

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN L.L.C.,
Petitioner,

v.

CALABRESE STEMER LLC,
Patent Owner.

IPR2024-00368
Patent 8,783,564 B2

Before SHARON FENICK, SCOTT B. HOWARD, and
ANDREAS BALTATZIS, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining All Challenged Claims Unpatentable

Dismissing Petitioner's Motion to Exclude

35 U.S.C. § 318(a); 37 C.F.R. § 42.64(c)

I. INTRODUCTION

A. *Background and Summary*

Askeladden L.L.C. (“Petitioner”) filed a petition for *inter partes* review challenging claims 1–19 of U.S. Patent 8,783,564 B2 (Ex. 1001 (“the ’564 patent”)). Paper 1 (“Pet.” or “Petition”). Calabrese Stemer LLC (“Patent Owner”) disclaimed claims 10–19. Paper 6 (“Prelim. Resp.”), 1–2; Paper 7 (Disclaimer in a Patent Under 37 C.F.R. § 1.321(a)). We instituted *inter partes* review on claims 1–9. Paper 8 (“Dec. on Inst.” or “Institution Decision”).

Patent Owner filed a patent owner response (Paper 12, “PO Resp.”), Petitioner filed a reply (Paper 18, “Pet. Reply”), and Patent Owner filed a sur-reply (Paper 19, “PO Sur-reply”). On March 27, 2025, the parties presented oral arguments in a video hearing, and the Board entered a transcript into the record. Paper 36 (“Tr.”).

Patent Owner additionally filed a Motion to Seal (Paper 22), which was dismissed as moot (Paper 30), and a Revised Motion to Seal (Paper 29). Petitioner filed a Motion to Exclude (Paper 33, “Mot. Excl.”); Patent Owner filed a Response to Motion to Exclude (Paper 34, “Opp.”); and Petitioner filed a Reply in support of the Motion to Exclude (Paper 35).

We have jurisdiction under 35 U.S.C. § 6(b)(4). For the reasons set forth in this Final Written Decision, we determine that Petitioner demonstrates by a preponderance of evidence that the challenged claims are unpatentable. We also dismiss Petitioner’s motion to exclude as moot.

B. *Real Parties in Interest*

Petitioner identifies only itself as a real party in interest (RPI) and submits a supporting declaration from Glenn J. Perry and a supporting

exhibit. Pet. 1; Ex. 1004; Ex. 1005. Patent Owner identifies only itself as an RPI. Paper 4 (Patent Owner’s Mandatory Notices), 1.

C. Related Matters

Each party asserts that there are no pending related matters that would affect or be affected by a decision in this proceeding. Pet. 1–2 (noting two terminated district court matters); Paper 4, 1. Petitioner notes that it concurrently filed two petitions for *inter partes* review of related patents. Pet. 2.

D. The ’564 Patent

The ’564 patent is directed to providing “[a]n added level of security . . . for charge transactions.” Ex. 1001, code (57). “Upon presenting a charge card number for a purchase” a cardholder receives, via a cell phone or personal digital assistant “a message . . . that a charge authorization request has been received. The message may include the merchant, a charge amount, and a time and date.” *Id.*; *see also id.* at 1:56–2:14. The specification of the ’564 patent describes that correcting mistakes in transactions may not be simple and may be time consuming, and that fraud and innocent mistakes are costly. *Id.* at 1:28–43. It adds that “[e]xtraneous authorization security” may be “too intrusive” and may “have a negative impact on the transaction.” *Id.* at 1:44–46.

The ’564 patent describes the system with reference to its Figure 1, “a schematic diagram illustrating a transaction according to the invention,” which is reproduced immediately below. *Id.* at 3:29–31.

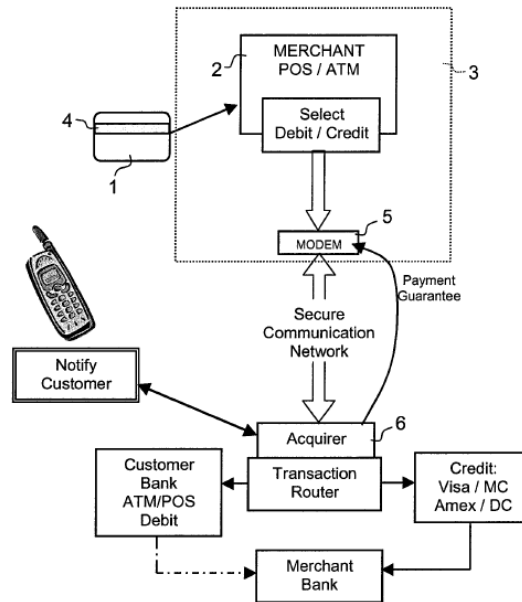


FIG. 1

Figure 1 depicts a simplified process stream in a cashless sales transaction, including a charge card 1, merchant terminal 3, acquirer 6, and customer wireless device (depicted but not labeled with an element number). *Id.* at 3:40–61. Charge card 1 is presented at merchant terminal 3. *Id.* at 3:40–45, 4:31–38. “[M]erchant terminal 3 connects, through a modem 5, to an acquirer 6” that “checks against its data sources whether or not the transaction should be authorized.” *Id.* at 3:51–55. “At the same time, a corresponding customer profile is checked as to the customer’s set preferences concerning the notification/authorization options.” *Id.* at 3:55–57. If the customer’s profile is set to “notification,” the system notifies the cardholder by sending a message to the cardholder’s wireless device, such as a cell phone. *Id.* at 3:59–61, 4:38–44. The message may be an audible message or an SMS message sent to the customer’s phone. *Id.* at 3:62–65, 5:39–41. “The simple notification, of course, does not add any time to the transaction.” *Id.* at 4:10–11.

The '564 patent additionally includes a flow diagram illustrating a method for charge request processing in Figure 2, reproduced immediately below. *Id.* at 3:32–33.

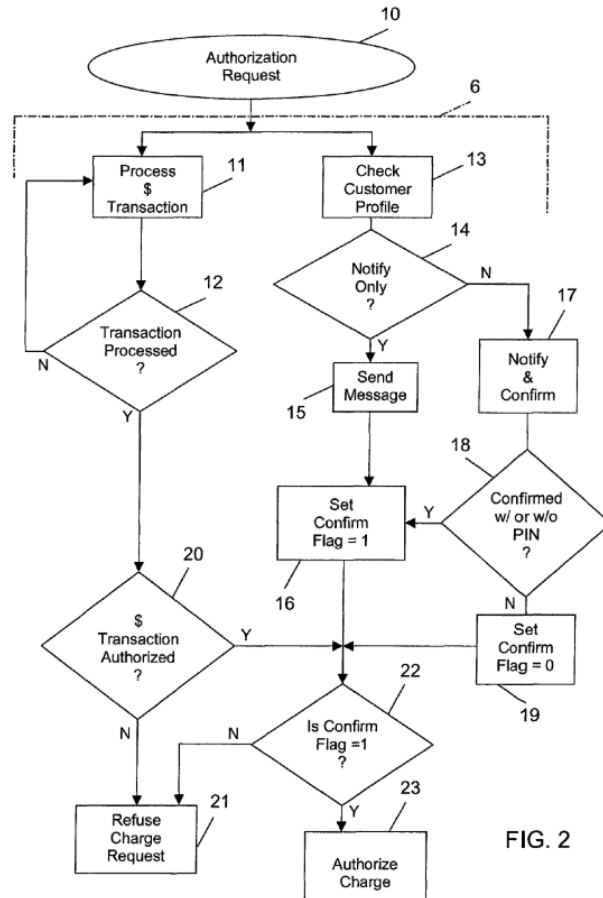


FIG. 2

Figure 2 shows a flow diagram that begins with an authorization request gathering the required information (element 10) and includes conventional processing of a charge authorization in elements 11, 12, and 20. *Id.* at 5:27–32, 5:61–62. At the same time, a customer profile associated with the account number is checked (element 13). *Id.* at 5:32–33. If the profile is set to “Notify Only” (element 14) then a message is sent and a flag is set (elements 15, 16). *Id.* at 5:37–39, 5:41–42. If the financial transaction has been authorized after conventional processing (element 20) and the flag has

been set indicating that the customer has been notified of the transaction, the charge is authorized. *Id.* at 5:64–6:3.

