

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN, L.L.C.
Petitioner

v.

OHVA, INC.
Patent Owner

IPR2023-00921
U.S. Patent 9,679,286

**PETITIONER'S AUTHORIZED REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

As authorized by the Board, Petitioner submits this reply in response to

Patent Owner's Preliminary Response ("POPR") (Paper 6).

I. THE MARCH 29, 2017 OFFICE ACTION RESPONSE DOES NOT SHOW SUPPORT FOR THE NEW MATTER OF THE CLAIMS.

The Petition showed that the challenged claims are not entitled to a priority date earlier than the filing date of the '286 Patent (March 3, 2015). Pet., 12-27. Patent Owner ("PO") relies on a March 29, 2017 Office Action Response ("Response") (EX2002) that is not in the file history of the '286 Patent to incorrectly argue that the challenged claims have an earlier priority date. The challenged claims recite subject matter that is only supported by the newly added "Brief Summary of the Invention" section of the '674 Application that issued as the '286 Patent. The Board should find that the references asserted in the Petition are prior art to the challenged claims and institute review.

A. The Response does not establish written description support for limitations [1.3.1] and [3.3].

As shown in the Petition, at least the limitations "convert the analog variable voltage audio signal...to the transaction data as digital data" (limitations [1.3.1] and [3.3]) are not entitled to the September 19, 2006 filing date of the '030 Application. Pet., 12-27; EX1003, ¶¶61-92.

For example, "the concepts of 'conversion of' or 'converting' analog data to digital data appear nowhere" in the '030 Application. Pet., 20; EX1003, ¶¶71-77.

PO cites to essentially one passage from the '286 Patent that it says supports

limitations [1.3.1] and [3.3]. POPR, 17 (citing EX1001, 14:43-45; EX2002, 8-9).

That passage is reproduced below.

If is act 1408 the token deployment mode is not dynamic, then at act 1410 the applet write the token file in encrypted form to the root drive on the client PC.

EX1001, 14:43-45. This passage does not describe “convert[ing] the analog variable voltage audio signal...to the transaction data as digital data” as claimed.

Recognizing the deficiency, PO relies on attorney argument in the Response to fill in the gaps, namely that (1) the “token file” is the analog variable voltage audio signal (POPR, 17 (citing EX2002, 8)), and (2) “writ[ing] the token” describes converting it into transaction data as digital data (POPR, 17-18). Neither of these conjectures are supported by the Response.

First, the Response does not show that the “token file” referenced in 14:43-45 of the '286 Patent is an analog variable voltage audio signal. The Response points to “the microphone port” for the claim terms “analog variable voltage audio signal,” and describes transferring a “sound pass file” and “sound pass token.” EX2002, 8 (quoting EX1001, 7:37-42). But PO ignores the fact that this token is saved in a *digital* memory (EEPROM 407) as *digital* audio files (MP4, Way, AVI, or others). EX1001, 7:37, 39-40.

Second, and relatedly, writing a digital token does not describe analog-to-

digital conversion. Rather, this passage about encryption is consistent with Mr.

McNair's explanation that the '030 Application "describes features related to the use of a user-specific token and independent verification in the log-in and data exchange process." EX1003, ¶73; Pet., 19. PO's assertion that a POSITA would understand writing a digital token as analog-to-digital conversion is entirely conclusory and not supported by the Response. POPR, 17-18. Rather, the Response merely argues that analog-to-digital conversion is inherent in the original disclosure. EX2002, 9 ("[T]he analog variable voltage signal...MUST be digitized."). Here, the Response cites only to the '030 Application, p. 19, ll. 19-27 (EX1001, 11:52-64) which just generically describes encryption.

Nothing in the Response or the POPR shows that the claim terms "convert[ing] the variable voltage audio signal" to "transaction data as digital data" are supported by the grandparent '030 Application.

B. The Response does not establish support for a "smart phone" as the "computerized appliance."

The Response argues that "the host machine may be a PC or a smart telephone" because "Applicant believes" a POSITA would "understand[] that the teachings regarding the PC also read on...a smart telephone." EX2002, 9. The Response cited 7:17-20 of the '286 Patent as its sole support for this assertion, which says "the key jack may be plugged into...a mobile smart telephone." EX2002, 9. A POSITA would not interpret this passage in the way the Patent

Owner suggests. Pet., 24-25, 27; EX1003, ¶ 125.

The computerized appliance in the '286 Patent is consistently and repeatedly illustrated and described as a PC, not a smart telephone. EX1001, Figs. 2, 3, 7 ("PC 203"), 4:51-52, 5:47, 6:61-7:3, 9:28-37, 9:50-57, 11:66-67, 12:20, 13:20-24, 15:6-12. PO relies on 7:52-55 of the '286 Patent, but this portion merely describes a PC as having "a mobile device key jack 400" for bidirectionally communicating with a mobile device. POPR, 16. The above-identified passages do not provide written description support for a smart telephone having a processor that "convert[s] the analog variable voltage audio signal...to the transaction data as digital data."

C. The Examiner never withdrew his designation of the application as a continuation-in-part.

PO argues that, simply by allowing the claims, the Examiner "apparently withdrew her contention that the '286 Patent was a 'continuation in part.'" POPR, 14-15; Pet., 10, 19 (Examiner indicating that the '674 Application is a continuation-in-part). PO incorrectly assumes that a notice of allowance ratifies all the Applicant's arguments in the Response. However, the Examiner's designation of the '286 Patent as a continuation-in-part ("CIP") was never withdrawn.

