IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

CARBYNE BIOMETRICS, LLC, Plaintiff, v. APPLE INC., Defendant.	Civil Action No. 1:23-CV-00324 **JURY TRIAL DEMANDED**

DEFENDANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UNDER 35 U.S.C. § 101

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Ex. J	Excerpt from the File History of U.S. Patent No. 10,713,656, retrieved from the website of the U.S. Patent and Trademark Office
Ex. K	Excerpt from the File History of U.S. Patent No. 11,526,886, retrieved from the website of the U.S. Patent and Trademark Office
Ex. L	Excerpt from the File History of U.S. Patent No. 9,972,010, retrieved from the website of the U.S. Patent and Trademark Office
Ex. M	Excerpt from the File History of U.S. Patent No. 11,475,105, retrieved from the website of the U.S. Patent and Trademark Office
Ex. N	Excerpt from the File History of U.S. Patent No. 10,929,512, retrieved from the website of the U.S. Patent and Trademark Office
Ex. O	Excerpt from the File History of U.S. Patent No. 11,514,138, retrieved from the website of the U.S. Patent and Trademark Office
Ex. P	Identity Theft Resource Center, *Scammers Steal Deceased Man's Identity via Mail*, (Aug. 8, 2017), *available at* https://www.idtheftcenter.org/post/scammers-steal-deceased-mans-identity-via-mail/
Ex. Q	Excerpt from Samsung's Answer, Affirmative Defenses, & Counterclaims, *RightQuestion, LLC v. Samsung Elecs. Co.*, No. 2:21-cv-00238, Dkt. 56 (E.D. Tex. Mar. 4, 2022)
Ex. R	Excerpt from *RightQuestion LLC v. Samsung Elecs. Co.*, No. 2:21-cv-00238-JRG, slip op (E.D. Tex. Apr. 18, 2022)

The asserted patents are patent ineligible. ***First***, Apple's motion addressed each asserted claim, and did not rely on claim representativeness. ***Second***, Carbyne's reliance on determining "aliveness" with biometrics is insufficient to save the Fraud Reduction Patents from ineligibility, as the claims' recitations are conclusory and lack the specificity of any actual technological improvement or solution unique to computers or computer networks. ***Third***, with respect to the Authentication Patents, Carbyne admits that the patents merely claim means for "restricting access to sensitive information" for safer and more convenient authentication (Opp. at 14), which is a longstanding economic practice that can be performed mentally or manually and is therefore abstract. None of the concepts identified by Carbyne is inventive, as each is routine and conventional. The asserted patents are thus invalid under § 101, and this case should be dismissed.

I. APPLE'S MOTION ADDRESSED EACH ASSERTED CLAIM, AND DID NOT RELY ON CLAIM REPRESENTATIVENESS

Apple's Motion addressed each asserted claim in both *Alice* steps 1 and 2. Carbyne's assertion that Apple treated one claim from each patent family as representative is incorrect and appears to be based on Apple's Motion having expressly recited the complete claim language of only two of the asserted claims, rather than all 64. But Apple's analysis did not end with those two claims or fail to analyze the other claims. Instead, after reciting and addressing each limitation in those two claims, Apple's Motion further discussed the additional or different elements found in the other independent and dependent claims of each patent, *e.g.*, Mot. at 4-6, 13-15, as Carbyne itself acknowledged, *e.g.*, Opp. at 8; Mot. at 5. It so happens that the other claims within the same family have significantly overlapping language with claim 9 of the '010 and claim 13 of the '138.[1]

[1] Confirming the significant overlap in claim language and claimed concepts, applicant acknowledged that the claims within each family are not patentably distinct by filing terminal disclaimers to overcome double patenting rejections. Ex. J ('656 over '010 and its parent, '041); Ex. K at 13-14 ('886 over '010 and '656); Ex. L (disclaiming '010 over its parent, '041); Ex. M

But overlapping claim language did not require Apple to treat claims as representative, nor did it.

As a result, Carbyne's remaining arguments—e.g., that some claims' purportedly "distinct limitations" preclude any claim from being representative—miss the mark. Critically, Carbyne has not identified any legally distinct elements that were not addressed in Apple's Motion, or explained *any* legal relevance for the purportedly "distinct" limitations it identifies. Opp. at 5-8. For example, the "cloud storage" limitation neither alters the abstract idea nor adds an inventive concept. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1348-49 (Fed. Cir. 2014). And Apple expressly addressed the remaining claim elements argued by Carbyne. Mot. at 5 ("password," display, storing data), 12 ("set of images"), 14,19 (data storage, receipt, transmittal, "two generic processors"). Carbyne elides Apple's descriptions of the claim categories, which closely track the claims. *E.g.*, *compare* Mot. at 5 ("origin of collected information (virtual likeness provided by the recipient of a transaction)"), *with* '656 cls. 4 ("wherein the virtual likeness of the face of the recipient was provided by the recipient"), 13 (same).[2] In sum, Apple has "rebut[ted] the presumption of independent validity" by showing that every asserted claim is independently invalid under § 101 because each claim within the same family is directed to the same abstract idea and lacks any inventive concept.