The '564 patent contemplates that the notification may be set to notify a third party, such as an employer or relative, rather than the person presenting the card. *Id.* at 5:17–26.

E. Illustrative Claim

Of claims 1–9, claim 1 is independent and claims 2–9 depend from claim 1. As discussed previously, claims 10–19 have been disclaimed. Prelim. Resp. 1–2; Paper 7.

Claim 1, reproduced below with bracketed identifiers added (corresponding to those in the Petition) is illustrative:

1. A method for processing a transaction, comprising the steps of:

[1a] receiving a request for authorizing a transaction for an account, said request received via a first transmission channel, said request including at least an identification of the customer's account;

[1b] determining whether or not the account includes a request for notification to the customer of any transactions;

[1c] notifying the customer via a second transmission channel only if the account includes a request for notification of any transactions;

[1d] the second transmission channel being distinct from the first transmission channel; and

[1e] authorizing the transaction without requiring a response from the customer.

Ex. 1001, 6:5–19.

F. Evidence

Petitioner relies on the following patent evidence.

Name	Patent Document	Exhibit
Horie et al. ("Horie")	JP 2002-133100	Ex. 1009 (Translation: Ex. 1006)

Petitioner additionally relies on a declaration of Dr. Robert Akl, Ex. 1003.

G. Prior Art and Asserted Grounds

Petitioner asserts that claims 1–9 would have been unpatentable on the following grounds¹:

Claim(s) Challenged	35 U.S.C. § ²	Reference(s)/Basis
1–9	102	Horie
1–9	103	Horie

Pet. 9.

II. ANALYSIS

A. Legal Standards

A patent claim is unpatentable under 35 U.S.C. § 102 if “the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation.”

Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed.

¹ A ground asserting claims 10–19 unpatentable was also included in the Petition, as these claims have been disclaimed we do not list this ground here. *See* Prelim. Resp. 1–2; Paper 7.

² The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102 and 103 that became effective on March 16, 2013. Because the ’564 patent claims priority to an application filed before this effective date, we apply the pre-AIA version of the statutory basis for unpatentability. *See* Ex. 1001, code (60), 1:4–13.

Cir. 2000). “A single prior art reference may anticipate without disclosing a feature of the claimed invention if such feature is necessarily present, or inherent, in that reference.” *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 958 (Fed. Cir. 2014). Moreover, the reference must also “disclose[] within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim.” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). However, “the reference need not satisfy an *ipsissimis verbis* test.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009).

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103 that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) if in evidence, “secondary considerations” of non-obviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in any particular case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that “it is error to reach a conclusion of obviousness until all those factors are considered,” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1328 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

The level of ordinary skill in the pertinent art at the time of the invention is a factor in how we construe patent claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). It is also one of

the factors we consider when determining whether a patent claim is obvious over the prior art. *See Graham*, 383 U.S. at 17–18.

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696–697 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). “Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case.” *Id.*

Petitioner argues that a person having ordinary skill in the art would have had “experience in the hardware and software used in the field of securely transmitting and processing authorization requests over wired and wireless networks, such as requests for the processing of financial transactions,” and “a bachelor’s degree in computer science, computer engineering, electrical engineering, or a related study, and would have at least one or two years of experience with wired and wireless networks used to securely process requests for authorization of activity such as financial transactions.” Pet. 7–8 (citing Ex. 1003 ¶ 22). Petitioner further argues that “[l]ess experience is necessary with additional education (e.g., a Master’s degree), and likewise, less education is necessary with additional work experience (e.g., 5–6 years).” *Id.* at 8 (citing Ex. 1003 ¶ 22).

Before institution, Patent Owner did not dispute or comment on this definition. In instituting, we adopted and used (for the purpose of determining whether to institute) Petitioner’s definition, with the exception

of removing the open-ended term “at least” from the description of years of experience. Dec. on Inst. 9.

Patent Owner “does not disagree, for the purposes of this submission, with the level of ordinary skill in the art as proffered by Petitioner, Pet. 7–8, and as adopted by the [Board,] Dec. [on Inst.] 9.” PO Resp. 2. Despite this agreement, Patent Owner also suggests additional or different qualifications relating to education and experience such as “educat[ion] in general physics and/or . . . experience in wireless and wired network technology. Further, the person of ordinary skill in the art will be experienced in data transmission over secure transmission channels and open, non-secured transmission channels.” *Id.*; *see also* PO Sur-reply 2–3, 6. While Patent Owner “does not disagree” with Petitioner’s definition of one of ordinary skill, Patent Owner appears to argue that the definition is too narrow and proposes to expand it. PO Resp. 2–3; PO Sur-reply 3 & nn. 4, 6.

Petitioner opposes the expanded definition proposed by Patent Owner. Pet. Reply 2. According to Petitioner, “Patent Owner offers no evidence or explanation as to why they should be included in the definition of a [person having ordinary skill in the art] or how these qualifications affect the ultimate issues of anticipation and obviousness in this proceeding.” *Id.*

The definition of a person having ordinary skill in the art that we adopted in the Institution Decision is supported by the testimony of Dr. Akl. Ex. 1003 ¶ 22. Patent Owner states that it agrees with that definition, while also proposing a broader definition that includes those with other qualifications. PO Resp. 2. Although Patent Owner argues that “the supporting evidence [for its addition] is broadly present in the case, namely, in the Patent-in-Suit and the associated intrinsic evidence” (PO Sur-reply 3 n.6), Patent Owner does not direct us to any specific portion of the record.

See id. We decline to search the record to find the evidence that supports it. *See United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) (“Judges are not like pigs, hunting for truffles buried in briefs.”); *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archaeologist with the record.”).

