

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.

Case No. IPR2024-01221
U.S. Patent No. 7,314,167

Patent Owner Demonstratives

Independent Claims of the '167 Patent

1. An apparatus for providing a secure transaction, the apparatus comprising:

an **image capture device** configured **to capture an image, the image** having **information embedded therein** including information relating to a transaction;

a memory configured to store predetermined information;

an input unit configured to receive input information provided by a user;

a processor configured to:

verify the user based on the input information to ensure that the user is authorized to use the apparatus; and

generate an output based on the **information embedded in the image** and the predetermined information; and

an output unit configured to forward the output generated by the processor,

wherein the output includes a digital signature to be used to signify authorization by the user with respect to the transaction.

19. An apparatus for providing a secure transaction, the apparatus comprising:

an image capture device configured **to capture an image, the image** having **information embedded therein**;

a memory configured to store predetermined location;

an input unit configured to receive input information provided by a user; a processor configured to:

verify the user based on the input information to ensure that the user is authorized to use the apparatus; and

generate an output based on the **information embedded in the image** and the predetermined information; and

an output unit configured to forward the output generated by the processor,

wherein the output unit includes control logic configured to forward the output using a message delivery protocol.

23. A method of providing secure transaction, the method comprising:

configuring a portable device to:

capture an image, the image having **information embedded therein, the information embedded** in the image including information relating to a transaction;

store predetermined information;

receive input information provided by a user;

verify the user based on the input information to ensure that the user is authorized to use the portable device;

generate an output based on **the information embedded in the image** and the predetermined information; and forward the generated output to the user,

wherein the output includes a digital signature to be used to signify authorization by the user with respect to the transaction.

Claim Term: “image capture device configured to capture an image”

Patent Owner Position

Accordingly, a person of ordinary skill at the time of the ‘167 Patent reading the claims in light of the specification would have understood the recitation in claims 1 and 19 of an “*image capture device configured to capture an image*” in combination with a processor configured to “generate an output *based on the information embedded in the image*,” to be referring to an *imaging-based bar code reader* and not a *laser-based barcode scanner*. Ex. 2029, ¶76. Similarly, a person of ordinary skill at the time of the ‘167 Patent reading the claims in light of the specification would have understood the recitation in claims 23, 29 and 43 of “configuring a portable device to ... *capture an image*” and “generate an output based on the information embedded in the [*captured*] image” to be referring to an *imaging-based bar code reader* and not a *laser-based barcode scanner*. *Id.*

POR, 29

Petitioner’s Position

160:13-16, 161:18-25. Thus, the term “image capture device,” as used in the ‘167 patent, is any device that can capture that image, i.e., can capture the printed object or symbol. Importantly, both imaging-based barcode scanners *and* laser-based barcode scanners can capture a printed object or symbol, e.g., a printed barcode, thus rendering Patent Owner’s proposed construction unduly narrow and inconsistent with the ‘167 patent specification.

Reply, 7

As explained in the Petition, the ‘167 patent does not define an “image capture device,” but indicates that an image capture device may include digital cameras “or other types of image capturing devices” that are used to capture images. Pet., 15; Ex. 1001, 5:8-11. Thus, consistent with the ‘167 patent specification, the plain and ordinary meaning of the term “image capture device” refers to “any device that can capture an image,” which includes both imaging-based and laser-based barcode scanners. ID, 21-22 (previously rejecting Patent Owner’s narrow construction); Pet., 15; Ex. 1048, 163:1-6.

Reply, 8

Claim Term: “information embedded in the image”

Patent Owner Position

Unlike a barcode where information is embedded into the bars and spaces of a barcode, human readable text in the form of unencrypted human readable alphanumeric characters is not embedded into (or incorporated into) something else. Ex. 2029, ¶79. Accordingly, a person of ordinary skill at the time of the ‘167 Patent reading the claims in light of the specification would have understood that human readable text in the form of unencrypted human readable alphanumeric characters is not “embedded” information. *Id.*

Petitioner’s Position

As noted above, and as supported by Dr. Berisso’s testimony, the plain and ordinary meaning of “embedded” does not exclude human readable alphanumeric characters. Consequently, Patent Owner’s construction of “the image having information embedded therein,” as excluding alphanumeric characters is incorrect. Instead, “the image having information embedded therein” should be construed as any information “derived from” an image, whether contained in a barcode, in alphanumeric characters, or in some other type of image. *See* ID, 15.

