UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

APPLE INC.,
Petitioner

v.

CARBYNE BIOMETRICS, LLC,
Patent Owner

_____

Case: IPR2024-00330
U.S. Patent No. 10,713,656

_____

PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S REPLY

TABLE OF CONTENTS

I. PETITIONER'S EXPERT DECLARATION SHOULD BE GIVEN NO WEIGHT IN THE MOTIVATION TO COMBINE AND LIKELIHOOD OF SUCCESS ANALYSIS. 1

II. PATENT OWNER'S MOTIVATION TO COMBINE ARGUMENTS ARE NOT INTERNALLY CONTRADICTORY, DO NOT MISCHARACTERIZE PRIOR ART, AND DO NOT MISAPPLY LAW. ...1

A. Patent Owner Does Not Mischaracterize the Prior Art. 1

B. Patent Owner Does Not Misapply the Law. 3

C. There Are No Fact Issues that Require a Trial. 3

III. CONCLUSION.....3

I. PETITIONER'S EXPERT DECLARATION SHOULD BE GIVEN NO WEIGHT IN THE MOTIVATION TO COMBINE AND LIKELIHOOD OF SUCCESS ANALYSIS.

The paragraphs of Petitioner's expert declaration on the motivation to combine and likelihood of success are virtual copies of the corresponding arguments in the Petition. POPR at 30-33, 50-51. The Board routinely gives "no probative weight" to these kinds of copy-and-paste declarations. *See* POPR at 30-31. Petitioner does not deny that large portions of its expert declaration, specifically those paragraphs on the motivation to combine, are exact copies of the Petition. Rather, Petitioner contends that any overlap between the Petition and expert declaration should not discount the evidentiary value of its expert declaration. *See* Reply at 1-2. But this is not what the Board held in *Kinetic Technologies* or *Volkswagen*, where it afforded expert declarations that were virtual copies of the petition little to no weight. *See* POPR at 30-31. The Board should do the same here.

II. PATENT OWNER'S MOTIVATION TO COMBINE ARGUMENTS ARE NOT INTERNALLY CONTRADICTORY, DO NOT MISCHARACTERIZE PRIOR ART, AND DO NOT MISAPPLY LAW.

A. Patent Owner Does Not Mischaracterize the Prior Art.

Patent Owner's arguments relating to analogous art and the lack of a motivation to combine do not contradict the prior art's explicit disclosures and a POSITA's knowledge and common sense. *See* Reply at 3.

Stone's disclosure does not mention fraud prevention or enhanced security. Stone is concerned with providing a visual representation of the amount of currency subject to a virtual transaction to provide a "user with a more visually rich interface." POPR at 16, 40. Any reference in Stone to user "authentication" is incidental to this goal. *See* Reply at 4; POPR at 44.

Hoyos and the FFIEC Guidance are concerned with biometric authentication techniques. POPR at 35-36, 52. And despite Petitioner's argument to the contrary, neither expressly discloses visual interfaces or improvements to them. *See* Reply at 3. For instance, the FFIEC Guidance never mentions visual interfaces, and Hoyos only mentions that a web-based authentication system existed in the prior art and discloses a web cam and computer setup for capturing photos of a user for biometrics—it never mentions a user interface. *See* Ex. 1013 at [0006] and [0034].

Patent Owner's arguments against Petitioner's alleged motivation to combine also do not disregard a POSITA's knowledge or common sense. Petitioner does not explain what knowledge or common sense Patent Owner disregards. *See* Reply at 4. In its Reply, Petitioner instead states that a POSITA would have combined Stone (visually improved interface) with Hoyos or the FFIEC Guidance (improved biometric authentication techniques) because "user interface and authentication are inseparably interwoven to serve as the foundational ***authentication interfaces*** for preventing fraud." *Id.* This conclusory statement is not a motivation to combine.

B. Patent Owner Does Not Misapply the Law.

Patent Owner did not misapply the law for analogous art as Petitioner claims. *See* Reply at 5. Patent Owner applied the test for analogous art set forth by the Federal Circuit and explained in detail why Petitioner's Stone reference is not analogous art under this test. POPR at 39-41.

C. There Are No Fact Issues that Require a Trial.

Finally, Petitioner states that there are factual disputes that can only be resolved at trial. Reply at 5. But Patent Owner's arguments largely go to the motivation to combine. Given the little to no weight the Board should afford Petitioner's expert declaration regarding the motivation to combine, and Patent Owner's robust citations to the prior art references in its preliminary response, there are no factual disputes that require a trial.

III. CONCLUSION

For the reasons stated herein and in the POPR, institution should be denied.

Dated: May 28, 2024

Respectfully submitted,

/s/Richard A. Kamprath
Richard A. Kamprath
Reg. No. 65,320
rkamprath@mckoolsmith.com
McKool Smith, P.C.
300 Crescent Court, Suite 1500
Dallas, Texas 75201
Telephone: (214) 978-4000
Facsimile: (214) 978-4044

George Fishback
Reg. No. 76,345
gfishback@mckoolsmith.com
McKool Smith, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701
Telephone: (512) 692-8700
Facsimile: (512) 692-8744

Counsel for Patent Owner, Carbyne Biometrics, LLC

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of this **PATENT OWNER'S PRELIMINARY SUR-REPLY TO PETITIONER'S REPLY PURSUANT TO 37 C.F.R. § 42.10(b)** has been served on Petitioner via email on the following counsel of record for Petitioner:

David W. O'Brien
David.obrien.ipr@haynesboone.com

Kelly Gehrke Lyle
Kelly.lyle@haynesboone.com

Hong Shi
Hong.shi.ipr@haynesboone.com

Dated: May 28, 2024

Respectfully submitted,

/s/Richard A. Kamprath
Richard A. Kamprath
Reg. No. 65,320