Additionally, while Patent Owner proposes expanding the definition, Patent Owner has not explained how that difference would materially affect the outcome of this proceeding. PO Resp. 2; PO Sur-reply 3 & nn. 4, 6. Dr. Akl uses Petitioner’s definition in his testimony (Ex. 1003 ¶¶ 22, 23) and Patent Owner makes no argument regarding how, if we adopted Patent Owner’s broader definition, Dr. Akl’s conclusions would be affected. Patent Owner’s use of its definition does not describe the conclusions of one “educated in general physics” differently to one of ordinary skill as defined by Petitioner. PO Sur-reply 6. Patent Owner does not present declarant testimony regarding knowledge of one of ordinary skill in the art under any definition.³

For these reasons, we maintain the definition of a person having ordinary skill in the art we adopted in the Decision on Institution: a person having ordinary skill in the art would have had experience in the hardware and software used in the field of securely transmitting and processing authorization requests over wired and wireless networks, such as requests for the processing of financial transactions, and a bachelor’s degree in computer science, computer engineering, electrical engineering, or a related study, and would have one or two years of experience with wired and wireless

³ *See infra* footnote 5.

networks used to securely process requests for authorization of activity such as financial transactions. Less experience is necessary with additional education (e.g., a Master's degree), and likewise, less education is necessary with additional work experience (e.g., 5–6 years).

C. Claim Construction

We apply the same claim construction standard used in the federal courts, in other words, the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b) (2023).

Claim terms are generally given their ordinary and customary meaning as would be understood by one with ordinary skill in the art in the context of the specification, the prosecution history, other claims, and extrinsic evidence including expert and inventor testimony, dictionaries, and learned treatises, although extrinsic evidence is less significant than the intrinsic record. *Phillips*, 415 F.3d at 1312–17. Usually, the specification is dispositive, and it is the single best guide to the meaning of a disputed term. *Id.* at 1315. The specification may reveal a special definition given to a claim term by the patentee, or the specification or prosecution history may reveal an intentional disavowal of claim scope by the inventor. *Id.* at 1316. If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification “with reasonable clarity, deliberateness, and precision.” *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998). A disavowal, if any, can be effectuated by language in the specification or the prosecution history, but “the standard for disavowal is exacting, requiring clear and unequivocal evidence that the

claimed invention includes or does not include a particular feature.” *Poly-Am., L.P. v. API Indus., Inc.*, 839 F.3d 1131, 1136 (Fed. Cir. 2016).

1. “distinct”

In the Petition, Petitioner asserted that “no claim terms require an express construction.” Pet. 8 (citing Ex. 1003 ¶ 62). In the Institution Decision, we identified that arguments made by Patent Owner regarding limitation 1d of claim 1 (“the second transmission channel being *distinct* from the first transmission channel” (emphasis added)) might be grounded in claim construction, but that on that record no evidence or argument regarding a specific claim construction had been made. Inst. Dec. 21.

Patent Owner’s Response and subsequent briefing by the parties discuss the proper construction of limitation 1d of claim 1 and of the term “distinct,” which appears in limitation 1d and, via dependency, in all challenged claims. PO Resp. 5–15; Pet. Reply 6–15; PO Sur-reply 6–12.

a) Parties’ Assertions

Patent Owner proposes that “distinct from” be construed as “distinct from, separate, and independent of” or, alternatively or in addition, that the proper construction would append to limitation 1d of claim 1 that “the first and second transmission channels do not overlap.” PO Resp. 10.

Patent Owner argues that the “gist” of the ’564 patent is a process by which, after an authorization request, notification of a user and authorization of the requested transaction occur “independently” and “separately,” with neither process delaying or encumbering the other process. *Id.* at 3–6 (citing Ex. 1001, 6:5–19 (claim 1), Fig. 2). Petitioner argues that Figure 1 of the ’564 patent shows “the transmission channels are distinct, in that they are completely separate and independent of one another. *Id.* at 6 (citing Ex. 1001, Fig. 1). Patent Owner argues that if the two channels recited in

claim 1 were to overlap, it would require security over the recited second transmission channel, and user notification would be slowed. *Id.* at 7, 11; PO Sur-reply 16–17. Patent Owner admits that “[t]he ordinary and customary meaning of the term [“distinct”] is that the objects of the juxtaposition (i.e. the first and second transmission channels) are not identical, they are not the same, they are distinguishable, they are not indistinguishable, they are discrete and individual, etc.” and that “[t]he specification of the ’564 Patent does not express any intent to impart a novel meaning to the term.” PO Resp. 13. However, Patent Owner argues, “[t]he specification nevertheless ‘narrows’ the term by its use in the context.” *Id.* at 13 (citing Ex. 1001, Fig. 1).

Patent Owner additionally argues that the prosecution history indicates support for construing “distinct” as “distinct from, separate, and independent of.” *Id.* at 10, 15 (citing Ex. 1013, 45, 48 (Amendment in U.S. Patent Application 11/077,783 (“the ’783 application”)⁴, filed July 12, 2006)); PO Sur-reply 7–9. These remarks concerned an amendment to then-pending claim 1 of that application, applicant argued that Figure 1 supported the claim amendment, which added references to “a first transmission channel” and “a second transmission channel independent of and separate from the first transmission channel.” Ex. 1003, 40–50; *see id.* 42 (amending claim 1 in the ’783 application). In the remarks, applicant referred to these elements of the claims in that application as “independent of one another [and] separate and distinct.” *Id.* at 45, 48 (quoted at PO Resp. 14). Patent Owner also cites claim 9’s additional requirement that the

⁴ The ’564 patent claims priority to the ’783 application, through divisional and continuation applications. Ex. 1001, code (60), 1:7–13.

authorization and notification are performed “substantially concurrently” as supporting the interpretation that the channels are independent and separate from each other. *Id.* at 17–18 (citing Ex. 1001, 1:44–46, 1:50–55, Fig. 2).

Patent Owner additionally argues that the specification supports adding “the first and second transmission channels do not overlap” to limitation 1d of claim 1, again citing Figure 1 of the ’564 patent. PO Resp. 15–16.

Petitioner, in reply, asserts that “distinct” should be given its plain and ordinary meaning, which Petitioner argues does not exclude a partial overlap between transmission channels. Pet. Reply 6–13. Petitioner asserts, relying on Patent Owner’s discussion of the “ordinary and customary” meaning, that the ordinary and customary meaning does not require the absence of any overlap between two entities that are “distinct.” *Id.* at 12. Petitioner additionally argues that neither the cited portions of the specification nor the prosecution history cited indicate a different construction, and that the patentee did not act as lexicographer or disavow claim scope. *Id.* at 7–13. Petitioner also asserts that Patent Owner’s construction would exclude a preferred embodiment, illustrated in Figure 1 of the ’564 patent. *Id.* at 13–15. Patent Owner argues that Petitioner is incorrect in this assertion. PO Sur-reply 9–12 (citing Ex. 1001, Fig. 1, Fig. 2).

b) Our Analysis and Determination

As instructed by our reviewing court in *Phillips*, we begin by examining the words of the claim and turning to the specification as the “single best guide” to the meaning of a disputed term. *Phillips*, 415 F.3d 1315.