Claim Term: “information embedded in the image”

Patent Owner Position

The understanding of a person of ordinary skill in the art at the time of the ‘167 Patent that human readable text is not “embedded” information is consistent with the specification of the ‘167 Patent, which never uses the term “embedded” to refer to human readable text. Patent Owner’s position is also consistent with the dictionary definition of “embedded,” which defines something as being “embedded” when it is “*incorporated into something else* as an essential characteristic.” Ex. 2027, 1 and *see also* Ex. 2028, 1 (defining “embedded” as functioning *as part of a larger device* rather than as an independent unit or system”); Ex. 2029, ¶78. In this respect, Mr. Purvis’s opinion that “embedded” information includes information *contained in any barcode* is in keeping with dictionary definition which defines something (e.g., information) as being “embedded” when it is “*incorporated into something else*” (e.g., a barcode). Ex. 1036, ¶8 (emphasis added); Ex. 2029, ¶78.

POR, 31

Thus, in all of the Petition’s mappings in Grounds 1-3, the Petition mapped the “*information embedded in the image*” *solely* to *information in barcodes* in Wang.

Petitioner’s Position

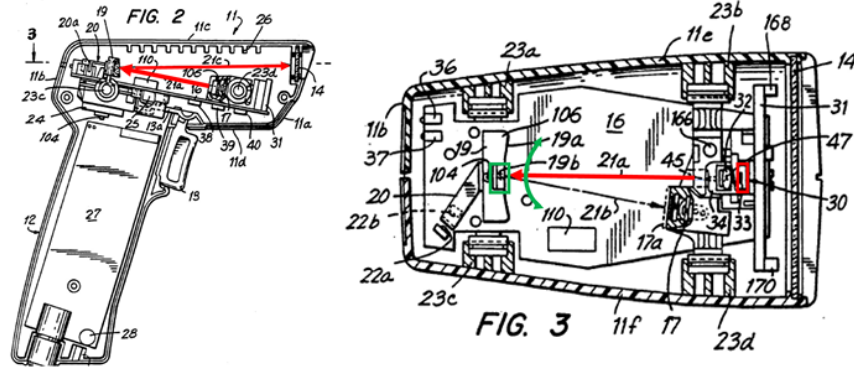
[1f] generate an output based on the information embedded in the image and the predetermined information; and

Wang describes that the PEAD can generate “transaction approval data” (an output) in response to the user agreeing to a transaction. [0075]-[0083], [0115].

The output is based on information embedded in the image:

To approve and complete a transaction, the price of the item being purchased is required. [0115]. The price of the item is generated based on barcode data (information embedded in an image): “The cellular phone would display the price of the item the user entered (or scanned in). If the user agrees to pay for the item, the user can approve the transaction by pressing the button on the phone.” *Id.* Such approval, which is based on the embedded barcode image information, results in the generation of “transaction approval data.” [0076], [0115] (stating that “the approval process...is described in [related] U.S. Pat. 5,917,913,”¹⁰ which describes the generation of “transaction approval data” in response to approval of a transaction). *Id.* Thus, the transaction approval data (output) is based on price information embedded in a barcode image. EX1002 at 78.

What is a barcode scanner?

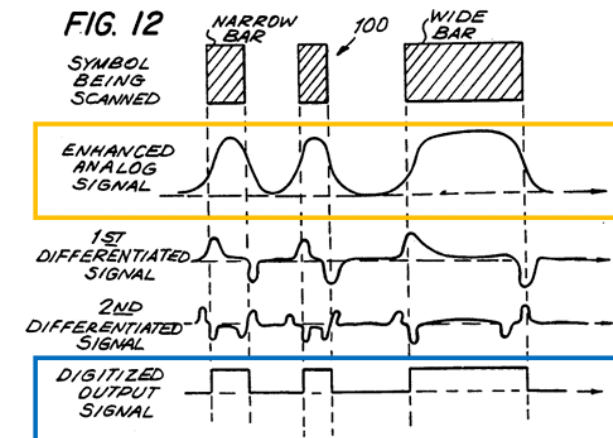
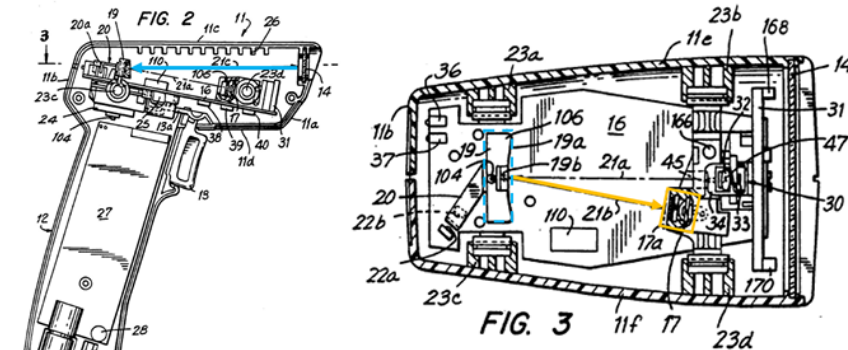


