

UNITED STATES PATENT AND TRADEMARK OFFICE

IN THE UNITED STATES PATENT TRIAL AND APPEAL BOARD

NETAPP, INC., LENOVO (UNITED STATES) INC., and EMC CORP.,
Petitioner

v.

INTELLECTUAL VENTURES II, LLC
Patent Owner

CASE IPR: IPR2017-00467
U.S. PATENT NO. 6,968,459

REQUEST FOR REHEARING

Mail Stop *Patent Board*
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), NetApp, Inc., Lenovo (United States) Inc., and EMC Corp. (collectively “Petitioner”) respectfully request that the Board reconsider its decision not to institute *inter partes* review (“IPR”) of U.S. Patent No. 6,968,459 (“459 Patent”) on the basis of Ground 2 as presented in the Petition (Paper 1) in this proceeding. Specifically, Petitioner requests that the Board reconsider its decision that the Petition did not show that there is “a reasonable likelihood that petitioner would prevail” in showing that at least one of claims 15, 18, 24 and 25 is obvious over Uchida in view of Bramhill. 35 U.S.C. §314(a); Paper 10 (“Institution Decision”) at pp. 13-15.

This Request for Rehearing focuses on two specific portions of the Petition that Petitioner believes the Board misapprehended or overlooked, and identifies the portions of the Petition (and evidence submitted with the Petition) that set forth each matter. 37 C.F.R. § 42.71(d).

II. CLAIMS 15, 18, 24, AND 25 ARE OBVIOUS OVER UCHIDA AND BRAMHILL (PETITION GROUND 2)

a. The Petition Explained the Combination of Uchida with Bramhill

On page 14 of the Institution Decision, the Board found that “[n]either Petitioner nor Mr. Justice explains how Bramhill’s cybermetrics would be combined with Uchida’s passwords in order to provide restricted-access preventing

data from being written when the device-specific security information is not sensed.” Institution Decision, p. 14.

Petitioner respectfully submits that the “Motivation to Combine” section of the Petition, supported by Mr. Jestice’s declaration at ¶¶87-88, with regard to Ground 2 sets forth the explanation the Board found to be lacking and overlooked. In particular, page 49 of the Petition states: “A POSA would have been motivated to **modify the *source* for Uchida’s security with the cybermetrics disclosures of Bramhill.**” Petition, p. 49.¹ Pages 49 and 50 of the Petition, as well as cited paragraphs 87 and 88 of Mr. Jestice’s declaration, explain why “a POSA would understand **Bramhill’s use of a cybermetric as an alternate or addition to the security information disclosed in Uchida.**” Petition, pp. 49-50; Ex. 1002, ¶87.

Mr. Jestice also explained that the combination of Bramhill and Uchida “would have involved combining known methods and systems, for example, using the **device-specific disk formatting information disclosed in Bramhill either in addition to or in place of the password disclosed in Uchida,** and basing an encryption/decryption code on such device-specific security information.” Ex. 1002, ¶88 (cited on page 50 of the Petition). He further explained the combination in paragraph 91 (cited on page 51 of the Petition).

¹ All emphasis is added unless indicated otherwise herein.

Petitioner submits that the Board appears not to have considered the combination analysis provided in the Petition (and cited evidence, including the testimony of Mr. Jestice) with regard to *how* Uchida would have been combined with Bramhill. Accordingly, Petitioner requests rehearing with regard to the issue of the combinability of Uchida and Bramhill.

b. The Petition Relied on Uchida’s Disclosure of Restricted-Access to a Subset of a Disk

On page 14 of the Institution Decision, the Board asserted that “Uchida fails to teach restricted-access preventing writing data when the disk is not password protected (i.e., when the storage device does not contain the device-specific security information).” Institution Decision, p. 14. Petitioner requests rehearing of this determination. Rehearing is appropriate because Petitioner believes the Board misapprehended or overlooked the portions of Uchida (and the corresponding testimony of Mr. Jestice) that the Petition relies on as satisfying this limitation.

The Board assumed for purposes of its Institution Decision that “Uchida’s passwords meet the claimed device-specific security information” in claims 15 and 18. Institution Decision, p. 14. Notwithstanding, the Board relied on only a portion of one cited embodiment of Uchida—a portion that the Petition did not rely on in explaining why the claims of the ‘459 Patent are obvious—to decide to deny institution of Ground 2 on the ground that Uchida did not disclose restricted access

when the disk is not password protected. In particular, the Institution Decision relied on step 62 of Figure 10 of Uchida, and overlooked the steps of Figure 10 (namely, Steps 63, 64, 65 and 66 of Figure 10) that the Petition actually relies on with regard to the restricted-access recited in claims 15 and 18. Institution Decision, p. 14 (citing to step 62 of Uchida at 11:51-53); Petition, pp. 62-64, 67-68 (addressing “restricted-access” and “prevent write access” limitations of claims 15 and 18, respectively); *see also* pp. 54-56, 68-70 (addressing “full-access” and “permit write access” limitations of claims 15 and 18, respectively), p. 45 (“partial read access may be granted on one correct password...whereas full read and write access...may be granted based on a different correct password.”). The Board concluded that “Uchida thus teaches allowing full access rather than restricted access, when the storage device does not store the device-specific security information.” Institution Decision, p. 14.

However, as set forth in the Petition, “the predetermined password of Uchida is an example of the device specific security information stored on the security device.” *See, e.g.*, Petition, p. 53. The Petition also explains that in the embodiment of Uchida where “a user enters a password and ‘the first [predetermined] password coincides, a user is allowed to access *all* of the bands 0-9, and when the second [predetermined] password coincides, the user is allowed to access only the band 0.’” Petition, p. 54 (square brackets in Petition); *see also* p.

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