

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELOADDEN L.L.C.,
Petitioner,

v.

LIBERTY PEAK VENTURES LLC,
Patent Owner.

IPR2023-00422
Patent 8,905,301 B2

Before DANIEL J. GALLIGAN, SHARON FENICK, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Askeladden L.L.C. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,905,301 B2 (Ex. 1002, “the ’301 patent”). Pet. 1. Liberty Peak Ventures, LLC (“Patent Owner”) waived filing a Preliminary Response. Paper 5. Based on the information presented in the Petition, we instituted an *inter partes* review of claims 1–7 (Paper 7). Subsequent filings include a Patent Owner Response (Paper 9, “PO Resp.”) and a Petitioner Reply (Paper 10, “Reply”). Patent Owner elected not to file a Sur-reply. We held an oral hearing on April 25, 2024, a transcript of which has been entered into the record. Paper 15. Patent Owner declined to participate in the hearing. Ex. 3001.

We have jurisdiction over this proceeding under 35 U.S.C. § 6(b). After considering the evidence and arguments of the parties, we determine that Petitioner has proven by a preponderance of the evidence that claims 1–20 are unpatentable.

II. BACKGROUND

A. Related Matters

The parties identify four infringement lawsuits involving the ’301 patent, each of which has settled: *Liberty Peak Ventures, LLC v. The Charles Schwab Corporation*, No. 2:22-cv-00376 (E.D. Tex.) (filed Sep. 28, 2022); *Liberty Peak Ventures, LLC v. Zions Bancorporation, N.A.*, No. 2:22-cv-00195 (E.D. Tex.) (filed June 8, 2022) (terminated Oct. 4, 2022); *Liberty Peak Ventures, LLC v. Regions Fin. Corp.*, No. 2:21-cv-00417 (E.D. Tex.) (filed Nov. 9, 2021) (terminated June 2, 2022); and *Liberty Peak Ventures, LLC v. Citigroup Inc.*, No. 6:21-cv-00711 (W.D. Tex.) (filed Jul. 08, 2021)

(terminated Jan. 24, 2022). Pet. 2; Paper 3, 2. Petitioner has also filed the following *inter partes* review on related U.S. Patent No. 7,837,100 B2:

Askeladden L.L.C. v. Liberty Peak Ventures, LLC, IPR2023-00421 (PTAB, filed Dec. 29, 2022).

B. Real Parties-in-Interest

Askeladden identifies itself as the only real party-in-interest (RPI). Pet. 1. Patent Owner identifies itself as the sole RPI. Paper 3, 2.

C. The '301 patent

The '301 patent describes systems and methods for issuing and tracking debit cards. Ex. 1002, code (57) (Abstract). Figure 1 depicts an example of such a system:

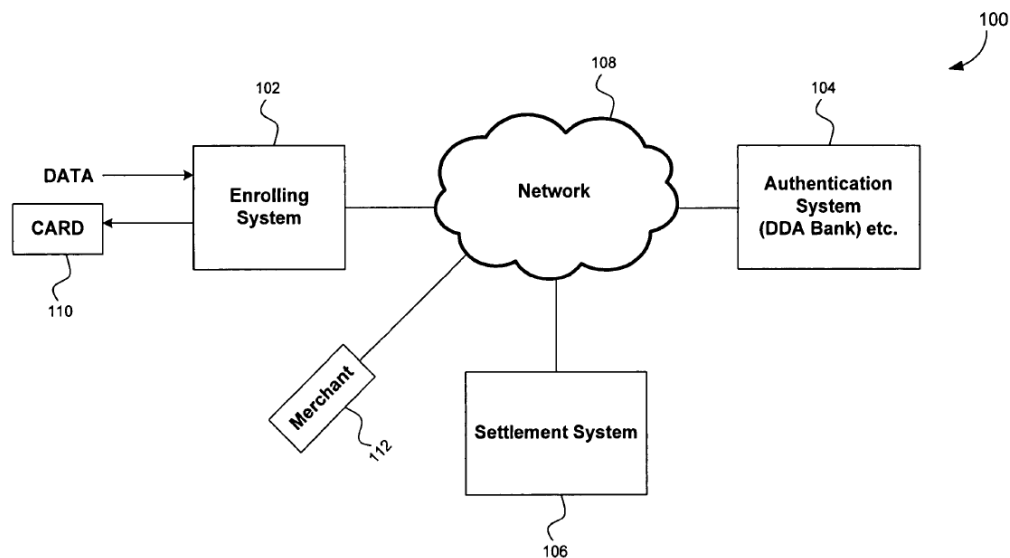


FIG. 1

Id. at 6:53. Figure 1 depicts system 100, which includes enrolling system 102, network 108, authentication system 104, and settlement system 106.

Id. at 6:53–55. Customers wanting to use a debit card program enter information or data into enrolling system 102. *Id.* at 6:56–58. This

information is transmitted through network 108 to authentication system 104. *Id.* at 6:60–62. Once the person’s identity has been verified and financial information has been accepted, one or more accounts (e.g., main and overdraft) of the person are associated with debit card 110. *Id.* at 6:64–67. Settlement system 106 generates a periodic report of transactions, the main account, and the overdraft account. *Id.*, code (57).

D. Challenged Claims

Claim 1 is illustrative of the challenged claims:

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, 12:63–13:9.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 5):

Claim(s) Challenged	35 U.S.C. § ¹	Reference(s)/Basis
1, 3–5, 7–16	102	Foss ²
14	103	Foss, Applicant Admitted Prior Art (“AAPA”) ³
3	103	Foss, Gopinathan ⁴
2, 6, 17–20	103	Foss, Hirka ⁵

Petitioner relies on two declarations by Ivan Zatkovich (Exs. 1003, 1014). Patent Owner does not rely on declaration evidence.

III. ANALYSIS

A. Principles of Law

Petitioner bears the burden to demonstrate unpatentability, and that burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

To show anticipation under 35 U.S.C. § 102, each and every claim element, arranged as in the claim, must be found in a single prior art

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. The ’301 patent was filed prior to March 16, 2013. Ex. 1002, code (22). We therefore apply the pre-AIA versions of §§ 102, 103.

² U.S. Publication No. 2004/0225604 A1 to Foss, published Nov. 11, 2004 (Ex. 1008).

³ Ex. 1002, 7:37–38, 8:4–14, 8:59–61. *See* Pet. 8 & n.3, 22–23, 47; Ex. 1003 ¶¶ 369, 465–468.

⁴ U.S. Patent No. 6,330,546 B1 to Gopinathan, issued Dec. 11, 2001 (Ex. 1010).

⁵ WIPO Publication No. WO 02/21374 A1 to Hirka, published March 14, 2002 (Ex. 1009).

reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008). The prior art need not, however, use the same words as the claims. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). The anticipation inquiry takes into account the literal teachings of the prior art reference and inferences the ordinarily skilled person would draw from it. *Eli Lilly and Co. v. Los Angeles Biomedical Res. Inst. at Harbor-UCLA Med. Ctr.*, 849 F.3d 1073, 1074–75 (Fed. Cir. 2017).

A claim is unpatentable as obvious if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a)). We resolve the question of obviousness based on underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the prior art and the claims; (3) the level of skill in the art; and (4) when in evidence, objective indicia of nonobviousness. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

We apply these principles to the Petition’s challenges.

B. Level of Ordinary Skill in the Art

Petitioner asserts that

a POSITA [person of ordinary skill in the art] would have a bachelor’s degree in computer science, computer engineering, data science, electrical engineering, or a related study, and would have at least one or two years of experience with payment processing systems, credit card and debit card payment transactions, and industry practices and standards for

processing purchase transactions and authenticating participants.