Ex. 2021, Figures 2 and 3 (annotations added). The laser beam emanating from the laser light source 33 (red box above) is initially directed toward a scanning mirror (green box above). A high-speed motor causes the mirror to oscillate about an arc such that that the scanning mirror sweeps the laser beam reflected by the mirror through (and exiting window 14) an angular arc of about 30° (corresponding to the green arc above) at a rate of about 20 scans or 40 oscillations per second. *Id.*, 8:63-9:14. Ex. 2029, ¶42. The swept laser beam exits the laser scanner through the window 14, and is visible on the barcode being scanned, as shown below:



POR, 6

Laser light hitting the barcode symbol reflects off the symbol as a specular component in one direction and as a scattered component in many directions. Ex. 2021, 8:6-10. The portion of the scattered laser light which returns along the optical path corresponding to the blue arrow (below) impinges upon a spherical collecting mirror (blue box below), which directs the returning light along the path corresponding to the orange arrow to a photosensor (orange box below). *Id.*, 9:15-27; Ex. 2029, ¶43.



POR, 7

What is an image capture device?

Optical readers tend to fall into one of three *classes*: wand readers, *laser scan engine optical readers* and *image sensor based optical readers*. ...

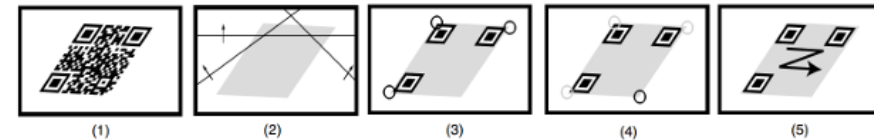
Laser scan engine based optical readers comprise a laser diode assembly generating a laser light beam, a moving mirror for sweeping the laser light beam across a decodable symbol and a signal is generated corresponding to the decodable symbol.

Image sensor based optical readers comprise multielement image sensors such as CID, CCD, and CMOS image sensors and an imaging optic for focusing an image onto the image sensor. ... Image sensor based optical readers are more durable and offer additional features relative to laser scan engine based bar code readers. One function which has been incorporated into image sensor based optical readers is a picture taking function. Optical readers have been developed which can both take pictures and decode decodable symbols represented in *captured image* data. Ex. 2026, 1:19-47.

Again, in contrast to a barcode laser scanner which simply sweeps a laser beam across a one-dimensional barcode and analyzes the intensity of the returned light, image capture devices use a camera to first capture a pixel image containing the code (e.g., a QR code) and subsequently apply image processing to identify the location of QR code within the image and step along pixels in the image representing the cells of the code to determine the information stored in the code. Ex. 2029, ¶56.

POR, 15-16

A typical image capture device for reading QR codes begins by using a camera to capture a two-dimensional pixel image (which may be skewed) that includes an image of the QR code. Ex. 2023, 3. The input image (leftmost image, below) is then processed in the five steps illustrated below so that the decoder can correctly process the potentially skewed image:



POR, 13

POR, 15

Wang's Barcode Scanner is not an "image capture device" configured to capture an image

Wang at [0115] fails to expressly or inherently disclose an *imaging-based* barcode reader. While Wang at [0115] discloses a barcode scanner, Wang is wholly silent as to the type or class of barcode scanner used for scanning the barcode. Ex. 2029, ¶89. Thus, Wang does not expressly disclose an *imaging-based* barcode reader. Nor is an imaging-based barcode reader inherent in Wang, as Wang's barcode scanner could have been implemented with a barcode laser scanner (which is not an imaging-based barcode reader.) *Id.* Simply put, since there is no requirement in Wang that its barcode reader *must* be an imaging-based barcode reader, an imaging-based barcode reader is not inherently disclosed in Wang. *Id.*

