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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PERSONAL WEB TECHNOLOGIES, LLC, and
LEVEL 3 COMMUNICATIONS, LLC
Patent Owner and Appellant

Appeal 2020-000459
Reexamination Control 90/013,764
Patent 6,928,442 B2
Technology Center 3900

Before KEVIN F. TURNER, BRADLEY W. BAUMEISTER, and
IRVIN E. BRANCH, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(b) and 306, Patent Owner¹ appeals from the final rejection of claim 7 of US 6,928,442 B2, issued to Farber et al. Aug. 9, 2005, (“the ’442 patent”). 2019 Appeal Br. 30. We have jurisdiction under 35 U.S.C. § 6(b). Oral argument was conducted January 30, 2020. A transcript of the argument is of record.

We REVERSE.

¹ Patent Owner identifies PersonalWeb Technologies, LLC and Level 3 Communications, LLC as the real party in interest. Appeal Brief filed July 22, 2019 (“2019 Appeal Br.”) 1.

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STATEMENT OF THE CASE

Overview of the Procedural History

This is Patent Owner's second appeal to the Board of the Examiner's rejection of claim 7 of the '442 patent. In our prior Decision (*Ex parte Personal Web Technologies, LLC, and Level 3 Communications, LLC*, 2018-003936 (mailed Sept. 25, 2018) ("the '3936 Decision"), we reversed the Examiner's two obviousness rejections of claim 7 under 35 U.S.C. § 103(a). We then exercised our discretionary authority under 37 C.F.R. § 40.50(b), issuing two new grounds of rejection, both also under 35 U.S.C. § 103(a) and also over the same respective prior-art references. *See* '3936 Decision. The differences in the reasoning between the Examiner's original grounds of rejection and the Board's new grounds of rejection are addressed in more detail, below.

In response to the Board issuing the new grounds of rejection and in accordance with 37 C.F.R. § 4.50(b)(1), Patent Owner filed a Request to Reopen Prosecution on November 26, 2018, which request was accompanied by new evidence. After considering Patent Owner's new evidence and arguments, the Examiner maintained the obviousness rejections of claim 7. Final Act. 4 (mailed Mar. 20, 2019) ("2019 Final Act."). Patent Owner now appeals these new grounds of rejection. *See* 2019 Appeal Br.

The present appeal also is the latest appeal of various related proceedings. *See* 2019 Appeal Br. 2–26 (listing approximately 167 related court proceedings, eight related reexaminations before the USPTO, and 29 *inter parte* reviews). Particularly relevant, and discussed below, is the

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2019 decision of the Court of Appeals for the Federal Circuit regarding Patent Owner’s appeal of the final written decision of the Board in an *inter partes* review IPR2013-00596 of US 7,802,310 B2. *PersonalWeb Technologies, LLC v. Apple, Inc.*, 917 F.3d 1376 (Fed. Cir. 2019) (“*PersonalWeb II*”).

The Claimed Invention

Patent Owner describes the present invention as follows:

Data files are distributed across a plurality of computers. The computers may form a network such as a content delivery network (CDN) or a peer-to-peer network. The network may operate as a TCP/IP network such as the Internet. Data files may represent [] digital messages, images, videos or audio signals. For content—data items or files in the system—a name is obtained (or determined), where the name is based, at least in part, on a given function of the data in a data item or file. The given function may be a message digest or hash function, and it may be MD4, MD5, and SHA. A [copy] of a requested file is only provided to licensed (or authorized) parties. The system may check one or more computers for unauthorized or unlicensed content. Content is served based on a measure of availability of servers.

Abstract.

Claim 7 is the sole claim on appeal:

7. A method, in a system in which a plurality of files are distributed across a plurality of computers, wherein some of the computers communicate with each other using a TCP/IP communication protocol, the method comprising:

obtaining a name for a data file, the contents of said data file representing a digital image, the name having been determined using at least a given function of the data in the data file, wherein the data used by the given function to determine the name comprises the contents of the data file; and

in response to a request for the data file, the request including at least the name of the data file, providing a copy of the file from a given one of the plurality of computers, wherein a copy of the requested file is not provided to unlicensed parties or to unauthorized parties.

