

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN, L.L.C.,

Petitioner,

v.

OHVA, INC.,

Patent Owner.

Case No. IPR2023-00921

U.S. Patent No. 9,679,286

**PATENT OWNER'S AUTHORIZED SUR-REPLY
TO PETITIONER'S AUTHORIZED REPLY**

TABLE OF EXHIBITS

Exhibit	Description
2003	Declaration of Donald R. Boys (October 26, 2023)
2004	“Fax Docs” Word Document (March 29, 2017)

As authorized by the Board, Patent Owner submits this Sur-Reply in response to Petitioner's Reply to Patent Owner's Preliminary Response.

**I. THE EXAMINER IMPLICITLY WITHDREW HIS
"CONTINUATION-IN-PART" DESIGNATION**

Petitioner continues to claim, rather disingenuously, that the '286 Patent is a "continuation-in-part" because, according to Petitioner, the Examiner's "designation of the '286 Patent as a continuation-in-part ("CIP") was never withdrawn." (Reply at 4.) Apart from the fact that the '286 Patent, as issued, clearly states on its face that it is "**a Continuation**" (EX1001 at 18, 1:9 (emphasis added))—***not*** a continuation-in-part—Petitioner's argument fails to heed other critical context during prosecution showing that the Examiner ultimately agreed with the Patent Owner.

Petitioner makes much of the Examiner's position in the Final Rejection that the addition of new matter rendered the '674 application a continuation-in-part. However, Petitioner fails to acknowledge that the Examiner expressly stated that: "The Examiner will reconsider the prior art rejections if Applicant can show that: 1) the amended claims are supported; and 2) the specification does not add new matter." EX1002 at 110. Ultimately, the Examiner ***did*** reconsider the prior art rejections—and withdrew them—precisely because the amended claims were supported and the specification did not add new matter.

In the Final Rejection, the Examiner rejected the claims as anticipated under 35 U.S.C. § 102 based on a reference apparently dating from 2015, U.S. Pat. No.

9,016,572 (“Babu”). EX1002 at 117-118, 129. Ultimately, however, in the Notice of Allowability accompanying the Notice of Allowance the Examiner analyzed what he believed was the closest prior art. Babu, the 2015 reference, was not among it. Instead of analyzing Babu, the Examiner focused his analysis on references pre-dating the September 20, 2005 priority date—namely the Deepquest reference from April 3, 2005, and Goldthwiate from 2004. EX1002 at 36.

Clearly, this indicates that the Examiner agreed with the applicant that the ’286 Patent was entitled to its September 20, 2005 priority date. If the Examiner had believed that the ’674 application was entitled only to its filing date of March 3, 2015, then the Examiner would surely have considered the 2015 Babu reference as the closest prior art, particularly since the Examiner had just previously rejected the claims as anticipated by Babu. As such, the Examiner agreed that the ’286 Patent is entitled to its early September 20, 2005 priority date, and allowed it to issue as a Continuation—not as a continuation-in-part.

II. THE WRITTEN DESCRIPTION OF THE ’286 PATENT CONTAINS SUPPORT FOR LIMITATIONS [1.3.1] AND [3.3].

Petitioner points to an isolated passage from the specification as supposedly not disclosing support for converting analog data to digital data, but fails to read the passage from the perspective of a skilled artisan and misses other important aspects of the specification. As explained elsewhere in the ’286 Patent:

One device that is disclosed herein and that may serve as a sound pass token is a smart card used in conjunction with a card reader. Another device that may be used as a sound pass token is a unique key device termed a key jack by the inventor. The key jack may be adapted to be inserted into any “audio in” line on a PC such as the microphone port, telephone jack, or any auxiliary port having connection directly or indirectly to the sound card on the PC. The key jack is manipulated to play the modulated sound pass by pressing a button provided on the device when the device is properly inserted into the PC. The applet on the PC makes use of the sound pass token, demodulating the signal and generating the hash code for send to the authentication server.