Pet. 12 (citing Ex. 1003 ¶¶ 159–161). Patent Owner does not submit a contrary skill definition. *See* PO Resp. Patent Owner asserts that Petitioner’s skill definition is not “well-grounded in the facts,” but this assertion is conclusory and unpersuasive. *See id.* at 11. We discuss this assertion again below in the context of Patent Owner’s merits arguments.

We are persuaded that Petitioner’s proposal is generally consistent with the problems and solutions in the ’301 patent and prior art of record. We note, however, that the open-ended language “at least” expands the range of experience indefinitely with no upper bound. We adopt Petitioner’s definition of the level of skill with the exception of the language “at least.”

C. Claim Construction

In *inter partes* review, we construe a claim using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b).

We address the meaning of one claim term.

1. “*account information of the separate account*”

Claims 1 and 7 recite “sending, using the computer-based authorization system, an account information request that includes *account information of the separate account*.” Patent Owner argues that the word “of” in this phrase “specifies a possessive relationship—i.e., the information *belongs to* the separate account and is not merely associated with it.” PO

Resp. 6. Petitioner responds that “of” in this phrase means “associated with” or “connected to.” Reply 5. For the reasons below, we agree with Petitioner that “of” means “associated with,” not “belongs to.”

Patent Owner bases its analysis on a dictionary definition of the word “of”:

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.

PO Resp. 6–7 (citing Ex. 2001).

Petitioner responds that the dictionary Patent Owner relies on contains other definitions for “of” and that “of” therefore does not require a possessive meaning. Reply 5. Below is a portion of Petitioner’s highlighted image from this dictionary, showing several definitions for “of”:

of  (üv, öv; əv when unstressed)

prep.

1. Derived or coming from; originating at or from: *customs of the South*.
2. Caused by; resulting from: *a death of tuberculosis*.
3. Away from; at a distance from: *a mile east of here*.
4. So as to be separated or relieved from: *robbed of one's dignity; cured of distemper*.
5. From the total or group comprising: *give of one's time; two of my friends; most of the cases*.
6. Composed or made from: *a dress of silk*.
7. Associated with or adhering to: *people of your religion*.
8. Belonging or connected to: *the rungs of a ladder*.
9.
 - a. Possessing; having: *a person of honor*.
 - b. On one's part: *very nice of you*.
10. Containing or carrying: *a basket of groceries*.
11. Specified as; named or called: *a depth of ten feet; the Garden of Eden*.
12. Centering on; directed toward: *a love of horses*.
13. Produced by; issuing from: *products of the vine*.
14. Characterized or identified by: *a year of famine*.

Id. at 9. Petitioner highlights two definitions that it argues are not possessive—“[a]ssociated with or adhering to,” and “[b]elonging or connected to.” *Id.*

Patent Owner does not explain why it chose a definition requiring possession when the same dictionary proposes other definitions, such as “[a]ssociated with.” *See* PO Resp. 6–7. Nor does Patent Owner point to any disclosure in the ’301 patent specification that supports its more restrictive construction. When discussing “account information” in connection with an “account,” the specification merely describes “account information *for* the account.” Ex. 1002, 1:54–55, 10:49–50 (emphasis added). The phrase “account information of the separate account” does not occur in the specification, and neither party addresses any relevant prosecution history. There is no basis in the intrinsic record, then, for reading a restrictive interpretation of this phrase.

Patent Owner overlooks that where the specification does not use a term restrictively, “the broader dictionary definition . . . is preferable.”

Interval Licensing LLC v. AOL, Inc., 766 F.3d 1364, 1377 (Fed. Cir. 2014); *see also Phillips v. AWH Corp.*, 415 F.3d, 1303, 1322–23 (Fed. Cir. 2005) (en banc) (“[J]udges are free to . . . rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.” (internal quotation omitted)). As noted above, the parties point to no intrinsic evidence, whether in the specification or prosecution history, that informs the meaning of the term “of.” And the definition “associated with” in Patent Owner’s proffered dictionary is a broader definition than the definition “possessing.” *See* Ex. 2001, 2. Accordingly, we agree with Petitioner that the phrase “account information of the separate account” in claims 1 and 7 at least encompasses “account information associated with the separate account.”