Patent Owner describes “the ordinary and customary meaning of the term” as requiring “that the objects of the juxtaposition (i.e., the first and

second transmission channels) are not identical, they are not the same, they are distinguishable, they are not indistinguishable, they are discrete and individual, etc.” PO Resp. 13. Patent Owner does not argue that the plain meaning of the word “distinct” requires “separate, and independent of” or that the distinct objects “do not overlap” but rather that the plain meaning described is narrowed by the intrinsic evidence. *Id.*

Having analyzed the arguments and the evidence cited by Patent Owner, we do not agree. We begin with the claim language, which does not further describe the two transmission channels, let alone contradict the plain meaning. Ex. 1001, 6:5–19. Dependent claims also shed no additional light. Certain claims further specify transmission-channel-related requirements: that the first transmission channel be “selected from the group consisting of wireless and landline channels” (claim 7); that the request received via the first transmission channel be “provided via the Internet” (claim 5); or that the notifying step (via a second transmission channel) comprise “sending an SMS message to the customer (claim 2). *Id.* at 6:20–21, 6:28–29, 6:33–35. No claims further restrict claim 1 by describing both transmission channels. *Id.* Claim 9 requires that the notification be “substantially concurrent,” but nothing in the record establishes that substantially concurrent authorization and notification would require non-overlapping transmission channels, or that an overlap in the transmission channels, even if it did “encumber” the authorization process with the notification process, would prevent the processes from being “substantially concurrent.”

While Patent Owner presents arguments about “the gist” of the invention (PO Resp. 4) and describes “an immediate separation of the two processes” as being disclosed by Figures 1 and 2 of the ’564 patent’s specification, we do not see in the specification an indication of a special

definition being given to a claim term by a patentee, or disclaimer or disavowal of a broader scope. *See Phillips*, 415 F.3d at 1316–1317; PO Resp. 13 (“The specification of the ‘564 Patent does not express any intent to impart a novel meaning to the term distinct.”). Although we agree with Patent Owner that Figure 1 illustrates transmission channels that are separate and non-overlapping, we do not see any indication that this is more than a description of preferred embodiments or that there was a limitation of the invention to these embodiments, and our reviewing court “has repeatedly ‘cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.’” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1346–47 (Fed. Cir. 2015) (quoting *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1328 (Fed. Cir. 2002)). The specification similarly does not support that Figure 2 is intended as limiting.

With respect to Patent Owner’s arguments regarding the “gist” of the patent, requirements regarding security and speed, and the asserted showing in Figure 2 that the processes of authorization and notification do not “encumber” one another, after a review of the record, we are provided no evidence⁵ that one of ordinary skill in the art, in the context of the

⁵ In a footnote, Patent Owner notes that Petitioner’s objection to attorney argument “also begs the question why [Patent Owner’s counsel,] a patent attorney who is educated in general physics and, in this case, is an inventor in the subject Patent, should not be enabled to discuss the meaning and interpretation of a claim term.” PO Sur-reply 7 n.18. Patent Owner misunderstands our rules. Expert testimony is presented in the form of an affidavit or declaration, with cross examination of affidavit testimony then available to the opposing party. 37 C.F.R. §§ 42.53(a), 42.51(b)(1)(ii); *see* 37 C.F.R. § 42.2 (“affidavit”). Additionally “[e]xpert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a).

specification and the evidence before us, would have understood Figure 2, claim 9, or any portion of the specification to require two channels that do not overlap. Patent Owner asserts that the channels could not overlap because:

Claim 1 explicitly recites that the “first transmission channel” includes “identification of the customer’s account” If there were an overlap [of the first transmission channel and the second transmission channel], even a partial overlap, then the data packets must be secure as well. In that case, the same protocol would have to be used for the notification as the packets that came in, since they pass through the same secure network again. The result would be a slowing down of the process.

PO Resp. 7; *see id.* at 4, 10; PO Sur-reply 16–18. No evidence is cited to support these contentions. However, even if evidence had been presented establishing that one of ordinary skill in the art would have understood that any overlap of transmission channels would result in “slowing down of the process” or if the intrinsic evidence included this conclusion, this would not be dispositive. “Mere criticism of a particular embodiment encompassed in the plain meaning of a claim term is not sufficient to rise to the level of clear disavowal.” *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2012).

The cited statements made during prosecution of the ’783 application relate to a claim amendment that amended a claim by adding “a first transmission channel” and “a second transmission channel *independent of and separate from the first transmission channel.*” Ex. 1013, 42 (underlining elided, emphasis added). First, the then-pending claims did not use the instant claim limitation “distinct,” and the cited statements therefore are of limited relevance as referring to a different limitation. Second, the applicant’s arguments in the ’783 application that the claim amendment to

the then-pending claims in that application found support in Figure 1 (Ex. 1013, 45) do not lead us to conclude that that the specification requires that transmission channels be “independent of and separate from” each other, merely that Figure 1 would support a claim that required such independence/separation (as the then-pending claims of the ’783 application did). Similarly, arguments distinguishing over prior art with respect to this feature (Ex. 1013, 48) related the then-pending claims, and we do not agree that they shine light on the proper construction of limitation 1d in claim 1 before us now.

For these reasons, we decline to construe the term “distinct” in limitation 1d of claim 1 to “narrow” the ordinary and customary meaning of the term (*see* PO Resp. 13) to require that the second transmission channel be “separate and independent” of the first transmission channel, or to require that in limitation 1d “the first and second transmission channels do not overlap.” We do not provide a specific claim construction, but determine that the plain and ordinary meaning of limitation 1d of claim 1 encompasses overlapping first and second transmission channels that are distinct. As discussed *infra*, Section II.D.2, this is sufficient to resolve the controversy before us. Because “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy,’” we need not construe the term further. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

2. Additional Terms

No other constructions are necessary to resolve the controversy before us, and we make no further constructions. *See Nidec Motor Corp.*, 868 F.3d at 1017.

D. Anticipation by Horie

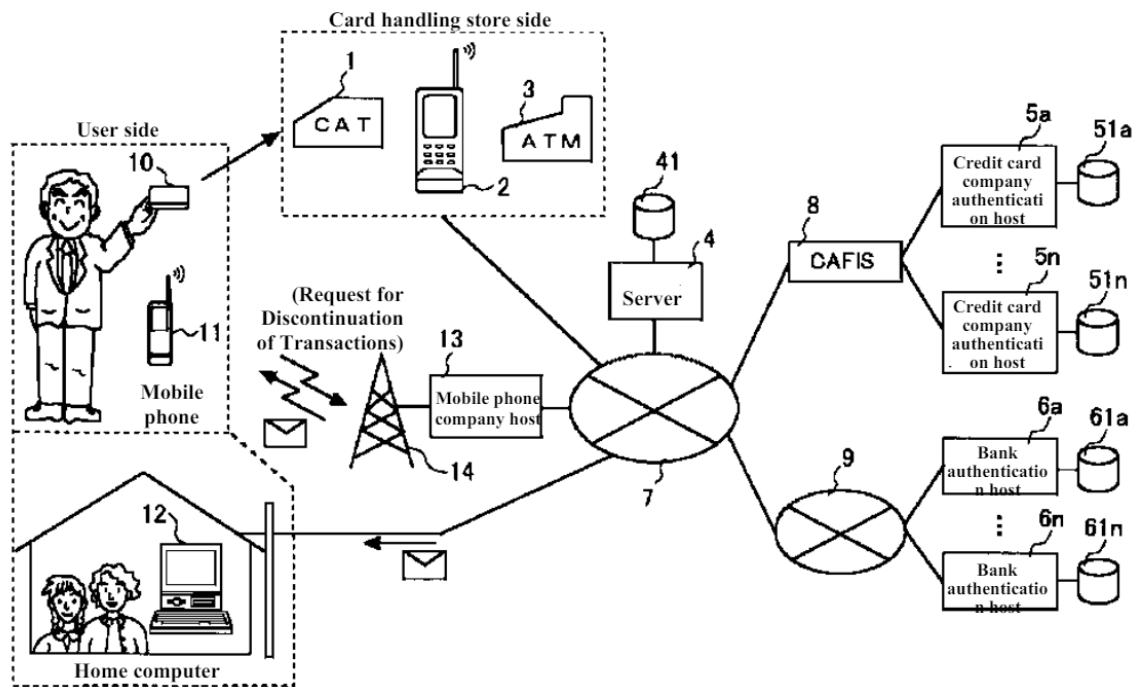
1. Overview of Horie

Horie is titled “Card Usage Status Notification Method,” and discloses “a card payment transaction system that enables online card payment transactions through data communication between a card transaction terminal device and a card authentication host,” in which the “card authentication host is provided with a means to create an email to notify the user of a card payment transaction, and a means to send the above created email to a pre-specified address for each card.” Ex. 1006, code (57).

