

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EARLY WARNING SERVICES, LLC,

Petitioner

v.

INTELLECTUAL VENTURES II, LLC,

Patent Owner

Inter Partes Review No.

IPR2024-01221

U.S. Patent No. 7,314,167

**PETITIONER'S MOTION TO EXCLUDE EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64(c)**

I. Introduction

Pursuant to 37 C.F.R. § 42.64(c), Petitioner Early Warning Services, LLC, (“Petitioner”) moves the Board to exclude from the record inadmissible exhibits submitted by Intellectual Ventures II, LLC, (“Patent Owner” or “PO”), specifically, Exhibits 2024-2026 and paragraphs 44-63, 66-67, 69-76, 77-79, 88, 90, and 101-102 of Exhibit 2029. On May 16, 2025, Petitioner timely and specifically objected to Exhibits 2024-2026 and Exhibit 2029 on these bases. Paper No. 17 at 1-3.

PO attempts to use extrinsic evidence (Exhibits 2024, 2025, 2026, and 2029) to construe claim terms “image capture device” and “the image having information embedded therein.” PO’s Response (“POR”) Paper 16, 26-32; PO’s Sur-Reply (“POSR”), Paper 21, 1-5. As explained below, such use is improper as the intrinsic evidence alone provides the meaning of the claim terms, and PO’s extrinsic evidence contradicts the intrinsic evidence. Accordingly, the extrinsic evidence should be excluded as lacking probative value, confusing the issues, and misleading to the Board under FRE 403.

The Federal Circuit has made clear when “the intrinsic evidence alone will resolve any ambiguity in a disputed claim term . . . it is improper to rely on extrinsic evidence.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996). A patent’s specification and, when applicable, prosecution

history, are “intrinsic evidence to which the PTAB gives priority when it construes claims.” *Knowles Elecs. LLC v. Cirrus Logic, Inc.*, 883 F.3d 1358, 1361-62 (Fed. Cir. 2018) (footnote omitted); *Vitronics*, 90 F.3d at 1582 (noting that the claims, specification, and prosecution history are “the most significant source[s] of the legally operative meaning of disputed claim language.”). Only when necessary may extrinsic evidence be used to construe claims, and even then, ***extrinsic evidence must be consistent with the intrinsic evidence***. *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 977 (Fed. Cir. 2014); *Bell Atl. Network Servs. v. Covad Commc’ns Grp.*, 262 F.3d 1258, 1269 (Fed. Cir. 2001) (stating extrinsic evidence “***may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history.***”) (emphasis added).

Here, the intrinsic evidence is clear on the plain and ordinary meaning of “image capture device” and “the image having information embedded therein,” making extrinsic evidence unnecessary. Additionally, the extrinsic evidence conflicts with the intrinsic evidence making its use not only unnecessary, but improper. Because it contradicts the intrinsic evidence, the extrinsic evidence is not probative, confuses the claim construction issues, and is misleading to the Board. For these reasons, this evidence should be excluded under FRE 403 to the extent that it conflicts with the intrinsic evidence.

II. Extrinsic evidence on “image capture device” should be excluded under FRE 403.

Claims 1 and 19 recite, *inter alia*, “an image capture device configured to capture an image.” Ex. 1001, Claims 1, 19.¹ PO (improperly) uses Exhibits 2024-2026 and portions of Exhibit 2029 to narrowly construe the term to mean “imaging-based bar code readers and not a laser-based barcode scanner.” POR, 11-13, 18-20, 26-30, 37-38, 44; POSR, 1-5. The plain and ordinary meaning of the term “image capture device” is readily apparent from the specification: the term means any device that can capture an image. PO’s extrinsic evidence is both unnecessary and conflicts with the intrinsic evidence and should be excluded under FRE 403.

A. “image capture device” is any device that can capture an image.

As an initial matter, the ’167 Patent makes clear that an “image” is not limited to a barcode and can include alphanumeric characters and printed objects and symbols. Petitioner’s Reply to PO’s Response (“Reply to POR”), Paper 19, 4-8. PO’s expert agreed. Ex. 1048, 70:7-23. For example, in referring to FIG. 7, the

¹ Petitioner construes “an image capture device configured to capture an image” (Claims 1 and 19) and “configuring a portable device to . . . capture an image ” (Claims 23, 29, and 43) together. POR, 26-30. Discussion of “image capture device” herein applies to both claim limitations.

