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Paper No. ____

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SECURITY FIRST INNOVATIONS, LLC
Patent Owner.

Case No. IPR2024-00212
Patent No. 11,178,116

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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¹ All emphases in this paper are added, and internal citations omitted, unless otherwise indicated.

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SFI's Request (Paper 43) provides no valid reason to disturb the FWD's (Paper 42) well-reasoned findings on the Tajima-Foster and Foster-Hayhurst combinations.

I. THE BOARD CORRECTLY ANALYZED TAJIMA-FOSTER

SFI's allegation that the Board's "analysis of the Tajima/Foster combination" improperly "relied on...new evidence" in an "excessive...reply expert declaration" (Request, 11) is conclusory and meritless. The reply declaration's Tajima-Foster section is only 8 pages long (EX1111, ¶¶34-47), and the FWD (at 21) cites it for rebutting "Patent Owner's argument[s]" in the POR (Paper 17). Petitioners "may introduce new evidence...[that] is a legitimate reply to evidence introduced by the patent owner." *Anacor Pharms., Inc. v. Iancu*, 889 F.3d 1372, 1380 (Fed. Cir. 2018).

SFI next argues that the Board "overlooked" that Tajima stores an encryption key's information "with a *different* data fragment," which would preclude "Foster's synchronized transmission" that requires "keeping the encryption key with the *same* data that it encrypts." Request, 12 (SFI's emphasis). But the Board *did* consider this and was "not persuaded," because "Petitioner's combination" secures "*Tajima's data* (which does not require synchronization)..., not Foster's." FWD, 22. In other words, Petitioner's Tajima-Foster combination does not need to perform "Foster's synchronized transmission." It performs *Tajima's* data encryption and storage, modified by Foster's teaching to encrypt the key "using a KEK (Key Encryption Key)"—not Foster's synchronized transmission. FWD, 20 (citing Pet., 34-40).

Foster is “read for *all* that it teaches, including uses [of a KEK] beyond its primary purpose.” *In re Mouttet*, 686 F.3d 1322, 1331 (Fed. Cir. 2012). SFI lacks any authority for its assertion that Foster’s teaching to encrypt a key cannot be combined with Tajima “in *any* way” just because combining a *different* Foster teaching (where to store a key) might create “incompatibility.” Request, 12-13. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011) (cited in Request, 13) supports *Petitioner* because it says an obvious combination can “select[]” particular “prior art *elements*” to combine so long as there is motivation, which the Board found here.

SFI finally argues the Board “overlooked” that “applying Foster’s KEK to Tajima[]” is “unnecessary”/“useless” and has “drawbacks.” Request, 13-14. Again, far from overlooking SFI’s points, the Board evaluated and found them “unavailing.” FWD, 21. Foster’s KEK is not “redundant”; it “increase[s] security” over Tajima’s obfuscation. *Id.* Whether Tajima thought its own “solution” sufficient (Request, 13-14) is beside the point—Tajima “did not need to hold itself out as flawed for a POSA to alter it.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 97 F.4th 915, 929 (Fed. Cir. 2024). SFI’s Request at 13 also mischaracterizes Dr. Bhattacharjee’s testimony. He was not talking about Tajima in EX2046, 58:23-59:5. And the Board explicitly “considered [SFI]’s other arguments and f[ou]nd them lacking” for “reasons already discussed.” FWD, 22. To the extent SFI now alleges there were more “drawbacks” it could have argued (Request, 14), those were not in SFI’s briefs and are waived.

II. THE BOARD CORRECTLY ANALYZED FOSTER-HAYHURST

A. Hayhurst Is Analogous Art

SFI argues that “Hayhurst’s field is ‘decentralized media delivery’” and is “unrelated to” the ’116 patent’s field of “securing data.” Request, 3. The Board properly rejected that argument because Hayhurst “describes its ‘Technical Field’ as ‘electronic media delivery...including *the secure handling and storage* of such media.’” FWD, 28-29 (quoting EX1007, [0002]). SFI argues that, by crediting Hayhurst’s *Technical Field*, the Board “erred” by “focus[ing] on a single clause in the specification taken out of context.” Request, 3. But the Board did look to the clause’s context—it is literally in the section that sets forth Hayhurst’s “field.” It is unclear how any other clause could be more probative of what is in Hayhurst’s field than the *Technical Field* statement. SFI’s request that the Director reverse the Board and find that Hayhurst inaccurately characterized its own “Field” strains credulity.