II. THE FRAUD REDUCTION PATENTS CLAIM INELIGIBLE SUBJECT MATTER

At Alice Step 1, Carbyne does not dispute that collecting, receiving, and analyzing information (including location) about a user to enable a transaction is abstract. Opp. at 16. Nor does Carbyne dispute that the USPTO repeatedly found the concept of analyzing biometric data to

('105 claims over '512); Exs. N, O (both '512 and '138 over parent '696). *See SimpleAir, Inc. v. Google LLC*, 884 F.3d 1160, 1168 (Fed. Cir. 2018) (disclaimers "strong clue" applicant thought claims not patentably distinct).

[2] Carbyne, in contrast, did not track the claim language. *Compare* Opp. at 8 ("providing for brand or vendor association"), *with* '886 cl. 10 (not reciting that concept or language).

determine "aliveness" ineligible under § 101. Mot. at 6; Ex. K at 7-11, 15, 18-23, 26. Despite this, Carbyne wrongly contends that *the same "aliveness" requirement* renders these claims a "technological improvement." Opp. at 17. Carbyne is wrong.[3] *See* Mot. at 7-9.

First, Carbyne does not (and indeed can not) contend the claims recite *how* "aliveness" detection is performed or provide a technological solution for that function—omissions that are fatal. Carbyne effectively concedes the claimed "aliveness" determination is a "black box" when it argues that (i) "[o]ther rules [beyond the sole example provided in the specification] can be applied for making this determination," Opp. 15-16, and (ii) "***how*** a [POSITA] would implement" the claimed invention is an *enablement* issue (i.e., conceding the implementation is not claimed), Opp. at 19. Tellingly, Carbyne focuses on the alleged problem solved by and benefits of the "aliveness" determination, Opp. 15-16, rather than explaining what the solution is. Carbyne does not attempt to distinguish *Dropbox*, which held that a feature is merely a "functional abstraction" when the specification fails to describe an actual "technological solution" for its implementation. *Dropbox, Inc. v. Synchronoss Techs., Inc.*, 815 F. App'x 529 (Fed. Cir. 2020); Mot. at 8-9. In short, there is no disclosed "technological solution" for the claimed "aliveness" determination.

Second, Carbyne's identified idea—using biometrics to determine whether a transaction participant is alive—is neither a solution to a computer problem nor a technological improvement and is itself abstract. *See* Opp. at 15. Even absent computer networks, fraudsters scheme without "a physical link to the victim." *Id.*[4] As a result, fraud checks to prevent the use of a decedent's identity have long been routine, such as those performed by a bank before permitting in-person bank withdrawals or by a notary as part of a real estate transaction. Mot. at 9. Carbyne contends

[3] Carbyne's allegation that Apple purportedly reads the "aliveness" determination out of the claims, Opp. at 17, is belied by Apple's reference to "alive" twenty times in its opening brief.
[4] *See, e.g.*, Ex. P (discussing scheming without a physical link as a well-known problem).

an "aliveness" determination is necessary only in remote transactions, Opp. at 18—but this only proves Apple's point that Carbyne's alleged solution ("analyze a user's biometric information to determine that the user is alive," Opp. 15) is the one traditionally used by commercial actors. Historically, to prevent fraudsters from using another person's identity, especially that of decedents, market participants performed major transactions before notaries or in person. Carbyne's claims do no more than apply that concept to an electronic transaction, which is insufficient. *See Accenture Global Servs. v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013) ("[S]imply implementing an abstract concept on a computer" patent ineligible). Moreover, Carbyne's argument that the claims "improv[e devices'] technical functionality" by claiming "a processor … with improved biometric authentication capabilities" has been rejected repeatedly, as Apple previously explained. Mot. at 7-8 (citing *USR LLC v. Apple Inc.*, 10 F.4th 1342, 1352 (Fed. Cir. 2021) and *Blue Spike v. Google Inc.*, No. 14-cv-01650, 2015 WL 5260506, at *6 (N.D. Cal. Sept. 8, 2015)).

