:12-16. The system also maintains the electronic identification indicia in an authorized user profile library in correlative relation with electronic identifications of all authorized users. *Id.* at 2:51-64. The system selectively permits authorized users to access the selected software program, and prevents unauthorized access. *Id.* at 3:29-36. As explained in Francisco, one of the advantages of Francisco's authorization check mechanism is to improve system security by preventing unauthorized access to proprietary software programs. *Id.* at 1:26-35, 54-59.

Langer

Langer discloses a method of accessing files in a network of computers. Ex. 1007, 3. For instance, a file request that includes a unique identifier for the file may be embedded in a news article. *Id.* at 3-4. By selecting the file request, users are automatically informed of the nearest location of the file. *Id.*

Langer further discloses that a unique identifier for a file is calculated using a cryptographic hash function (e.g., MD5) on the entire contents of the file, rather than the file's location. *Id.* at 4. For a package (e.g., an archive) that is divided into its component files, a unique identifier for each component file is calculated by using an MD5 hash function on the contents of the component file. *Id.* at 5. The unique identifier for the entire package is calculated by applying an MD5 hash function again to the concatenation of the MD5 hashes of the component files in numeric order ("a hash of hashes"). *Id.*

Kahn

Kahn discloses a system for storing and controlling delivery of digital objects (e.g., digital image files) to authorized users. Ex. 1006, 1:17-21; 2:17-32. The system enables the holders of rights (e.g., copyrights) in digital objects to control terms and conditions under which they are accessed by users in the network. *Id.* at 3:4-13. In particular, users can be authorized to receive digital objects if their certificates match the information on file with the system, otherwise access to the requested digital object will be denied. *Id.* at 22:26-26:38; 25:1-3, 54-57. According to Kahn, messages may be sent between system components via direct connections (e.g., "TCP/IP"). *Id.* at 10:39-48.

“Obtaining a name for a data file”

Independent claim 1 recites the following limitation:

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;

Ex. 1001, 39:44-47 (emphasis added). Independent claims 7 and 23 each recite a similar limitation. *Id.* at 40:25-30; 42:11-14.

In its preliminary response, PersonalWeb argues that Woodhill does not disclose or suggest the aforementioned “name” claim limitation. Prelim. Resp. 4-5. According to PersonalWeb, Woodhill’s granularization technique does not teach a binary object identifier, and therefore, a binary object identifier cannot be a “name” for a “data file.” *Id.* at 5-6. PersonalWeb also submits that Woodhill does not use binary object identifiers as names for data files, and does not provide names for binary objects or granules. *Id.* PersonalWeb maintains that Woodhill’s “file name” (item 40 in Figure 3 and item 80 in Figure 4 of Woodhill) does not meet the “name” claim limitation as they are unrelated to the contents of respective files. *Id.* PersonalWeb alleges that “[i]t cannot reasonably be said that all ‘identifiers’ are ‘names,’” because “a fingerprint is an identifier for a person, it is not a ‘name’ for that person.” *Id.*

We are not persuaded by PersonalWeb’s arguments. PersonalWeb narrowly focuses on Woodhill’s granularization function and does not consider Woodhill’s disclosure, as a whole, from the perspective of one with ordinary skill in the art. *See Paulsen*, 30 F.3d at 1480.

Notably, PersonalWeb takes the position that each of the functionalities (e.g., concurrent onsite/offsite backup, granularization, and auditing) of the DSM program is a separate and distinct embodiment. *See, e.g.,* Prelim. Resp. 10-11. However, Woodhill specifically states that each of the functions operates in cooperation with the other functions to form *a unitary computer program*. Ex. 1004, 4:62-5:2; figs. 5a-5l. Woodhill divides the DSM program into several distinct functions for explanation purposes. *Id.*

PersonalWeb's arguments also are not commensurate with the scope of the claims because they rest on an overly narrow construction of the claim term "data file" by importing a limitation from a preferred embodiment into the claims. Prelim. Resp. 5-6. As discussed above, the broadest reasonable interpretation for the claim term "data file" is "a named data item," and it does not preclude a "data file" from including smaller "data files."

