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

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

DEFENDANT'S AMENDED PRELIMINARY INVALIDITY CONTENTIONS

Prior Art Combinations for the ’512 Patent	
’512 Primary References	**Alone and/or with one or more of the following (collectively “’512 Secondary References”):**
UPEK System (*see* Ex. A-01)[1] Sahara Slate Tablet (*see* Ex. A-02)[2] Aegis Bio (*see* Ex. A-03)[3] Johansson (*see* Ex. A-04)[4] Buer (*see* A-05)[5] Kesanupalli (*see* A-06)[6] Digital Persona Pro (*see* Ex. A-07)[7] Jazayeri (*see* Ex. A-08)[8]	UPEK System Sahara Slate Tablet Aegis Bio Johansson Buer Kesanupalli Digital Persona Pro Jazayeri Shin[9] Sharma[10] Dropbox[11] LastPass[12] Keeper[13] KeePass[14] Pearson[15] Robinson[16] Shi[17] Brown[18] Challener[19] Cheng[20] Sumner[21] Davis[22] Shen[23] Karimi[24] Avetisov[25] Chandrasekaran[26] TLS[27] Swami[28] AutomatedBuildings[29] Windows 7[30] TPM[31] HTTPS Wiki[32] WesternDigital WD ShareSpace 8[33] APA

[1] UPEK Development Kit with UPEK Protector Suite 2009 (“UPEK System”) (*see* Exhibit A-01).

[2] Sahara Slate PC i500 Tablet PCs with a Trusted Platform Module using UPEK Protector Suite 2009 and/or BitLocker (“Sahara Slate Tablet”) (*see* Exhibit A-02).

[3] Aegis Bio Encrypted Biometric Hard Drive with UPEK Protection Suite and Windows Host Machine (“Aegis Bio”) (*see* Exhibit A-03).

[4] U.S. Patent No. 8,775,214 (“Johansson”) (*see* Exhibit A-04).

Prior Art Combinations for the ’105 Patent	
’105 Primary References	**Alone and/or with one or more of the following (collectively “’105 Secondary References”):**
UPEK System (*see* Ex. A-01) Sahara Slate Tablet (*see* Ex. A-02) Aegis Bio (*see* Ex. A-03) Johansson (*see* Ex. A-04) Buer (*see* A-05) Kesanupalli (*see* A-06) Digital Persona Pro (*see* Ex. A-07) Jazayeri (*see* Ex. A-08) The ’351 patent (*see* Ex. A-09)[43]	UPEK System (*see* Ex. A-01) Sahara Slate Tablet (*see* Ex. A-02) Aegis Bio (*see* Ex. A-03) Johansson (*see* Ex. A-04) Buer (*see* Ex. A-05) Kesanupalli (*see* Ex. A-06) Digital Persona Pro (*see* Ex. A-07) Jazayeri (*see* Ex. A-08) Shin (*see* Ex. A-O2) Sharma (*see* Ex. A-O2) Dropbox (*see* Ex. A-O2) LastPass (*see* Ex. A-O2) Keeper (*see* Ex. A-O2) KeePass (*see* Ex. A-O2) Pearson (*see* Ex. A-O2) Robinson (*see* Ex. A-O2) Shi (*see* Ex. A-O2) Brown (*see* Ex. A-O2) Challener (*see* Ex. A-O2) Cheng (*see* Ex. A-O2) Sumner (*see* Ex. A-O2) Davis (*see* Ex. A-O2) Shen (*see* Ex. A-O2) Karimi (*see* Ex. A-O2) Avetisov (*see* Ex. A-O2) Chandrasekaran (*see* Ex. A-O2) TLS references (*see* Ex. A-O2) Swami (*see* Ex. A-O2) AutomatedBuildings (*see* Ex. A-O2) Windows 7 (*see* Ex. A-O2) TPM (*see* Ex. A-O2) HTTPS Wiki (*see* Ex. A-O2) WesternDigital WD ShareSpace 8 (*see* Ex. A-O2) Hubner (*see* Ex. A-O2)[44] Kodama (*see* Ex. A-O2)[45] Landry (*see* Ex. A-O2)[46] Craswell (*see* Ex. A-O2)[47] APA

[43] U.S. Patent No. 10,360,351 to Jakobsson (the “’315 Patent”) (granted July 23, 2019) (*see* Exhibit A-09).