The Fraud Reduction claims are unlike the claims to specific techniques at issue in *Ancora* and *SRI*. In *Ancora,* the Federal Circuit found that "[i]mproving security … can be a non-abstract computer-functionality improvement if done by a *specific technique* that departs from earlier approaches to solve a specific computer problem." *Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343, 1348 (Fed. Cir. 2018) (emphasis added). *SRI* likewise concerned a "specific technique" that "prevent[s] the normal, expected operation of a conventional computer network." *SRI Int'l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1304 (Fed. Cir. 2019). In contrast, the Fraud Reduction claims neither recite a specific technique nor prevent the normal operation of a network. *Cf. Ancora*, 908 F.3d at 1348. The claims recite a "black box" function, not a "new technique." Opp. at 18.

Third, Carbyne offers no other rebuttal to Apple's showing that the claims' "essentially

result-focused, functional character" confirms their ineligibility. Opp. 18. Carbyne does not even attempt to rebut Apple's cited cases. Mot. at 7 (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016); *Yu v. Apple Inc.,* 1 F.4th 1040, 1043 (Fed. Cir. 2021); *Solutran, Inc. v. Elavon, Inc.*, 931 F.3d 1161, 1168 (Fed. Cir. 2019)).

As for Alice Step Two, Carbyne applies an improper legal framework, which fatally infects Carbyne's arguments. Courts must first set aside the abstract idea of the claims, and then consider "[**w]hat else** is there in the claims." *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014) (citation omitted). But to show an inventive concept, Carbyne points exclusively to the very abstract idea to which the claims are directed (*compare* Mot. 6 *with* Opp. 15, 19-20), and as such its arguments should be disregarded. Regardless, Carbyne does not dispute that the claims lack the necessary specificity to support an inventive concept (*compare* Mot. 11-12 (citing *Yu* and *USR*) *with* Opp. 19-20 (addressing none of Apple's cases)), and its own cases confirm the need for specificity to survive Step 2. *E.g.*, *CosmoKey Sols. GmbH & Co. v. Duo Sec. LLC*, 15 F.4th 1091, 1099 (Fed. Cir. 2021) ("[h]ere, the claim limitations are more specific").[5] Carbyne's pleading only confirms that the "aliveness" determination is a black box, and that the claims lack the specificity necessary to support the finding of any inventive concept. Compl. ¶ 60 (reciting multiple methods of determining "aliveness," none of which is (or is even alleged to be) required by the claims).

III. THE AUTHENTICATION PATENTS CLAIM INELIGIBLE SUBJECT MATTER

At Alice Step 1, the Authentication Claims are directed to an unpatentable abstract idea.[6]

[5] Nor does *Mytee* have any applicability here. *Mytee Prod., Inc. v. Harris Rsch., Inc.*, 439 F. App'x 882, 886 (Fed. Cir. 2011) (party supplied *no* rationale for motivation to combine).

[6] Carbyne's first argument, that Samsung "did not raise § 101 as a defense in a litigation…with some of the same patents," is both erroneous and irrelevant. Opp. at 9. Only one of the Authentication Patents was asserted in the Samsung litigation, and Samsung *did* raise § 101 as a defense *and* as a counterclaim in its answer. Ex. Q at ¶¶ 79, 114. Regardless, arguments that an unrelated entity did or did not make are not relevant to the present litigation.

Indeed, Carbyne does not dispute that *nearly half* of the asserted Authentication Claims are directed to an abstract idea. Specifically, claims 1, 3, 7, 8, 10, 13, 15, 19, 22, and 25 of the '138 and claims 1, 18, and 35 of the '105 do not contain *any* of the three supposedly "technological solutions" that Carbyne argues render the claims non-abstract—use of two processors to perform bifurcated tasks, a restricted interface, and a secure storage. Opp. at 10-11. The purported solution Carbyne primarily relies on—bifurcating tasks between two processors—is not recited in *any* of the 20 asserted '138 and '105 claims, and the other two are recited in only seven claims. Opp. at 11;[7] '105 cls. 9, 11, 28; '138 cls. 11-12, 23-24. Thus, because Carbyne has failed to defend their eligibility, at least 13 of the 31 asserted claims indisputably are directed to an abstract idea.