References

The Examiner relies upon the following prior art:

Name	Reference	Date
Woodhill ²	US 5,649,196	July 15, 1997
Kahn	US 6,135,646	Oct. 24, 2000
Stefik	US 7,359,881 B2	Apr. 15, 2008

The Prior and Current Rejections

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Woodhill and Kahn. 2019 Final Act. 4 (maintaining the obviousness rejection as set forth by the Board in the '3936 Decision). The rationale of the presently appealed rejection, as newly set forth in the '3936 Decision, differs slightly from the rationale of the obviousness rejection, as set forth in the prior final rejection from which the '3936 Appeal was taken. *See* Final Action mailed Mar. 8, 2017 (“2017 Final Action”).

In particular, the Examiner originally found in the 2017 Final Action, that Woodhill discloses most of claim 7’s limitations. 2017 Final Act. 4 (generally adopting Third Part Requester’s rationales, as set forth in the Request for Ex Parte Re-examination, 18–26 (filed June 10, 2016) (“Reexam Request”). In the 2017 Final Action, the Examiner took the position that

² Woodhill issued from application number 08/555,376, filed November 9, 1995 (“the Woodhill '376 Application”). The Woodhill '376 Application is a continuation of parent application number 08/085,598 filed July 1, 1993, now abandoned (“the Woodhill '598 Application”).

Woodhill's disclosure of the granularization restore procedure, as described in relation to Woodhill's Figure 5I, *teaches* claim 7's limitation, "in response to a request for the data file, the request including at least the name of the data file, providing a copy of the file from a given one of the plurality of computers." *See, e.g.*, Examiner's Answer 3 (mailed Sept. 21, 2017) (*incorporating by reference* the proposed rejection of pages 21–26 of the Reexam Request; *see also* Reexam Request 23 ("The identifiers are sent as part of the request to restore a binary object. . . . This technique is illustrated in the flow chart depicted in FIG. 5i."); Woodhill, col. 17, l. 18–col. 18, l. 9; Fig. 5I (describing the process for restoring previous versions of binary objects).

To underscore, the position of Requester and the original position of the Examiner was *not* that Woodhill's granularization restore procedure merely *renders obvious* the act of retrieving a requested data file using a content-based identifier, such as an identifier that is generated using a hash function of the file contents. Rather, the Examiner's and Requester's position was that Woodhill's granularization restore procedure actually *teaches* the act of retrieving a request data file using a content-based identifier, as claimed.

The Examiner further found that Woodhill does *not* teach the following elements: (1) the computers communicate using a TCP/IP protocol, (2) the data files could represent, in particular, digital images; or (3) the files are not provided to unlicensed or unauthorized parties. 2017 Final Act. 4–5. The Examiner found that Kahn teaches these limitations. *Id.* (citing, respectively, Khan, col. 10, ll. 44–46; col. 1, ll. 17–

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19; and col. 2, ll. 17–21). The Examiner determined that motivation existed to combine the references’ teachings in a manner that renders claim 7 obvious. *Id.* at 5.

In the 2017 Final Action, the Examiner additionally rejected claim 7 under 35 U.S.C. § 103(a) as unpatentable over Woodhill and Stefik. The Examiner relied upon Woodhill in the same manner as in the rejection over the combination of Woodhill and Khan. 2017 Final Act. 5–6. The Examiner relied on Stefik for the same teachings that were relied upon in Khan. 2017 Final Act. 6–7 (citing Stefik, col. 26, ll. 50–54; col. 6, ll. 31–33; and col. 7, ll. 6–27).