Horie describes providing a notification via, *e.g.*, a mobile phone or personal computer, that a card payment transaction has been made. Ex. 1006, code (57), ¶ 1. Horie describes that the conventional card payment transaction system provides information regarding such transactions via receipts provided during the transaction and in periodic invoices and usage status inquiry services. *Id.* ¶¶ 3–4. Horie notes that a fraudulent transaction may not be discovered for some time, and that there may be situations in which one party wishes to track legitimate transactions of others using the credit card account. *Id.* ¶ 4. Thus, Horie proposes a system by which a card usage status notification is made via email or mobile phone notification. *Id.* ¶¶ 5, 6, 8, 12–18, 20–22. The notification may include “transaction content information such as card usage date and time and card usage location information.” *Id.* ¶¶ 16, 17, 23.

Horie's Figure 1 is reproduced below,

[FIG. 1]



Horie Figure 1 “is a diagram showing a schematic configuration of a card payment transaction system.” Ex. 1006, “Brief Description of the Drawings”. In Figure 1, card 10 is used for a payment and authenticated using card transaction terminal devices 1, 2, and 3. *Id.* ¶¶ 39, 44. Credit card company authentication hosts 5a–5n perform card authentication processing for credit cards in conjunction with CAFIS⁶ 8 and bank authentication hosts 6a–6n perform authentication for debit cards in conjunction with an interbank network 9. *Id.* ¶¶ 39–40. Network 7 connects the card transaction terminal devices 1, 2, and 3, with CAFIS 8 and interbank network 9. *Id.* ¶¶ 39, 42. In addition, user’s mobile phone 11 and

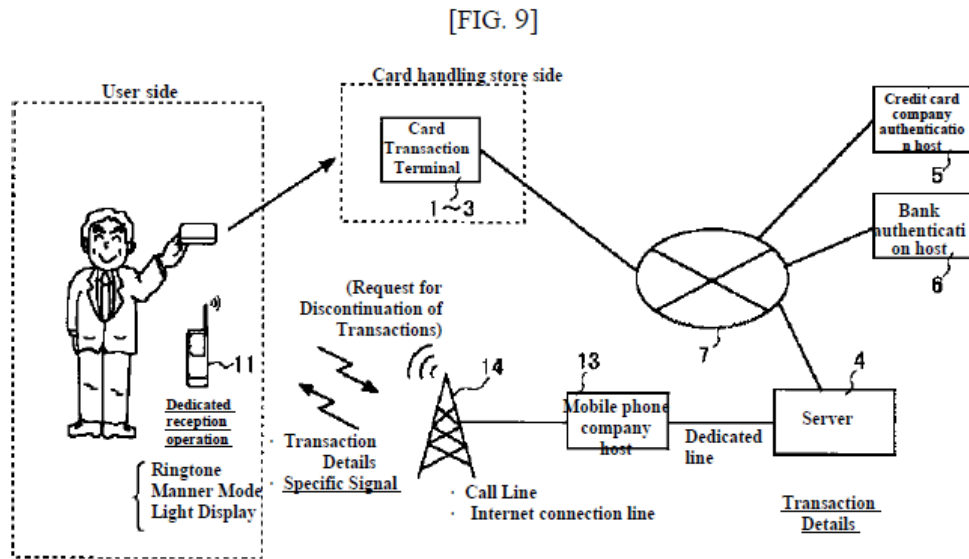
⁶ CAFIS refers to the “Credit And Finance Information Switching system,” a cashless payment platform used in Japan. *See* <https://www.nttdata.com/global/en/about-us/ntt-data-history> (accessed May 19, 2025).

home computer 21 are connected to the network 7. *Id.* ¶ 41. Information processing server 4 is also connected to network 7. *Id.* ¶¶ 39, 44.

Horie describes that, based on an authentication processing request from the card transaction terminal, information is transmitted to the card authentication host. *Id.* ¶ 53, Fig. 3. The authentication process is then performed, and, if successful, a signal indicating success and any necessary data is transmitted back to the card transaction terminal. *Id.* ¶¶ 54, 56, Fig. 3. A predetermined file is then called to determine whether a notification should be sent via email. *Id.* ¶¶ 57, 58, Fig. 3. If the email notification is requested, the email is sent via the information processing server, and an email transmission processing request is made. *Id.* ¶¶ 59–60, Fig. 3.

Horie also describes that, “although an e-mail is sent to notify the user after the card authentication process in the card payment transaction, the email can also be sent, for example, during the card authentication process.” *Id.* ¶ 73. Horie continues, “[i]n such a case, for example, it would be possible to prevent fraudulent card use by making it possible to issue a transaction cancellation request to the authentication hosts 5 to 6 via the mobile phone 11.” *Id.*

Horie Figure 9 is reproduced below.



Horie Figure 9 “is a diagram showing a schematic configuration of another aspect” of the invention. Ex. 1006, “Brief Description of the Drawings.” The card payment system of Figure 9 “is similar to that of the first embodiment, but in that the mobile phone company host 13 is connected to the server 4 via a dedicated line. *Id.* ¶ 76. “[W]hen there is a card payment transaction, . . . a processing request is sent from the side of the server 4 to the host of the applicable mobile phone company to make such notification.” *Id.* ¶ 77.

2. Claim 1

a) Petitioner’s Contentions

Petitioner argues that, to the extent the preamble is limiting,⁷ the “method for processing a transaction” of the preamble (Ex. 1001, 6:5–6) is disclosed by Horie’s method for a card payment transaction system using a

⁷ Because we determine Petitioner has sufficiently shown that Horie discloses the preamble, we need not determine whether the preamble is limiting. See *Nidec*, 868 F.3d at 1017.

“card usage status notification method that automatically notifies a card user . . . that a card payment transaction has occurred.” Pet. 21 (citing Ex. 1006 ¶ 1; Ex. 1003 ¶¶ 210–211).

