

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 REPLY IN SUPPORT OF THE
MOTION TO EXCLUDE EVIDENCE**

I. Introduction

As the proponent of Exhibits 2024-2026 and 2029, Patent Owner (“PO”) bears the burden to prove admissibility. Fed. R. Evid. (“FRE”) 104(a); *Sci. Applications Int’l Corp. v. U.S.*, 175 Fed. Cl. 389, 396. PO failed to meet that burden and cannot meet it now.

PO characterizes its extrinsic evidence as supporting how a person of ordinary skill in the art would have understood the claim terms “image capture device” and “the image having information embedded therein.” PO’s Opposition to Motion to Exclude (“Opp.”), Paper 27, 1-2. As fully briefed, however, PO fails to recognize that the ’167 Patent provides the plain and ordinary meaning of these claim terms. PO’s use of extrinsic evidence when intrinsic evidence informs the meaning of the claim terms is impermissible. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996). Moreover, as explained in the MTE and further below, PO’s extrinsic evidence contradicts the intrinsic evidence which is precluded by Federal Circuit precedent. MTE, Paper 26, 3-9; *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).

PO’s use of extrinsic evidence to supplant the intrinsic evidence on the meaning of the claim terms should be excluded under FRE 403 because it lacks

probative value, confuses the claim construction issues, and is misleading the Board.¹

II. Exhibits 2024-2026 and 2029 (¶¶ 44-63, 66-67, 69-76, 88, and 101-102) conflict with the plain and ordinary meaning of “image capture device” and should be excluded.

As stated in the MTE, the plain and ordinary meaning of the term “image capture device” is any device that can capture an image. MTE, 3-7. PO’s extrinsic evidence is impermissible because the ’167 Patent informs the meaning of the claim term, and the extrinsic evidence contradicts the intrinsic evidence.

PO pedantically details its extrinsic evidence in its Opposition, but ultimately, PO uses the extrinsic evidence in an attempt to deviate from the plain and ordinary meaning of “image capture device” and instead narrowly construe the term to cover only imaging-based bar code readers and not to laser-based barcode scanners. Opp., 3-8; PO’s Response (“POR”), Paper 16, 19.

¹ PO argues “[t]he Motion does not contest that the evidence in question is relevant (i.e., has probative value).” Opp., 1. In fact, the MTE states exactly that on page 1: “Accordingly, the extrinsic evidence should be excluded as lacking probative value, confusing the issues, and misleading to the Board under FRE 403.” MTE, 1.

The '167 is unmistakable: a printed barcode *is one type (not the only type)* of “image.” *Id.*, 10:29-25. Further, the image capture device *may* include a digital camera² “*or other types of image capture devices.*” Ex. 1001, 5:21-22 (emphasis added). PO argues its construction is correct because the '167 Patent never mentions laser scanners. Opp., 8. The Federal Circuit precedent on this point makes clear that silence of a particular embodiment “does not rise to the level of either lexicography or disavowal” required for PO’s narrow interpretation. *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1367 (Fed. Cir. 2012).

Accordingly, PO’s use of Exhibits 2024-2026 and 2029 (§§ 44-63, 66-67, 69-76, 88, and 101-102) conflicts with the intrinsic evidence and is impermissible under Federal Circuit precedent. The extrinsic evidence thus lacks probative value, confuses the claim construction issues, and is misleading the Board, and thus should be excluded under FRE 403.

² PO claims it “never contended that a digital camera is the only type of image capture device,” but PO’s position is clear: “[i]n contrast to a barcode laser scanner . . . bar code image capture devices use a camera” POR, 10, 15; Opp., 9.

III. Exhibit 2029 (§§ 77-79 and 90) conflict with the plain and ordinary meaning of “the image having information embedded therein” and should be excluded.

As stated in the MTE, the plain and ordinary meaning of the term “the image having information embedded therein” is any information derived from an image, including alphanumeric characters. MTE, 7-10. PO’s extrinsic evidence is impermissible because the ’167 Patent informs the meaning of the claim term, and the extrinsic evidence again contradicts the intrinsic evidence.

PO uses Exhibit 2029 (§§ 77-79 and 90) to support its incorrect and unduly narrow construction that “the image having information embedded therein” excludes human-readable text. POR, 31-32, 39. The ’167 is clear: alphanumeric characters in images may contain embedded information. Ex. 1001, 7:55-59 (“[T]he image . . . may include a unique number, nonce,³ a transaction number or a random number, a number that the secure device 100 will use to derive the authentication code.”). PO does not, and cannot, point to a “clear and unmistakable” disclaimer in the ’167 Patent to support its narrow construction. *Thorner*, 669 F.3d at 1367 (Fed. Cir. 2012).

³ PO argues “the nonce would have been presented as a barcode” but does not specify how the other number types listed would have been a barcode. Opp., 12.

In view of the foregoing, PO's use of Exhibit 2029 (§§ 77-79 and 90) conflicts with the intrinsic evidence and is not permitted under Federal Circuit precedent. The extrinsic evidence lacks probative value, confuses the claim construction issues, and is misleading the Board, and thus should be excluded under FRE 403.

IV. Conclusion

PO impermissibly uses extrinsic evidence to construe claim terms "image capture device" and "the image having information embedded therein." POR, 26-32; POSR, 1-5. Accordingly, PO's extrinsic evidence, Exhibits 2024-2026 and 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. Petitioner respectfully requests that the Board grant the Motion to Exclude.

Dated: November 6, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below a copy of **PETITIONER’S REPLY IN SUPPORT OF THE MOTION TO EXCLUDE EVIDENCE** (Paper 29), **PETITIONER’S UPDATED EXHIBIT LIST** (Paper 20), and **Exhibit 1049** have been served by email upon the following:

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