

Kahoot! v. Rubin

Inter Partes Review Case No. IPR2023-00693

Patent No. 9,064,367

“thereby” clause is limiting

New claim limitation: “wherein the second subset of the information includes information not transmitted to the first device *thereby protecting the second subset of the information not transmitted to the first device from potential malware on the first device.*”

Test: “a ‘whereby’ clause generally states the result of the patented process. However, *when the ‘whereby’ clause states a condition that is material to patentability*, it cannot be ignored in order to change the substance of the invention.” *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005)

“thereby” clause is limiting

If the second subset of information is not protected from malware on the first device, then limitation is not met.

Dr. Traynor: isolation provides protection; but if no isolation then the second subset of information is not protected, and the limitation is not met. Ex. 2009, ¶¶84-85.

Analogous Prior Art

Two separate tests define the scope of analogous prior art:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed **and**,
- (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.”

(Airbus S.A.S. v. Firepass Corp., 941 F.3d 1374, 1379 (Fed. Cir. 2019) (emphasis added); *see also Unwired Planet LLC*, 841 F.3d 995 (Fed. Cir. 2016))

1. **Field of Endeavor:**

To determine the field of endeavor, the Board must consider “*explanations of the invention's subject matter in the patent application, including the embodiments, function, and structure of the claimed invention.*” *Airbus S.A.S.*, 941 F.3d at 1380 (emphasis added).

Analogous Prior Art

Airbus considered....

1. The “written description” and the “claims” of the patent and prior art including....
 - **preamble of claim 1** (“[a] system for providing breathable fire-preventive and fire suppressive atmosphere”)
 - the **title** of the patent (“Hypoxic Fire Prevention and Fire Suppression Systems”)
 - the **specification** (“the Specification . . . is indisputably directed to the problem of fire prevention and fire suppression”)CONCLUSION: the “challenged claims are expressly directed to a fire-preventive and fire-suppressive system”

2. **'376 Patent**
 - preamble of all independent claims (“*A method of protecting information*”)
 - all the claims (“*thereby protecting the second subset of the information*”)
 - the title of the patent (“*Utilization of Multiple Devices to Secure Online Transactions*”)
 - the abstract (“*The invention described herein can be configured for securing communications against malware by utilizing two devices with differential or application-specific components during an online session*”)
 - The “Field of Invention” (“*securing communications against malware by utilizing two devices with differential or application-specific components during an online session.*”)
 - The “Detailed Description” (“*The present invention describes a system where the user has persistent use of a first device and a second device throughout the use of an online application to prevent a compromise of the transaction if malware infects either device.*”)CONCLUSION: **the challenged claims are directed towards security and protecting information with two devices during an online application**

Analogous Prior Art

1. '376 Field of Endeavor Compared to the Cited Prior Art (as analyzed through *Airbus*):

ZHA -- *Field: "a method for displaying an interface, an apparatus, a terminal and a server"*

TAKAHASHI – *Field: "a technique for controlling game progress with a communication terminal of a user via a communication network"*

TSUSHIMA – *Field: "The present invention relates to a content providing system, a control method thereof, and particularly to a streaming distribution technique for encoded video data"*

KLING – *Field: "This invention relates generally to the field of online transaction security."*

Analogous Prior Art

Two separate tests define the scope of analogous prior art:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed **and**,
- (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.”

(Airbus S.A.S. v. Firepass Corp., 941 F.3d 1374, 1379 (Fed. Cir. 2019) (emphasis added); see also Unwired Planet LLC, 841 F.3d 995 (Fed. Cir. 2016))

2. Reasonably Pertinent to the Inventor’s Particular Problem:

“[A] reference outside an inventor's field of endeavor is ‘reasonably pertinent’ only if its subject matter ‘logically would have commended itself to an inventor's attention in considering his problem.’ In other words, references are ‘reasonably pertinent’ only if ‘a person of ordinary skill would reasonably have consulted those references and applied their teachings in seeking a solution to the problem that the inventor was attempting to solve.’” Airbus S.A.S., 941 F.3d at 1382; See MPEP § 2141.01(A)

Analogous Prior Art

2. **The '376 Patent's "particular problem"** – to prevent the compromise of an online transaction by malware (Ex. 2005, ¶18)

ZHA -- Problem: reducing "network traffic" and "operational complexity" for the user. Ex. 1004, Col.1:33-43

TAKAHASHI – Problem: that a user of a social network games uses a "mobile communication terminal irrespective of where the user is" and as a result "it is difficult to realize a variety of types or forms of games on the assumption that the user uses a single communication terminal." Ex. 1007, ¶5

TSUSHIMA – Problem: seeks to provide a wider range of "operational inputs" for a user when using a mobile device as the controller for a video display (whether a game or a video) on a separate "display device." Ex. 1010, ¶¶10-11

KLING – Problem: to "overcome the challenge of providing adequate security for online transaction on inherently insecure platforms." Ex. 1023, ¶004.

