

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

DH INTERNATIONAL LTD.,
Patent Owner.

Case IPR2024-01321
Patent No. 7,628,333

**PETITIONER'S PRE-INSTITUTION REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

The Board authorized Petitioner to file a five-page reply to Patent Owner's Preliminary Response (POPR) addressing Patent Owner's allegations of "procedural errors" and its constructions of "activation cue." Patent Owner's alleged errors mischaracterize Petitioner's reliance on the cited references and should be rejected. And Patent Owner's unduly narrow constructions are inconsistent with the express disclosures of the '333 Patent (Ex. 1001) and should be rejected.

I. Petitioner's Reliance on *Shogase* and *Fare* is Proper to Show How a Person of Ordinary Skill Would Have Understood the Asserted References

Patent Owner incorrectly faults the Petition for "attempt[ing] to improperly expand" prior art teachings by "present[ing] additional references that are not part of the asserted grounds." POPR, 8. However, Petitioner properly relies on the additional references—*Shogase* and *Fare*—to inform how a person of ordinary skill would have understood the teachings of asserted references *Hoff* and *Ong*, respectively. See *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015) (references outside an obviousness combination "can legitimately serve to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness"); *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1372–73 (Fed. Cir. 2019) (affirming Board's finding that the petitioner properly relied on an additional reference to demonstrate how a person of ordinary skill would have understood teachings in an asserted reference).

For example, *Hoff*'s card expressly includes a keyboard and display typical of “very smart card[s]” at the time. *Hoff*, 10:9–13. *Hoff* also explains that these cards are protected by a PIN. *Id.*, 5:4–7. Petitioner relies on *Shogase* to show how one of ordinary skill would have understood these components to function in entering the PIN. Petition, 24, 44, 69. *Hoff* itself relies on *Shogase* for the same purpose. *Hoff*, 4:6–14, 10:9–13; *see also* POPR, 5 (Patent Owner admitting that “*Hoff* does mention *Shogase*”).

Similarly, *Ong* discloses a “transmitter receiver” for communicating with a transaction terminal. *Ong*, 3:63–67, 4:30–34. Petitioner relies on *Fare* to show that a person of ordinary skill would have understood this type of disclosed component to be a “communication port”—the same term used in the '333 Patent. Petition, 58; *see Realtime Data*, 912 F.3d at 1372–73 (“HP relied on Nelson merely to explain that O'Brien's encoder is a type of dictionary encoder.”).

Because Petitioner does not assert *Shogase* or *Fare* in combination with any other reference, no motivation to combine is required. *Realtime Data*, 912 F.3d at 1373 (“We conclude that, in this case, the Board was not required to make any finding regarding a motivation to combine given its reliance on O'Brien alone.”).

For these reasons, Petitioner's reliance on *Shogase* and *Fare* is proper and Patent Owner's arguments to the contrary should be rejected.

II. Patent Owner's Improper Narrowing of "Activation Cue" is Unsupported by the Intrinsic Record

Patent Owner advances multiple constructions for the term "activation cue." Patent Owner first asserts in its section heading that "'activation cue' should be construed as a [sic] 'a *unique* indicator.'" POPR, 12 (emphasis added). This construction shifts in the following sentence, which proposes the term "means a *predetermined* indicator." *Id.* Patent Owner then introduces an intent requirement, contending that "the activation cue *must be intended as* a predetermined indicator." *Id.* Patent Owner also appears to suggest that the activation cue cannot serve any additional function, arguing that it is "not a message or signal recognized as a message or signal for other action." *Id.* These constructions are not supported by the intrinsic record.

Regarding uniqueness, the '333 Patent never uses the term "unique" or otherwise suggests that uniqueness is required. *See generally* Ex. 1001. Instead, the '333 Patent discloses that the "activation cue" is "a data communication of a specific type which will be recognized by electronic device 10 as an activation cue." Ex. 1001, 5:67–6:3. A data communication would not need to be "unique" to be recognized in this way. In addition to conflicting with the patent specification, Patent Owner offers no support for this construction, mentioning it only in a heading. POPR, 12.

To support its “predetermined indicator” construction, Patent Owner cites only one portion of the ’333 Patent, which states that an activation cue may “for example” be a “predetermined bit sequence.” POPR, 12 (citing Ex. 1001, 6:1–3). However, the claims and specification only require the activation cue to be a data communication of a type recognizable as the activation cue. Ex. 1001, 5:67–6:3, claims 1, 10, 11. The predetermined bit sequence—an “example” of this data communication (*id.*, 6:2–3)—is not imported to the claims without a clear intent by the patentee, which is absent here. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc). Patent Owner’s further argument that the activation cue is “not a message or signal recognized as a message or signal for other action” is incorrect; all that the specification requires is that it be a data communication of a type recognizable as a cue.

The specification is also silent regarding any requirement for the activation cue to be “intended as” a predetermined indicator. POPR, 12. As long as it is recognized by the electronic device as an activation cue, it meets the test provided in the patent specification. Ex. 1001, 5:67–6:3. Mr. Zaheer’s declaration—Patent Owner’s only cited support for its intent requirement—does not discuss intent and cites the same three-line passage from the specification discussed above. Ex. 2001, ¶¶49–52. Patent Owner’s overly narrow constructions are not supported and should be rejected.

Contrary to Patent Owner's assertions, Petitioner did not "waive[] its right to make new claim construction arguments." POPR, 12. In *Microsoft v. Uniloc*, cited by the Patent Owner for this proposition, the Board accepted the petitioner's responsive claim construction arguments where they addressed a dispute raised by the patent owner. IPR2019-01188, Paper 27 at *19 (P.T.A.B. Nov. 4, 2020). Indeed, Patent Owner's quotation omits the preceding clause, which states "[t]he petitioner may respond to any . . . new claim construction issues raised by the patent owner." *Id.* Here, Petitioner addresses Patent Owner's unreasonable interpretation and maintains that the term's plain meaning is clear in view of the intrinsic record.

III. Conclusion

For these reasons and those advanced in the Petition, Patent Owner's arguments should be rejected and trial instituted.

Dated: January 17, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response** was served electronically via email on January 17, 2025, in its entirety on the following:

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Patent Owner has consented to service by email.

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