[44] U.S. Patent Publication No. 2012/0150808 (“Hubner”) (*see* Exhibit A-O2).

Prior Art Combinations for the ’138 Patent	
’138 Primary References	**Alone and/or with one or more of the following (collectively “’138 Secondary References”):**
UPEK System (*see* Ex. A-01)	UPEK System (*see* Ex. A-01) Sahara Slate Tablet (*see* Ex. A-02) Aegis Bio (*see* Ex. A-03) Johansson (*see* Ex. A-04) Buer (*see* Ex. A-05) Kesanupalli (*see* Ex. A-06) Digital Persona Pro (*see* Ex. A-07) Jazayeri (*see* Ex. A-08) Shin (*see* Ex. A-O2) Sharma (*see* Ex. A-O2) Dropbox (*see* Ex. A-O2) LastPass (*see* Ex. A-O2) Keeper (*see* Ex. A-O2) KeePass (*see* Ex. A-O2) Pearso (*see* Ex. A-O2) Robinson (*see* Ex. A-O2) Shi (*see* Ex. A-O2) Brown (*see* Ex. A-O2) Challener (*see* Ex. A-O2) Cheng (*see* Ex. A-O2) Sumner (*see* Ex. A-O2) Davis (*see* Ex. A-O2) Shen (*see* Ex. A-O2) Karimi (*see* Ex. A-O2) Avetisov (*see* Ex. A-O2) Chandrasekaran (*see* Ex. A-O2) TLS references (*see* Ex. A-O2) Swami (*see* Ex. A-O2) AutomatedBuildings (*see* Ex. A-O2) Windows 7 (*see* Ex. A-O2) TPM (*see* Ex. A-O2) HTTPS Wiki (*see* Ex. A-O2) WesternDigital WD ShareSpace 8 (*see* Ex. A-O2) APA
Sahara Slate Tablet (*see* Ex. A-02)	
Aegis Bio (*see* Ex. A-03)	
Johansson (*see* Ex. A-04)	
Buer (*see* A-05)	
Kesanupalli (*see* A-06)	
Digital Persona Pro (*see* Ex. A-07)	
Jazayeri (*see* Ex. A-08)	

Examples of these disclosures and embodiments are identified in the following sections and in the attached Preliminary Invalidity Claim Charts in Exhibits A-01 through A-08 and A-O2.

Prior Art Combinations for the ’010 Patent	
’010 Primary References	**Alone and/or with one or more of the following:**
Stone (*see* Exhibit B-01)[63] Baldwin (*see* Exhibit B-02)[64] Griffin (*see* Exhibit B-03)[65] FaceCash (*see* Exhibit B-04)[66] PayPal (*see* Exhibit B-05) [67]	Stone (*see* Exhibit B-01) Baldwin (*see* Exhibit B-02) Griffin (*see* Exhibit B-03) FaceCash (*see* Exhibit B-04) PayPal (*see* Exhibit B-05) Hoyos (*see* Exhibit B-O[68] Varghese (*see* Exhibit B-O)[69] Shuckers (*see* Exhibit B-O)[70] Bolle (*see* Exhibit B-O)[71] Ikeda (*see* Exhibit B-O)[72] BioID (*see* Exhibit B-O)[73] Carter (*see* Exhibit B-O)[74] Park (*see* Exhibit B-O)[75] APA

Examples of these disclosures and embodiments are identified in the following sections and in the attached Preliminary Invalidity Claim Charts in Exhibits B-01 through B-05 and B-O.

As evidenced by the exemplary prior art set forth above, the ’010 Patent discloses nothing new and is, at most, a description of well-known and obvious communication apparatuses and methods for switching on a communication element.