'167 Patent indicates that a printed barcode is *one type (not the only type) of “image.”* Ex. 1001, 10:29-25 (“[t]he printed form 700 includes certain transaction information as well as an *image 710, such as a barcode . . .*”) (emphasis added). PO’s use of extrinsic evidence to construe “image capture device” to refer only to imaging-based barcode readers contradicts the meaning of “image” from intrinsic evidence and is faulty for this reason alone.

The '167 Patent goes on to teach the image capture device may include a digital camera “*or other types of image capture devices.*” Ex. 1001, 5:21-22. Therefore, the plain reading of the intrinsic evidence makes clear that other types of image capture devices do not require a camera and in view of the intrinsic evidence, “image capture device” should not be limited to mean “imaging-based bar code readers and not a laser-based barcode scanner.” Reply to POR, 8; Institution Decision, Paper 10, 21-22 (previously rejecting PO’s narrow construction). Instead, the “image capture device,” as used in the '167 Patent, is *any* device that can capture an image (e.g., an alphanumeric character, and printed object and symbol). Ex. 1001, 5:21-22, 10:29-25. PO’s expert even volunteered that a laser barcode scanner, which is not an imaging-based scanner, can “capture” an image as required by the claims. Ex. 1048, 163:1-6, 163:25-164:4. In view of the foregoing, PO’s proposed construction, which is limited to imaging-based bar code readers, is unduly narrow and inconsistent with the '167 Patent specification.

B. PO's extrinsic evidence on "image capture device" is unnecessary and conflicts with the intrinsic evidence.

As explained above, intrinsic evidence mandates that "image capture device" means any device that can capture an image (e.g., an alphanumeric character, and printed object and symbol). PO's reliance on extrinsic evidence to construe the term is thus unnecessary. Moreover, PO's extrinsic evidence directly contradicts the intrinsic evidence and should be excluded for this reason also.

First, PO uses Exhibits 2024-2026 to limit "image capture device" to include only barcode readers. POR, 11-13, 19-20 (discussing Exhibits 2024-2026 and stating "practitioners in the field at the time of the '167 Patent understood that imaging-based bar code readers and laser-based scanning barcode readers were different classes of devices and referred to a 'captured image' solely in connection with image-based readers. Ex. 2024, 1:19-2:9; Ex. 2025, 3:4-49; Ex. 2026, 1:19-47; Ex. 2029, ¶63."). As explained above, the intrinsic evidence alone supplies the meaning of "image capture device" and does not limit the image to a "barcode," nor does it limit "image capture devices" to imaging-based bar code readers. PO's extrinsic evidence is thus unnecessary and should be excluded under FRE 403.

Second, paragraphs 44-63, 66-67, 69-76, 88, and 101-102 of Dr. Berisso's Declaration (Exhibit 2029) discuss Exhibits 2024-2026, further contradicting the intrinsic evidence on the meaning of "image capture device" and should be excluded under FRE 403. The Declaration attempts to narrow "image capture

devices” to only those devices that use a camera. For example, the Declaration states, “[i]n contrast to a barcode laser scanner . . . image capture devices use a camera.” It also incorrectly alleges that practitioners referred to “image capture” and “captured image” solely in connection with image-based readers. Ex. 2029, ¶¶ 44-63, 66-67, 69-76, 88, and 101-102. As discussed above, this interpretation directly contradicts the intrinsic evidence and Dr. Berisso’s own testimony regarding the intrinsic evidence:

Q. And you would agree, then that *a laser barcode scanner can scan an image, such as a UPC barcode, as the term ‘image’ is used in the challenged patent*, wouldn’t you?

A. Yes.

Ex. 1048, 163:25-164:4 (emphasis added). Dr. Berisso went on to state, unprompted, that a laser-based barcode scanner “captures” a barcode image:

A. (Dr. Berisso) so the laser can specifically scan the printed paper version.

Q. And *the printed paper version is the image*, right?

A. The image that has been *captured*, yes.

Id., 163:1-6 (emphasis added). The intrinsic evidence, which is supported by PO’s testimony, supports that an “image capture device” is any device that can capture an image. PO’s extrinsic evidence is unnecessary and improperly conflicts with the intrinsic evidence. For this reason, Exhibits 2024-2026 and

Ex. 2029, ¶¶ 44-63, 66-67, 69-76, 88, and 101-102, should be excluded under FRE 403.