In the context of Woodhill, database files, other files, binary objects, and granules each are *named data items*. Ex. 1004, 4:13-30; 14:65-15:4. Depending on their sizes, the smallest unit of a data item being processed by the DSM program can be a file, binary object, or granule. *Id.* Given Woodhill's teachings, one with ordinary skill in the art would have recognized that any maximum binary object size or maximum granule size that produces the most efficient results (in terms of processing time and amount of data that must be backed up) may be utilized. *Id.* at 4:23-26; 14:65-15:4.

Applying the broadest reasonable interpretation of the claim term “data file” (i.e., a named data item), a binary object constitutes a “data file,” because each individual binary object is a data item that is identified uniquely by a binary object *identifier* (i.e., a “name”). Ex. 1004, 4:21-26; 8:33-36. Similarly, a granule constitutes a “data file,” as each individual granule is a data item that is identified uniquely by a contents *identifier* (i.e., a “name”)—which is calculated against the contents of the granule and a 32-bit hash number in the same manner as binary object identifiers. Ex. 1004, 15:24-30; *see also id.* at 7:60-8:65; fig. 5a, step 138. Furthermore, a file, including a database file, also constitutes a “data file,” in that each individual file is a data item that is identified uniquely by at least one binary object *identifier* (i.e., a “name”). *Id.* at 4:12-47, fig. 3.

We do not agree with PersonalWeb that a binary object *identifier* is not a “name” for a binary object. We appreciate that a physical object, such as a *fingerprint*, normally is not used as a “name” of a person, because it is difficult to reproduce verbally or in text form. In contrast, a binary object *identifier*—in the form of numbers that uniquely identify the particular binary object—is relatively easy to reproduce and use. Ex. 1004, 7:60-8:65.

PersonalWeb does not dispute that binary object *identifiers* are calculated based, at least in part, on a given function of the data, wherein the data used by the given function to determine the identifier comprises the contents of the data item, as required by the claims. Indeed, Woodhill discloses that binary object identifier 74, as shown in Figures 3 and 5a, is comprised of binary object size field 64, binary object CRC32 field 66,

binary object LRC field 68, and *binary object hash field* 70. Ex. 1004, 7:64-8:1, figs. 3, 5a (item 138). The binary object hash field 70 is calculated based on the contents of the binary object using a hash algorithm. *Id.* at 8:22-32.

As to PersonalWeb's argument that Woodhill's "file name" (item 40 in Figure 3 and item 80 in Figure 4 of Woodhill) does not meet the "name" claim limitation, Rackspace does not rely on that disclosure of Woodhill, but rather the content-based data *identifiers* of Woodhill to teach the "name" claim limitation. *See* Pet. 22-24 ("Just like the disclosure in the '442 Patent, Woodhill discloses using content based data *identifiers to identify (name)* sequences of bytes, called 'binary objects.'") (citing Ex. 1010, p. 31; Ex. 1004, 7:60-8:65, figs. 2, 3). Indeed, Woodhill's "file name" normally given by the user is not being used by the DSM program to identify the data item uniquely. According to Woodhill, the DSM program uses the binary object *identifier* or contents *identifier* to identify the particular data item uniquely. Ex. 1004, 8:33-34 ("[I]t is important that the possibility of two different binary objects being assigned the same Binary Object identifier 74 be very small."); *id.* at 8:59-52 ("[T]he probability that the [DSM] program 24 will generate the same Binary Object Identifier 74 for two different binary objects is extremely low."); *id.* at 15:24-41. More importantly, Woodhill states that the "critical feature to be recognized in creating a Binary Object Identifier 74 is that the identifier should be based on the contents of the binary object so that the Binary Object Identifier 74 changes when the contents of the binary object changes" so that "duplicate binary objects, even

if resident on different types of computers in a heterogeneous network, can be recognized from their identical Binary Object Identifiers 74.” Ex. 1004, 8:58-65.

