

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

Case IPR2016-00789
Patent 8,402,555 B2

Before GLENN J. PERRY, RAMA G. ELLURU, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

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

Unified Patents Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–26 of U.S. Patent No. 8,402,555 B2 (Ex. 1001, “the ’555 patent”). William Grecia (“Patent Owner”) filed a Preliminary Response (Paper 5, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we deny institution of an *inter partes* review.

I. BACKGROUND

A. The ’555 Patent

The ’555 patent is titled “Personalized Digital Media Access System (PDMAS).” Ex. 1001, at [54]. The ’555 patent describes a digital rights management system that manages access rights across a plurality of devices via digital media personalization to protect digital media subject to illegal copying. *Id.* at 1:19–26; 4:47–48.

The system includes a first receipt module, an authentication module, a connection module, a request module, a second receipt module, and a branding module. *See id.* at Fig. 1. The first receipt module receives a branding request from a user’s (content acquirer’s) device. *Id.* at 5:45–47. The branding request is a read and write request of metadata of the digital media and includes a membership verification token corresponding to the digital media. *Id.* at 5:47–50. The authentication module authenticates the membership verification token. *Id.* at 5:56–57. The connection module establishes communication with the user’s device. *Id.* at 5:58–60. The

request module requests an electronic identification reference from the user's device. *Id.* at 6:4–6. The second receipt module receives the electronic identification reference. *Id.* at 6:6–8. The branding module brands metadata of the digital media by writing the membership verification token and the electronic identification into the metadata. *Id.* at 6:8–11.

Figure 3, which is reproduced below, illustrates this process.

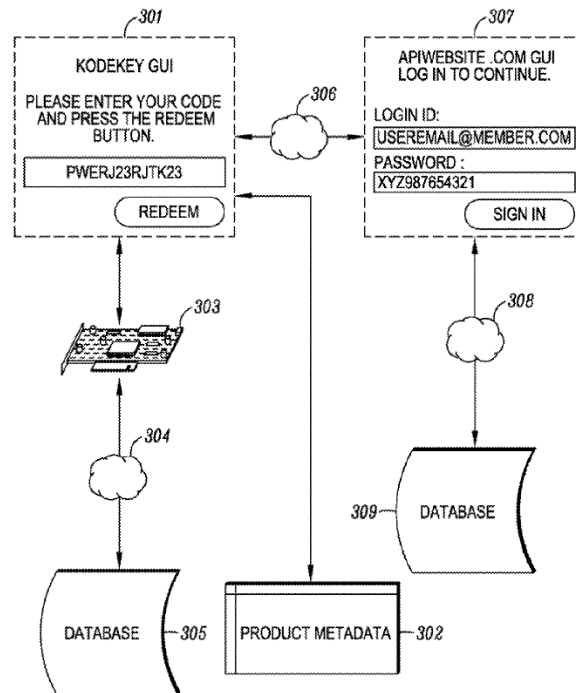


FIG. 3

In particular, Figure 3 is a flow chart of the process of digital media personalization. *Id.* at 4:23–25. A user posts a branding request via Kodekey GUI 301, which prompts the user to enter a token and press the redeem button. *Id.* at 6:65–67, 7:1–3. Product metadata 302 is associated with the digital media to be acquired. *Id.* at 7:3–4. The Kodekey GUI is connected to token database 305. *Id.* at 7:6–7. The user is then redirected to APIwebsite.com GUI 307, which prompts the user to enter a login id and password to access the digital media from database 309. *Id.* at 7:10–11, 14–

17. The APIwebsite.com GUI interfaces to a web service membership, where the user's electronic identification is collected and sent back to the Kodekey GUI. *Id.* at 7:10–14. The database containing the digital media is connected to the web service membership. *Id.* at 7:17–19.

B. Illustrative Claim

Petitioner challenges claims 1–26 of the '555 patent. Claims 1, 12, and 15 are independent. Claim 1 is illustrative of the claims under challenge:

1. A method for monitoring access to an encrypted digital media, the method facilitating interoperability between a plurality of data processing devices, the method comprising:

receiving an encrypted digital media access branding request from at least one communications console of the plurality of data processing devices, the branding request being a read or write request of metadata of the encrypted digital media, the request comprising a membership verification token provided by a first user, corresponding to the encrypted digital media;

authenticating the membership verification token, the authentication being performed in connection with a token database;

establishing a connection with the at least one communications console wherein the communications console is a combination of a graphic user interface (GUI) and an Application Programmable Interface (API) protocol, wherein the API is related to a verified web service, the verified web service capable of facilitating a two way data exchange to complete a verification process;

requesting at least one electronic identification reference from the at least one communications console wherein the electronic identification reference comprises a verified web service account identifier of the first user;

receiving the at least one electronic identification reference from the at least one communications console; and
branding metadata of the encrypted digital media by writing the membership verification token and the electronic identification reference into the metadata.

C. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–26 of the ’555 patent on the following grounds.¹ Pet. 4, 14–59.

Reference(s)	Basis	Claims Challenged
DeMello ²	§ 102	1–6, 8–22, 24, and 25
DeMello, Wieder, ³ and “the admitted prior art”	§ 103	1–10, 12–15, and 17–24
Pestoni ⁴	§ 102	1–10, 12–15, and 17–24
Pestoni, Wieder, and “the admitted prior art”	§ 103	1–10, 12–15, and 17–24
DeMello, Wieder, Wisner, ⁵ and “the admitted prior art”	§ 103	11, 16, 25, and 26

¹ In summarizing its asserted grounds on page 4 of the Petition, Petitioner requests cancellation of claims 1–26 as unpatentable under 35 U.S.C § 103 based on “[t]wo main references,” but states on page 14 of the Petition that the same references “anticipate and/or render obvious the claimed subject matter.” Given the substance of Petitioner’s arguments, we address claims 1–25 under 35 U.S.C. §§ 102 and 103. We address claim 26 under only 35 U.S.C. § 103 because Petitioner does not present an anticipation argument for this claim.

² DeMello, U.S. Patent No. 6,891,953 B1, issued May 10, 2005 (Ex. 1005).

³ Wieder, U.S. Patent No. 8,001,612 B1, issued Aug. 16, 2011 (Ex. 1007).

⁴ Pestoni, U.S. Publ’n No. 2008/0313264 A1, published Dec. 18, 2008 (Ex. 1006).

⁵ Wisner, U.S. Patent No. 6,385,596 B1, issued May 7, 2002 (Ex. 1008).

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