

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN, L.L.C.,

Petitioner,

v.

LIBERTY PEAK VENTURES, LLC,

Patent Owner.

Case No.: IPR2023-00422

U.S. Patent No. 8,905,301

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EXHIBIT LIST

<u>Exhibit No.</u>	<u>Description</u>
2001	Excerpt from the American Heritage Dictionary of the English Language for “of.”
2002	US PGPUB 20050246289 of Alexander IV et al.

I. INTRODUCTION

The Board should confirm the patentability of claims 1-15 of U.S. Patent 8,905,301 (the “’301 patent”), because the challenges set forth in the petition as to these claims fall short.

Independent claims 1 and 7 each recite, among other things, sending, using the computer-based authorization system, an account information request that includes account information *of* the separate account. The word “of” in this context specifies a possessive relationship. That is, the account information included in the account information request is account information *belonging to* the separate account. Foss fails to teach or suggest such an account information request that includes account information of a separate account. In fact, Foss is silent as to what information is actually included in any such communication and there is no reason why account information of a separate account would be inherent to such a request. Accordingly, independent claims 1 and 7, and each of their respective dependent claims, are not anticipated by Foss.

Further, the challenges to claims 2, 3, 6, and 14, which are alleged to be obvious in view of Foss when considered in combination with various prior art references or so-called admitted prior art, should be found wanting. Each of claims 2, 3, 6, and 14 depends from claim 1 and, therefore, includes

the features of claim 1. In each case, the petition cites the so-called admitted prior art or a secondary reference for details concerning limitations of the respect dependent claims, but does not allege or demonstrate that the cited admitted prior art or secondary references teaches or suggests sending, using the computer-based authorization system, an account information request that includes account information *of* the separate account. Instead, the petition relies on Foss for such teachings in the same form as is specified for the alleged anticipation by Foss of claim 1. In fact, because the proposed combinations of Foss and the admitted prior art or secondary references do not teach or suggest this feature of claim 1, all of the petition’s challenges to claims 2, 3, 6, and 14 fail.

II. THE BOARD SHOULD CONFIRM THE PATENTABILITY OF CLAIMS 1, 3-5, AND 7-15 OVER FOSS, WHICH FAILS TO TEACH OR SUGGEST AN ACCOUNT INFORMATION REQUEST THAT INCLUDES ACCOUNT INFORMATION *OF* THE SEPARATE ACCOUNT.

A petition must be judged as it is written. The Board may not overlook flaws in the petition or reformulate its challenges to enhance their suitability. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018) (“[I]t’s the petitioner, not the Director, who gets to define the contours of the proceeding.”); *see also id.* (“[T]he petitioner is master of its complaint . . .”);

see also id. at 1353 (forbidding the Board from “curat[ing]” the petition). As explained below, the petition fails to demonstrate that claims 1, 3-5, and 7-15 are anticipated by Gopinathan.

A. Claims 1 and 7 Require Sending an Account Information Request that Includes Account Information *Of* a Separate Account.

Claim 1 of the ’301 patent recites,

1. A method comprising:

receiving, at a computer-based authorization system, a transaction request associated with a debit account, wherein the debit account is associated with a separate account;

sending, using the computer-based authorization system, an account information request that includes account information of the separate account;

receiving, at the computer-based authorization system, status information of the separate account in response to the account information request; and

authorizing, using the computer-based authorization system, the transaction request based on the status information.

Ex. 1002 at 12:63 – 13:9 (emphasis added). The “separate account” recited in the claim corresponds to a demand deposit account (DDA) or an overdraft account that is associated with the debit account. *Id.* at 6:64-67. At the end

of the day, purchases made on the debit account are deducted from that DDA or, if insufficient funds are available in the DDA, from the overdraft account. *Id.* at 7:2-5, 28-32. It is for this reason that when a purchase on the debit account is attempted, the authorization process involves an assessment of the DDA or overdraft account (i.e., the separate account) associated with the debit account. The specification explains:

[F]or each transaction, fund availability may be verified, for example using authentication system 104.

Id. at 7:10-12.

[T]he authorization process may call a third-party vendor (e.g., eFunds or First Data Corporation of Greenwood Village, Colo.) to validate that the DDA is in good standing. Once the DDA is verified, the transaction is authorized by the CAS after which the authorization code is sent back to the merchant BAU.