POR, 38

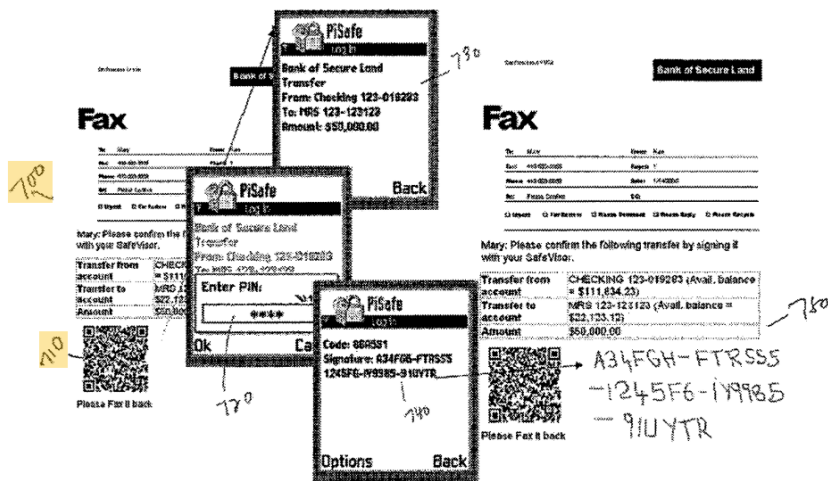


FIG. 7

Q. What is an image-capture device"

A. A device that uses electronics generally to capture an image, capture a picture.

* * *

Q. Okay. And what sorts of devices can read two-dimensional barcodes?

A. For two-dimensional, you are limited to the imager-type scanners because you have to have that vertical component and a -- the term used in the -- in the report was a flying laser, a flying spot.

It's a laser scanner, it is not able to capture the information that a 2D matrix symbol has because it's not -- it's not designed that way.

Q. Okay.

A. It just doesn't work.

Q. So is it your testimony that it is impossible to use a laser scanner to read a two-dimensional barcode

Attorney Golub: Objection Form.

A. Yes.

Q. Impossible?

A. Yes.

Sur-Reply, 3-4

"DEMONSTRATIVE EXHIBIT - NOT EVIDENCE"

Wang's OCR Reader is not an "image capture device configured to capture an image, the image having information embedded therein"



POR, 33

Wang discloses two readers: a barcode scanner and an optical character recognition (OCR) reader. Of those two readers, the only one *even capable* of extracting embedded information from a barcode is Wang's *barcode scanner*. As Patent Owner's expert testified, an *OCR scanner* is *incapable of recognizing a barcode*:

Q. Could you use an OCR scanner to interpret this barcode?

ATTORNEY GOLUB: Objection.

THE WITNESS: No.

BY ATTORNEY KRIEGER:

Q. Why not?

A. An OCR scanner is a task-specific device that is looking for characters to optically recognize. It would look at this picture, say there are no characters there, and so nothing would happen.

EX1048, 169:20-170:5 (emphasis added). Since Wang's OCR scanner is incapable of reading a barcode, the Petition's mappings in Grounds 1-3 specifying that the "information embedded in the image" be information extracted from a barcode are left with attempting to map Wang's *barcode reader* to the "image capture device" recited in the challenged claims. At this point, however, the mappings in the Petition fall apart, because Wang *fails* to expressly or inherently disclose that its barcode reader is an *imaging-based* barcode reader, as required by the challenged independent claims.³ Thus, in Ground 1-3, the mappings in the Petition fail to demonstrate that all of the limitations of the challenged independent claims are met.

Sur-Reply, 7-8

The Petition Alleges that Wang's barcode information is "information embedded in the image"

[1f] generate an output based on the information embedded in the image and the predetermined information; and	Wang describes digitally signed "receipts" as outputs, which are based on image information (data from barcodes) and predetermined information (private key). Ex. 1002 at 62-63. After "agree[ing] to pay for the item, the user can approve the transaction by pressing the button on the phone...." The device then generates a digitally signed receipt as an output: "[T]he PEAD can generate the receipt...." [0115]. The digitally signed receipt is based on information embedded in an image (barcode information): "[T]he PEAD can generate the receipt...by querying the item price using the barcode as the index for price lookup table...." <i>Id.</i>; Ex. 1002 at 78. The digitally signed receipt is also based on the predetermined information (private key): "[T]he PEAD user can sign the receipt electronically using PEAD...." [0115]. "[T]he PEAD may be employed to 'sign' any computer file for authentication purposes" and indicates that authentication is based on encryption "using the user's private key." [0085]. Thus, the private key (predetermined information) is utilized to digitally sign the receipt. Ex. 1002 at 79-81.
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Petition, 46

Claim 23	Wang (Ex. 1004)
[23f] generate an output based on the information embedded in the image and the predetermined information; and	Wang describes digitally signed "receipts" as outputs, which are based on image information (data from barcodes) and predetermined information (private key). Ex. 1002 at 94. After "agree[ing] to pay for the item, the user can approve the transaction by pressing the button on the phone...." The device then generates a digitally signed receipt as an output: "[T]he PEAD can generate the receipt...." [0115]. The digitally signed receipt is based on information embedded in an image (barcode information): "[T]he PEAD can generate the receipt...by querying the item price using the barcode as the index for price lookup table...." <i>Id.</i> Ex. 1002 at 78. The digitally signed receipt is also based on the predetermined information (private key): "[T]he PEAD user can sign the receipt electronically using PEAD...." [0115]. "[T]he PEAD may be employed to 'sign' any computer file for authentication purposes" and indicates that authentication is based on encryption "using the user's private key." [0085]. Thus, the private key (predetermined information) is utilized to digitally sign the receipt. Ex. 1002 at 79-81.