For the foregoing reasons, Rackspace, on this record, has demonstrated that one with ordinary skill in the art would have recognized that Woodhill, in combination with Francisco, describes the “name” limitation as recited in claims 1, 7, and 23.

“Request for the data file”

Independent claim 1 recites the following limitation:

in response to *a request for the [] 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,

Ex. 1001, 39:48-51 (emphasis added). Independent claim 7 recites a similar limitation. *Id.* at 40:31-36.

In its preliminary response, PersonalWeb takes the position that Woodhill does not disclose or suggest the aforementioned “request” claim limitation, because neither a binary object nor a granule is a “data file.” Prelim. Resp. 4-5, 7-8, 10. PersonalWeb argues that Woodhill’s update request for granules is not a request for a large database file or any other “data file.” *Id.* at 7-8. PersonalWeb also contends that Woodhill does not use binary object identifiers in any “request” for a binary object, because Woodhill does not seem to use binary object identifiers for accessing binary objects in the compression routine performed by the DSM program. *Id.* 7-8 (citing Ex. 1004, 11:65-12:5). PersonalWeb further maintains that

Woodhill's backup file server only sends particular "granules" of a large database file to a local computer, and not a copy of an entire large database file to a local computer. *Id.*

We are not persuaded by PersonalWeb's arguments, because they again rest on an overly narrow construction of the claim term "data file" by importing a limitation from a preferred embodiment into the claims. As discussed above, the broadest reasonable interpretation for the claim term "data file" is "a named data item," and it does not preclude a "data file" from including smaller "data files."

Specifically, PersonalWeb's arguments are based incorrectly on the premise that binary objects and granules are not "data files," and that only database files can be "data files." As we articulated previously, binary objects and granules are *named data items*. Each binary object is identified uniquely by a binary object *identifier* (i.e., a "name"), and each granule is identified uniquely by a content *identifier* (i.e., a "name"). Ex. 1004, 8:33-36; 15:29-38. Therefore, each binary object and granule is a "data file" because the claim term "data file" is broadly, but reasonably, construed as a named data item.

PersonalWeb's reliance on the compression routine disclosure is misplaced, as Rackspace does not rely on that disclosure of Woodhill to teach or suggest the "request" claim limitation. As noted by Rackspace in its petition (Pet. 25-26), Woodhill's DSM program transmits an *update request* from the local computer to the remote backup file server, for *restoring a current version of a file* (comprised of current versions of binary

objects) to a previous version of that file (comprised of previous versions of binary objects). Ex. 1004, 17:18-46; fig. 5i, items 444, 446. Contrary to PersonalWeb's contention that the update request does not include "at least the name of the particular file," Woodhill specifically discloses that the *update request* includes the *binary object identification record*, which includes the binary object *identifier* (i.e., a "name") for the previous version of each binary object, as well as the *identifier* (i.e., a "name") for the current version of each binary object as it exists on the local computer. *Id.*; *see also id.* at 4:35-47; fig. 3, item 74.

Moreover, the DSM program reconstructs each previous version of the binary objects by comparing the *identifiers* of the previous version and the *identifiers* of the current version. *Id.* at 17:46-50. If the *identifiers* do not match, the DSM program transmits a copy of the granule (i.e., a "data file") from the remote backup file server to the local computer. *Id.* at 17:60-64. More importantly, in the situation where all of the previous granules have been changed so that none of the identifiers matches, the DSM program would transmit all of the granules that are associated with the database file (i.e., the entire database file) to the local computer. *Id.* Given Woodhill's teachings, one with ordinary skill in the art would have appreciated that the DSM program would transmit a granule, a binary object, or the entire database file, depending on the amount of changes made to the previous version of the database file.