The remaining 18 asserted claims are also abstract, and Carbyne's arguments to the contrary fail. Carbyne first describes the Authentication Patents as directed to "restrict[ing] access" to a person's "sensitive information" to "enable safer and more convenient authentication"—but that itself is an abstract idea. Opp. at 9, 12. *See Dropbox*, 815 F. App'x 529, 530-32 (Fed. Cir. 2020) (finding "data security" system providing authentication associated with a user fell "squarely within the [abstract] category of controlling access to data"); *Pres. Wellness Techs. LLC v. Allscripts Healthcare Sols*., No. 2:15-cv-1559-WCB, 2016 WL 2742379, at *7–8 (E.D. Tex. May 10, 2016), *aff'd* 684 F. App'x 970 (Fed. Cir. 2017) (finding abstract claims restricting access to medical records). Far from being "necessarily rooted in computer technology" to "overcome a problem specifically arising in the realm of computer networks," *SRI Int'l, Inc.*, 930 F.3d at 1303, the problems Carbyne identifies—unprotected sensitive information and inconvenience—are not unique to computers, as Apple's unrebutted real-world analogies demonstrate. For example,

[7] Carbyne erroneously contends that claim 1 of the '105 recites a restricted interface—it does not. Opp. at 11. Carbyne also cites to the restricted interface in a claim that is not even asserted against Apple—claim 10 of the '105. *Id*.

security guards stationed at a building's entrance enable safer and more convenient authentication by keeping a copy of an individual's photo ID, available only to security personnel, so the individual need not provide their ID to security every time authentication is required. *See* Mot. at 16-17. Merely limiting the application of an abstract concept that can be performed in the mind to the field of computer networking cannot save the claims. *E.g., FairWarning IP, LLC v Iatric Sys., Inc.*, 839 F.3d 1089, 1094-95 (Fed. Cir. 2016) (invalidating claims that "merely implement an old practice in a new environment"). And Carbyne did not even attempt to rebut Apple's cited cases. Mot. at 16-18 (discussing *Electric Power, Yu, Solutran, DDR Holdings, FairWarning, Umbanet*, *Intellectual Ventures*, *WhitServe LLC*, *Blue Spike,* and *RecogniCorp*).

Carbyne's three so-called "technical solutions" to restrict access to sensitive information are not technical solutions at all and do not render the claims non-abstract. Far from "abstract[ing] away" the details, Apple addressed each of Carbyne's identified "technical details." Mot. at 15-16 (restricted interface), 15-18 (secure storage), 14-16, 18 (processors). "The separation and bifurcation of tasks" between two processors ('512 cls. 1-4, 10-14, 20-21)—the only limitation Carbyne cites to distinguish the Authentication Claims from those found abstract in *Prism* and *USR*—does not change the abstract nature of the claims. Opp. at 12. "Dividing and assigning tasks among computers" for "distributed processing" is an abstract idea. *Coho Licensing LLC v. Glam Media, Inc.*, No. 14-cv-01576 JSW, 2017 WL 6210882, at *4–5 (N.D. Cal. Jan. 23, 2017), *aff'd sub nom. Coho Licensing LLC v. Oath Inc.*, 710 F. App'x 892 (Fed. Cir. 2018) ("The [patents] recite the abstract idea of distributed processing—merely splitting up a job into smaller pieces to be completed by multiple participating computers in the hierarchy."); *Appistry, Inc. v. Amazon.com, Inc.*, No. C15-311 MJP, 2015 WL 4210890, at *2 (W.D. Wash. July 9, 2015), *aff'd*, 676 F. App'x 1007 (Fed. Cir. 2017) (finding abstract claims describing "using a network of multiple actors …

by breaking down the job into small pieces, each handled by a different actor"). Adding one abstract idea to another does not render the claim nonabstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017). Likewise, contrary to Carbyne's representation (Opp. at 11-12), the specification clarifies that restricting access to information can be performed with generic, off-the-shelf processors. '512 at 2:13-20. Reciting an arrangement of generic computer components cannot change the claim's abstract nature. *Appistry, Inc.*, 2015 WL 4210890, at *2-3.

The same is true regarding the claimed restricted interface and secure storage, whether alone or together. '512, 3:60-4:26 (secure storage), cls. 1-4, 10-14, 20-21; '105 18:45-61 (restricted interface); '138 cls. 11-12, 23-24. Using multiple conventional computer components in conventional ways to restrict access to sensitive information to enable safer and more convenient authentication does not change the abstract nature of the claims. *Alice*, 573 U.S. at 226*; WhitServe LLC v. Dropbox, Inc.*, 854 F. App'x 367, 371 (Fed. Cir. 2021) (use of particular form of storage in a system safeguarding data did not alter abstract idea of maintaining data records). None of Carbyne's cited cases is to the contrary. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336, 1339 (Fed. Cir. 2016) (claims directed to "a specific implementation of a solution to a problem in the software arts"); *TecSec, Inc. v. Adobe Inc*., 978 F.3d 1278, 1293 (Fed. Cir. 2020) (claims "identif[ied] a 'specific' improvement in computer capabilities or network functionality").