Petition, 40

Wang discloses that a barcode may be used to store information useable as

an index to lookup an item price. Ex. 1004 at [0115]. Denso discloses that it was well known to use barcodes and multi-dimensional barcodes interchangeably to serve as an information code. Ex. 1026 at [0013]. The use of a two-dimensional barcode in place of a standard barcode would enable more data to be encoded within the same space, as the use of two-dimensions increases the data density of the image. The additional data capacity would not only support a greater amount of data, but would also support additional types of data, such as uniform resource locators (URLs), binary codes, and structured data. Multi-dimensional barcodes provide other benefits over standard barcodes, such as supporting error-correction that enables the multi-dimensional barcode to be read even if a portion of the barcode is stained or missing and the ability to be read at various angles. For at least these reasons, a POSA would be motivated to modify Wang to use a multi-dimensional barcode as the barcode as taught by Denso. Ex. 1002 at 134-135.

Petition, 55-56

Petitioner Never Alleges In the Petition that Human Readable Text is the “information embedded in the image”

“In an [inter partes review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.”

Harmonic Inc. v. Avid Tech., Inc., 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)

(requiring inter partes review petitions to identify

“with particularity . . . the evidence that supports the grounds for the challenge to each claim”))

(emphasis added). This burden never shifts to

Patent Owner. See *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to each claim.”

Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc., 853 F.3d 1272, 1286 (Fed. Cir. 2017)

“[W]e find no support for the PTO’s position that the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.”) *Ire Magnum Oil Tools*, 829 F.3d at 1381

Petitioner's New Argument renders ““embedded”” superfluous

The expansive reading in the Reply of “embedded information” as “any information ‘derived from’ an image” including human-readable alphanumeric characters, renders the claim term “embedded” a nullity. Under Petitioner’s construction, it is as if the claim read “the image having information therein” as opposed to what the claim actually says, which is “the image having information embedded therein.” Put another way, the claim language dictates that simply having an image with information in it is insufficient: rather, the claim language requires having an image with “embedded information” therein. Ascribing no meaning to “embedded” violates the basic tenet of claim construction that all terms have meaning.

Sur-Reply, 11

In attempting to expand the concept of “embedded information” to human-readable alphanumeric characters, the Petition argues for the first time in the Reply that the plain and ordinary meaning of “embedded” is “any information ‘derived from’ an image.” Reply, 12 (emphasis added). In addition to completely lacking support in the record or otherwise, this new construction fails to ascribe any meaning to “embedded.” The new construction simply requires that information come from the image, which is no different from simply saying that the image has information in it. Lacking from Petitioner’s new construction is the attribution of any meaning to the term “embedded.”

Sur-Reply, 11

1. An apparatus for providing a secure transaction, the apparatus comprising:

an **image capture device** configured **to capture an image, the image** having **information [] therein** including information relating to a transaction;

a memory configured to store predetermined information;

an input unit configured to receive input information provided by a user;

a processor configured to:

verify the user based on the input information to ensure that the user is authorized to use the apparatus; and

generate an output based on the **information [] in the image** and the predetermined information; and

an output unit configured to forward the output generated by the processor,

wherein the output includes a digital signature to be used to signify authorization by the user with respect to the transaction.

“information embedded in the image” is not Human Readable Text

Citing the deposition of Patent Owner’s expert, the Reply incorrectly suggests that Patent Owner’s expert conceded that “embedded information” in the context of the ‘167 Patent includes numeric information. Reply, at 9, *citing*, EX1048, at 72:21-23 and 25. The Reply fails to mention that the cited testimony was not about the ‘167 Patent, but rather “ring decoders you might get from a Cracker Jack box.” Below is the testimony in context:

Q. Okay. Are you familiar -- I’m probably dating myself here. But are you familiar with, like -- it was actually probably before my time -- like, ring decoders you might get from a Cracker Jack box?

ATTORNEY GOLUB: Objection.

THE WITNESS: Unfortunately.

BY ATTORNEY KRIEGER:

Q. Okay. And how does that work?

A. The concept of a ring decoder is that you have a message that’s been transposed, and you use the decoder ring by twisting it to get back to the original message.