Rackspace also directs our attention to Woodhill's auditing function as another example that describes the "request" claim limitation. Pet. 25-26

(citing Ex. 1010, p. 32-33; Ex. 1004, 18:16-23). PersonalWeb responds that there is no request for a “data file” in Woodhill’s self-audit procedure that includes a binary object identifier, and the Binary Object Identification Record 58 is not described as part of a “request” for the binary object. Prelim. Resp. 9-10. PersonalWeb’s argument is not persuasive, as it is incorrectly based on the premise that a binary object is not a “data file” and fails to recognize that a binary object identification record includes a binary object *identifier*, which is a unique identifier for each binary object.

Ex. 1004, 4:35-47; fig. 3, items 58, 74.

Woodhill discloses that the DSM program performs auditing and reporting functions on a periodic basis to ensure that binary objects, which already have been backed up, may be restored. Ex. 1004, 18:11-13. As Rackspace noted (Pet. 25-26), the DSM program initiates a restore by requesting a binary object (i.e., a “data file”) identified by a binary object identification record, which includes the binary object *identifier* (i.e., a “name”) stored in the file database. *Id.* at 18:16-19; fig. 5j, item 500; *see also id.* at 4:35-47; fig. 3, item 74. The DSM program restores the binary object (i.e., a “data file”) from either one of the disk drives or one of the local computers or *from the remote backup file server*. *Id.* at 18:19-23.

Finally, PersonalWeb argues that “it would be legal error to switch back and forth between Woodhill’s granularization embodiment, and Woodhill’s ‘self-audit’ embodiment.” Prelim. Resp. 10-11. We are not persuaded. As discussed above, PersonalWeb improperly characterizes each of the functionalities of Woodhill’s DSM program as a separate and distinct

embodiment. To the contrary, Woodhill specifically states that each of the functions operates in cooperation with the other functions to form *a unitary computer program*. Ex. 1004, 4:62-5:2; figs. 5a-5l. Woodhill merely divides the DSM program into several distinct functions for explanation purposes. *Id.*

For the foregoing reasons, Rackspace has demonstrated on this record that one with ordinary skill in the art would have recognized that Woodhill, in combination with Francisco, describes the “request for the data file” limitation as recited in claims 1 and 7.

“Determining a copy of the data file is on a particular computer”

Claim 2 depends from claim 1, and recites “determining, using at least the name, whether a copy of the data file is present on a particular one of said computers.” Ex. 1001, 39:54-56. Independent claim 23 recites a similar limitation (“using at least said list [of file names] to determine whether . . . copies of some of the plurality of data files are present on a particular computer”). *Id.* at 42:15-17.

In its preliminary response, PersonalWeb argues that a granule is not a “data file” because it is a very small part of a large database file and Woodhill does not “name” granules. Prelim. Resp. 11. PersonalWeb also contends that Woodhill cannot determine whether a particular granule or binary object is present on a particular computer. *Id.* at 12-13.

We are not persuaded by PersonalWeb’s arguments. Again, they are based incorrectly on the premise that binary objects and granules are not “data files,” and that only database files can be “data files.” As discussed

above, binary objects and granules are *named data items*. Each binary object is identified uniquely by a binary object *identifier* (i.e., a “name”), and each granule is identified uniquely by a content *identifier* (i.e., a “name”). Ex. 1004, 8:33-36; 15:29-38. Therefore, each binary object and granule is a “data file” because the claim term “data file” is broadly, but reasonably construed as a named data item.

