UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EARLY WARNING SERVICES, LLC,
Petitioner,

v.

WILLIAM GRECIA,
Patent Owner.

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IPR2020-00763
Patent 8,887,308 B2

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

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I.   INTRODUCTION

Early Warning Services, LLC ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claim 1 of U.S. Patent No. 8,887,308 B2 (Ex. 1001, "the '308 patent"). William Grecia ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.").[1] With our authorization, Petitioner filed a Reply (Paper 8) to Patent Owner's Preliminary Response, and Patent Owner filed a Sur-Reply (Paper 9) to Petitioner's Reply. *See* Paper 7. We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we decline to institute an *inter partes* review of the challenged claim.

II.   BACKGROUND

A. Related Proceedings

The parties identify several federal district court cases relating to the '308 patent. Pet. 1–2; Paper 5, 2. The parties also identify several other petitions for *inter partes* review relating to the '308 patent. Pet. 2–3; Paper 5, 2.

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[1] We note that Patent Owner captioned Paper 6 as "Mandatory Notices." This appears to be a typographical error. Accordingly, we treat Paper 6 as Patent Owner's Preliminary Response.

B. The '308 Patent

The '308 patent describes a digital rights management system, that manages access rights across a plurality of devices via digital media personalization, to protect digital media subject to illegal copying. Ex. 1001, 1:20–27, 4:48–49. To illustrate, Figure 3 of the '308 patent is reproduced below.
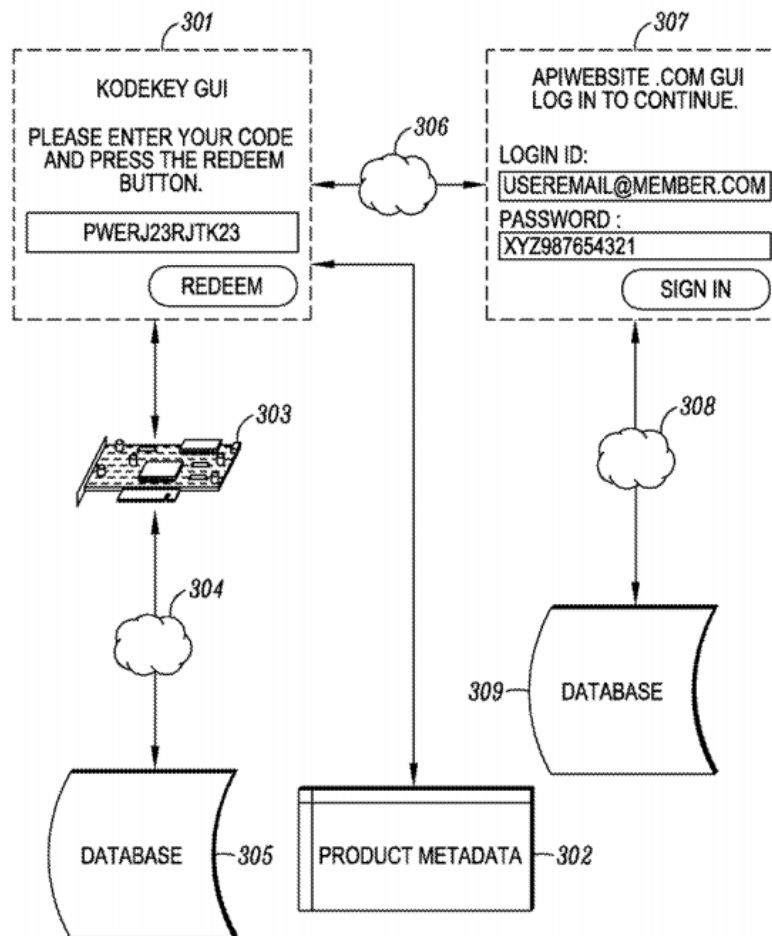

FIG. 3

Figure 3 is a flow chart of a digital media personalization process. *Id.* at 4:23–25. A user wishing to access certain digital media (e.g., videos, audios, games) posts a branding request via Kodekey GUI 301, which prompts the user to enter a token and press the redeem button. *Id.* at 6:19–

21, 6:66–7:4. The branding request is a request to read or write metadata associated with the digital media and includes a membership verification token corresponding to the digital media. *Id.* at 5:48–51. The token may be a unique serial number assigned to the digital media. *Id.* at 6:38–40. It represents the digital media provider's permission to grant access rights. *Id.* at 9:21–23. Kodekey GUI 301 is connected to token database 305, which reads, writes, and store tokens. *Id.* at 7:7–11. Token database 305 is used to authenticate the token entered at Kodekey GUI 301. *Id.* at 8:20–22; *see also id.* at 8:53–56 ("According to an embodiment of the present invention, an identifier for the digital media is stored in a database with another database of a list of associated tokens for cross-reference identification for verification.").

After authentication, the user is redirected to APIwebsite.com GUI 307, which prompts the user to enter a login ID and password to access the digital media from database 309. *Id.* at 7:11–12, 15–18. The APIwebsite.com GUI interfaces to a web service membership (e.g., Facebook), where an electronic identification for the user is collected and sent to Kodekey GUI 301. *Id.* at 7:11–15, 10:41–46. Kodekey GUI 301 also is connected to product metadata 302, which is readable and writable metadata associated with the digital media to be acquired. *Id.* at 7:4–5. Product metadata 302 is branded by writing the token and the user's electronic identification reference into the metadata. *Id.* at 8:28–31.

For a subsequent access request, the user's electronic identification reference is compared against the electronic identification reference in metadata 302. *Id.* at 13:52–56. If there is a match, access rights are granted to the user. *Id.* at 13:56–61.

C. Challenged Claim

Petitioner challenges claim 1 of the '308 patent:

1. A process for transforming a user access request for cloud digital content into a computer readable authorization object, the process for transforming comprising:

a) receiving an access request for cloud digital content through an apparatus in process with at least one CPU, the access request being a write request to a data store, wherein the data store is at least one of:

a memory connected to the at least one CPU;

a storage connected to the at least one CPU; and

a database connected to the at least one CPU through the Internet; wherein

the access request further comprises verification data provided by at least one user, wherein the verification data is recognized by the apparatus as a verification token; then

b) authenticating the verification token of (a) using a database recognized by the apparatus of (a) as a verification token database; then

c) establishing an API communication between the apparatus of (a) and a database apparatus, the database apparatus being a different database from the verification token database of (b) wherein the API is related to a verified web service, wherein the verified web service is a part of the database apparatus, wherein establishing the API communication requires a credential assigned to the apparatus of (a), wherein the apparatus assigned credential is recognized as a permission to conduct a data exchange session between the apparatus of (a) and the database apparatus to complete the verification process, wherein the data exchange session is also capable of an exchange of query data, wherein the query data comprises at least one verified web service account identifier; then

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