On appeal of the 2017 Final Action, the Board disagreed with the Examiner, finding that “Woodhill’s granularization restore procedure does not return to the local computer, the particular data entity that was initially requested.” ’3936 Decision 10 (citing Woodhill col. 17, l. 18–col. 18, l. 9). The Board then found claim 7 obvious for a different reason, though. The Board determined that other portions of Woodhill—the disclosure associated with the self-audit routine and Woodhill’s claim 1—at least rendered obvious claim 7’s disputed limitation of retrieving a data file using the content-based identifier. *Id.* at 12–15; *see also* Woodhill, col. 18, ll. 10–38 (explaining how binary object identifiers 74 are calculated and compared as part of the auditing and reporting routine); *id.* claim 1, col. 22, ll. 3–4 (reciting, “said calculated binary object identifier being saved as the name of the associated binary object”).

In the ’3936 Decision, the Board acknowledged, “Woodhill does not expressly state what data is used to access or retrieve binary objects for

performing the self-audit routine.” ’3936 Decision at 13. The Board further reasoned that, nonetheless, it still would have been at least obvious to use the binary object identifiers 74 for retrieving the binary objects when performing the self-audit routine:

Given that Woodhill’s self-audit routine retrieves a binary object to perform the audit,¹ it at least would have been obvious—if not inherent—that some sort of binary object name would be used to retrieve the binary object. Further, given that Woodhill expressly discloses that the binary object identifier can serve as the binary object’s name, it would have been obvious to one of ordinary skill to have used Woodhill’s binary object identifier in the self-audit routine to retrieve the binary object being audited.

’3936 Decision 12.

The Board also provided a motivation for why it would have been at least obvious to use the binary object identifiers 74 in this manner:

Given that Woodhill does not expressly state what data is used to access or retrieve binary objects for performing the self-audit routine, one of ordinary skill would have been motivated to look for possible ways to access or retrieve these objects. Woodhill expressly states the binary object identifier is used as a name of the binary object (e.g., claim 1), which renders the identifier [] a reasonably foreseeable piece of data for performing this task. The fact that Woodhill further discloses that additional data fields alternatively may be used to request binary objects does not negate the fact that the binary object identifier is one of the data fields one of ordinary skill would [have] consider[ed] using.

’3936 Decision 13 (citation omitted).

It is this rationale of the Board that the Examiner now relies on for maintaining the rejection in the most recent Final Action. 2019 Final Act. 4 (“The rejection[] and corresponding explanations provided in the September 25, 2018 decision of the PTAB [in relation to the rejection over

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Woodhill and Kahn] are maintained and incorporated herein by reference.”); *see also id.* at 5 (maintaining the obviousness rejection over Woodhill and Stefik for the same reasons). Accordingly, we analyze Patent Owner’s arguments regarding the rejections of claim 7 (*see* 2019 Appeal Br.) based on the Board’s and the Examiner’s current rationale.

Standard of Review

The Board conducts a limited *de novo* review of the appealed rejections for error based upon the issues identified by Patent Owner, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

I.

Patent Owner notes that

[c]laim 7 requires, *inter alia*, “obtaining a name for a data file, the contents of said data file representing a digital image . . . ; and in response to a request for the data file, the request including at least the name of the data file, providing a copy of the file”

2019 Appeal Br. 53–54. Patent Owner argues, “[t]his subject matter is not found in the newly proposed combinations.” *Id.* at 54.

More specifically, Patent Owner argues that the Court of Appeals for the Federal Circuit recently held that Woodhill only discloses the binary object identifier being used for one purpose—“to perform a one-to-one comparison with the Binary Object Identifier associated with the backed-up version of the binary object, which occurs after the appropriate binary object has been located.” 2019 Appeal Br. 54 (citing *PersonalWeb II*, 917 F.3d at 1382.

