

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

INTELLECTUAL VENTURES II, LLC,
Patent Owner.

Case IPR2017-00467
Patent 6,968,459 B1

Before THOMAS L. GIANNETTI, PATRICK M. BOUCHER, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

NetApp, Inc., Lenovo (United States) Inc., and EMC Corporation (collectively, “Petitioner”) requested an *inter partes* review of claims 15, 18, 24, and 25 (the “challenged claims”) of U.S. Patent No. 6,968,459 B1 (“the ‘459 patent”). Paper 1 (“Petition” or “Pet.”). Patent Owner Intellectual Ventures II, LLC filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). We denied the Petition and did not institute an *inter partes* review. Paper 10 (“Dec.”). Petitioner requests rehearing of our decision not to institute review. Paper 11 (“Reh’g Req.”).

“The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). We “review [our] decision for an abuse of discretion.” *Id.* § 42.71(c). The request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* § 42.71(d).

After considering the Request for Rehearing, we determine that Petitioner has not demonstrated that we abused our discretion in denying institution. We deny the Request for Rehearing for the following reasons.

II. BACKGROUND

Petitioner advanced two grounds of unpatentability, namely that all challenged claims would have been rendered obvious by the combination of Blakley¹ and Bramhill² or, alternatively, by the combination of Uchida³ and

¹ Blakley III et al., U.S. Patent No. 5,677,952, iss. October 14, 1997 (Ex. 1005).

² Ian D. Bramhill & Mathew Sims, Copyright in a Digital Age, BT Technol. J. Vol. 15 No. 2 (April 1997) (Ex. 1007).

³ Uchida, U.S. Patent No. 7,124,301 B1, iss. October 17, 2006 (Ex. 1006).

Bramhill. Pet. 16. Petitioner does not request rehearing of our disposition of its challenges combining Blakley and Bramhill, and instead only requests rehearing of our disposition of its grounds asserting Uchida and Bramhill. Reh’g Req. 1 (citing Dec. 13–15).

In our Decision, we determined Petitioner failed to show a reasonable likelihood of success on its challenges combining Uchida and Bramhill because Petitioner failed to show teachings or suggestions sufficient to meet the following limitation of independent claim 15: “providing restricted-access to the storage device when the storage device does not store the device-specific security information by preventing the digital data from being written to the storage device during the write access.” Dec. 13–15. We similarly determined Petitioner failed to show teachings or suggestions sufficient to meet the commensurate limitation recited in independent claim 18: “configuring the storage drive to prevent write access to the storage device when the security information is not sensed.” *Id.* at 15.

III. ANALYSIS

Petitioner argues that we erred in our Decision for two reasons. First, according to Petitioner, “the Board appears not to have considered the combination analysis provided in the Petition (and cited evidence, including the testimony of Mr. Justice) with regard to *how* Uchida would have been combined with Bramhill.” Reh’g Req. 3. Second, Petitioner asserts that our review of its Uchida analysis addressed Step 62 of Uchida’s Figure 10, “but did not address the relied-on logic of Uchida that follows Step 62 of Figure 10 (namely, Steps 63, 64, 65 and 66 of Figure 10).” *Id.* at 6.

Having considered Petitioner’s arguments in its Request for Rehearing, we are not persuaded that we abused our discretion. Petitioner

first contends that we overlooked the “Motivation to Combine” section of its Petition, wherein Petitioner asserts one of ordinary skill in the art would use Bramhill’s cybermetrics either in addition to or in place of the passwords disclosed in Uchida. Reh’g. Req. 2 (citing Pet. 49–51; Ex. 1002 ¶¶ 87, 88, 91). Petitioner’s argument is not responsive to the deficiency we identified. We stated in our Decision that even if “Uchida’s passwords meet the claimed device-specific security information, 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).” Dec. 14 (emphasis added). Adding to or replacing Uchida’s passwords with Bramhill’s cybermetrics does not explain how Uchida, even with the proposed password/cybermetric combination, would prevent data from being written when the password/cybermetric combination is not stored (claim 15) or sensed (claim 18). *Id.*

We are similarly not persuaded by Petitioner’s second argument that we overlooked Petitioner’s reliance on the “logic of Uchida that follows Step 62 of Figure 10 (namely, Steps 63, 64, 65 and 66 of Figure 10)” because this logic is not relevant to our findings. As Petitioner admits, Figure 10 of Uchida describes actions taken when Uchida’s removable optical magnetic disk is protected by two pre-determined passwords, which are stored on the disk. Pet. 63 (citing Ex. 1006, 3:31–34; Ex. 1002, ¶¶ 177–178); *see also* Reh’g. Req. 4. Claims 15 and 18, however, require preventing writing to the disk “when the disk is *not* password protected (i.e., when the storage device does *not* contain the device-specific security information).” Dec. 14 (emphases added). As we explained in our Decision, Petitioner fails to show that Uchida meets the language of the challenged claims because STEP S62

of Uchida’s Figure 10 “teaches allowing full access, rather than restricted access, when the storage device does not store the device-specific security information.” *Id.* With regard to independent claim 18, we stated, “[l]ike Figure 10 discussed in Section IV.C.1 above, Figure 9 describes writing data when Uchida’s disk is not password protected.” *Id.* at 15 (citing Ex. 1006, 10:65–66 (“If it is not protected by a password, the data is written (STEP S52)”). We thus are not persuaded by Petitioner’s second argument because it does not address Petitioner’s failure to show how Uchida’s methods purportedly teach preventing writing when Uchida’s disk is not password protected.

IV. CONCLUSION

Upon consideration of the Petitioner’s Request for Rehearing, the Petition, the Preliminary Response, and the evidence before us, we determine that Petitioner has not established that we abused our discretion in denying institution of an *inter partes* review based on its grounds asserting the combination of Uchida and Bramhill against claims 15, 18, 24, and 25. Accordingly, we deny the Request for Rehearing.

V. ORDER

It is hereby

ORDERED that the Request for Rehearing is denied.

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