Q. Okay. So, for example, a number might correspond to a letter. Is that fair to say?

A. Yes.

Q. Okay.

A. It’s a substitution system.

Q. It’s a substitution system where you’re substituting something for a letter, correct?

A. Correct.

Q. Okay. In order to form a coded message, correct?

25 A. Correct.

Sur-Reply, 14

For all of the reasons set forth above, the expansive reading in the Reply of “embedded information” as “any information ‘derived from’ an image” including human-readable alphanumeric characters should be rejected.

Sur-Reply, 15

Citing to a different portion of the deposition of Patent Owner’s expert, the Reply incorrectly alleges that Patent Owner’s expert “acknowledged that alphanumeric characters can contain embedded product information.” Reply, at 10 (emphasis added), *quoting*, EX1048, at 214:8-11. The quoted testimony, however, refers only to information in general -- and makes no mention of embedded information as recited in the challenged claims. Below is the quoted testimony:

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.

This testimony does not refer to the term “embedded,” and therefore cannot be an acknowledgement “that alphanumeric characters can contain embedded product information,” as alleged in the Reply.

Sur-Reply, 15

TAO and PTM's Barcode Scanner are not an "image capture device configured to capture an image"

Point-of-sale Software for the Palm Computing Platform

Are you selling products at trade shows or expos? Taking orders from customers in their home or office? Submitting bids or issuing quotations in a field situation? Delivering product and need to issue a receipt? For all these situations and more, **Take An Order!** is the handheld tool you need. Combined with any Palm Computing platform handheld device including barcode scanning SPT units from Symbol Technologies and a portable printer like the Canon BJC-55 or Brother MPrint, **Take An Order!** gives you an office that travels with you.

* * *

If you're equipped with a Symbol SPT PalmOS handheld with its built-in barcode scanner, it's even easier! Just point the scanner at the product, press the scan button, and the item is added to the order!

Ex. 1005, at 1-2 (red underlining added). The SPT units from Symbol Technologies identified in TAO are barcode laser scanners. See, e.g., Ex. 2009, Symbol SPT 1800 Series Product Reference Guide, at 109 ("The SPT 1800 has an integrated bar code laser scanner"); Ex. 2010, Symbol SPT 1700 Series Product Reference Guide, at 108 ("The SPT 1800 has an integrated bar code laser scanner"); Ex. 2029, ¶83.

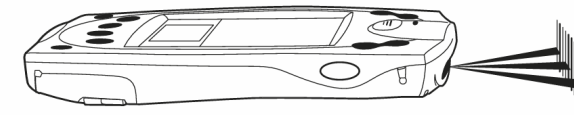
Scanning with the SPT 1800

The SPT 1800 has an integrated laser bar code scanner which, if your unit is configured to use scanning input, allows you to collect data by scanning bar codes. The SPT 1800 decodes the following bar code types:

- UPC-A/UPC-E/UPC-E1
- EAN-8/EAN-13
- Bookland EAN
- Code 128
- UCC/EAN-128
- ISBT 128
- Code 39
- Trioptic Code 39
- Code 93
- I 2 of 5
- D 2 of 5
- Codabar
- MSI Plessey.

To scan bar codes with the SPT 1800:

1. Start your scanning application.
2. Aim the scanner at the bar code.
3. Press either the right, left or center scan trigger. Make sure the red scan beam covers the entire bar code. The green scan LED lights and a beep sounds to indicate a successful decode.



POR, 35

EX2009, 109

EX 1010 - Internet Archive Declaration (July 16, 2024) - is not a basis for any of the grounds in the petition

Ground	35 U.S.C.	Claims	Basis
I	§§ 102/103	1, 4, 5, 7, 12, 17, 23, 26, 27, 29, 34, 43	Anticipated by Wang. Obvious over Wang in view of Drummond
II	§ 102	1, 2, 4, 7, 12, 13, 17	Anticipated by Wang

Ground	35 U.S.C.	Claims	Basis
III	§ 103	19-21, 39-41	Obvious over Wang in view of Drummond
IV	§ 103	8, 30	Obvious over Wang in view of Denso
V	§ 103	13	Obvious over Wang in view of Raines
VI	§ 103	1, 4, 5, 7, 23, 26, 27, 29, 43	Obvious over TAO in view of PTM and Wang.

Petition, 29-30

Ground VI Is Limited to EX1005, EX1006 and EX1004

Independent Claim 1	
Claim 1 [Preamble 1] 1. An apparatus for providing a secure transaction, the apparatus comprising:	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) “the handheld tool ” is an apparatus. Ex. 1005 at 1. “ Taking orders from customers... ” is a transaction. <i>Id.</i> “Our software runs on...PalmOS...and is licensed for use on handheld devices made by palmOne (including the Treo...) .” <i>Id.</i> at 3. The Treo “[r]equires a password to see any data...” indicating that it is secure . Ex. 1006 at 24, 129.

