IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Ex Parte Reexamination of	Issue Date: March 29, 2016
U.S. Patent No. 9,298,905	Confirmation No. 7424
Inventor: John J. Giobbi	Art Unit: 3992
Assignee: Proxense, LLC	Examiner: Carlson, Jeffrey D.
Control No. 90/015,053	

Title: **BIOMETRIC PERSONAL DATA KEY (PDK) AUTHENTICATION**

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INTERVIEW SUMMARY

Patent Owner thanks Examiner Jeffery D. Carlson, Reexamination Specialist C. Michelle Tarae, and Supervisory Patent Examiner Michael Fuelling for the interview conducted on October 9, 2024.

Prior to the Interview, Patent Owner submitted and an Agenda detailing why a request for adverse judgement under 37 C.F.R. § 42.73(b) will be filed in IPR2024-00234. As noted in the Agenda, in *Google, LLC. v. Proxense, LLC,* IPR2024-00234, Decision Granting Institution, Paper 10 at 10-11 (PTAB July 23, 2024), the PTAB apparently construed "financial transaction" as recited in claims 1, 9, and 13 as including transactions in which the principal parties are a merchant (e.g., grocery store) and a user. Financial transactions in which the principal parties are a user and merchant, however, lack written description support and/or are not enabled by the 905 Patent. The claims, as apparently construed by the PTAB in IPR2024-00234, therefore, are invalid under 35

U.S.C. § 112 irrespective of the prior art. This renders moot the Final Rejection and Appeal in the present proceedings, as well as the grounds for invalidity asserted in IPR2024-00234. Accordingly, Patent Owner will be filing a request for adverse judgement under 37 C.F.R. § 42.73(b) in IPR2024-00234.

In support of construing the claims to encompass financial transactions in which the principal parties to the transaction are a merchant and a user, the PTAB stated the following:

> "***Fig. 7.*** Although the trusted key authority in this example is not a principal party to the transaction (***here, the parties are the user and the application***), it is an active participant in facilitating the transaction. ***In another preferred embodiment of the '905 Patent***, trusted key authority 320 plays an active role in transactions, e.g., verifying to a grocery store that a biometric key presented by a customer is legitimate, thereby allowing the transaction to proceed. Id. at 6:39–53, Figs. 3–4. However, despite trusted key authority's active participation, ***the parties to such a transaction are the customer and the grocery store***, not trusted key authority 320." IPR2024-00234, Paper 10 at 10-11 (emphasis added).

Figures 3 and 4, however, neither disclose nor enable a transaction between a grocery store and customer. Rather, Figures 3 and 4 depict a system and method the 905 patent details as conforming with Figure 7, which the PTAB found discloses a transaction where "the parties to the transaction are the user and the application."

Figure 7 (reproduced below) details the code utilized to authenticate a biometric key in the method 400 for authenticating a biometrically verified user. Method 400 is illustrated in Figure 4 (reproduced below). Specifically, the 905 Patent states:

> "The code is utilized to authenticate the biometric key itself ***450, 460 as described below with reference to FIG. 7*** and profile information is received. ***Responsive to successful authentication of the key, access is allowed 470 to the application***." 905 Patent, 7:23-28 (emphasis added).

Accordingly, Figure 4 incorporates Figure 7. Consequently, as Figure 7 depicts a transaction in which "***the parties are the user and the application,***" Figure 4 must also depict a transaction in which the parties are the user and the application, and ***not*** a transaction in which the parties are a customer and grocery store.

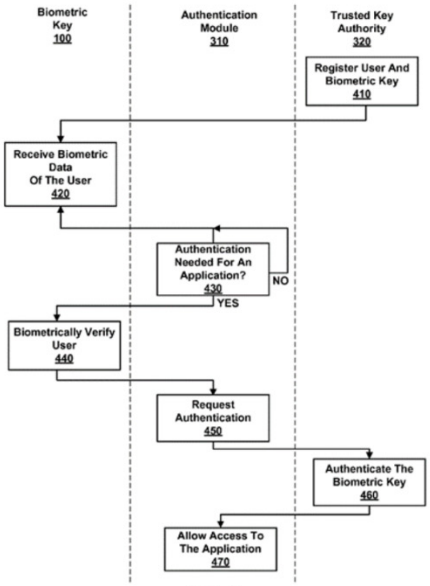

FIG. 4

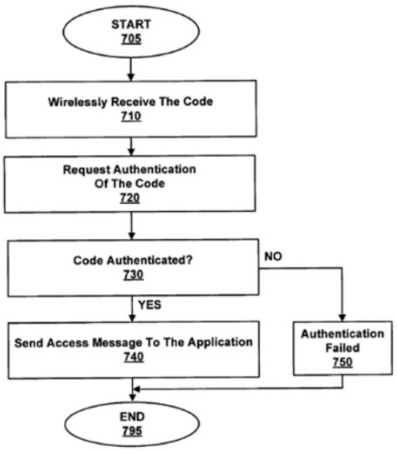

FIG. 7

Figure 3 (reproduced below) also fails to show a transaction in which the parties are a user and a merchant.