Kling + Lim

- Kling fails to disclose “if and only if”

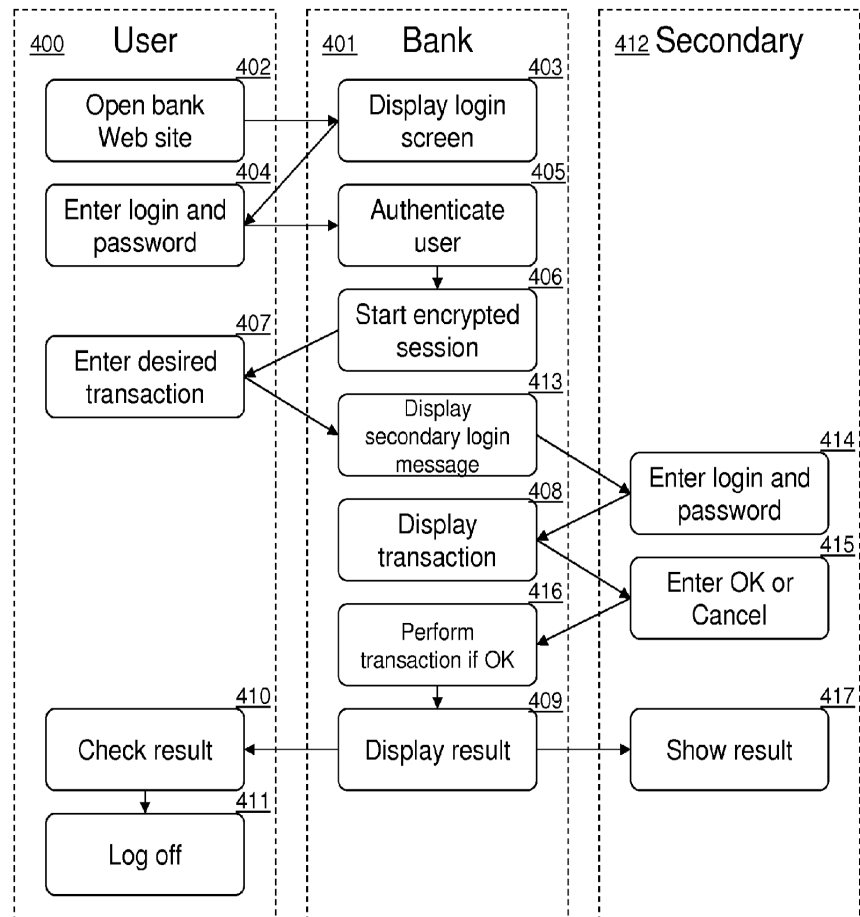


FIG. 4

Kling
Ex. 2023
Fig. 4

Kling + Lim

LIM – discloses single device authentication

[0043] That is, in the present invention, the user terminal **50** itself that will connect with the service server **300** does not perform authentication.

[0044] In the present invention, the user terminal **50** only displays an identifier on a monitor screen in the authentication process, but does not become a principal agent of the authentication. However, for authentication, the identifier displayed on the user terminal **50** is necessary for the authentication process of the authentication system **200** using authentication information. Additional authentication is per-

Lim

Ex. 1030

¶¶43, 44

Kling + Lim

- Many other issues:

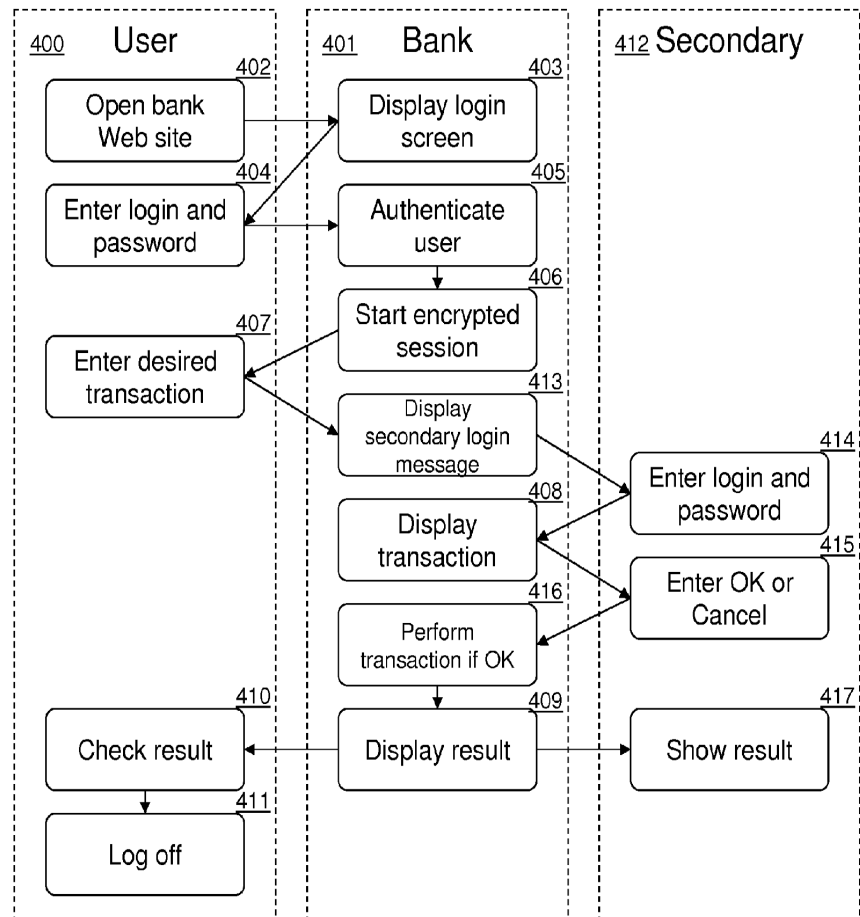


FIG. 4

Kling
Ex. 2023
Fig. 4

Teaching away

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not criticize, discredit, or otherwise discourage investigation into the invention claimed.”

Galderma Laboratories, L.P. v. Tolmar Inc., 737 F.3d 731, 739 (Fed. Cir. 2013) (citing *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, [567 F.3d 1314, 1327](#) (Fed.Cir.2009)).