Patent Owner additionally argues that our reviewing court further held that **“Woodhill’s only disclosed method of locating a current or previous file is by searching for the file using standard file block information, including the file name and location Woodhill does not disclose searching for a file based on a content-based identifier.”** *Id.* at 56 (citing *PersonalWeb II*, 917 F.3d at 1382). Patent Owner summarizes that the PTAB’s and the Examiner’s current interpretation of Woodhill is contradicted by our reviewing court’s findings in *PersonalWeb II*. 2019 Appeal Br. at 57.

Patent Owner’s arguments on this point are unpersuasive. We recognize that our reviewing court held that Woodhill does not disclose searching for a file based on a content-based identifier. But this fact does not demonstrate error in the current rejection because in the ’3936 Decision, the Board did *not* find that Woodhill *discloses* using the binary object identifier to locate the binary object. The Board, instead, determined that in light of what Woodhill does teach, it *would have been obvious* to have used Woodhill’s binary object identifier for this purpose:

Given that Woodhill’s self-audit routine retrieves a binary object to perform the audit,[□] it at least would have been obvious—if not inherent—that some sort of binary object name would be used to retrieve the binary object. Further, given that Woodhill expressly discloses that the binary object identifier can serve as the binary object’s name, it would have been obvious to one of ordinary skill to have used Woodhill’s binary object identifier in the self-audit routine to retrieve the binary object being audited.

’3936 Decision 12.

II.

Patent Owner additionally acknowledges that “[t]he new grounds of rejection are based on Woodhill’s self-audit procedure, described at column 18, lines 10 through 38, and [further based on] claim 1 of Woodhill[,] which refers to a binary object identifier as a ‘name’ for a binary object.” 2019 Appeal Br. 64 (emphasis omitted). Patent Owner also presents various arguments in relation to this rationale.

Most persuasive, Patent Owner argues that the only place Woodhill ever refers to a binary object identifier as a “name” is in the claims, but that this language was introduced into Woodhill’s claims as new matter. *Id.* at 64–65. According to Patent Owner, Woodhill added the language about the binary object identifier constituting a “name” by way of a claim amendment that was filed on January 5, 1996—“after the April 1, 1995 effective filing date of the ’442 patent.” 2019 Appeal Br. 65; *see also* Woodhill’s 08/555,376 continuation application, SECOND PRELIMINARY AMENDMENT, claim 21 (issued as claim 1).

Patent Owner contends, therefore, “Woodhill’s description of a binary object identifier as a ‘name’ in the claims of Woodhill is not prior art to either the [present] ’442 patent or the [parent] ’280 patent.” 2019 Appeal Br. 65. Patent Owner argues that the Board erred by simply assuming that the “name” term in claim 1 of Woodhill, as issued, was supported by the July 1993 filing of Woodhill’s parent application, and that the Board erred by not addressing or considering the issue of priority when it made the new ground of rejection. Appeal Br. at 67.

Patent Owner's arguments are persuasive. The Board's new grounds of rejection are based, in part, on the emphasized language of Woodhill's claim 1:

1. A system for distributed management of the storage space and data on a networked computer system wherein the networked computer system includes at least two storage devices for storing data files, said distributed storage management system comprising:

means for selectively copying data files stored on one of the storage devices to another of the storage devices;

means for dividing each data file into one or more binary objects of a predetermined size;

means for calculating a current value for a binary object identifier for each binary object within a file, *said calculation of said binary object identifier being based upon the actual data contents of the associated binary object, said calculated binary object identifier being saved as the name of the associated binary object;*

means for comparing said current name of a particular binary object to one or more previous names of said binary object;

means for storing said current name of said binary object;
and

means for controlling said means for selectively copying binary objects in response to said means for comparing.

Woodhill, claim 1 (filed as claim 21 in the '376 Application).