Id. at 8:7-14.

In step 1, the debit card information is received at a merchant, and an authorization process begins. The authorization process starts through a communication between the merchant and a card issuer system (e.g., Amex-GES). In step 2, the card issuer system is notified of the requested transaction. In steps 3 and 4, the customer's information stored in a database is cross

referenced. In steps 5, 6, 7, and 8 an account status is retrieved. In one example, the account status is retrieved by a card issuer or third party system verifying the information using information stored in another database. In step 9, if verification is successful, the requested transaction is allowed to occur and the transaction is completed.

Id. at 8:52-63 (referring to steps 1-9 illustrated in Figure 7).

Claim 1 specifies that, in seeking to authorize a transaction, the computer-based authorization system sends an account information request *that includes account information of the separate account.* *Id.* at 13:1-3.

Again, the reason for doing so is because,

at the end of each business day, purchases made with the debit card 110 are deducted from the customer's specified DDA via the ACH.

Id. at 7:5-7. Accordingly, the method recited in claim 1 involves the computer-based authorization system sending an account information request that includes, for example, information *of* the demand deposit account or *of* the overdraft account associated with the debit account.

In *inter partes* reviews such as this one, the Board applies the same claim construction standard used to construe a claim in a civil action under 35 U.S.C. § 282(b). *Changes to the Claim Construction Standard for*

Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018). Accordingly, the claims are to be construed consistent with their plain and ordinary meaning as understood by a person of ordinary skill in the art as considered in the context in which the terms of the claims are used. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996); *see also ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003). “The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips*, 415 F.3d at 1313.

The “ordinary and customary meaning” of the sending step of claim 1, especially in light of the teachings of the specification, is that the account information request sent by the computer-based authorization system includes *account information of the separate account*. Ex. 1002 at 13:1-3. In this context, the word “of” specifies a possessive relationship – i.e., the information ***belongs to*** the separate account and is not merely associated with it. The American Heritage Dictionary notes that this type of “double generative” construction, in which a possessive form appears as the object of the preposition “of,” has been in use in the English language since the 1300s

and serves to eliminate ambiguities that can arise in language. For example, whereas the phrase “Bob’s photograph” could mean either “a photograph of Bob” (i.e., one containing Bob’s image) or “a photograph that is in Bob’s possession,” a “photograph of Bob’s” can only mean one that Bob has in his possession, regardless of who or what is shown in the image. Ex. 2001.

Using “of” in such a fashion, as it is in claim 1, thus advances the goal of “particularly pointing out and distinctly claiming the subject matter which the inventor [] regards as the invention.” 35 U.S.C. § 112(b).

Given the long history of such usage of the term “of” in common English, a person of ordinary skill in the art would readily understand that claim 1 is reciting the sending of information *belonging to* the separate account by the computer-based authorization system. This is, therefore, the construction which the Board should accord to the claim. *Phillips*, 415 F.3d at 1314 (“In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words.”)

Claim 7 recites the identical phrase, *sending, using the computer-based authorization system, an account information request that includes*

account information of the separate account. Ex. 1002 at 13:33-35.

Accordingly, this claim should be construed in the same fashion as claim 1. *See Phillips*, 415 F.3d at 1314 (acknowledging that like terms should be construed consistently across related claims).

B. Foss Does Not Anticipate Claim 1.

Petitioner's Ground 1 challenges claim 1 as being anticipated by Foss under 35 U.S.C. § 102(a) and (e). Pet. at 5. Anticipation requires that a prior art reference set forth "each and every element" of a claim "as set forth in the claim." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); *and see Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2019) (anticipation not only requires that each element of a claim be present in a prior art reference, but also the "arrangement or combination" of those elements). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Foss describes "[a] system and method for providing a checkless checking account." Ex. 1008 at Abst. Within that system, "the first step of a transaction 400 is receiving an authorization request 405 requesting a [] withdrawal." *Id.* at [0065]. "Next, an all authorization edits 410 step is

performed. The all authorization edits 410 step authorizes the transaction. If the all authorization edits 410 step fails, the process returns to the authorization request 405 step and waits for another authorization request. If the all authorization edits 410 step passes, the process proceeds to update the deposit and overdraft accounts, step 450, and applies any applicable fees, step 455.” *Id.* at [0065]-[0066]. The point of the all authorization edits process is to see if there are available funds for a transaction. *Id.* at [0066].

