

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Paul Poniatowski

Patent Owner

v.

Apple Inc.

Petitioner

Inter Partes Review Case No. IPR2024-00731

U.S. Patent No. 8,270,578

RESPONDING TO *INTER PARTES* REVIEW

OF U.S. PATENT NO. 8,270,578

And Mandatory Notices

Dear Sirs,

Because of my health problems, I am only now able to respond.

Re. The '578 Patent' s Priority Date:

The PCT/CA2004/000513, filed April 7, 2004 has made disclosure on a new subject matter on page 9- 10 of the document lines 32- 22 . Exb. 2001:

“As an example, advertisers could include in their advertising a specific telephone code which users may enter while listening to an audio feed.

Entering the code would then automatically connect the end user to the advertiser's telephone call-in center so the end user can then take advantage of the offer (e.g. a vacation trip for a low promotional price).

Alternatively, end users may establish an account, with their credit cards on file, with the operators of the system. These end users may then do their shopping over the telephone based on what is being advertised on the display screens. End user choices, such as the colour, size, or type of merchandise, could be entered by the end user via the telephone keypad using specific telephone codes shown in the video feeds. To verify an end user's identity, PIN (personal identification numbers) could be associated with each end user account.

Such PIN numbers would be required to validate/finalize the transaction before the end user's credit card is charged and before the item is shipped to the end user's on-file address or before the end user can pick up the item. As an alternative, an end user's bank account can be tied in with the end user's system account and the purchase price of the end-user's purchase can be automatically debited to from his/her bank account. The use of PIN numbers or some similar scheme for validation for this configuration would, of course, be required for security. End users can also be provided, by of way of their mobile telephone's screen, with different payment options. A dedicated PAY button on the mobile handset can be provided so that activation of this button brings up the end user's payment option.”

Re. optical input : in 2004 when the patent was filed, smart phones were in its infancy. It was't till late 2000's when megapixel cameras were introduced. Disclosure in PCT page 10, l.ine 6-9 states : *“end users may then do their shopping over the telephone based on what is being advertised on the display screens. End user choices, such as the colour, size, or type of merchandise, could be entered by the end user via the telephone keypad”*

Since the human eye is a primary optical input it would be logical for those skilled in art to apply any available technology to further modify and

improve the shopping experience by taking a scan/pic of the products bar codes, instead entering them manually. This automated method is used in retail stores for decades. After all they say picture is worth a thousand words. Not to mention how sketches, paintings , photographs or films are created. Re. prices of goods : it is a common sense that when a person is shopping, goods are priced accordingly by their vendor, eg. *vacation trip for a low promotional price.*

Re. network hub for wireless exchange between commercial establishment and a mobile phone:

“To verify an end user's identity, PIN (personal identification numbers) could be associated with each end user account. Such PIN numbers would be required to validate/finalize the transaction before the end user's credit card is charged and before the item is shipped to the end user's on-file address or before the end user can pick up the item. As an alternative, an end user's bank account can be tied in with the end user's system account and the purchase price of the end-user's purchase can be automatically debited to from his/her bank account. The use of PIN numbers or some similar scheme for validation for this configuration would, of course, be required for security. End users can also be provided, by of way of their

mobile telephone's screen, with different payment options'.

It is well known fact that for decades that debit or credit card transactions in commercial establishments are executed at financial hubs. It would be obvious to the skilled in art to accept such architecture as a basic standard set up within all retailers.

Therefore there is a plenty of evidence in written description on financial transactions taking place with a commercial establishment.

Petitioner alleged prior art publications -presuming '578 Patent is obvious or lacking novelty -must disclose the "enabling disclosure." If someone with ordinary skill in the relevant field of technology cannot figure out how to make and/or use the '578 Patent based on the alleged prior art publications, then they can't be cited as prior art for obviousness.

The Petitioner's cited prior art is inadequate for following reasons:

Re. Wang. PEAD is an authorisation device (it says so in title of Wang's invention) for approving a transaction request send from the POS back to client's PEAD and only then -" if the user agrees to pay, he will press the

approve button to authorise the transaction”. Act of approval or authorisation is vastly different than act of initiation, therefore it is not in the same field of endeavour nor its art is analogous to ‘578 Patent where in “a mobile phone equipped with a dedicated actuator for initiating a commercial transaction”.

Re. Dua. The mobile device is applied to financial transactions. Wallet icon simply represents payment function. Does not initiate commercial transaction but rather finalise one. It is not the same as a mobile phone equipped with a dedicated actuator for initiating a commercial transaction. Therefore Dua is not in the same field of endeavour nor its art is analogous to ‘578 Patent.

Re. Yong. A device as a simple scanner Fig.5 that can not perform as mobile phone. The device collects products data for further task but does not initiate transaction. The transaction commences at POS terminal. Therefore Yong is not in the same field of endeavour nor its art is analogous to ‘578 Patent.

For all the facts and reasons stated herein it is believed that there is no grounds for revocation of the U.S. Patent No. 8,270,578.

Respectfully submitted ,

Paul Poniatowski,

October 7 , 2024

MANDATORY NOTICES 37 C.F.R. § 42.8(a)

(1) Real party-in-interest :

Paul Poniatowski is the real party-in-interest, 37 C.F.R. § 42.8(b) .

(2) Related matters :

Pursuant to the 37 C.F.R. § 42.8(b) it is to be disclosed that *Poniatowski v. Apple Inc.* , Case No. 6:23-cv-00316 (W.D. Tex) was dismissed without prejudice for improper service.

(3) Lead and back-up counsel :

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