Prior to the second preliminary amendment, the as-filed claims of the '376 Application did not recite that the calculated binary object identifier was saved as a name:

1. A system for distributed management of the storage space and data on a networked computer system wherein the

networked computer system includes at least two storage devices for storing data files comprised of one or more binary objects, said distributed storage management system comprising:

means for selectively copying the binary objects stored on one of the storage devices to another of the storage devices;

means for calculating a current value for a binary object identifier for selected binary objects stored on the storage devices wherein said calculation of said binary object identifier is based upon the actual data contents of the associated binary object;

means for storing said current value of said binary object identifier as a previous value of said binary object identifier;

means for comparing said current value of said binary object identifier associated with a particular binary object to one or more previous values of said binary object identifier associated with that particular binary object; and

means for commanding said means for selectively copying binary objects in response to said means for comparing.

Woodhill '376 Application, claim 1 (as originally filed).

We, therefore, review Woodhill's '376 Application, as originally filed, to determine whether the Specification either employs the term "name" or otherwise teaches binary object identifiers as being used as a name of the binary objects. Our review indicates that the '376 Application's originally filed Specification includes no such disclosure or teaching. At most, Woodhill's originally filed '376 Application merely teaches using the binary object identifiers for comparing current versions of binary objects with stored versions of binary objects:

means for calculating a current value for a binary object identifier for selected binary objects stored on the storage devices wherein said calculation of said binary object identifier

is based upon the actual data contents of the associated binary object;

means for storing said current value of said binary object identifier as a previous value of said binary object identifier;

means for comparing said current value of said binary object identifier associated with a particular binary object to one or more previous values of said binary object identifier associated with that particular binary object.

Woodhill '376 Application, originally filed claim 1; *see also* Woodhill '376 Application 35:20–36:17 (setting forth section 5. Auditing and Reporting).

To be sure, an identifier arguably can be characterized as also constituting a “name.” For example, the identifier “Prisoner 24601” arguably can be characterized as constituting the name of Jean Valjean. *See* Victor Hugo, *Les Miserables* (1862). But Patent Owner’s claim 7 does not merely recite that the content-based identifier *constitutes* a name. Rather, claim 7 more specifically requires that a requested data file *be retrieved using* the content-based identifier. *See* Woodhill, claim 7 (“in response to a request for the data file, the request including at least the name of the data file, providing a copy of the file from a given one of the plurality of computers”). It is this manner of using the binary object identifier that Woodhill’s originally filed application fails to disclose.

Upon further consideration, then, we understand Woodhill provides limited support to the term “name”—Woodhill uses “name” only to refer to an identifier that is used for comparing binary objects. Beyond this limited meaning, the term “name” receives no priority prior to the April 1, 1995 effective filing date of Patent Owner’s claim 7. As such, Woodhills’ use of

the term “name” neither constitutes prior art, nor can be relied upon for teaching that it was known to use a content-based identifier specifically for retrieving a requested file. Without being able to rely on Woodhill’s disclosure of the term “name” for this specific teaching, we agree with Patent Owner that the Examiner has not established that claim 7 is obvious over Woodhill in combination with the teachings of only Kahn or of only Stefik. We, therefore, withdraw the new grounds of rejection that we issued in the ’3936 Decision.

We choose not to exercise our discretionary authority under 37 C.F.R. § 41.50(b) to inquire further whether claim 7 might be rendered obvious over the combination of Woodhill, Kahn or Stefanik, and some additional teachings or noticed facts. We, instead, limit our inquiry to the question that originally was presented to us—whether the Examiner has established that claim 7 is unpatentable for the reasons originally set forth by Requester and adopted by the Examiner at the time of the ’3936 Decision. *See Frye*, 94 USPQ2d at 1075 (explaining that the Board conducts a limited *de novo* review of the appealed rejections for error based upon the issues identified by Patent Owner, and in light of the arguments and evidence produced thereon).

On the record before us, we conclude that the Examiner has not established a *prima facie* case of obviousness.

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DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
7	103(a)	Woodhill, Khan		7
7	103(a)	Woodhill, Stefik		7
Overall Outcome				7

REVERSED

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