2. *Remaining terms*

Patent Owner also argues that the recited “separate account” corresponds to “a demand deposit account (DDA) or an overdraft account that is associated with the debit account.” PO Resp. 3 (citing Ex. 1002, 6:64–67). Petitioner does not dispute the meaning of this term. As neither this nor any other terms are in dispute, we find it unnecessary to construe any further claim terms. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Asserted Anticipation by Foss

Petitioner contends that claims 1, 3–5, and 7–16 are anticipated by Foss. Pet. 13–59.

1. Overview of Foss

Foss describes a system and method for providing a checkless checking account. Ex. 1008, code (57). The system and method provide transactional functionality of a branded card, wherein an account is funded from the account owner’s personal funds. *Id.* The checkless checking account may also be combined with a credit component to expand its functionality. *Id.*

2. Independent claim 1

a. Undisputed limitations

Patent Owner does not dispute Petitioner’s arguments regarding the preamble and the following limitations of claim 1.

Petitioner asserts that Foss teaches the preamble (“A method comprising”) and all the limitations of claim 1 by disclosing, in Figure 4, “a flow diagram that illustrates the operation of performing a transaction.”⁶ Pet. 19–20 (citing Ex. 1008, Fig. 4; Ex. 1003 ¶¶ 359–360). We reproduce Petitioner’s annotated version of Figure 4 in the next section below.

Petitioner next asserts that Foss discloses the claimed “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.” Pet. 23–27. For example, Petitioner asserts that

⁶ We need not determine whether the preamble is limiting because we determine that Foss discloses it.

Foss teaches, using a **computer-based authorization system** (See Ex1008, Fig. 2, [0017], [0033], [0055] and [0037]), receiving a **transaction request** (e.g., ‘**an authorization request 405**’) which is associated with a **debit account** (e.g., a ‘**basic card account**’) (Ex1008, [0065]; Ex1003, ¶372), and associating the **debit account** with a **separate account**.

Id. at 23–24; *see also id.* at 25–26 (citing Ex. 1008, Fig. 4, blocks 425, 446).⁷

In addition, Petitioner contends that Foss discloses the claimed “receiving, at the computer-based authorization system, status information of the separate account in response to the account information request.” Pet. 30–32. Petitioner argues, for example, that

Foss further teaches receiving, at the ‘account management component 240’ of the computer-based authorization system (see discussion in element [7PRE] and [1A/7A]), **status information** (e.g., ‘**available overdraft protection balance . . . in this case \$300**’ (Ex1008, [0066])) of the separate account in response to the **account information request** from step 446 (Ex1008, [0066]; Ex1003, ¶390).

Id. at 30; *see also id.* at 30–31 (citing Ex. 1008, Fig. 4, block 446).

Finally, Petitioner contends that Foss discloses the claimed “authorizing, using the computer-based authorization system, the transaction request based on the status information.” Pet. 32–34. For instance, Petitioner contends,

Foss further teaches **authorizing** (‘**authorization OTB edit check 415**’ (Ex1008, Fig. 4 and [0066])) using the ‘transactional processing component 250’ of the computer-based authorization system (see discussion in element [7PRE] and [1A/7A]), the transaction request (e.g., ‘authorization request 405’, Ex1008, [0065]) based on the **status information** earlier returned (e.g., the ‘**available overdraft protection**

⁷ We omit Petitioner’s text colorization throughout this decision.