For “receiving a request for authorizing a transaction for an account . . . said request including at least an identification of the customer’s account,” of limitation 1a of claim 1 (Ex. 1001, 6:7–10), Petitioner cites Horie’s “card authorization processing request” and argues that one of ordinary skill in the art would have understood that the “card information” and “necessary information” that is read at the transaction terminal and sent to the card authentication host in Horie would have included identification of the customer’s account. Pet. 21–22⁸ (citing Ex. 1006 ¶¶ 46–48; Ex. 1003 ¶ 213). Petitioner argues that the receipt of a request “via a first transmission channel” as recited in limitation 1a (Ex. 1001, 6:8–9) is disclosed by Horie’s “network” connecting the card transaction terminal device to the host, by the specific communications described with respect to the transmissions (e.g. in Figure 1), and (in part) by the “interbank network” connecting the network with the bank authentication and credit card authentication hosts. *Id.* at 22–23 (citing Ex. 1006 ¶¶ 39, 40, 44, 54, 76, Fig. 1; Ex. 1003 ¶¶ 213–215).

With respect to limitation 1b, “determining whether or not the account includes a request for notification to the customer of any transactions” (Ex. 1001, 6:11–12), Petitioner cites Horie’s disclosure that information regarding whether a user should be notified of a card payment transaction is

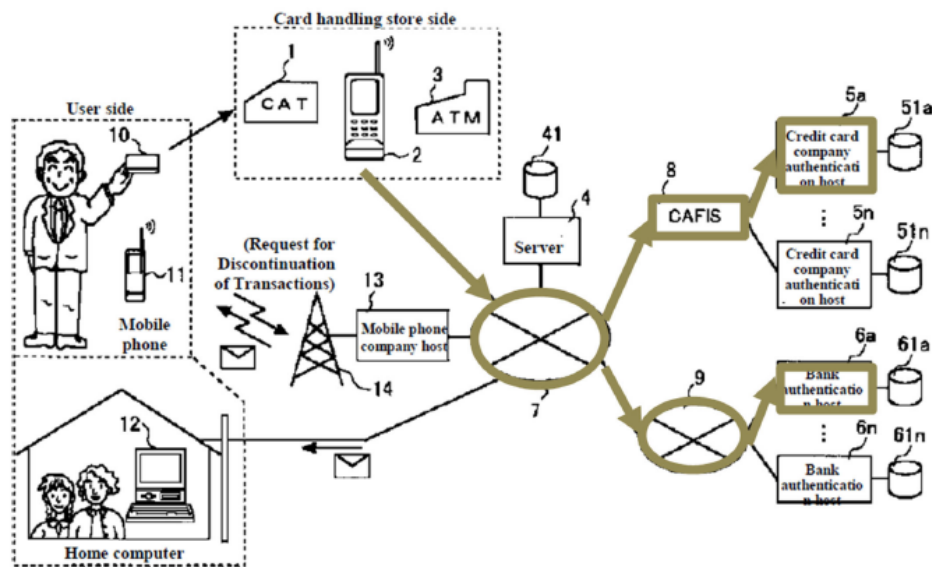
⁸ In certain cases, the Petition uses different colored text; in our quotations from the Petition we remove this emphasis.

stored in a predetermined file and consulted during the transaction. *Id.* at 24 (citing Ex. 1006 ¶ 57; Ex. 1003 ¶ 217).

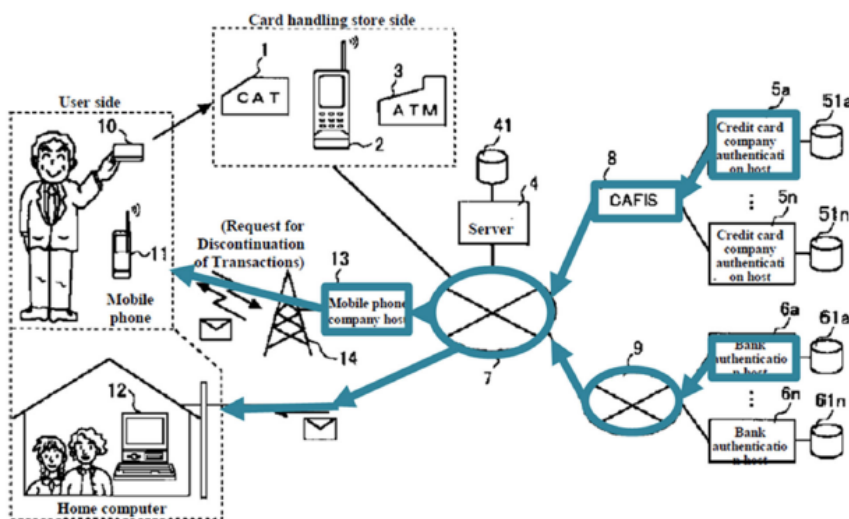
For limitation 1c’s notification of a customer, Petitioner cites Horie’s disclosure that an email is sent to notify a user of a card payment transaction. Pet. 24–25 (citing Ex. 1006 ¶ 44, Fig. 1; Ex. 1003 ¶ 219). Petitioner argues that Horie makes such a notification “only if the account includes a request for notification of any transactions” because Horie discloses that a normal card payment transaction is performed if notification has not been requested, but that a notification by email or phone is made if notification was requested. *Id.* at 25–26 (citing Ex. 1006 ¶¶ 59, 78; Ex. 1003 ¶¶ 221, 223). With respect to the second transmission channel, Petitioner cites Horie’s disclosure of user notification via a mobile phone company host and base station (if to the customer’s mobile phone) and via a connection of a personal computer to a network (if to that personal computer). *Id.* at 25 (citing Ex. 1006 ¶¶ 41, 76, Fig. 1; Ex. 1003 ¶¶ 221, 223).

For limitation 1d’s requirement that “the second transmission channel [must be] distinct from the first transmission channel” (Ex. 1001, 6:16–17), Petitioner argues that the transmission channel from the card transaction terminal devices (for the first transmission channel) and to the user (for the notification to a customer) are distinct because they include different connections, different hardware elements, and operate independently of one another in the data transmission. *Id.* at 26–29 (citing Ex. 1006 ¶¶ 44, Fig. 1; Ex. 1003 ¶¶ 224–227). Petitioner provides two annotated versions of Horie’s Figure 1, reproduced below, to illustrate the difference in transmission channels, with a first communication channel highlighted in khaki in the first and in blue in the second.

[FIG. 1]



[FIG. 1]



Id. at 27. As seen in the two annotated versions of Horie's Figure 1, Petitioner contends that the two channels are different because only the first includes a path from the card handling store to network 7, and only the second includes connections between network 7 and mobile phone 11 or home computer 12 of a user. *Id.* at 27–28. Petitioner additionally argues that the Horie's disclosure of a dedicated line between mobile phone company host 13 and server 4 would have been understood by one of

ordinary skill in the art to mean a line “distinct from other lines of communication.” *Id.* at 28 (citing Ex. 1003 ¶ 226; *see* Ex. 1006 ¶¶ 76, 78, Fig. 9).