Foss is silent as to what information is actually included in any communication during the all authorization edits process. The petition relies on testimony from Mr. Zatkovich to fill in this blank, see Pet. at 28 (citing Ex1003, ¶¶ 386, 388), but that testimony fails to compare the actual language of the claims with the asserted reference (Foss) and fails to establish that the claimed feature is inherent in Foss’ disclosure. As a result, the petition fails to “specify where each element of the claim is found in the prior art.” 37 C.F.R. § 42.104(b)(4). Consequently, the claims cannot be found to be anticipated by Foss. *Verdegaal Bros.*, 814 F.2d at 631.

First, the testimony relied upon by Petitioner alleges that a person of ordinary skill in the art would understand that sending account information requests would include information *about* the separate account. Ex1003 at ¶ 388. Elsewhere, Mr. Zatkovich says that the account information may be

associated with the separate account. *Id.* at ¶¶ 386, 387. Not only are these remarks rather conclusory, and therefore of little value to the Board, 37 C.F.R. § 42.65(a), they do not even address the requirements of claim 1. As explained above, claim 1 requires that account information *of* the separate account be sent. The claim specifies a possessive relationship whereas the declarant’s testimony fails to indicate or even address such possession.

Notably, Mr. Zatkovich does not provide any construction for the claim limitation being addressed in his testimony, and instead says none is needed. Ex. 1003 at ¶ 94. But Mr. Zatkovich does not explain what information *about* the account or *associated with* the account is information *of* the account or *why* they should be treated as one in the same. His testimony is said to rely on the “plain and ordinary meaning” of the claim terms, *id.*, yet he offers no explanation as to what that plain and ordinary meaning is. For the Board to accept a purported expert’s testimony it is incumbent upon the expert to describe sufficient facts and data on which the expert’s opinion is based. 37 C.F.R. § 42.65(a); *and see* PTAB Consolidated Trial Practice Guide at p. 35 (Nov. 2019). That includes the understanding of a person of ordinary skill in the art; yet here, Mr. Zatkovich has not provided any sufficient facts or data to support his opinions concerning the meaning of the claims.

Even Mr. Zatkovich's description of the person of ordinary skill in the art is of little assistance. For example, he specifies that such an individual would have a certain level of education and some work experience, but says nothing about what that background would provide such an individual, especially concerning the construction question at issue. *See* Ex. 1003 at ¶ 161. The PTAB's predecessor, the Board of Patent Appeals and Interferences, recognized that expert testimony about the level of ordinary skill in the art can be probative, but only if it is well-grounded in the facts. *Ex. Parte Jud*, Appeal No. 2006-1061 (Appl. No. 09/505,713), slip op. at 5-6 (BPAI Jan. 30, 2007) (informative) (rehearing with expanded panel). Here, Mr. Zatkovich offers nothing that would ground his assertions regarding the understanding of a person of ordinary skill in the art and instead offers only what the expanded panel in *Jud* found to be "typically insufficient," that is, testimony regarding "what education and work experience the hypothetical person of skill had." *Id.* at 6. As the *Jud* panel remarked, such testimony "assumes that the reader already appreciates what such a person would have known," and tends to be redundant because "the basis for a stated education level and work experience (if any is given) tends to be whatever would be necessary to understand and use references in the pertinent art." *Id.* In short, nothing in Mr. Zatkovich's testimony, and by extension the arguments set

forth in the petition, provide any basis for the Board to accept the unstated, and unsupported, argument that information *about* the separate account or *associated with* it, is information *of* the separate account.

