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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

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Case No.: IPR2017-00791  
Patent 8,533,860

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**PRELIMINARY RESPONSE BY PATENT OWNER WILLIAM  
GRECIA**

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## INTRODUCTION

William Grecia owns U.S. Patent No. 8,533,860 (the “‘860 patent”), which claims, among other things, “[a] method for authorizing access to digital content using a cloud system . . . .” (Ex. 1001 (‘860 patent) at 14:31-32.) The method includes the following six steps, all of which must be performed before authorized access to the digital content is granted:

- receiving a digital content access request from a communications console (first apparatus), where the request includes a token corresponding to the digital content requested;
- authenticating the token;
- establishing a connection with the first apparatus using an application programmable interface (“API”) related to a verified web service (second apparatus), wherein the web service completes a verification process;
- requesting at least one identification reference;
- receiving the at least one identification reference; and
- writing at least one of the verification token or the identification reference into the metadata of the digital content.

The Examiner supported allowance of the ‘860 patent by reasoning that, although the prior art taught authentication of tokens and writing these

tokens into the metadata of digital content, no one had yet taught steps 3, 4, and 5—*viz.*, “establishing a connection with a verified web service” and “requesting [and receiving] at least one identification reference from the at least one communications console . . . .” (Ex. 2001 at 13-15.)

Mastercard’s asserted prior art—Apple’s iTunes system—is repetitive of the prior art that the Examiner considered. All of this prior art lacks an API connection related to a verified web service to complete the verification process by requesting and receiving an identification reference.

In fact, none of Mastercard’s references mentions an API connection. Rather, Mastercard relies on its expert in 2017 to say, “Use of an API such as the iTunes store search API to communicate with the iTunes store (i.e., server) is well known to one of ordinary skill in the art at the time of the invention.” (Ex. 1019 (Cherukuri Decl.) ¶ 131.) 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 ‘860 patent claims

Instead, the Mastercard references disclose what the Examiner determined other prior art discloses: authenticating and writing verification tokens into the metadata of the digital content—steps 1, 2, and 6 of the ‘860 method.

For this reason, Grecia respectfully requests that the Board deny Mastercard’s petition as to all challenged claims.

## **BACKGROUND**

This section has four parts. Grecia first describes the ‘860 patent. Second, he describes pertinent portions of the file history. Third, Grecia discusses the prior art references that Mastercard asserts against the ‘860 patent. And, fourth, Patent Owner concludes with a statement that he does not believe that claim construction is required to resolve this controversy between him and Mastercard.

### **I. The ‘860 Patent**

In summary, claim 1 consists of six steps: First, “receiving a digital content access request” that includes “a verification token provided by a first user corresponding to the digital content . . . .” (Ex. 1001 at 14:38-46.)

Second, “authenticating the verification token . . . .” (*Id.*)

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