UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MASTERCARD INTERNATIONAL INCORPORATED,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

_____

Cases IPR2017-00788
Patent 8,402,555 B2

_____

Before JAMESON LEE, MICHAEL W. KIM, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge*.

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

I.   BACKGROUND

In a Decision rendered on July 3, 2017, we denied institution of trial
with respect to claims 1–26 of U.S. Patent No. 8,402,555 B2 ("the '555
patent") on any alleged ground of unpatentability asserted in the Petition.

Paper 7 ("Dec."). The Decision stated that the Petition alleged the following grounds of unpatentability:

Claim(s) Challenged	Basis	References
1–25	§ 103(a)	Ameerally and Zweig, with further support by Frakes, Gautier, Anderson, Taylor, Christman, and iTunes® Terms
26	§ 103(a)	Ameerally, Zweig, Kondrk, and Suitts, with further support by Frakes, Gautier, Anderson, Taylor, Christman, and iTunes® Terms

Id. at 7.

On August 2, 2017, Petitioner filed a Request for Rehearing ("Request" or "Req. Reh'g") (Paper 8). Petitioner requests that we "reconsider obviousness under Section 103 of claims 1–11 and 15–23 of the '555 Patent." *Id.* at 2.

On request for rehearing, the burden of showing a decision on whether to institute trial should be modified lies with the party challenging the decision. 37 C.F.R. § 42.71(d). "When rehearing a decision on petition, a panel will review the decision for an abuse of discretion." 37 C.F.R. § 42.71(c). "The request 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." 37 C.F.R. § 42.71(d). For reasons discussed below, we decline to modify the Decision to institute trial on any claim. Thus, Petitioner's Request is *denied*.

II.   DISCUSSION

Petitioner frames the issue for this rehearing request as follows:

> Independent claim 1 of the '555 Patent recites a method that can be broken into six steps. (Decision, p. 5). Independent claim 15 recites a computer program that performs the steps recited in claim 1. (Decision, p. 4). Step six is "branding metadata of the encrypted digital media by writing (a) the membership verification token and (b) the electronic identification reference into the metadata." (Ex. 1001, col. 14, lns. 62–64) (annotated with "(a)" and "(b)" for clarity.
>
> The Board concluded that the Petitioner's evidence showed steps 1–5 and subpart (a) of step 6. (Decision pp. 32–33). However, the Board determined that Petition did not show that the prior art taught subpart (b) of step 6, specifically "branding metadata of the encrypted digital media by writing . . . (b) the electronic identification reference into the metadata."
>
> Petitioner submits that the Board misapprehended or overlooked evidence presented in the Petition regarding subpart (b) of step 6 and the state of the art at the time of the claimed invention.

Req. Reh'g 2 (footnote omitted).

We did not misapprehend or overlook any evidence presented by Petitioner in the Petition regarding subpart (b) of step 6 of independent claims 1 and 15, including the state of the art at the time of the claimed invention. Rather, as we indicated in the Decision, Petitioner has not adequately explained why that which Petitioner regards as the electronic identification reference written into the metadata, as recited in subpart (b) of step 6, is or comes from the login information supplied by the user, i.e., the user's email address, that the iTunes® system had requested and received according to the prior steps of claims 1 and 15. Dec. 32–33. That is what claims 1 and 15 require, and sufficient explanation is lacking in the Petition.

For instance, with respect to Petitioner's discussion of Frakes, we stated:

> The Figure illustrates detailed information kept by Frakes' iTunes® system for a digital movie file. *Id.* at 4. Petitioner asserts: "*Frakes* illustrates 'Purchased By' and 'Account Name' in the metadata of the iTunes® media file (grayed out in image for privacy, but field illustrated), such that the claimed 'electronic identification reference' was necessarily written into the metadata as saved by iTunes®. (Cherukuri Decl. ¶ 139)." Pet. 41–42. However, neither Petitioner nor Mr. Cherukuri explains why the "Purchased By" or "Account Name" field is necessarily the login information, e.g., the user's e-mail address, that the iTunes® system had requested and received, as had been explained by Petitioner and Mr. Cherukuri above when accounting for requesting an electronic identification reference and receiving the electronic identification reference. It is not explained why the fields cannot be another identification reference.

Dec. 32. With respect to Petitioner's discussion of Zweig, we stated:

> The argument [about Zweig] establishes that, in the metadata for the digital content purchased or downloaded by a user, there is an identifier, an electronic identification reference, that identifies that user. However, neither Petitioner nor Mr. Cherukuri explains why that identifier in the metadata is necessarily the login information, i.e., the user's e-mail address, that the iTunes® system had requested and received, as had been explained by Petitioner and Mr. Cherukuri above when accounting for requesting an electronic identification reference and receiving the electronic identification reference. It is not explained why the fields cannot be another identification reference . . . .

Id. at 32–33. With respect to the other references, we stated:

> As applied by Petitioner, none of the other prior art references, on this record, makes up for this deficiency with regard to the step or operation of "branding metadata of the encrypted digital media by writing the membership verification

token and the electronic identification reference into the metadata" recited in claims 1, 12, and 15.

Id. at 33.

Petitioner in the Request identifies various other portions of prior art, *not* identified and explained in the Petition in connection with what Petitioner identifies as step 6 of claims 1 and 15: "branding metadata of the encrypted digital media by writing the membership verification token and the electronic identification reference into the metadata." Req. Reh'g 5–12. Petitioner points to Figure 5 of Ameerally and Figure 7B of Gautier, each of which shows in the upper right-hand corner of a screen shot of an iTunes display an email address in a box named "Account." *Id.* at 6–7. Petitioner does not point out where in the Petition such specific identification *and* corresponding explanation exist in connection with the last step, i.e., step 6, of claims 1 and 15. Petitioner also notes a screenshot appearing in Taylor, on the upper right-hand corner of which is an unlabeled box containing an email address. *Id.* at 6. Petitioner does not point out where in the Petition such specific identification, and any corresponding explanation, exist for the last step, i.e., step 6, of claims 1 and 15.

Similarly, Petitioner cites to and reproduces text from Gautier's Paragraph 83, and notes that that text refers to "account identifier" by the description "such as an email address." *Id.* at 8. Petitioner suggests that that disclosure from Gautier is discussed on page 39 of the Petition. Req. Reh'g 8. Page 39 of the Petition does not contain any discussion or explanation with regard to Paragraph 83 of Gautier, especially with regard to the last step of claims 1 and 15. In any event, the quoted text from Gautier actually undermines Petitioner's position, in that it describes the user's email address only as an example of an account identifier, by use of the language "such

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