Second, there is nothing *inherent* or *necessary* about any information being sent in Foss that must make it include account information *of* the separate account. *See* Pet. at 28. For example, it would be sufficient for an authorization system to send a debit card number and allow the receiving system at the demand deposit account holding facility to resolve that debit card number to that demand deposit account to determine whether sufficient funds are available for a current transaction. *See, e.g.,* Ex. 2002 at [0031].¹ Such a procedure would avoid possible exposure of the demand deposit account or overdraft account information if the communication from the authorization system were intercepted or snooped, thereby making it more secure from the standpoint of safeguarding consumer information. Sending

¹ Ex. 2002 is US PG PUB 2005/0246289 of Alexander, IV et al., which was cited and relied upon by the Examiner during prosecution of the application that became the '301 patent. Ex. 1006 at 121-126. Alexander describes sending an “account number associated with [a] transaction card,” which account number is later resolved to a source account at the receiving institution. Ex. 2002 at [0031].

the debit card number would not be sending “account information *of* the separate account” as recited in claim 1 (instead, it would be account information of the debit account); hence, nothing in Foss demands that “account information of the separate account” be sent.

Thus, claim 1 is not anticipated by Foss.

C. Foss Does Not Anticipate Claim 7.

Petitioner’s Ground 1 further challenges independent claim 7 as being anticipated by Foss. Pet. at 5. As noted above, claim 7 recites, in part, “sending, using the computer-based authorization system, an account information request that includes *account information of the separate account.*” Ex. 1002 at 13:33-35 (emphasis added). This is the same limitation as is included in claim 1; hence, for the same reasons as with respect to claim 1, Foss does not anticipate claim 7.

D. Foss Does Not Anticipate Any of Claims 3-5 or 8-15.

Petitioner’s Ground 1 further challenges dependent claims 3-5 and 8-15 as being anticipated by Foss. Pet. at 5. Claims 3-5 and 10-15 depend from claim 1 and claims 8 and 9 depend from claim 7. *Id.* at 13:11-20, 13:42 – 14:20. Each respective dependent claim is not anticipated by Foss for at least

the same reasons as its respective independent claim. *Hartness Int'l. Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100 (Fed. Cir. 1987) (a claim that depends from a nonobvious independent claim is nonobvious because it contains all of the limitations of that independent claim plus a further limitation); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983) (“anticipation is the epitome of obviousness”) (quoting *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982)).

III. THE BOARD SHOULD CONFIRM THE PATENTABILITY OF CLAIMS 2, 3, 6, AND 14 OVER PETITIONER’S REMAINING CHALLENGES.

The challenges set forth as Grounds 2-4 in the petition each rely on conclusions of obviousness. Pet. at 5. Accordingly, the petition must include “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The challenger must supply the factual basis for the challenge and “may not resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). Additionally, in cases such as the present, where the obviousness challenges involve a modification or combination of teachings,

the Petitioner must also establish that one skilled in the art would have made such a combination, *Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1367 (Fed. Cir. 2012) (“[W]hether there is a reason to combine prior art references is a question of fact.”); *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1337 (Fed. Cir. 2016) (“Whether a skilled artisan would be motivated to make a combination includes whether he would select particular references in order to combine their elements.”), and would have had a reasonable expectation of success in doing so. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016).

A. Claim 14 is Not Obvious In View of Foss and the AAPA.

The petition alleges that claim 14 is obvious in view of Foss when considered in combination with certain alleged admitted prior art. Pet. at 5. In particular, the petition alleges that because the '301 patent acknowledges the existence of vendors such as eFunds or First Data Corporation of Greenwood Village, Colo., it would have been obvious for a person of ordinary skill in the art to send an account information request to such a vendor. *Id.* at 47-48.

Whether or not this is true, the petition nevertheless relies on Foss to teach the elements of claim 1 as in its case for anticipation. There is no

allegation that claim 1 would have been obvious in view of Foss under 35 U.S.C. § 103. *See, e.g.*, Pet. at 5, 45-48.

Claim 14 depends from claim 1 and therefore includes all of its features. As previously explained, Foss is silent as to what information is actually included in any communication during the all authorization edits process, and does not disclose *sending, using the computer-based authorization system, an account information request that includes account information of the separate account*. Furthermore, there is no allegation in the petition that such a step is admitted prior art. *See* Pet. at 47 (alleging only that “it would have been obvious in view of the admitted prior art, as implicitly recognized in the ’301 Patent, that third party vendors, such as ‘eFunds or First Data Corporation of Greenwood Village, Colo.’ would be recipients of account information requests.”) (citations omitted).