At Alice Step 2, none of Carbyne's identified concepts is even arguably inventive, and its conclusory assertions to the contrary should be disregarded. Carbyne concedes that the claims disclose nothing more than an "authentication technique" to address the "tedium" and lack of security in authentication systems, and Carbyne's emphasis on the alleged benefits (and not the inventive concept) is telling, Opp. at 13-14. The specifications admit that this technique is implemented using generic components performing generic functions, none of which is inventive

alone or as an ordered combination. Conclusory statements to the contrary in the complaint should be disregarded. Compl. ¶¶ 47-48 (alleging improvements (e.g. "secure backup, "wiping") not described as such in specification), ¶¶ 49-50 (legal conclusions); *IBM v. Zillow Grp., Inc.*, 50 F.4th 1371, 1379-80 (Fed. Cir. 2022) (Under Rule 12(b)(6), "[w]e disregard conclusory statements.").

Bifurcating tasks amongst multiple processors is not inventive because the claims and specification make clear that this limitation requires only generic processors to perform that function. '512 at 2:13-20 (generic processor); Opp. at 13-14; Compl. ¶¶ 42-45. This is not enough. *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1169–70 (Fed. Cir. 2018) (generic parallel processing components did not render claim non-abstract); *Appistry, Inc.*, 2015 WL 4210890, at *4 ("That computers are capable of dividing a task" is "basic," and claiming tasks "hierarchically implemented by various actors…is not inventive," nor is "separating the actors' geographic locations."). The "secure backup" ('512 cls. 1, 11, 21), "same brand backup" ('105 cls. 1, 18, 35), and "using a cryptographic key as the credential" ('105 cls. 1, 18, 35; '138 cls. 1, 13, 25) limitations do not disclose inventive concepts because the specifications do not "explain the technological processes underlying the purported technological improvement[s]" contrary to Carbyne's allegations. Opp. at 14; Complaint at ¶ 46 (secure backup in the '512), ¶ 47 (same brand backup in the '105), ¶ 48 (cryptographic key in the '138); *WhitServe LLC*, 854 F. App'x at 372. Indeed, the specification explains that "technical material that is known in the technical field related to the invention has not been described in detail." '512 at 2:33-36. Instead, the claims rely on ordinary storage, backup, and cryptographic operations capabilities of computers and apply those ordinary functionalities in the particular context of an authentication technique, which is insufficient. *WhitServe LLC*, 854 F. App'x at 372. Likewise, the claimed combinations are not inventive because the claims merely recite "restricting access to information" with the requirement to

perform it on a set of generic computer components, unlike the claims in *BASCOM*, and no limitation "necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality," unlike the claims in *Amdocs*. *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350–51 (Fed. Cir. 2016); *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1300–01 (Fed. Cir. 2016).

Finally, Carbyne argues that, before Apple's Motion can be adjudicated, two claim terms need to be construed, but tellingly Carbyne does not propose a construction for either, let alone articulate how such a construction would change the analysis. Opp. at 14. Even assuming constructions most favorable to Carbyne, these elements are still not inventive. For example, the "restricted interface" [8] must encompass at least a "dedicated physical connection" or an "application programming interface," which are both routine and conventional. Opp. at 6, '105 cls. 10-11. As for "secure backup," after Carbyne's predecessor argued that no construction was necessary, a court construed "perform a secure backup of the record to a storage service" as "create a backup of the record that is protected from unauthorized access and transmit it to a storage service," which is routine and conventional. Ex. R at 14-15. Backup of information protected from unauthorized access is an age-old practice. Thus, no claim construction issues preclude dismissal. *Sanderling Mgmt. v. Snap Inc.*, 65 F.4th 698, 703-04 (Fed. Cir. 2023) (affirming dismissal where plaintiff identified terms for construction but failed to provide proposed constructions or explain how its constructions would make any difference to the *Alice* analysis).

IV. CONCLUSION

For these reasons, Apple respectfully asks the Court to dismiss with prejudice.

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[8] Carbyne argues that "restricted interface" may not be generic because Samsung's IPR petition failed to identify it in one art combination—but Carbyne conflates § 102 with § 101. *Berkheimer v. HP Inc.*, 890 F.3d 1369, 1381 (Fed. Cir. 2018) ("In the § 101 inquiry, … novelty and obviousness … are 'of no relevance.'") (citation omitted).

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system on June 28, 2023.

/s/ Melissa R. Smith

Melissa R. Smith