Claim 1	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) Wang discloses an apparatus for providing a secure transaction. “portable electronic authorization devices (PEADs) which eliminate the security risks associated with... approving transactions... ” Ex. 1004 at [0002].
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Claim 1	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) Wang discloses an apparatus for providing a secure transaction. “portable electronic authorization devices (PEADs) which eliminate the security risks associated with... approving transactions... ” Ex. 1004 at [0002].
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Claim 1	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) “[r]equires a password to see any data...” Ex. 1006 at 24, 129; Ex. 1002 at 148. A password is “input information.”
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Claim 1 [1h] the output includes a digital signature to be used to signify authorization by the user with respect to the transaction.	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) “As a further example, the PEAD may be employed to sign any computer file for authentication purposes (e.g., to authenticate the date or the user).” Ex. 1004 at [0085]. A POSA would understand from TAO in view of Wang that the order of TAO may include a digital signature, as described in Wang, to provide verification that the order was created by an authorized user. Ex. 1002 at 150-156.
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Dependent Claim 4	
Claim 4 Element 4	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) “use on handheld devices made by palmOne (including the Treo” Ex. 1005 at 3. “Requires a password to see any data...” Ex. 1006 at 129. “require the user to enter a password, to furnish fingerprints or a voice print, or other biometrics” Ex. 1004 at [0073]. Ex. 1002 at 163.

Dependent Claim 5	
Claim 5 5. The apparatus of claim 1 wherein the output unit is a display.	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) “the day’s sales are summarized and displayed and/or printed.” Ex. 1005 at 2-3. The day’s sales (e.g., orders) is an output that is presented on a display. Ex. 1002 at 164.

Claim 7 7. The apparatus of claim 1 wherein the image includes a barcode.	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) “ barcode-scanning capability... a PalmOS handheld equipped with a barcode scanner ”. Ex. 1005 at 3. “point the scanner at the product, press the scan button, and the item is added to the order!” <i>Id.</i> at 1; Ex. 1002 at 165.
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Claim 23 23. A method of providing secure transaction, the method comprising:	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) See Ground 6, Element 1 preamble. TAO discloses a method for providing a secure transaction. Ex. 1002 at 166.
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Claim 23 [23h] wherein the output includes a digital signature to be used to signify authorization by the user with respect to the transaction.	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) See Ground 6, Element 1h. <i>See also</i> Ex. 1002 at 150-156.
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Dependent Claim 26	
Claim 26 26. The method of claim 23 wherein the input information includes one of a personal identification number and biometric information.	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) See Ground 6, Claim 4 analysis. <i>See also</i> Ex. 1002 at 169.

Dependent Claim 27	
Claim 27 27. The method of claim 23 further comprising: configuring the portable device to display the output.	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) See Ground 6, Claim 5 analysis. To display the order as taught by TAO, the device must be configured to do so. Ex. 1002 at 170.

Dependent Claim 29	
Claim 29 29. The method of claim 23 wherein the image includes a barcode.	TAO (Ex. 1005), PTM (Ex. 1006), and Wang (Ex. 1004) See Ground 6, Claim 7 analysis. <i>See also</i> Ex. 1002 at 171.

Independent Claim 43	
Claim 43 Preamble 43 Elements 43a-g Element 43h	TAO (Ex. 1005), PTM (Ex. 1006) and Wang (Ex. 1004) See Ground 6, Preamble 23 analysis. See Ground 6, Elements 23a-g analysis. “ software runs on...handheld devices made by palmOne (including the Treo...) .” Ex. 1005 at 1-2. The Palm Treo is a cellular phone. Ex. 1006 at 1; Ex. 1002 at 172.

Sur-Reply, 17-20

Thus, the question presented in this Trial is limited to the contours of the Petition and specifically, with respect to Ground VI, whether TAO as defined by EX1005 (together with the other references relied on in Ground VI) meet all of the limitations of the challenged claims.

Sur-Reply, 22

The Petition never even mentions pages 5-6 of EX1010.

As an initial matter, the Petition never even mentions pages 5-6 of EX1010. The Petition cites to EX1010 only four times (once on page 6 and three times on page 26). All four citations refer to pages of EX1010 other than pages 5-6 - not one of the citations even references pages 5-6 of EX1010. The statement in the Reply (at 19, note 9) that the new theory based on pages 5-6 of EX1010 “was presented in the Petition” and “appears to have been overlooked by Patent Owner” strains credulity. Patent Owner could not have overlooked Petitioner’s new theory, because it was not in the Petition.