Contrary to PersonalWeb’s contention, Woodhill uses the *identifier* (i.e., a “name”) of a data item (i.e., a “data file”) to determine whether a copy of the data item is present on a particular computer, as required by the claims. *See, e.g.*, Ex. 1004, 17:36-46; 18:11-38. As articulated previously, when the DSM program requests a copy of the binary object or granule (i.e., a “data file”) from the remote backup file server (i.e., a “computer”), the DSM program transmits a request that includes the *identifier* (i.e., a “name”) for the previous version of each binary object, as well as the *identifier* (i.e., a “name”) for the current version of each binary object as it exists on the local computer. *Id.* at 17:18-46; fig. 5i, items 444, 446. By comparing the identifiers stored in the remote backup file server with the identifiers of the current version of each binary object as it exists on the local computer, the DSM program determines whether to transmit a copy of the binary object or granule from the remote backup file server to the local computer. Given Woodhill’s disclosure, one with ordinary skill in the art would have understood that, if a copy of the binary object or granule is not present on the remote backup file server, the DSM program would not transmit a copy of the binary object or granule.

For the foregoing reasons, Rackspace has established sufficiently on this record that one with ordinary skill in the art would have recognized that Woodhill, in combination with Francisco, describes the “determining” limitation as recited in claims 2 and 23.

Reasons to combine Woodhill and Francisco

In its preliminary response, PersonalWeb argues that Rackspace 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.” Prelim. Resp. 13 (emphases in the original). PersonalWeb also submits that there is no reason to incorporate Francisco’s authorization check mechanism into Woodhill, because Woodhill already has an authorization check system based on access control list data. *Id.* at 15-16. PersonalWeb further maintains that one with ordinary skill in the art “would not have provided a component to address a problem that did not exist or was already solved.” Prelim. Resp. 16 (citing *Ex Parte Rinkevich*, Appeal 2007-1317 (PTAB May 29, 2007)).

PersonalWeb’s arguments are not persuasive. As Rackspace notes, although Woodhill “does not expressly disclose a technique for accomplishing access control,” nevertheless “it was well known at the time to maintain a listing of authorized users and [to] compare the requesting party’s credentials against a listing of authorized users before providing a copy of the requested file.” Pet. 30-31 (citing Ex. 1010, p. 43-44). Rackspace directs our attention to Francisco, which discloses that “a method for maintaining integrity through selectively coded preauthorized software

program and user identification and subsequent automatic authentication of both a selected program and permitted user thereof when system resources are to be utilized.” *Id.* at 31 (citing Ex. 1005, 1:10-15). Dr. Mercer testifies that it “would have been obvious to combine Woodhill’s access control data with the user authentication techniques taught by Francisco to only provide copies of the requested file if the file is authenticated and is provided to an authorized party identified in a table[,] as set forth in Francisco.” Ex. 1010, p. 44.

More importantly, Francisco indicates that one area of growing primary concern at the time of the invention was the controlling of access to proprietary software program materials, and that unauthorized access to program materials could lead to serious breaches of system security. Ex. 1005, 1:26-35. To improve system security, Francisco implements a method for generating electronic identification indicia that uniquely and selectively identify the selected programs and, subsequently, uses the electronic identification indicia and an authorized user profile library to check whether the users requesting the programs have the proper authorization. *Id.* at 1:54-59; 2:12-44. Implementing Francisco’s authorization check mechanism in Woodhill’s distributed computer network system would have been an obvious improvement. One with ordinary skill in the art would have had good reason to incorporate a known approach for improving system security. *KSR*, 550 U.S. at 421 (“Where there is a design need or market pressure to solve a problem and there are a finite number of identified predictable solutions, a person of ordinary skill has good reason to

pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely to the product not of innovation but of ordinary skill and common sense.”). Moreover, PersonalWeb has not provided sufficient evidence that such an implementation would have been beyond the level of an ordinarily skilled artisan. *KSR*, 550 U.S. 417 (“ “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Rackspace’s reasoning to incorporate Francisco’s authorization check mechanism into Woodhill’s distributed computer network system to improve system security, which, in turn, prevents unauthorized access to proprietary software program materials, is supported sufficiently by the evidence of record. For the foregoing reasons, we concluded that Rackspace provides an articulated reason with a rational underpinning to justify the legal conclusion of obviousness.