Accordingly, irrespective of whether or not a person of ordinary skill in the art would have found it obvious to use a third party vendor as a recipient of an account information request, it remains the case that the proposed combination of Foss and the admitted prior art fails to teach or suggest *sending, using the computer-based authorization system, an account information request that includes account information of the separate account*. Hence, claim 14 is not obvious in view of the combined teachings

of these references. *CFMT, Inc. v. Yieldup Int'l. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (obviousness requires a suggestion of all limitations in a claim) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

B. The Board Should Confirm the Patentability of Claim 3 over Foss and Gopinathan.

The petition alleges that claim 3 is obvious in view of Foss when considered in combination with Gopinathan. Pet. at 5. In particular, the petition alleges it would have been obvious for a person of ordinary skill in the art to modify Foss to include a fraud detection system and methods as taught by Gopinathan. *Id.* at 64.

Claim 3 depends from claim 1 and therefore includes all of its features. As previously explained, Foss is silent as to what information is actually included in any communication during the all authorization edits process, and does not disclose *sending, using the computer-based authorization system, an account information request that includes account information of the separate account*. Furthermore, there is no allegation in the petition that such as step is taught by Gopinathan. *See* Pet. at 59-67.

Accordingly, irrespective of whether or not a person of ordinary skill in the art would have found it obvious to modify Foss to include a fraud detection system and methods as taught by Gopinathan, it remains the case

that the proposed combination of Foss and Gopinathan fails to teach or suggest *sending, using the computer-based authorization system, an account information request that includes account information of the separate account*. Hence, claim 3 is not obvious in view of the combined teachings of these references. *CFMT, Inc.*, 349 F.3d at 1342.

C. The Board Should Confirm the Patentability of Claims 2 and 6 Over Foss and Hirka.

The petition alleges that each of claims 2 and 6 are obvious in view of Foss when considered in combination with Hirka. Pet. at 5. As to claim 2, the petition alleges it would have been obvious for a person of ordinary skill in the art to modify the overdraft account of Foss in view of Hirka so that it is a credit card account. *Id.* at 73. And, as to claim 6, the petition alleges it would have been obvious for a person of ordinary skill in the art to modify Foss in view of Hirka to include accounts managed at different financial institutions. *Id.* at 75.

Each of claims 2 and 6 depends from claim 1 and, therefore, each includes all of the features of claim 1. As previously explained, Foss is silent as to what information is actually included in any communication during the all authorization edits process, and does not disclose *sending, using the computer-based authorization system, an account information request that*

includes account information of the separate account. Furthermore, there is no allegation in the petition that such as step is taught by Hirka. *See* Pet. at 69-75.

Accordingly, irrespective of whether or not a person of ordinary skill in the art would have found it obvious to modify the overdraft account of Foss in view of Hirka so that it is a credit card account, and/or to modify Foss in view of Hirka to include accounts managed at different financial institutions it remains the case that the proposed combination of Foss and Hirka fails to teach or suggest *sending, using the computer-based authorization system, an account information request that includes account information of the separate account.* Hence, neither of claims 2 nor 6 is obvious in view of the combined teachings of these references. *CFMT, Inc.*, 349 F.3d at 1342.

IV. CONCLUSION

For at least the foregoing reasons, the Board should confirm the patentability of the challenged claims. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (“In an [inter partes review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”) (citing 35 U.S.C. § 312(a)(3) (requiring inter

partes review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (the burden of persuasion never shifts to the Patent Owner); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (a petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements”).

Respectfully submitted,

Dated: October 10, 2023

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WORD-COUNT CERTIFICATE

I certify that the foregoing document complies with the type-volume limitation of 37 C.F.R. § 42.24(a) and (b) and contains 4,262 words (including words in drawings created by the Patent Owner or as annotations added by the Patent Owner to images reproduced in this document) based on the word count indicated by Microsoft® Word for Mac v. 16.75, excluding those portions exempted by the rule.

/Tarek N. Fahmi/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing:

PATENT OWNER'S RESPONSE

and its accompanying exhibits were served on October 10, 2023, by filing this document through the PTAB E2E System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following addresses:

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The parties have agreed to electronic service in this proceeding.

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