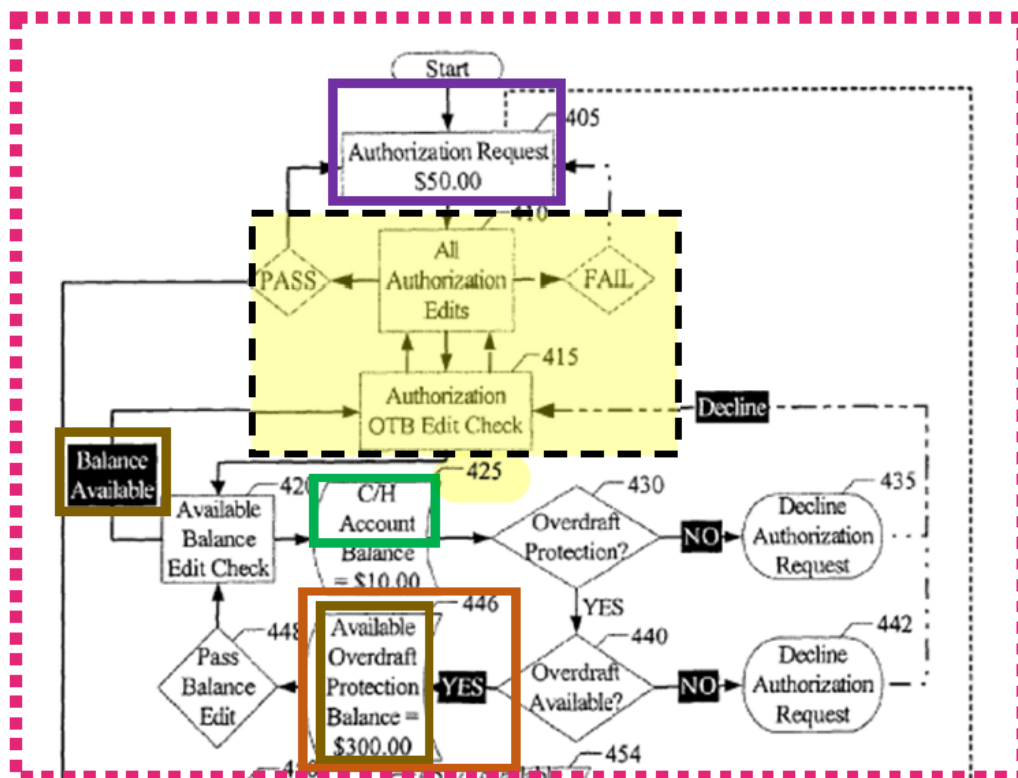
balance' (Ex1008, [0066]; Ex1003, ¶¶395-396; *see* Ex1008, Fig. 4).

Id. at 32–33; *see also id.* at 33 (citing Ex. 1008, Fig. 4, blocks 410 and 446).

Petitioner has shown that Foss discloses the preamble and each of the above limitations of claim 1, which Patent Owner does not dispute.

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

Petitioner asserts that Foss Figure 4 discloses the claimed “sending” limitation. Pet. 28–30. A portion of Foss’s Figure 4, annotated by Petitioner, is reproduced below.



Id. at 19. The above portion of Figure 4 illustrates an example operation of performing a transaction. Ex. 1008 ¶ 65. In particular, the flow diagram depicts an illustrative example of authorizing a transaction for a customer

who has opened a basic card account with a current balance of \$10 and an overdraft option with a limit of \$300. *Id.*

Petitioner explains that it maps Foss's overdraft account to the claimed "separate account." Pet. 27 (citing Ex. 1008 ¶¶ 53, 54, 66; Ex. 1003 ¶ 378). Petitioner then asserts that "Foss discloses **as step 446** in Figure 4, sending, using the 'account management component 240' . . . an **account information request** (e.g., . . . checking in step 446 '**available overdraft balance**')." *Id.* at 28 (citing Ex. 1008 ¶ 66; Ex. 1003 ¶¶ 361–382).

Petitioner further explains that Foss teaches, "[i]f overdraft funds are available at step 440, the **available overdraft protection balance is checked at step 446.**" *Id.* (citing Ex. 1008 ¶ 66; Ex. 1003 ¶¶ 384–385).