EX1001 at 20, 6:56-7:3; *see also id.* at 19, 4:39-43; and *id.* at 20, 5:56-67.

The client has a sound file token 901 located on a PC or on some external device like a cell phone, PDA, or other handheld device capable of playing the sound file. The current sound file has the user ID number and the last session key sent to the server at the last successful transaction that required authentication.

EX1001 at 23, 11:13-17.

In the broader context of the patent, a skilled artisan would recognize that any card data from “a smart card used in conjunction with a card reader” (a “sound pass token”) was analog data that had to be converted into digital data prior to entering, e.g., a USB port connection that only accepts a digital signal, or before being transmitted across a network. EX1001 at 20, 6:56-7:3. Thus, a skilled artisan would recognize that when an “applet on the PC makes use of the sound pass token, *demodulating the signal*,” the analog data is necessarily converted to digital data. *Id.* (emphasis added).

Petitioner focuses on the word “convert,” but ignores what the disclosure would actually impart to the skilled artisan. Moreover, analog-to-digital conversion

was known in the art and was not the point of novelty here. It is well-established that “a patentee can rely on information that is ‘well-known in the art’ to satisfy written description.” *Streck, Inc. v. Rsch. & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1285 (Fed. Cir. 2012).

III. THE WRITTEN DESCRIPTION OF THE '286 PATENT CONTAINS SUPPORT FOR A “SMART TELEPHONE” AS A “COMPUTERIZED APPLIANCE”

Petitioner ignores other aspects of the specification showing support for a “smart telephone.” For example, when the “sound file token” (i.e., analog data from the card and card reader) comes to be “located on a PC or on some external device like a cell phone, PDA, or other handheld device,” and the “current sound file has the user ID number and the last session key sent to the server at the last successful transaction that required authentication,” a skilled artisan would recognize that this necessarily discloses that the analog sound file token was converted to digital data on a “cell phone, PDA, or other handheld device.” EX1001 at 23, 11:13-17; Fig 9.

IV. THE APPLICANT ADDRESSED THE ALLEGED “NEW MATTER” ISSUES DURING AN EXAMINER INTERVIEW

On further investigation, the attorney responsible for prosecuting the '286 Patent, Donald R. Boys, has discovered that the March 29, 2017 Response, previously submitted in this IPR as EX2002, was apparently not filed. *See* EX2003 [Declaration of Donald R. Boys], at ¶¶ 1-5. It appears that the Response was never actually filed because the Examiner indicated during an interview that a formal

response would not be necessary. *See id.*, ¶ 3. The Examiner invited the applicant to submit the proposed claim amendments informally, along with a summary of the applicant's rationale regarding the priority date issue. *See id.* Mr. Boys apparently faxed to the Examiner a Word document, entitled "Fax Docs," recently located by Mr. Boys. The document is submitted herewith as EX2004.

This document shows that the applicant *did* discuss with the Examiner the priority and alleged "new matter" issues, directing his attention to portions of the '030 application (pg. 19, ll. 19-27 and pg. 12, ll. 25-27) corresponding to 11:13-20 and 7:52-57 of the '286 Patent. *See* EX2004 at 4. Applicant specifically pointed out that "[o]ne with skill in the art clearly understands that the analog variable voltage signal is not transmitted on a wireless network and MUST be digitized."¹ *Id.*

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¹ Notably, the Notice of Allowability states that it is "responsive to 3/29/17." EX1002 at 32. Further, it states that "[a]uthorization for this examiner's amendment was given in an interview with Donald Boys (Reg [sic] no. 35,074) on 3/31/17." *Id.* at 33. Moreover, it contains an Examiner's Amendment entering the proposed amendments from the document located by Mr. Boys. *Compare* EX2004 at 5-6, with EX1002 at 33-35.

CERTIFICATE OF SERVICE

It is hereby certified that on October 27, 2023, a copy of the foregoing document was served via Electronic Mail upon the following:

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