PersonalWeb’s argument – Woodhill cannot be combined with Francisco

PersonalWeb maintains that “it would not have been obvious to have modified Woodhill’s granularization procedure based on Francisco to have used Woodhill’s binary object identifiers 74 to determine whether alleged access to each binary object was authorized/unauthorized.” Prelim. Resp. 13-14. According to PersonalWeb, “Woodhill’s granularization process relates only to ‘large’ database files that each have many binary objects and many granules” (Ex. 1004, 14:52-67; 15:11-17; 17:18-22, 31-35), whereas

“Francisco discloses checking to see if a user is authorized to access an entire ‘program.’” Prelim. Resp. 14.

We are not persuaded by PersonalWeb’s arguments. “It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *see also In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc) (“[T]he criterion [is] not whether the references could be physically combined but whether the claimed inventions are rendered obvious by the prior art as a whole.”).

PersonalWeb fails to recognize that Woodhill’s granularization procedure merely applies to large database files, and not applicable to all of the data files. Ex. 1004, 14:53-15:8. Further, Woodhill specifically states that a single binary object represents the data stream if the size of the data stream is equal to or less than *previously defined convenient maximum binary object size* (e.g., one megabyte). *Id.* at 4:23-26. Only when the data stream is larger than the maximum binary object size, then the DSM program divides the data stream into multiple binary objects. *Id.* at 4:26-30. PersonalWeb incorrectly assumes that Francisco’s programs are larger than the maximum binary object size. In fact, Francisco does not indicate the size of the program, but merely states that the program may be considered broadly “as arbitrarily ordered series of actions or instructions, in binary form, capable of being interpreted and executed by an information processing system for the purpose of manipulating information.” Ex. 1005, 2:16-22. Moreover, one with ordinary skill would have recognized that

Woodhill's previously defined convenient maximum binary object size is adjustable to accommodate larger data streams, if necessary. *KSR*, 550 U.S. at 420-21.

PersonalWeb's "teaching away" argument

PersonalWeb further alleges that Woodhill teaches away from Rackspace's proposed combination, because the modification "would have resulted in dramatic increase in both human intervention and costs which Woodhill teaches would have been undesirable." Prelim. Resp. 16-17 (citing Ex. 1004, 1:61-64; 2:45-46). In particular, PersonalWeb argues that "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" and that would have been inefficient and very costly. *Id.* (citing Ex. 1005, 2:53-64).

PersonalWeb's arguments are unavailing. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the [inventor]." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). A reference does not teach away, however, if it merely expresses a general preference for an alternative invention, but does not "criticize, discredit, or otherwise discourage" investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

At the outset, Francisco's authorization check mechanism is an automated computer method. Ex. 1005, 1:9-15 ("This invention relates to

data processing system security . . . *automatic* authentication of both a selected program and permitted user thereof when system resources are to be utilized.”). PersonalWeb does not explain adequately why incorporating an *automated* authorization check mechanism would increase human intervention significantly. Nor do we discern any evidence on this record supporting PersonalWeb’s allegation that such implementation would increase human intervention dramatically.

Although implementing Francisco’s authorization check mechanism may increase cost, such disadvantages are not dispositive of non-obviousness, especially in view of the explicit teachings of Francisco as to the advantages of an authorization check mechanism to improve system security, which, in turn, prevents unauthorized access to proprietary software program materials. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.”). As evidenced by Francisco, one with ordinary skill in the art would have appreciated that unauthorized access to program materials could lead to serious breaches of system security, thereby affecting the proprietary value of the programs. Ex. 1005, 1:25-35. Moreover, any additional cost associated with improving system security could be recovered from licensing or user fees of the software programs. Therefore, the cost to improve the system security would be out-weighed by the advantages of preventing unauthorized access to proprietary software program. *See Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8

(Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.”).

For the foregoing reasons, we are not persuaded by PersonalWeb’s argument that Woodhill teaches away from implementing Francisco’s authorization check mechanism in its distributed computer network system environment.

