

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, INC.,  
Petitioner,

v.

PERSONALWEB TECHNOLOGIES, LLC and  
LEVEL 3 COMMUNICATIONS, LLC,  
Patent Owners.

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Case IPR2014-00702  
Patent 5,978,791

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Before KEVIN F. TURNER, JONI Y. CHANG, and  
MICHAEL R. ZECHER, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. INTRODUCTION

Unified Patents, Inc. (“Unified”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–4, 29–33, 35, and 41 of U.S. Patent No. 5,978,791 (“the ’791 patent,” Ex. 1001). Paper 1. PersonalWeb Technologies, LLC and Level 3 Communications, LLC (collectively “PersonalWeb”) timely filed a Patent Owner Preliminary Response (“Prelim. Resp.”). Paper 8. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

**THRESHOLD.**—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Based on the particular circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d) and deny the Petition.

### A. *Related Matters*

Unified identifies three other Petitions for *inter partes* review filed by third parties that involve the ’791 patent: (1) *EMC Corp. and VMware, Inc. v. PersonalWeb Techs., LLC*, IPR2013-00082 (we held claims 1–4, 29–33, and 41 unpatentable as being anticipated by, or obvious over, Woodhill, and our decision in that regard now is on appeal before the United States Court of Appeals for the Federal Circuit); (2) *NetApp, Inc. v. PersonalWeb Techs.*

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*LLC*, IPR2013-00319 (we denied the Petition as to claims 1–3, 29, and 35); and (3) *Rackspace US, Inc. v. PersonalWeb Techs. LLC*, IPR2014-00057 (we instituted an *inter partes* review as to claims 1–4, 29–33, 35, and 41 as being anticipated by, or obvious over, Woodhill). Pet. 3. In addition, Unified indicates that the '791 patent is the subject of a pending *ex parte* reexamination titled U.S. Patent Application No. 90/012,931. *Id.* Unified also identifies numerous matters where PersonalWeb asserted claims of the '791 patent against third parties, as well as ten other Petitions for *inter partes* review filed by third parties that are related to other patents owned by PersonalWeb. *Id.* at 4–6.

Unified filed its Petition along with a Motion for Joinder requesting that we join this proceeding with IPR2014-00057. Paper 3. In a decision entered concurrently, Unified's Motion for Joinder is denied.

#### *B. The Invention of the '791 Patent*

The invention of the '791 patent relates to a data processing system that identifies data items using substantially unique identifiers, otherwise referred to as True Names, which depend on all the data in the data item and only on the data in the data item. Ex. 1001, 1:14–18; 3:29–32, 6:6-10. According to the '791 patent, the identity of a data item depends only on the data and is independent of the data item's name, origin, location, address, or other information not directly derivable from the data associated therewith. *Id.* at 3:33–35. The invention of the '791 patent also examines the identities of a plurality of data items in order to determine whether a particular data item is present in the data processing system. *Id.* at 3:36–39.

*C. Illustrative Claims*

Claims 1, 30, 33, and 35 are independent claims. Claims 2–4 and 29 depend directly or indirectly from independent claim 1. Claims 31, 32, and 41 depend directly or indirectly from independent claim 30. Independent claims 1, 30, 33, and 35 are illustrative of the invention of the '791 patent and are reproduced below:

1. In a data processing system, an apparatus comprising:

identity means for determining, for any of a plurality of data items present in the system, a substantially unique identifier, the identifier being determined using and depending on all the data in the data item and only the data in the data item, whereby two identical data items in the system will have the same identifier; and

existence means for determining whether a particular data item is present in the system, by examining the identifiers of the plurality of data items.

Ex. 1001, 39:14–23.

30. A method of identifying a data item present in a data processing system for subsequent access to the data item, the method comprising:

determining a substantial unique identifier for the data item, the identifier depending on and being determined using all of the data in the data item and only the data in the data item, whereby two identical data items in the system will have the same identifier; and

accessing a data item in the system using the identifier of the data item.

*Id.* at 42:58–67.

33. A method of duplicating a given data item present at a source location to a destination location in a data processing system, the method comprising:

determining a substantially unique identifier for the given data item, the identifier depending on and being determined using all of the data in the data item and only the data in the data item, whereby two identical data items in the system will have the same identifier;

determining, using the data identifier, whether the data item is present at the destination location; and

based on the determining whether the data item is present, providing the destination location with the data item only if the data item is not present at the destination.

*Id.* at 43:11–23.