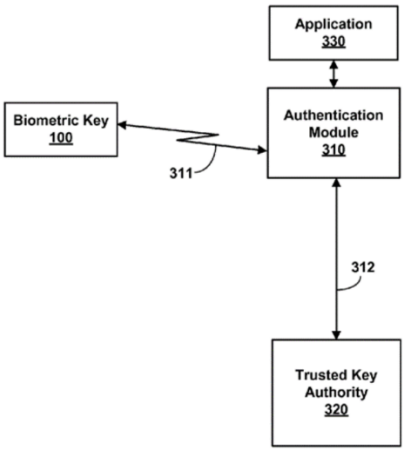

FIG. 3

With regards to Figure 3, the 905 Patent states:

> "Further, in one embodiment, ***authentication module 310 provides the code to trusted key authority 320*** in order to verify that it belongs to a legitimate key (e.g., when application 330 is security-critical). ***Authentication module 310 can send a message to application 330***, or otherwise allow access to the application, ***responsive to a successful authentication by trusted key authority 320.***"905 Patent, 6:13-19 (emphasis added).

Authentication module 310 providing the code to trusted key authority 320 corresponds to step 710 of Figure 7 ("Wirelessly Receive The Code") and step 450 of Figure 4 ("Request Authentication"). Furthermore, authentication module 310 sending a message to application 330 responsive to successful authentication by trusted key authority 320 corresponds to step 740 of Figure 7 ("Send Access Message To The Application"). Accordingly, Figure 3 is analogous to Figure 7 and therefore depicts a transaction in which the parties are the user and the application, and ***not*** a transaction in which the parties are a customer and grocery store.

As with Figures 3 and 4, the passage cited by the PTAB fails to describe a transaction between a user and merchant. The passage cited by the PTAB reads:

> "In one embodiment, trusted key authority 320 verifies that a code from a biometric key is legitimate. To do so, the trusted key authority 320 stores a list of codes for legitimate biometric keys. The list can be batched or updated each time a new user/key is enrolled. In one embodiment, trusted key authority 320 can also store a profile associated with a biometric key. The profile describes the user associated with the key, the key itself, the trusted key authority, and/or other relevant information. In one embodiment, the functionality of trusted key authority 320 is provided by a server or other computerized device."

> "In an open system, where unknown users can attempt authentication (***e.g., in a public grocery store***), trusted key authority 320 provides verification that a key presenting a certain code is legitimate."905 Patent, 6:39-53 (emphasis added).

Only once does the passage mention a merchant, but not as a party to a transaction. Rather, the merchant is only mentioned as the location of the transaction – "in a public grocery store." Accordingly, the passage does not describe a transaction in which the parties are a user and a merchant.

As the above demonstrates, the portions of the 905 Patent cited by the PTAB in support of its apparent construction fail to describe a transaction in which the parties are a user and merchant. Only transactions in which parties are a user and application are described. Consequently, the PTAB's apparent construction of a "financial transaction" lacks written description and/or is not enabled by the specification of the 905 Patent. Therefore, the claims of the 905 Patent, as apparently construed by the PTAB in IPR2024-00234, are invalid under 35 U.S.C. § 112, irrespective of the prior art. This renders moot the Final Rejection and Appeal in the present proceedings, as well as the grounds for invalidity asserted in IPR2024-00234.

SPE Fuelling advised Mr. Zak that irrespective of filing a request for adverse judgement under 37 C.F.R. § 42.73(b) in IPR2024-00234, the proceedings would be maintained because *inter*

partes review was not instituted on dependent claim 8. No agreement, consequently, was reached on how to terminate the proceedings to save the Office time and effort.

With this Interview Summary, Patent Owner has filed a Statutory Disclaimer under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming the entire term of U.S. Patent No. 9,298,905, thereby rendering the proceedings moot.

October 10, 2024

Respectfully submitted by:

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