Whether the combination would render Woodhill’s system inoperable

PersonalWeb contends that Francisco’s system would have rendered Woodhill’s distributed storage management system inoperable for its intended purpose, because Francisco’s algorithm would be varied periodically to enhance system security. Prelim. Resp. 17 (citing Ex. 1005, 2:43-44). In particular, PersonalWeb believes that Woodhill’s “binary object identifier 74 for one version of a binary object would be calculated using one algorithm, and a binary object identifier 74 for the next version of that binary object would be calculated using another algorithm, which would render Woodhill’s comparisons in the backup procedure unable to achieve their intended goal of detecting change.” *Id.*

PersonalWeb’s arguments are unpersuasive. As discussed above, “[t]o justify combining reference teachings in support of a [ground of unpatentability] it is not necessary that a device shown in one reference can be physically inserted into the device of the other.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). “The test for obviousness is not whether the

features of a secondary reference may be bodily incorporated into the structure of the primary reference.” *Id.*

We observe that Rackspace does not rely on Francisco’s teaching of changing the algorithm periodically in its proposed combination. The technique of changing the algorithm periodically is not required by the claims, and it is an optional feature of Francisco. Even if the algorithm is to be varied periodically, as alleged by PersonalWeb, one with ordinary skill in the art would have a migration plan to update all of the binary object identifiers with the new algorithm before using the new algorithm in the backup procedure of Woodhill. *KSR*, 550 U.S. at 420-21 (A person with ordinary skill in the art is “a person of ordinary creativity, not an automaton,” and “in many cases . . . will be able to fit the teachings of multiple patents together like pieces of a puzzle.”).

Therefore, we are not persuaded by PersonalWeb’s argument that incorporating Francisco’s authorization check mechanism into Woodhill’s distributed storage management system would have rendered it inoperable for its intended purpose.

Whether Langer is a “Printed Publication” Under 35 U.S.C. § 102(b)

In its petition, Rackspace takes the position that Langer is a “printed publication” under 35 U.S.C. § 102(b), because Langer was posted publicly on the “alt.sources.d” newsgroup on August 7, 1991, more than one year before the earliest priority date of the ’442 patent. Pet. 5, 40. To substantiate its position, Rackspace proffers a declaration of Dr. Narashimha Reddy. Ex. 1011.

In its preliminary response, PersonalWeb urges the Board to deny the asserted ground of unpatentability on the basis that Langer is not a prior art “printed publication” under 35 U.S.C. § 102(b). Prelim. Resp. 18-21. PersonalWeb alleges that “[t]here is no evidence establishing that Langer is a prior art ‘printed publication.’” *Id.* at 18. In particular, PersonalWeb asserts that Rackspace “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.” *Id.* at 19-20. PersonalWeb also maintains that 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.” *Id.* at 20.

We are not persuaded by PersonalWeb’s arguments. When determining whether to deny a ground of unpatentability on the basis that an asserted reference is not a prior art printed publication, we decide each case on the basis of its own facts. More specifically, the determination of whether a given reference qualifies as a prior art “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004).

The key inquiry is whether the reference was made “sufficiently accessible to the public interested in the art” before the critical date. *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989); *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981). Indexing is not “a necessary condition for a reference to be publicly accessible,” but it is only one among many factors that may bear on public accessibility. *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009). “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.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006).