35. A method for determining whether a particular data item is present in a data processing system, the method comprising:

(A) for each data item of a plurality of data items present in the system,

(i) determining a substantially unique identifier for the data item, the identifier depending on and being determined using all the data in the data item and only the data in the data item, whereby two identical data items in the system will have the same identifier; and

(ii) making and maintaining a set of identifiers of the plurality of data items; and

(B) for the particular data item,

(i) determining a particular substantially unique identifier for the data item, the identifier depending on and being determined using all of the data in the data item and only the data in the data item, whereby two identical data items in the system will have the same identifier; and

(ii) determining whether the particular identifier is in the set of data items.

*Id.* at 43:42–63.

*D. Prior Art Relied Upon*

Unified relies upon the following prior art reference:

Woodhill      US 5,649,196      July 15, 1997      Ex. 1003  
(effectively filed July 1, 1993)

*E. Alleged Grounds of Unpatentability*

Unified challenges claims 1–4, 29–33, 35, and 41 of the '791 patent based on the alleged grounds of unpatentability set forth in the table below. Pet. 7–8, 29-58.

<b>Reference</b>	<b>Basis</b>	<b>Challenged Claims</b>
Woodhill	§ 102(e)	1–4, 29–33, 35, and 41
Woodhill	§ 103(a)	1–4, 29–33, 35, and 41

II. ANALYSIS

PersonalWeb contends that multiple, overlapping petitions, each of which presents grounds of unpatentability based on Woodhill for many of the same claims, should not be instituted for the '791 patent. Prelim. Resp. 1. In particular, PersonalWeb notes that it appealed our decision in IPR2013-00082 to the Federal Circuit, in which we concluded that, based on a preponderance of the evidence, claims 1–4, 29–33, and 41 of the '791 patent were unpatentable as anticipated by, or obvious over, Woodhill. *Id.* at 1–2. PersonalWeb then contends that, if the Federal Circuit affirms

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our decision in IPR2013-00082, it would have been a waste of time, effort, and resources to re-litigate the same issues in this proceeding. *Id.* at 2.

PersonalWeb further contends that, even if the Federal Circuit reverses our decision in IPR2013-00082, it still would have been a waste of time, effort, and resources to re-litigate the same issues in this proceeding because all the challenged claims are under review in IPR2014-00057. *Id.* We agree with PersonalWeb.

We have discretion under 35 U.S.C. § 325(d) to reject a petition when the same or substantially the same prior art or arguments were presented previously in another proceeding before the Office. The relevant portions of that statute are reproduced below:

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d).

Although we recognize that, as a result of our decision, Unified will not have an opportunity to submit arguments or evidence with respect to claims 1–4, 29–33, 35, and 41 of the '791 patent, there are sufficient reasons to exercise our discretion to deny the Petition in this proceeding. Notably, in IPR2013-00082, we held that claims 1–4, 29–33, and 41 of the '791 patent are unpatentable as anticipated by, or obvious over, Woodhill, the same reference being asserted in this proceeding. *Compare* IPR2013-00082, Paper 83, 16–56, 66 *with* Pet. 7–8, 29–58. With the exception of claim 35,

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the pending outcome of IPR2013-00082 before the Federal Circuit may render moot the need to reach a final written decision regarding the patentability of claims 1–4, 29–33, and 41 of the '791 patent in this proceeding.

In IPR2014-00057, claims 1–4, 29–33, 35, and 41 of the '791 patent were challenged by Rackspace US, Inc. and Rackspace Hosting, Inc. (collectively “Rackspace”) as anticipated by, or obvious over, Woodhill. IPR2014-00057, Paper 1, 28–59. Upon reviewing the information presented in that Petition, as well as the arguments presented by PersonalWeb in its corresponding Preliminary Response, we concluded that Rackspace had shown a reasonable likelihood it would prevail in challenging claims 1–4, 29–33, 35, and 41 as anticipated by, or obvious over, Woodhill. IPR2014-00057, Paper 9, 25–26. The Petition in this proceeding challenges each claim that already is subject to an *inter partes* review in IPR2014-00057. *Compare* Pet. 7–8, 29–58 *with* IPR2014-00057, Paper 9, 26. Therefore, regardless of the outcome of IPR2013-00082 before the Federal Circuit, each of the challenged claims is under review in IPR2014-00057 and, if that trial were to proceed to a final written decision, a determination will be made as to whether claims 1–4, 29–33, 35, and 41 are unpatentable as anticipated by, or obvious over, Woodhill.

Taking into consideration the efficient administration of the Office under 35 U.S.C. § 316(b), as well as the reasons set forth in the decision denying Unified’s Motion to Joinder entered concurrently, we exercise our discretion under 35 U.S.C. § 325(d) and deny the Petition in this proceeding

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because the same or substantially the same prior art and arguments were presented previously in IPR2013-00082 and IPR2014-00057.

### III. ORDER

Accordingly, it is ORDERED that the Petition is DENIED.

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