Tellingly, the Response requested an Examiner interview "[i]f the Examiner is still of a mind that new matter exists." EX2002, 16. An Examiner interview occurred, but the Examiner's summary of the interview in the Notice of Allowance do not indicate that the Examiner withdrew the CIP designation. EX1002, 33.

Finally, as explained above, the face of the '286 Patent identifying it as a continuation does not show that the specific claim elements lacking support are entitled to the priority date of the '030 Application (they are not).

II. AUTHENTICITY CONCERNS ABOUT THE RESPONSE

There are several concerns regarding the authenticity of the Response.

First, the claim amendments of the Response are not reflected in the Notice of Allowance. For example, the Response presents claims 1, 8-9, 16, and new claims 18-25 (EX2002, 2-5), but the Notice of Allowance identifies only claims 1, 8-9, and 16 as being allowed and there is no discussion of new claims 18-25 in the Notice of Allowance. EX1002, 32-33. Second, there is a discrepancy in the naming convention of the Applicant's responses. Specifically, the Response is labeled as "Response E," while the last office action response was labeled "Response C" (filed 10/14/2016, following "Response A," filed July 8, 2015, and "Response B," filed December 7, 2015). EX1002, 192, 359, 287. Third, neither PO nor Mr. Boys (EX2001) produced any filing receipt for the Response in the file history of the '286 Patent.

Dated: October 20, 2023

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Respectfully submitted,

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PETITIONER'S EXHIBIT LIST

EX1001	U.S. Patent No. 9,679,286 to Colnot et al. ("286 Patent")
EX1002	Prosecution History of U.S. Patent No. 9,679,286 (U.S. Application No. 14/636,674) ("674 Application")
EX1003	Declaration of Bruce McNair
EX1004	<i>Curriculum Vitae</i> of Bruce McNair
EX1005	U.S. Patent No. 9,330,385 to Cho et al. ("Cho")
EX1006	U.S. Patent Publication No. 2013/0185208 to Aaron et al. ("Aaron")
EX1007	U.S. Patent Publication No. 2014/0008432 to de Geer et al. ("de Geer")
EX1008	U.S. Patent Publication No. 2013/0124606 to Carpenter et al. ("Carpenter")
EX1009	Declaration of Glenn J. Perry
EX1010	Letter Agreement Between Glenn J. Perry and Askeladden L.L.C dated May 20, 2020
EX1011	U.S. Application No. 14/524,842 ("842 Application")
EX1012	U.S. Application No. 11/533,030 ("030 Application")
EX1013	U.S. Provisional Application No. 60/719,273 ("273 Provisional")
EX1014	Comparison of the as-filed specification of the '674 Application (filed 2015) with the as-filed specification of the '842 Application (filed 2014)
EX1015	Comparison of the as-filed specification of the '674 Application (filed 2015) with the as-filed specification of the '030 Application (filed 2006)
EX1016	Comparison of the as-filed specification of the '842 Application (filed 2014) with the as-filed specification of the '030 Application (filed 2006)
EX1017	U.S. Patent No. 9,436,855 to Marcus et al. ("Marcus")
EX1018	U.S. Patent No. 8,302,860 to McKelvey ("McKelvey")
EX1019	KR 2003 0076045 ("Bluetooth")
EX1020	U.S. Patent No. 6,607,136 to Atsmon et al. ("Atsmon")
EX1021	U.S. Patent No. 7,761,374 to Sahota et al. ("Sahota")
EX1022	U.S. Application No. 2004/0093436 to Colnot ("Colnot")
EX1023	U.S. Patent Application No. 2005/0075134 to Steenstra et al. ("Steenstra")
EX1024	"Turning your mobile into a magnetic stripe reader," Deepquest ("Deepquest")

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EX1025	U.S. Patent Application No. 2004/0230489 to Goldthwaite et al. ("Goldthwaite")
EX1026	U.S. Patent Application No. 2004/039919 to Takayama et al. ("Takayama")
EX1027	U.S. Patent No. 9,016,572 to Babu et al. ("Babu")
EX1028	U.S. Patent No. 7,490,777 to Walsh ("Walsh")
EX1029	U.S. Patent No. 7,240,836 to Vrotsos et al. ("Vrotsos")
EX1030	"Application Programmer's Guide, IBM, 2011
EX1031	U.S. Patent No. 9,003,508 to Colnot et al. ("508 Patent")
EX1032	U.S. Patent Publication No. 2007/0064833 to Colnot et al. ("833 Publication")
EX1033	Memorandum of Director Katherine K. Vidal, "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," June 21, 2022 (" <i>Fintiv</i> Guidance")
EX1034	United States District Court – National Judicial Caseload Profile (March 2023)
EX1035	Apple Store, (September 14, 2005, Internet Archive Capture), available at https://web.archive.org/web/20050914225016/http://store.apple.com:80/1-800-MY-APPLE/WebObjects/AppleStore.woa
EX1036	<i>Identify your iPod Model</i> , Apple, available at https://support.apple.com/en-us/HT204217
EX1037	<i>Apple Announces iPhone 2.0 Software Beta</i> , Apple Press Release, March 6, 2008, available at https://www.apple.com/newsroom/2008/03/06Apple-Announces-iPhone-2-0-Software-Beta/
EX1038	<i>iPhone App Store Downloads Top 10 Million in First Weekend</i> , Apple Press Release, July 14, 2008, available at https://www.apple.com/newsroom/2008/07/14iPhone-App-Store-Downloads-Top-10-Million-in-First-Weekend/
EX1039	<i>Identify your iPhone model</i> , Apple, available at https://support.apple.com/en-us/HT201296

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service October 20, 2023

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Documents served **Petitioner's Authorized Reply to Patent Owner's Preliminary Response**

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