

Filed on behalf of William Grecia
By: Isaac Rabicoff (isaac@rabilaw.com)
Rabicoff Law LLC
73 W Monroe St
Chicago, IL 60603
Tel: (773) 669-4590

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED
Petitioner

v.

WILLIAM GRECIA
Patent Owner

Case No.: IPR2017-00793
Patent 8,887,308

**PRELIMINARY RESPONSE BY PATENT OWNER WILLIAM
GRECIA**

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INTRODUCTION

William Grecia owns U.S. Patent No. 8,887,308 (the “308 patent”), which claims “[a] process for transforming a user access request for cloud digital content into a computer readable authorization object” (Ex. 1001 (‘308 patent) at 14:31-33.) This process includes the following six steps, all of which must be performed before the access request is transformed into a computer readable authorization object that may be cross referenced in later access requests by a user:

- receiving a digital content access request through an apparatus (first apparatus), where the request is a write request to a data store and comprises verification data recognized by the first apparatus as a verification token; then
- authenticating the token using a verification token database; then
- establishing a connection between the first apparatus and a database apparatus using an application programmable interface (“API”) related to a verified web service (second apparatus), wherein establishing the API connection requires a credential assigned to the first apparatus and the verified web service completes a verification process through an exchange of query data that includes a verified web service account identifier; then

- requesting the verified web service account identifier; then
- receiving the verified web service account identifier; and, lastly,
- creating the computer readable authorization object by writing at least one of the verification token or the account identifier into the data store.

The ‘308 patent creates a computer readable authorization object that has the capacity for future use: “wherein the created computer readable authorization object . . . is processed by the [first] apparatus . . . using a cross-referencing action during subsequent user access requests” (Ex. 1001 (‘308 patent) at 14:31-33.)

The Examiner supported allowance of the ‘308 patent by reasoning that, although the prior art taught authentication of tokens and writing these tokens into a data store, no one had yet taught steps 3, 4, and 5—*viz.*, “establishing an API communication between the apparatus of (a) and a database apparatus” and requesting from the apparatus (a) at least one verified web service account identifier to complete the verification process. (Ex. 2001 (Notice of Allowance) at 6-7.)

Mastercard’s asserted prior art—Apple’s iTunes system—is repetitive of the prior art that the Examiner considered. Indeed, this prior art lacks an API connection related to a verified web service to complete the verification

process by requesting and receiving a verified web service account identifier.

In fact, none of Mastercard’s references mentions an API connection. Rather, Mastercard relies on its expert in 2017 to say, “The iTunes Music Store necessarily includes an API for interacting with iTunes.” (Ex. 1007 (Alexander Decl.) ¶ 118.) Of course, Mastercard’s expert’s argument cannot be incorporated into the Petition. *See, e.g.*, 37 C.F.R. § 42.6(a)(3) (“Arguments must not be incorporated by reference from one document into another document.”). Even if Mastercard was permitted to incorporate its expert’s argument into the Petition, however, the expert argument could not in any event stand in as a placeholder where disclosure or teaching of a prior art reference should have been. In short, Mastercard fails to assert one prior art reference that suggests an API connection—let alone an API connection related to a verified web service, as required by the ‘308 patent claim.

For this and four other reasons discussed below, Grecia respectfully requests that the Board deny Mastercard’s Petition in its entirety.

BACKGROUND

This section has four parts. Grecia first describes the ‘308 patent. Second, he describes pertinent portions of the file history. Third, Grecia discusses the prior art references that Mastercard asserts against the ‘308

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