III. Extrinsic evidence on “the image having information embedded therein” should be excluded under FRE 403.

Claims 1, 19, 23, 39, and 43 recite “the image having information embedded therein.” Ex. 1001, Claims 1, 19, 23, 29, 43. PO again improperly cites extrinsic evidence (portions of Exhibit 2029) to narrowly construe the term to exclude alphanumeric characters. POR, 30-32; POSR, 14-15. The plain and ordinary meaning of “the image having information embedded therein” is again clear from the intrinsic evidence: the term includes any information derived from an image,² and as explained below, such information could include alphanumeric characters. PO’s extrinsic evidence is again unnecessary, conflicts with the intrinsic evidence, and should be excluded under FRE 403.

A. “the image having information embedded therein” includes any information derived from the image.

The intrinsic evidence is clear: “the image having information embedded therein” could include human readable alphanumeric characters. As explained in the Reply to POR, the ’167 Patent provides several examples of alphanumeric

² The Institution Decision determined this definition was consistent with the ’167 Patent. Paper 10, 13.

characters in images that can contain embedded information. Ex. 1001, 7:55-59 (“[T]he image . . . may include a unique number, nonce, a transaction number or a random number, a number that the secure device 100 will use to derive the authentication code.”). In view of the foregoing, PO’s proposed construction of “the image having information embedded therein” as excluding human readable alphanumeric characters is unduly narrow and inconsistent with the ’167 Patent specification.

B. PO’s extrinsic evidence on “the image having information embedded therein” is unnecessary and conflicts with the intrinsic evidence.

As explained above, the intrinsic evidence supports “the image having information embedded therein” as including human readable alphanumeric characters. PO improperly uses portions of Exhibit 2029 (paragraphs 77-79, and 90) to limit the term, improperly contradicting the intrinsic evidence.

For example, PO argues, citing Exhibit 2029, that a POSA would have understood that human readable text is not ‘embedded’ information. POR, 31-32, 39. PO asserts its interpretation “is consistent with the specification of the ‘167 Patent, which never uses the term ‘embedded’ to refer to human readable text.” *Id.*, 31. First, this allegation is incorrect because the patent expressly states that the image containing embedded information may in fact include numeric characters. Ex. 1001, 7:55-59. Thus, the intrinsic evidence supports that the embedded

information may contain human readable text. Further, the '167 Patent contemplates the image containing “a number that the secure device³ 100 will use to derive the authentication code.” *Id.*, 7:55-59. Thus, the intrinsic evidence expressly references human readable alphanumeric characters (e.g., numbers) from information embedded in the image.

Moreover, PO's expert agreed that “a numeric message could include embedded information, such as the message that is intended for the recipient” Ex. 1048, 72:21-23, 25. In the context of UPC barcodes specifically, Dr. Berisso acknowledged that alphanumeric characters can contain embedded product information:

Q. And isn't it also true, then, that the numbers at the bottom of what is shown in Exhibit 1046 [(a UPC Barcode)] also contain product information?

A. Again, indirectly, yes.

Id., 214:8-11. As stated in the '167 Patent, and as agreed to by Dr. Berisso's testimony, the term “embedded” does not exclude human readable alphanumeric characters. PO's extrinsic evidence used to construe “the image having information embedded therein,” as excluding alphanumeric characters is thus unnecessary and

³ The “secure device” includes the “image capture device.” Ex. 1001, 5: 9-10.

improper since it conflicts with the intrinsic evidence. For this reason, Exhibit 2029, paragraphs 77-79 and 90, should be excluded under FRE 403.

IV. Conclusion

PO improperly uses extrinsic evidence to construe claim terms “image capture device” and “the image having information embedded therein.” POR, 26-32; POSR, 1-5. PO’s extrinsic evidence is unnecessary and improper since the intrinsic evidence alone provides the meaning of the terms, and the extrinsic evidence contradicts the intrinsic evidence. Accordingly, PO’s extrinsic evidence, Exhibits 2024-2026 and Exhibit 2029, ¶¶ 44-63, 66-67, 69-76, 77-79, 88, 90, and 101-102, should be excluded as lacking probative value, confusing the issues, and misleading to the Board under FRE 403.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of
PETITIONER'S MOTION TO EXCLUDE EVIDENCE PURSUANT TO 37
C.F.R. § 42.64(c) (Paper 26) has been served by email upon the following:

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