Contrary to PersonalWeb’s assertion, Rackspace presents testimony from Dr. Reddy that indicates Langer was posted to both the “alt.source.d” and “comp.archives.admin” newsgroups on August 7, 1991—which is more than one year prior to the earliest priority date (April 11, 1995) of the ’442 patent (April 11, 1994, “the critical date”). Ex. 1011 ¶ 13. Dr. Reddy testifies that, before the critical date, the “alt.source.d” and “comp.archives.admin” newsgroups were disseminated widely and readily accessible to the relevant technical community, and were devoted to technical discussions related to source code and computer archive administration, respectively. *Id.* ¶¶ 11-12, 15. Dr. Reddy further testifies that Langer was posted, before the critical date, on Usenet which was a publicly accessible site well known to those interested in the art and could be downloaded and retrieved from the site. *Id.* ¶¶ 9, 11-18. Accordingly, on

this record, we credit Dr. Reddy's testimony that Langer was made "sufficiently accessible to the public interested in the art" before the critical date. *Id.* ¶¶ 9-18.

With respect to PersonalWeb's argument that there is no evidence that either reference was catalogued or indexed in a meaningful way prior to the critical date, we are not persuaded. "[W]hile often relevant to public accessibility, evidence of indexing is not an absolute prerequisite to establishing online references . . . as printed publications within the prior art." *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012).

PersonalWeb also asserts that there "is no declaration from any alleged author of Langer stating when Langer was created, or to whom it was ever sent," and there is "no evidence of anyone seeing or receiving Langer prior to" the critical date. Prelim. Resp. 20. However, neither a declaration from the author of the reference, nor evidence of someone actually viewing the reference, is required to support a determination that the reference was publicly accessible to persons skilled in the pertinent art before the critical date. *See In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986) (concluding "that competent evidence of the general library practice may be relied upon to establish an approximate time when a thesis became accessible."); *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981) (Notwithstanding that there is no evidence concerning actual viewing or dissemination of any copy of the Australian application, the court held that "the contents of the application were sufficiently accessible to the public and to persons skilled

in the pertinent art to qualify as a ‘printed publication.’”); *In re Bayer*, 568 F.2d 1357, 1361 (CCPA 1978) (A reference constitutes a “printed publication” under 35 U.S.C. § 102(b) as long as a presumption is raised that the portion of the public concerned with the art would know of the invention.).

To support its contentions, PersonalWeb also directs our attention to a copy of Langer that allegedly has a “downloaded” date of July 29, 2003, and was submitted in another *inter partes* review by a different petitioner.

Prelim. Resp. 20. PersonalWeb, however, does not cite to a specific case number, nor does it provide a copy of the evidence it is relying upon in the instant proceeding. The burden should not be placed on the Board to hunt through all other *inter partes* reviews involving PersonalWeb’s patents, and to speculate which copy of Langer PersonalWeb is relying upon. We give no weight to evidence that has not been submitted in the instant proceeding. In any event, the mere fact that a “downloaded” copy of Langer has a date subsequent to the critical date is not sufficient to rebut Rackspace’s supporting evidence that Langer was posted originally on publicly accessible sites well known to those interested in the art before the critical date.

On this record, we determine that Rackspace has made a threshold showing to establish that Langer is a prior art printed publication within the meaning of 35 U.S.C. § 102(b). As a consequence, Langer is available as prior art for the purposes of this decision to demonstrate that the challenged claims of ’442 patent are unpatentable under 35 U.S.C. § 103(a).

Conclusion

For the foregoing reasons, we determine that the information presented in the petition shows that there is a reasonable likelihood that Rackspace will prevail in challenging claim 1, 2, 4, 7, 23, 27, 28, and 30 of the '442 patent as unpatentable under 35 U.S.C. § 103(a). At this stage in the proceeding, we have not made a final determination with respect to the patentability of the challenged claims.

V. ORDER

For the foregoing reasons, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted for the following grounds of unpatentability:

1. Claims 1, 2, 4, 23, 27, and 30 are unpatentable under 35 U.S.C. § 103(a) over Woodhill and Francisco;
2. Claim 7 is unpatentable under 35 U.S.C. § 103(a) over Woodhill and Kahn; and
3. Claim 28 is unpatentable under 35 U.S.C. § 103(a) over Woodhill, Francisco, and Langer; and

FURTHERED ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

Case IPR2014-00066
Patent 6,928,442

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