[63] U.S. Patent Publication No. 2010/0042535 (“Stone”) (*see* Exhibit B-01).
[64] U.S. Patent Publication No. 2007/0208816 (“Baldwin”) (*see* Exhibit B-02).
[65] U.S. Patent Publication No. 2009/0192937 (“Griffin”) (*see* Exhibit B-03).
[66] The FaceCash System (“FaceCash”) (*see* Exhibit B-04)
[67] The PayPal System (“PayPal”) (*see* Exhibit B-05).
[68] U.S. Patent Publication No. 2010/0014720 (“Hoyos”) (*see* Exhibit B-O).
[69] U.S. Patent Publication No. 2006/0282660 (“Varghese”) (*see* Exhibit B-O)
[70] U.S. Patent No. 8,098,906 (“Shuckers”) (*see* Exhibit B-O)
[71] U.S. Patent No. 7,130,452 (“Bolle”) (*see* Exhibit B-O)
[72] Japanese Patent Publication No. 2002007752 (“Ikeda”) (*see* Exhibit B-O)
[73] The BioID System (“BioID”) (*see* Exhibit B-O)
[74] U.S. Patent Publication No. 2009/0152343 (“Carter”) (*see* Exhibit B-O)
[75] U.S. Patent Publication No. 2008/0192980 (“Park”) (*see* Exhibit B-O)

Prior Art Combinations for the ’656 Patent	
’656 Primary References	**Alone and/or with one or more of the following:**
Stone (see Exhibit B-01) Baldwin (see Exhibit B-02) Griffin (see Exhibit B-03) FaceCash (see Exhibit B-04) PayPal (see Exhibit B-05)	Stone (see Exhibit B-01) Baldwin (see Exhibit B-02) Griffin (see Exhibit B-03) FaceCash (see Exhibit B-04) PayPal (see Exhibit B-05) Hoyos (see Exhibit B-O) Varghese (see Exhibit B-O) Shuckers (see Exhibit B-O) Bolle (see Exhibit B-O) Ikeda (see Exhibit B-O) BioID (see Exhibit B-O) Carter (see Exhibit B-O) Park (see Exhibit B-O) APA

Examples of these disclosures and embodiments are identified in the following sections and in the attached Preliminary Invalidity Claim Charts in Exhibits B-01 through B-05 and B-O.

As evidenced by the exemplary prior art set forth above, the ’656 Patent discloses nothing new and is, at most, a description of well-known and obvious communication apparatuses and methods for switching on a communication element.

Defendant contends that all claims that are anticipated by a particular reference are also rendered obvious by that same reference alone, or by the combination of two or more references from the following list: Stone; Baldwin; Griffin; FaceCash System; PayPal System; Hoyos; Varghese; Shuckers; Bolle; Ikeda; BioID, Carter; and Park. Defendant puts forth below certain exemplary combinations that further demonstrate the obviousness of the asserted claims. Defendant is currently unaware of the extent, if any, to which Plaintiff will contend that limitations of the claims at issue are not disclosed in the art identified by Defendant as anticipatory. To the extent that an issue arises with any such limitation, Defendant reserves the

of the Avatar References would have advantageously allowed an electronic financial transaction system as taught by each ’656 Primary Reference (Ex. B-01 through Ex. B-05) to display an avatar representing an appropriate transaction party, advantageously improving the security of the system and decreasing the possibility of mistake. A POSITA would have easily recognized the benefits of combining these references with one another.

F. Anticipation and Obviousness of the ’886 Patent

As set forth below and in the accompanying claim charts, each and every one of the Asserted Claims of the ’886 Patent is anticipated under 35 U.S.C. § 102 and/or rendered obvious under 35 U.S.C. § 103 in light of at least the following prior art, considered alone or in combination with each other and/or the understanding of a POSITA and the Applicant’s Admitted Prior Art discussed in Section III.B.

Prior Art Combinations for the ’656 Patent	
’656 Primary References	**Alone and/or with one or more of the following:**
Stone (see Exhibit B-01) Baldwin (see Exhibit B-02) Griffin (see Exhibit B-03) FaceCash (see Exhibit B-04) PayPal (see Exhibit B-05)	Stone (see Exhibit B-01) Baldwin (see Exhibit B-02) Griffin (see Exhibit B-03) FaceCash (see Exhibit B-04) PayPal (see Exhibit B-05) Hoyos (see Exhibit B-O) Varghese (see Exhibit B-O) Shuckers (see Exhibit B-O) Bolle (see Exhibit B-O) Ikeda (see Exhibit B-O) BioID (see Exhibit B-O) Carter (see Exhibit B-O) Park (see Exhibit B-O) APA

Examples of these disclosures and embodiments are identified in the following sections and in the attached Preliminary Invalidity Claim Charts in Exhibits B-01 through B-05 and B-O.

Dated: October 6, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was served electronically via email on October 6, 2023, on all counsel of record.

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