For limitation 1e’s requirement that the method of claim 1 include the step of “authorizing the transaction without requiring a response from the customer” (Ex. 1001, 6:18–19), Petitioner argues that Horie discloses sending an email notification to a user during the card authentication process (to allow for a cancellation request) as an alternative to sending such a notification after the card authentication process. *Id.* at 29–30 (citing Ex. 1006 ¶¶ 57, 58, 73; Ex. 1003 ¶¶ 232–233). Thus, Petitioner contends, Horie discloses an embodiment in which “the card [is] authorized for use regardless of any response from the customer.” *Id.* at 29–30.

b) Patent Owner’s Contentions

Patent Owner presents arguments relying on its proposed construction of limitation 1d. *See supra* § II.C. Under Patent Owner’s construction, Patent Owner argues that Horie does not disclose “the second transmission channel being distinct from the first transmission channel,” because the paths Petitioner cites from Horie as disclosing the “first transmission channel” and “second transmission channel” exhibit “considerable overlap.” PO Resp. 9–10; PO Sur-reply 13–15. Patent Owner admits that in Horie, “the transmission of the authorization request from the ‘merchant’ (1, 2, 3) to the server 7 uses a different communication channel than the notification from the server 4/network 7 to the user (11, 12).” PO Resp. 9. However, Patent Owner contends, in Horie, “[t]he communication between the server 7 and the credit card company 5, as well as the communication between the server 7 and the bank 6, proceed on the same channels, whether it be the authorization request or the notification/authorization.” *Id.* Thus,

Patent Owner argues that Horie does not disclose the distinct transmission channels of limitation 1d of claim 1.

Patent Owner additionally argues that Horie “does not discuss the concept of sending one message over a line that is secure and another message over a different line that may or may not be secure. [This] concept is not discussed in Horie; on the other hand, the concept is central to the speed of the ’564 invention.” PO Resp. 5, 7–11, 21. Patent Owner additionally argues that “The differences between the designs of Horie and the ’564 Patent claims 1-9 has implications for the speed in which the customer receives the notification.” *Id.* at 21; *see id.* at 7–8, 10, 11, 22; PO Sur-reply 16, 18.

c) Determination – Claim 1, Anticipation by Horie

After reviewing Petitioner’s arguments and evidence, we are persuaded that Petitioner sufficiently demonstrates that Horie discloses each element of claim 1.

Horie discloses a card payment transaction system that receives a request for authorizing a transaction, including an identification of the customer’s account. Ex. 1006 ¶¶ 1, 46–48; Ex. 1003 ¶¶ 210–211, 213. The first transmission channel is disclosed by the connection in Horie of the card transaction terminal device to the host, including the “interbank network” connecting Horie’s network to the bank authentication and credit card authentication hosts. Ex. 1006 ¶¶ 39, 40, 44, 54, 76, Fig. 1; Ex. 1003 ¶¶ 213–215. Horie describes consulting account information in a file to determine whether an account includes a request for notification, and, only if so, sending an email notifying a user of a card payment transaction. Ex. 1006 ¶¶ 44, 57, 59, 78, Fig. 1; Ex. 1003 ¶¶ 217, 219, 221, 223.

With respect to the second transmission channel, we determine it is disclosed in Horie's user notification via a mobile phone company host and base station (if to the customer's mobile phone) and via a connection of a personal computer to a network (if to that personal computer). Ex. 1006 ¶¶ 41, 76, Fig. 1; Ex. 1003 ¶¶ 221, 223.

Because we do not adopt Patent Owner's construction (including considering its arguments regarding speed and security of transmissions in the '564 patent), and instead adopt a construction encompassing overlapping between distinct transmission channels, *see supra* Section II.C.1, we determine that the requirement of limitation 1d that "the second transmission channel [must be] distinct from the first transmission channel" is disclosed by the different connections, different hardware elements, and independent operation of the two transmission channels identified in Horie, even though they overlap to some extent. Ex. 1006 ¶¶ 44, Fig. 1; Ex. 1003 ¶¶ 224–227; *see* PO Resp. 9.

Lastly, Horie discloses that the authorization of a transaction occurs without requiring a response from the customer. Ex. 1006 ¶¶ 57, 58, 73; Ex. 1003 ¶¶ 232–233.

For these reasons, we determine Petitioner has demonstrated by a preponderance of the evidence that the subject matter of claim 1 was anticipated by Horie.

3. *Claim 2*

Claim 2 depends from claim 1 and further specifies that "the notifying step comprises sending an SMS message to the customer." Ex. 1001, 6:20–21. Petitioner argues that this is disclosed in Horie's disclosure of notifying a user via a mobile phone, which one of ordinary skill in the art would have

understood would have been in the form of an SMS message. Pet. 30 (citing Ex. 1006 ¶¶ 18, 20, 79; Ex. 1003 ¶¶ 235, 237, 238).

Patent Owner contends that “Horie’s notification is by ‘email’” and that Dr. Akl is incorrect in testifying that it is sent by SMS. PO Resp. 20–21; PO Sur-reply 16–17. Patent Owner asks: “[i]f SMS was the ‘standard,’ as argued by Dr. Akl, why does Horie only explicitly refer to e-mail and why does Horie send an ‘e-mail’ to the customer’s mobile phone.” PO Resp. 20; PO Sur-reply 17. Patent Owner asserts that Horie’s disclosure is limited to relating that the customer’s phone is “expressly configured for receiving ‘emails.’” PO Resp. 20–21 (citing Ex. 1006, Fig. 9); PO Sur-reply 17 (ostensibly quoting “Horie, at 4”⁹). Patent Owner states that “Horie does not mention the receipt of a text message or SMS.” PO Resp. 21.

Petitioner asserts that Horie discloses a customer’s mobile phone “display by text” of received data regarding the content of card payment transactions, and refers to Dr. Akl’s testimony that “[a]t the time of the alleged invention, a [person of ordinary skill in the art] would have understood that ‘text’ sent to a mobile phone would have typically been in the form of an SMS message, which was the most common format used at the time for the delivery of text-based transmissions of data to and from mobile phones.” Pet. Reply 17–18.

The evidence before us in considering the disclosure of Horie includes only that disclosure and Dr. Akl’s testimony regarding “what the skilled artisan would understand [Horie] to be disclosing. *Sage Products, LLC v. Stewart*, 133 F.4th 1376, 1385 (Fed. Cir. 2025) (“[E]xpert opinion ‘may be

⁹ Patent Owner quotes a translation of Horie that is not in the record. We understand Patent Owner to be referring to paragraph 14 of Horie. *Compare* Ex. 1006 ¶ 14 *with* PO Sur-reply 17.

used to interpret [an] allegedly anticipating reference and to shed light on what it would have meant to ‘a person having ordinary skill in the art.’” (quoting *Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1345 (Fed. Cir. 2018)). The disclosure, as Patent Owner argues, does describe email notifications, but additionally describes “notification by sending and receiving specific data via a normal phone line of a mobile phone” and a “allow[ing] the mobile phone user to know that a particular card has been used for a payment transaction [through a] mobile phone [that] display[s] the content on the display by text, etc.” Ex. 1006 ¶¶ 20, 79. We credit Dr. Akl’s unrebutted testimony regarding these disclosures, including his testimony that, at the time of the alleged invention, SMS was a de-facto standard for receiving text messages by a mobile phone. Ex. 1004 ¶¶ 237–238 (citing Ex. 1008, Abstract, 1:53–63).

For these reasons, we determine Petitioner has demonstrated by a preponderance of the evidence that the subject matter of claim 2 was anticipated by Horie.