Even if it were necessary for the Board to make findings about other portions of Hayhurst cited in the Request at 3, that would not be grounds for reversal, because the same panel explained in IPR2024-00215 (Paper 43 at 11-12) how “all the parts of Hayhurst identified in [SFI]’s table” support that Hayhurst shares the ’854 and ’116 patents’ field of “securing data.” Additionally, reversal would be improper even if the Board had erred on field of endeavor, because Petitioner also argued reasonable pertinence (Paper 21 at 22-24). The Board in IPR2024-00215 (Paper 43 at 13-16)

found Hayhurst pertinent to the same three problems Petitioner identified here.

B. The Foster-Hayhurst Combination in the Petition and FWD Is Not a “Reply-Stage Theory”

SFI’s allegation that “[t]he FWD...invalidated the claims based upon a new theory presented only in reply” (Request, 4) is meritless. The Foster-Hayhurst combination is the same in the Petition, Reply, and FWD. The Petition did not make a “combination [that] was not...justified by any particular application, context, or embodiment of Foster” (Request, 6). As the Board explained, the combination’s use of “disclosure of storing video information in Foster began with the Petition,” and SFI’s “suggestion of surprise and prejudice is without merit.” FWD, 35.

As the Petition explained, Foster discloses encrypting content “which can be ‘*stored* by a recipient’ in a receiver (*e.g.*, *stored* in a consumer’s set-top box).” Paper 2 (“Pet.”), 52. Foster’s techniques are usable not just for live broadcasts, but also for pre-stored video-on-demand, *e.g.*, “*movie[s]*.” *Id.*, 53 (citing EX1006, [0038]); *see* FWD, 31-33. “*Like Foster*, Hayhurst concerns ‘electronic media delivery, such as video-on-demand’ and the ‘secure handling *and storage*’ of media files (*e.g.*, *movies*).” Pet., 55. Hayhurst’s “conventional set-top box” is “just like exemplary ‘set-top box’ receivers at *Foster’s* recipients” which include storage devices “*for storing*” media files. *Id.*, 56. In the combination, Hayhurst’s teachings motivate POSAs to “distributively *store[]*” a media file “on multiple subscriber units (like *Foster’s receivers*).” *Id.*, 61-62. Foster-Hayhurst thus “distributes” encrypted

content “to different respective Foster-Hayhurst subscriber units (*Foster’s recipients* 430 adapted to send *stored* content units to a requesting subscriber as taught by Hayhurst).” *Id.*, 66. See FWD, 29-32 (citing Pet., 51-54, 61-67).

SFI’s allegation that applying Hayhurst’s teachings to a “storage context” in Foster was “argued for the first time” in reply (Request, 8-9) is thus plainly untrue; the Board correctly rejected it. FWD, 35. It was *SFI* who first alleged that Foster is so “directed towards real time streaming of television and live events” that the combination with Hayhurst would be “unsuitable” if it had drawbacks in the limited context of “streaming live television.” POR, 47-48, 57 (alleging “the combination would not be capable of providing streaming (*e.g.*, real-time television)”). Petitioner properly presented reply evidence in response to “Patent Owner’s misapprehension that Foster is limited to streaming”—*e.g.*, by citing where Foster *also* discusses improving “DRMs (Digital Rights Management Systems)” that “stream[] *or store[]* content.” FWD, 32-33. This is entirely proper. *Anacor*, 889 F.3d at 1380.

SFI’s further assertions that Foster-Hayhurst has “drawbacks” outweighing its benefits (Request, 10-11) were also thoroughly considered and correctly rejected. The Board found “Foster teaches storing encrypted content, such as video-on-demand,” and thus benefits from Hayhurst’s techniques; and Hayhurst increases security in ways that “outweigh[] any drawbacks alleged by” SFI. FWD, 30, 34.

SFI’s request should be denied.

/Elisabeth Hunt/ June 25, 2025
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on June 25, 2025, a copy of the foregoing document, including any exhibits or appendices filed therewith, is being served via electronic mail, as previously consented to by Patent Owner, upon the following:

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