

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

CARBYNE BIOMETRICS, LLC,

Patent Owner

IPR2024-00329

U.S. Patent No. 9,972,010

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

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I. PO'S ARGUMENT AGAINST PETITIONER'S EXPERT EVIDENCE BOTH MISCHARACTERIZES PRECEDENT AND MISREPRESENTS THE RECORD.

PO misapplies precedent in arguing that the Board should accord Dr. Jones' testimony "no weight" based on correspondence between his testimony and the Petition. *See* POPR, 27-34, 40-44. *Kinetic Techs.* and *Volkswagen* stand for the proposition that conclusory, unsupported arguments by a party in its substantive paper(s) do not acquire greater evidentiary weight in mere repetition by an expert of the conclusory, unsupported arguments. *See Kinetic Techs., Inc. v. Skyworks Sols., Inc.*, IPR2014-00529, Paper 8, 15 (PTAB Sep. 23, 2014) ("Merely repeating an argument from the Petition in the declaration of a proposed expert does not give that argument enhanced probative value."); *see also Volkswagen Group of America, Inc. v. StratosAudio, Inc.*, IPR2021-00717, Paper 12, 35-37 (PTAB Nov. 12, 2021) (finding that declaration "provided little additional probative value" for a limitation recognized as missing from the applied art, but claimed to be obvious, citing only the expert), *Facebook, Inc. v. Voxer IP LLC*, IPR2021-00399, Paper 8, 22 (argument in Petition was inadequate; declaration that mirrored those arguments did not provide further support). By contrast, Dr. Jones' detailed discussion here includes articulated technical reasoning supported by annotated figures and specific cites to supporting evidence, including numerous paragraphs, tables, and figures of patents and papers. *See, generally*, (Jones Decl.) APPL-1003, ¶¶ 59-68, 197-200. (citing

numerous patents and publications). PO's cited cases involving conclusory expert declarations are therefore inapposite. That Petitioner's legal conclusion of obviousness in turn relied upon or even quoted portions of the expert's analysis in the Petition does not diminish the expert declaration's probative value, and it certainly does not render this case analogous to *Kinetic Techs* and *Volkswagon*. Indeed, in *Google LLC v Parus Holdings, Inc.*, even when the Board agreed "with Patent Owner's general characterization that [the expert] largely repeats most of the Petition *verbatim*," it nevertheless "disagree[d] with Patent Owner's implication that [the Board] should therefore summarily discount [the expert's] testimony." IPR2022-00805, Paper 7 at 9 (PTAB Nov. 2022). PO's argument that Dr. Jones' testimony should be afforded "no weight" is therefore premised on an incorrect application of the law.

Furthermore, PO relies on truncated and misleading cites to misrepresent Dr. Jones' declaration as "virtually identical" to the Petition. PO provides tables that only selectively reproduced portions of the declaration and petition to manufacture an impression that the two are the same, while wholesale omitting paragraphs where Dr. Jones articulates additional reasoning and rational underpinning his ultimate conclusions. *See e.g.* APPL-1003, ¶¶ 60-66 and 68 and ¶¶ 197-200 (providing opinions and facts regarding motivation to combine and reasonable expectation to succeed supported by numerous patents and publications). That PO resorts to

mischaracterizing precedent and cherry picking the record further confirms that its arguments undermining Dr. Jones' expert evidence are baseless and insupportable.

II. PO'S NO MOTIVATION TO COMBINE ARGUMENTS FAIL BECAUSE THEY ARE INTERNALLY CONTRADICTORY, MISCHARACTERIZE PRIOR ART, AND MISAPPLY LAW.

A. PO Mischaracterizes Prior Art.

PO's arguments regarding analogous art and motivation to combine fail, because they rely on mischaracterizations of the prior art that contradict both the prior art's explicit disclosure and POSITA's knowledge and common sense, and because they are internally contradictory.

Contrary to the prior art's explicit disclosure, PO mischaracterizes Stone as "not concerned with security of transactions," and Hoyos/FFIEC Guidance as "not pertain[ing] to visual interfaces or improving them." *See, e.g.*, POPR, 24, 32, 35, 42. However, Stone discloses secure transactions with multi-factor authentication (e.g., "*username, password,*" "*biometric id,*" and/or banking "*user account numbers, security information*") for fraud prevention. (Stone) APPL-1008, [0045], FIG. 2, [0046]. Hoyos and FFIEC Guidance each explicitly disclose visual interfaces. (Hoyos) APPL-1003, [0006] (describing a Web client station for obtaining biometric data), FIG. 2, [0034] (describing a user interface for capturing biometric data); (FFIEC Guidance) APPL-1037, 7, 11 (describing user interface to receive customer input in multi-factor authentication).

Furthermore, PO's attempt to cast Stone/Hoyos/Guidance/Varghese as references that "simply do not mesh" (POPR, 14) disregards a POSITA's knowledge and common sense. As opined by Dr. Jones' testimony, supported throughout by annotated example figures of Stone-Hoyos, Stone-Hoyos-Varghese, and Stone-Guidance, and specific cites to numerous references, as well as by user interface art on the face of the '010 Patent relied upon by Examiner during prosecution (APPL-1002, 87), in electronic financial transactions, user interface and authentication are inseparably interwoven to serve as the foundational *authentication interfaces* for preventing fraud. *See e.g.*, APPL-1003, ¶¶46, 59-63, 176, 189 (citing *e.g.*, APPL-1010, [0148] ("a bank or other financial institution may wish to invoke a higher security *authentication interface*...."; [0079] (describing "[a]uthentication *interface selection* criteria"), ¶¶64, 212 (explaining the interwoven relationship between user interactions through interfaces and authentication). Indeed, such integration of user interface and authentication for fraud prevention is so fundamental and deeply ingrained even in the mind of a layperson, that PO later makes the starkly contradicting admission that Stone's disclosure requires authentication. POPR, 39 (PO admitting authentication in Stone, stating "[a]s *Stone Figure 2 shows*, the user's account balance (208) is displayed on the interface.... Displaying an account balance would *require authentication of the user by the payment server*..., see [0046]").

B. PO Misapplies the Law and Disregards the Intrinsic Record.

PO's analogous art arguments also misapply the law and assume overly-narrow scope for analogous art, but do not provide analysis in support of its assumption. *See, e.g., Unwired Planet, LLC v. Google Inc.*, 841 F.3d 995, 1001 (Fed. Cir. 2016) (stating that the field of endeavor is "not limited to the specific point of novelty, the narrowest possible conception of the field, or the particular focus within a given field"). PO's arguments also contradict the intrinsic record. *See, e.g., APPL-1002*, 87 (Examiner applying user interface art (*e.g., Gaw, Fujioka*)); APPL-1001 ('010 Patent citing on its face numerous user interface art, *e.g., Haynes, Lindquist, Synstelien, Mengerink, etc.*). Moreover, PO's reliance on teaching away (based on the incorrect bodily incorporation of an example from Turk) is also misplaced, because it identifies nothing in prior art that criticizes, discredits, or otherwise discourages the claimed invention. *See In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Additionally, PO raises numerous meritless factual disputes, which are not practical to be fully addressed in this Reply. Such factual disputes can be resolved at trial with a fully developed record.

Petitioner's positions and statements of a POSITA's understanding are supported by evidence. PO's contentions are not evidence and cannot rebut Petitioner's evidence, and as such do not support denial of institution of the IPR. *Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009).

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e), service was made on Patent Owner as detailed below.

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