

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 SUR-REPLY TO PATENT
OWNER'S REPLY TO REQUEST FOR REHEARING**

The Board should grant rehearing and institute trial for the reasons set forth in Petitioner's Request for Rehearing ("Request") (Paper 12) of the Decision Denying Institution ("Decision") (Paper 11). Patent Owner's arguments in the Reply (Paper 13) lack merit.

I. PETITIONER'S ARGUMENTS IN THE REQUEST ARE PROPER

Patent Owner argues that the Request is improper because it (1) does not identify "all matters the Board misapprehended or overlooked" and (2) presents new arguments not included in the Petition. Reply, 1-3. Patent Owner is wrong.

A. Petitioner has identified legal error that warrants rehearing.

The Request identifies matters the Decision misapprehended or overlooked. Specifically, the Request shows that the Decision constitutes legal error because it interpreted "transaction data" as requiring limitations not recited in the claims. Request, 2-5. The Request therefore shows that the Decision is an abuse of discretion for which the Board should grant rehearing. "An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law...." *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005). The Board has granted rehearing and instituted review when the rehearing request showed that a denial of institution was based on "erroneous interpretation[s] of law." *See, e.g., TWI Pharms., Inc. v. Merck Serono SA*, IPR2023-00050, Paper 13, 4 (Dec. 20, 2023) (granting rehearing when the Board misapprehended the scope

of the challenged claims in denying institution).

As the Board should do here, the panel in *TWI* recognized on rehearing that it had “overlooked or misapprehended the scope of Patent Owner’s claims” by incorrectly importing a limitation not recited in the claims. *TWI*, IPR2023-00050, Paper 13, 4 (because “the claims do not exclude ‘flat dosing’..., we are persuaded that Petitioner has met its burden”). Other panels have similarly instituted on rehearing due to a misinterpretation of claim scope. *See, e.g., Apple Inc. v. Corephotonics, Ltd.*, IPR2020-00487, Paper 13, 3 (Nov. 5, 2020) (institution on rehearing when Board had “misapprehended the scope of” the claim terms); *Ford Motor Co. v. Ethanol Boosting Sys., LLC*, IPR2021-00339, Paper 17, 5-6 (Nov. 21, 2022) (institution on rehearing based on different claim construction).

B. Petitioner’s arguments in the Request are not improperly new because they are responsive to the legal error in the Decision.

Petitioner’s arguments in the Request are directly responsive to the legally erroneous interpretation of the term “transaction data” in the Decision. Specifically, the Request shows why it was improper to interpret “transaction data” as being distinguished from “account information” based on the embodiment of Fig. 11, when claims 1 and 3 are not limited to that embodiment, and there is no recitation of “account information” in the claims. Request, 2-5. The arguments in the Request therefore are properly responsive to the legal error in the Decision, and thus are not improper. *See Skky, Inc. v. MindGeek, s.a.r.l.*, 859 F.3d 1014, 1023

(Fed. Cir. 2017) (argument not improper if it “respond[s] to the positions laid out by...the Board.”), *Everstar Merch. Co. v. Willis Elec. Co.*, 2022 WL 1089909, at *4 (Fed. Cir. Apr. 12, 2022) (argument not improper if it “is a legitimate reply to arguments introduced in...the Board’s institution determination.”).

Patent Owner incorrectly argues that Petitioner should have argued in the Petition that “transaction data” may be equated with “account information” in the Petition. Reply, 2. Patent Owner is mistaken. There was no reason to anticipate that “transaction data,” as recited in claims 1 and 3, would be interpreted as excluding “account information” based on the Figure 11 embodiment, particularly when claims 1 and 3 do not recite any “account information” and are not limited to the Figure 11 embodiment. Request, 4-10. Thus, there was no reason for Petitioner to anticipate the legally incorrect finding that “transaction data” is distinguished from “account information” based on the Figure 11 embodiment. Request, 7-9.