Sur-Reply, 23

Second, the TAO reference (defined as EX1005) as presented in the Petition was a pdf document with no working hyperlinks. The pdf fails to include any http code evidencing a hyperlink to pages 5-6 of EX1010. Nor do any of the Internet Archive Declarations make that connection. In fact, TAO (EX1005) is the subject of one Internet Archive Declaration (EX1034) and pages 5-6 of EX1010 are the subject of a different Internet Archive Declaration (EX1010). Absent is any testimony in these declarations that clicking on a so-called hyperlink in EX1034 would have brought a user to pages 5-6 of EX1010. In fact, these two Internet Archive Declarations do not even mention each other.⁵ Simply put, there is no evidence that clicking on a hyperlink in TAO (EX1005) would have brought a user to pages 5-6 of EX1010. The assertion in the Reply that clicking on a hyperlink in TAO (EX1005) would have brought a user to pages 5-6 of EX1010 is limited to attorney argument, which is insufficient to carry Petitioner’s burden which requires a preponderance of evidence supporting Petitioner’s position.

Sur-Reply, 24

Steven's Creek Software website shown in EX1005 and 1010 are different.

Finally, there is a significant discrepancy between the webpages of Steven's Creek Software shown in Exhibit 1034 and the webpages shown in EX1010 that further undermines Petitioner's position. The Reply alleges that clicking on "here" in the red box on the page below would have taken a user to pages 5-6 of EX1010:

Want to learn more about PalmOS handhelds?

Our software runs on the Palm operating system (PalmOS). PalmOS is developed by [PalmSource](#), and is licensed for use on handheld devices made by [palmOne](#) (including the Treo, Zire, and Tungsten lines), Handspring (now part of palmOne), Sony, Symbol (some models), Kyocera, Samsung, and others. A complete, current list of licensees, with links to their respective websites, can be found [here](#).

Take An Order! is enhanced to take advantage of barcode-scanning capability, which means that if you have a PalmOS handheld equipped with a barcode scanner, the software will operate even more efficiently (although it definitely works without barcode scanning on "normal" PalmOS handhelds). There are a variety of options for barcode scanning using PalmOS handhelds; you can read all about them [here](#).

Sur-Reply, 24-25

Reply, at 18, citing EX1005, at 3. However, the corresponding pages from the Steven's Creek Software website shown in EX1005 and 1010 are different. On the left (below) is the portion of TAO (EX1005) with the alleged hyperlink (red box) to pages 5-6 of EX1010, while on the right (below) is the corresponding portion of the webpage from EX1010. Significantly, the portion of the webpages entitled "Want to learn more about PalmOS devices" (blue box on left, green box on right) are materially different.

TAO (Ex. 1005, 3)

More Information...

Want to learn more about Take An Order!?

We've tried to keep this page simple, but the complete manual for **Take An Order!** is part of the download when you download the software (see below). Even if you don't have a Palm, there are plenty of screen shots, so you can see everything the software can do, and how easy it is to use.

Want to try Take An Order! yourself?

You can download **Take An Order!** and put it through its paces without a Serial Number (password). There are some limitations (you can only select from the first ten items in your product catalog, and your receipts will have on them a notice that your copy of the software is unlicensed), but you'll be able to fully evaluate what **Take An Order!** can do for you and your business. [Download now.](#)

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Who we are...

Ex. 1010, 35

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Want to learn more about PalmOS handhelds?

Take An Order! runs on the Palm operating system, which is used on handheld devices made by Palm, Handspring, Sony, Symbol (some models), Kyocera, Samsung, and others. To learn more about the PalmOS and the wide variety of Palm Powered devices, visit the [PalmSource website](#).

Want to learn more about barcode scanning options for the Palm?

Many people aren't clear on what is necessary to do barcode scanning on a Palm. [Read all about it.](#)

Who we are...

Sur-Reply, 225

Conclusion

Grounds I-V Fail for the following reasons:

- *Wang's Barcode Scanner is not inherently or expressly an "image capture device configured to capture an image"
- Wang's OCR Reader is not an "image capture device configured to capture an image, the image having information embedded therein"
- Petitioner Never Alleges In the Petition that Human Readable Text is the "information embedded in the image"
- Petitioner's New Argument renders ""embedded" superfluous

Ground VI Fails for the following reasons:

- TAO and PTM's Barcode Scanner are not an "image capture device configured to capture an image"
- EX 1010 - Internet Archive Declaration (July 16, 2024)- is not a basis for any of the grounds in the petition