4. Claims 3–8

Petitioner argues that claims 3–8 are anticipated by Horie. Pet. 30–38. Patent Owner presents no additional arguments with respect to the limitations of these dependent claims. We summarize Petitioner’s contentions, which we determine demonstrate by a preponderance of the evidence that the subject matter of claims 3–8 were anticipated by Horie.

With respect to claim 3, dependent from claim 1 and further specifying that “the request is from the group consisting of a customer, an account holder, an authorized person, and an unauthorized person” (Ex. 1001, 6:22–24), Petitioner argues that Horie discloses a request from a

customer, account holder, or unauthorized person. Pet. 30–32 (citing Ex. 1006 ¶¶ 4, 6, 81; Ex. 1003 ¶¶ 243–245).

Claim 4 depends from claim 1, and adds an additional requirement that “the request is provided from the group consisting of an ATM, a POS terminal, a telephone and a device for virtual communication.” Ex. 1001, 6:25–27. Petitioner argues that Horie discloses an ATM as a card transaction terminal device. Pet. 32–33 (citing Ex. 1006 ¶¶ 25, 46–48; Ex. 1003 ¶¶ 247, 249, 250).

Claim 5 adds to claim 1 the requirement that “the request is a virtual request provided via the Internet” (Ex. 1001, 6:28–29) and Petitioner argues that this is disclosed in Horie’s request provided via a network that includes a server and sends email, and one of ordinary skill would have understood this to refer to the Internet. Pet. 33–34 (citing Ex. 1006 ¶ 29; Ex. 1003 ¶ 252).

Claim 6 depends from claim 1 and adds an additional requirement that “the transaction is selected from the group consisting of credit card, debit card, charge card, and ATM.” Ex. 1001, 6:30–32. Petitioner again argues that Horie discloses an ATM as a card transaction terminal device. Pet. 34 (citing Ex. 1006 ¶ 25; Ex. 1003 ¶ 256).

Claim 7 depends from claim 1 and requires that the first transmission channel “is selected from the group consisting of wireless and landline channels.” Ex. 1001, 6:33–35. Petitioner argues that Horie discloses each of these. Pet. 35–36 (citing Ex. 1006 ¶¶ 25, 39, 46–48; Ex. 1003 ¶¶ 260, 262, 263).

Claim 8 depends from claim 1 and further requires that the request be received “at a remote processing facility.” Ex. 1001, 6:36–37. Petitioner argues that Horie discloses several examples of a request received at a

remote processing facility located in a different location than the card transaction terminals. Pet. 36–38 (citing Ex. 1006 ¶ 39; Ex. 1003 ¶ 267).

In light of the evidence presented supporting each of these arguments, we determine Petitioner has demonstrated by a preponderance of the evidence that claims 3–8 were anticipated by Horie.

5. *Claim 9*

With respect to the additional requirement added by claim 9 to claim 1, that the claim 1 steps of notifying and authorizing are performed “substantially concurrently” (Ex. 1001, 6:38–40), Petitioner relies on its arguments with respect to claim 1 and additionally on paragraph 43 of Horie, which notes that “normal card authentication processing and card usage status notification via email are performed simultaneously.” Pet. 38 (citing Ex. 1006 ¶ 43; Ex. 1003 ¶ 270).

Patent Owner does not appear to present separate arguments with respect to claim 9, but does discuss claim 9 with reference to arguments regarding claim construction, as addressed in Section II.C.1. PO Resp. 17. Patent Owner argues that “[t]he use of the term ‘concurrent’ further shows that the processes have a temporal identity, while it also amplifies the fact that the communications through the transmission channels are independent and separate from one another.” *Id.*

We determine that Horie discloses substantially concurrent notification and authorization in the disclosure that the card processing and the notification are performed simultaneously. Ex. 1006 ¶ 43; Ex. 1003 ¶ 270. We therefore determine Petitioner has demonstrated by a preponderance of the evidence that claim 9 was anticipated by Horie.

E. Obviousness Over Horie

Petitioner additionally argues that each of claims 1–9 are obvious over Horie. Pet. 38–43. Because we determine that the challenged claims are anticipated by Horie, we do not address the parties’ arguments regarding those claims based on an alternate ground. *See Boston Sci. Scimed, Inc. v. Cook Gp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (“We agree that the Board need not address issues that are not necessary to the resolution of the proceeding.”).

III. PETITIONER’S MOTION TO EXCLUDE EXHIBIT 2001

Petitioner filed a timely objection to the Declaration of Mr. Stemer (Ex. 2001, “Stemer Declaration”). Paper 31; *see also* Paper 30 (Order setting forth expedited period for objections to Exhibit 2001). Petitioner preserved the objection by filing a timely motion to exclude. Mot. Exclude. Specifically, Petitioner argues that we should exclude Exhibit 2001 for three reasons: (1) it is untimely and prejudicial (37 C.F.R. §§ 42.23(b), 42.53(b); Fed. R. Evid. 403), (2) hearsay (Fed. R. Evid. 802), and (3) the best evidence rule (Fed. R. Evid. 1002). *Id.*

The Stemer Declaration is used only to support Patent Owner’s arguments with respect to secondary considerations.¹⁰ PO Sur-reply 19–22; Ex. 2001; Ex. 2002. Because we do not reach obviousness, *see infra* Section

¹⁰ Patent Owner’s Sur-reply references an “Affidavit,” which we understand to be the document filed as Paper 21 and designated as available only to “Filing Party and Board.” *See* Paper 23, Order Conduct of the Proceeding, entered January 31, 2025. Subsequently, Patent Owner filed this “Affidavit” (which was a declaration, *see* Paper 23, 2 n.6) as Exhibit 2001 and a redacted version as Exhibit 2002. *See* Exhibit 3001 (February 19, 2025 Board email to parties requiring Patent Owner to refile the confidential declaration as an exhibit and additionally to file a public version).

II.E, we do not consider the Stemer Declaration, and we therefore dismiss the motion to exclude as moot.

IV. EVIDENCE UNDER SEAL

We also remind the parties of the public's interest in maintaining a complete and understandable file history, and of the general expectation that information will be made public where the existence of the information is identified in a final written decision following a trial. *See Consolidated Trial Practice Guide* (2019), 21–22.¹¹ We also note that confidential information subject to a protective order ordinarily becomes public 45 days after denial of an institution decision or entry of a final judgment in a trial. *See id.* After the denial of institution or entry of final judgment, a party may file a motion to expunge confidential information from the record prior to the information becoming public. *See id.*; 37 C.F.R. § 42.56.

V. CONCLUSION

For the foregoing reasons, we conclude that Petitioner has demonstrated by a preponderance of the evidence the unpatentability of the challenged claims of the '564 patent. Specifically, Petitioner has shown by a preponderance of the evidence that the challenged claims are unpatentable as anticipated by Horie. We also dismiss Petitioner's motion to exclude Exhibit 2001 as moot.

¹¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
1–9	102	Horie	1–9	
1–9	103	Horie ¹²		
Overall Outcome			1–9	

VI. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Petitioner has shown by a preponderance of the evidence that claims 1–9 of the '564 patent are unpatentable; and

FURTHER ORDERED, that Petitioner's Motion to Exclude (Paper 33) is *dismissed* as moot;

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

¹² As explained above, because we determine that claims 1 through 9 are unpatentable as anticipated by Horie, we decline to address those claims on this ground.

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