Petitioner further argues, based on the testimony of Mr. Zatkovich, that "a POSITA would understand that [Foss's] request would necessarily include **account information** of the **separate account** (e.g., the **overdraft account**)." *Id.* (citing Ex. 1003 ¶¶ 386, 388). Citing Mr. Zatkovich's testimony, Petitioner explains that the account information would be, for example, an account number or account identification. *Id.* at 29–30 (citing Ex. 1008 ¶ 17; Ex. 1003 ¶¶ 385–386). In more detail, Mr. Zatkovich testifies that a POSITA would have understood that "an account number or other form [of] account identification" would have been associated with the overdraft account "using the 'linkage between the credit/overpayment component and the stored value component.'" Ex. 1003 ¶ 387 (quoting Ex. 1008 ¶ 17) (emphasis omitted), *cited in* Pet. 30. Elsewhere, Mr. Zatkovich explains that the "credit/overpayment component" is synonymous with an overdraft account, and the "stored value component" is synonymous with a "debit account." *Id.* ¶ 134.

In sum, then, Mr. Zatkovich’s testimony explains that the overdraft balance check request in Foss would have necessarily included an account number or account ID associated with the overdraft account because of Foss’s described linkage between the overdraft and debit accounts. *See id.* ¶¶ 134, 387. Thus, Mr. Zatkovich testifies, “a POSITA . . . would [have understood] that sending ‘account information requests’ would include information about the ‘separate account’ (the overdraft account) as required by [the] claim element.” *Id.* ¶ 388 (emphasis omitted), *cited in* Pet. 30.

Patent Owner argues that Foss is silent as to what information is included “during the all authorization edits process” and that Mr. Zatkovich’s testimony fails to establish that the claimed information is inherently in Foss. PO Resp. 9. Patent Owner first attacks Mr. Zatkovich’s testimony that “sending account information requests would include information *about* the separate account” or “*associated with* the separate account.” *Id.* at 9–10 (citing Ex. 1003 ¶¶ 386–388). Patent Owner argues that these assertions are conclusory and based on an incorrect claim construction of the word “of” requiring “a possessive relationship.” *Id.* at 10. As discussed above, we have not adopted Patent Owner’s claim construction of “account information of the separate account,” and thus this argument is without merit. We also disagree with Patent Owner that Mr. Zatkovich’s testimony is conclusory, as it is supported by Mr. Zatkovich drawing reasonable inferences from Foss’s disclosure. *See* Ex. 1003 ¶¶ 368–388 (citing Ex. 1008 ¶ 17).

Patent Owner next argues that “Mr. Zatkovich’s description of the person of ordinary skill in the art is of little assistance.” PO Resp. 11. That is because he “says nothing about what that background [education and

experience] would provide such an individual, especially concerning the construction question at issue.” *Id.* (citing Ex. 1003 ¶ 161). We do not view Patent Owner’s argument to have any consequence because Patent Owner does not propose a competing level of ordinary skill in the art. Nor does Patent Owner explain why Petitioner’s proposed level of skill is deficient, as Patent Owner merely asserts that Mr. Zatkovich’s proposed level of skill is not “well-grounded in the facts.” *Id.* As we explain above, we adopt Petitioner’s proposed level of skill in the art and find Patent Owner’s conclusory assertions to the contrary unavailing.

Finally, Patent Owner argues that “there is nothing *inherent* or *necessary*” about Foss sending information “that must make it include account information *of* the separate account.” PO Resp. 12. Patent Owner contends that sending a debit card number (instead of an overdraft account number) would be possible instead:

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.

Id. (citing Ex. 2002 ¶ 31 (unrelated U.S. Patent Publication No. 2005/0246289)). Sending the debit card number would not be sending “account information *of* the separate account,” Patent Owner argues, because it would be account information of the debit account, not the overdraft account. *Id.* at 12–13.