The Board has recognized that new arguments that address issues not reasonably expected are proper. *See Momentum Dynamics Corporation v. Witricity Corporation*, IPR2021-01165, Paper 9, 2 (Mar. 16, 2022) (institution on rehearing when the Board “d[id] not regard the explanations as belated because Petitioner reasonably might not have expected the Patent Owner or the Board to question these aspects.”). Patent Owner’s arguments would impose the requirement that petitioners predict every claim term that might later be disputed and preemptively

rebut each argument before it is raised. Such a requirement is unreasonable here

when “transaction data” should not be construed based on the Figure 11

embodiment. Accordingly, Petitioner's arguments in the Request regarding the

legally incorrect interpretation of “transaction data” are not improper.

II. THE DECISION'S ERROR WARRANTS REHEARING

A. The plain and ordinary meaning of “transaction data” includes the account information described by Cho.

Limitations in the specification may not be read into the claims, particularly if the claim terms at issue are unambiguous. *See, e.g., Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1371 (Fed. Cir. 2002)

(“limitations from...the specification will not be read in where, as here, the claim

terms are clear”); *Gart v. Logitech, Inc.*, 254 F.3d 1334, 1343 (Fed. Cir. 2001)

(“improper[to] add a limitation appearing in the specification and the drawings,

but not appearing in the unambiguous language of the claim”). Petitioner and

Patent Owner both construed all terms, including “transaction data,” according to

their plain and ordinary meaning. Petition, 28; Preliminary Response, 11. Thus,

there was no ambiguity about the meaning of “transaction data,” as recited in

claims 1 and 3. Transaction data comes “from a transaction card.” EX1001, 16:19-

20 (claim 1). Cho's account information, which comes from a transaction card,

teaches the claimed “transaction data.” Request, 12; Pet., 42 (citing EX1005, 3:20-

27 (“account information may be read from a card 130 by card payment apparatus

120.”), 4:28-32, 5:58-60, 10:10-14), 46 (citing EX1005, 3:22-27).

B. Patent Owner's claim differentiation arguments lack merit.

Patent Owner argues that claim differentiation requires an interpretation that “transaction data” exclude “account information” because “different claim terms are presumed to have different meanings.” Reply, 3, 4-5 (citations omitted). Patent Owner is wrong. None of the claims recite “account information.” Consequently, there is no need for claim differentiation between the claimed “transaction data” and the unclaimed “account information.” It is legal error to interpret “transaction data” as being distinguished from “account information” when the Figure 11 embodiment is not required by the claims. Request, 3-5. Patent Owner disregards the other embodiments in the '286 patent that do *not* exclude account information, focusing only on the portions “[w]here they are discussed together.” Reply, 5. As shown in the Request, it is legally incorrect to interpret “transaction data” as excluding “account information” that is discussed in the Figure 11 embodiment, when the challenged claims are not limited to this embodiment (Request, 5-7), and the '286 patent discloses other embodiments that do not differentiate “transaction data” from “account information.” Request, 7-9.

III. CONCLUSION

The Board should grant rehearing and institute a trial. The Decision constitutes legal error and is therefore an abuse of discretion.

Dated: February 6, 2024

HAYNES AND BOONE, LLP
2801 N. Harwood St., Suite 2300
Dallas, TX 75201
Customer No. 27683

Respectfully submitted,

/Jonathan R. Bowser/

Jonathan R. Bowser
Counsel for Petitioner
Reg. No. 54,574

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 February 6, 2024

Manner of service Electronic Email: isaac@rabilaw.com

Documents served **Petitioner's Sur-reply to Patent Owner's Reply to Request for Rehearing**

Persons served Isaac Rabicoff
Rabicoff Law LLC
600 Mamaroneck Ave, Suite 400
Harrison, NY 10528

/Jonathan R. Bowser/

Jonathan R. Bowser
Counsel for Petitioner
Reg. No. 54,574