We disagree with Patent Owner that this limitation is not inherently disclosed by Foss based on the possibility of Foss’s system sending debit account information instead of overdraft account information. That is because “account information of the separate account” encompasses

“account information *associated with* the separate account,” under the correct claim construction. *See* Ex. 1003 ¶ 387 (citing Ex. 1008 ¶ 17). As noted above, Mr. Zatkovich testifies that “the account information request would necessarily include account information *associated with* the overdraft account.” *Id.* ¶ 386 (emphasis changed). Foss’s linkage between debit and overdraft accounts means that Foss’s debit account information would necessarily be information associated with the overdraft account. *See id.* ¶ 387; Ex. 1008 ¶ 17. Thus, under the proper construction of the word “of,” Patent Owner’s assertion that Foss’s system could have sent a debit card number, rather than an overdraft account number, effectively *proves* Petitioner’s inherency argument.

In other words, Foss’s system necessarily must have sent either debit account information or overdraft account information as part of its authorization request. Otherwise, Foss’s system would not have been able to determine which overdraft account to authorize. Foss therefore inherently teaches “sending, using the computer-based authorization system, an account information request that includes account information of the separate account.”

c. Summary as to Claim 1

For the reasons explained above, Petitioner has proven by a preponderance of the evidence that claim 1 is anticipated by Foss.

3. Independent Claims 7 and 16

The parties raise similar arguments for independent claims 7 and 16 as for claim 1. *See* Pet. 18–34, 48–54; PO Resp. 13 (addressing only claim 7 and not claim 16). For similar reasons as discussed above, Petitioner has

proven by a preponderance of the evidence that claims 7 and 16 are anticipated by Foss.

4. Dependent Claims 3–5 and 8–15

Petitioner contends that dependent claims 3–5 and 8–15 are anticipated by Foss. Pet. 35–48, 54–67. Petitioner provides a detailed analysis explaining where Foss discloses the limitations in these dependent claims. Patent Owner does not dispute these assertions. We have reviewed Petitioner’s contentions and supporting evidence and find them persuasive. Thus, we determine that Petitioner has proven by a preponderance of the evidence that claims 3–5 and 8–15 are anticipated by Foss.

E. Asserted Obviousness over Foss and AAPA

Petitioner contends that dependent claim 14 would have been obvious over the combination of Foss and AAPA. Pet. 45–48. We do not reach this ground because we agree with Petitioner above that Foss anticipates claim 14. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. Apr. 30, 2020) (non-precedential) (recognizing that the “Board need not address issues that are not necessary to the resolution of the proceeding” and, thus, agreeing that the Board has “discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”).

F. Asserted Obviousness over Foss and Gopinathan

Petitioner contends that dependent claim 3 would have been obvious over the combination of Foss and Gopinathan. Pet. 59–67. We do not reach

this ground because we agree with Petitioner above that Foss anticipates claim 3.

G. Asserted Obviousness over Foss and Hirka

Petitioner contends that dependent claims 2, 6, and 17–20 would have been obvious over the combination of Foss and Hirka. Pet. 68–84.

Petitioner provides a detailed analysis explaining where the combination of Foss and Hirka discloses the limitations in claims 2, 6, and 17–20 and why a person of ordinary skill in the art would have combined the teachings of Foss and Hirka. Patent Owner does not dispute these assertions except to raise the same argument it made for claim 1. PO Resp. 18–19. We have reviewed Petitioner’s contentions and supporting evidence and find them persuasive. Thus, we determine that Petitioner has proven by a preponderance of the evidence that claims 2, 6, and 17–20 would have been obvious over the combination of Foss and Hirka.

IV. CONCLUSION⁸

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
1, 3–5, 7–16	102	Foss	1, 3–5, 7–16	
14	103	Foss, AAPA ⁹		
3	103	Foss, Gopinathan		
2, 6, 17–20	103	Foss, Hirka	2, 6, 17–20	
Overall Outcome			1–20	

V. ORDER

It is, therefore,

ORDERED that Petitioner has shown by a preponderance of the evidence that claims 1–20 of the '301 patent are unpatentable;

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

⁸ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

⁹ As we explain above, we do reach this ground or the next ground because we agree with Petitioner that Foss anticipates claims 3 and 14.

IPR2023-00422
Patent 8,905,301 B2

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