

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,

Petitioner,

v.

DH INTERNATIONAL LTD.,

Patent Owner.

PTAB Case No. IPR2024-01321

Patent No. 7,628,333

**PATENT OWNER'S PRE-INSTITUTION SUR-REPLY TO PETITIONER'S
PRE-INSTITUTION REPLY**

On January 10, 2025, the Board authorized Petitioner's filing of a five-page Reply to Patent Owner's Preliminary Response (POPR) and Patent Owner's filing of a five-page Sur-Reply addressing (1) the Patent Owner's allegations of "procedural errors;" and (2) the construction of an "activation cue." The Board admonished the parties not to introduce new evidence into the record or raise new arguments that go beyond the issues authorized.

I. PETITIONER'S RELIANCE ON SHOGASE AND FARE IS IMPROPER

Patent Owner identified the Petition's procedural errors in using the *Shogase* and *Fare* references directly in Petitioner's argument. *See* POPR, 5-6. Petitioner improperly attempted to reframe its improper use of these references as only showing what a person of skill in the art (POSITA) would know at the time of the invention. In support of its position, Petitioner cited/mis-cited two appellate cases.

Ariosa Diagnostics v. Verinata Health, Inc., 805 F.3d 1359, 1365 (Fed. Cir. 2015) states the introduction of additional references beyond the IPR obviousness ground combination "can legitimately serve to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness." *Id.* at 1365. However, what Petitioner left out was the reference at issue in *Ariosa* was how the references were invoked: "[a]rt can legitimately serve to document the knowledge that skilled artisans would bring to bear in reading the

prior art identified as producing obviousness ... Ariosa's Petitions and opening declarations invoked Exhibit 1010 in that way." *Id.* at 1365. A reference used for showing what a person of skill in the art knows must be used in that way. Thus, it was up to the Petitioner to articulate precisely which prior art references it was relying upon to show knowledge of a POSITA.

In the "Technology Overview" section of the Petition, the Petitioner demonstrated that it knew how to invoke another reference, *McCrindle* (Ex. 1009), not used in any of their obviousness grounds for the purpose of knowledge of skilled artisan. See Pet. 3. However, Petitioner did not include the *Shogase* (Exh. 1011) or *Fare* (Exh. 1012) in the Petition's "Technology Overview." When *Shogase* was cited in the Petition, it was explicitly cited for establishing additional functionality of a "keyboard" and not for what a POSITA would know. See Petition 24, 69. *Shogase*, as cited in the Petition is used to show the element of "entry of a PIN" with no mention of a POSITA. See, Petition 44. Further, *Shogase* is the only reference cited teaching the claim element "[w]hile entering a PIN, the display would be used for displaying operations associated with the PIN entry." *Id.*

In the very next sentence, Petitioner goes on to explain what a POSITA would know and not what *Shogase* shows a POSITA would know. These two sentences establish that Petitioner was not using *Shogase* to establish knowledge of a POSITA.

Instead, *Shogase* is used by Petitioner to directly describe claim elements, not for the knowledge of a POSITA. Similarly, the use of *Fare* by Partitioner is not for establishing what a POSITA would know. *Fare* is used in the argument of the Petition for “describing a “wireless communication port for communicating with a self-service transaction terminal.” Pet. 58. The single cite to *Fare* is between cites to *Ong* where all cites are directed to claim elements.

There are no indications in the Petition that *Shogase* or *Fare* are invoked to establish knowledge of a POSITA as was used by the courts in the case in *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015). Further, in *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1372-73 (Fed. Cir. 2019), the Petitioner erroneously states the Board’s finding. The Court found “in this case, the Board was not required to make any finding regarding a motivation to combine given its reliance on O’Brian alone.” *Id.* at 1373. There is no issue of any cited reference that is not part of a ground found in this opinion.¹

¹ Patent Owner wonders if Petitioner failed to understand (1) the cited case; or (2) Petitioner failed to understand that “dictionary” in that case was not a document, but a software structure.

Patent Owner reiterates that the Petition is flawed due to its procedural errors, and Petitioner is improperly trying to cast their procedural errors in a new light.

II. “ACTIVATION CUE” CLAIM TERM

Petitioner did not provide any claim construction for “activation cue” in its Petition. However, it was foreseeable that the term “activation cue” would be construed because it is a key element in the claims. Instead, Petitioner alleged that Patent Owner provided a construction that was unforeseen in their email to the Board in order to get permission to improperly make new arguments defining “activation cue.” *See* POPR, 12-13.

The Petitioner raises an issue with the term “unique” which only appears in Patent Owner’s heading in the POPR. Nowhere in the Patent Owner’s POPR argument does the term “unique” appear, nor does it appear in the patent. Petitioner admits that Patent Owner cites one example in the ’333 patent identifying an “activation cue” as a predetermined bit sequence. (Petitioner Reply, 4). However, the Petitioner erroneously states that cite was the only cite to specification, failing to note that the predetermined bit sequence is “recognized by the electronic device as an activation cue.” Ex. 1001, 6:1-3; POPR 12.

Patent Owner’s proposed construction is “[t]he activation cue must be intended as a predetermined indicator and not a message or signal recognized as a

message or signal for other action.” *See* Exh. 2001, ¶¶49-52.” *See* POPR, 12-13.

The construction is based on the specification language.

The construction provided by the Patent Owner in the POPR, does not have the term “unique” and Petitioner’s arguments are pointless because Patent Owner’s construction is based upon only intrinsic evidence found in the specification and not the term “unique.”

III. CONCLUSION

For these reasons and those asserted in the Patent Owner’s Preliminary Response (POPR), the Board should deny the Petition in view of the procedural errors in the Petition, deny the Petitioner’s claim construction, and adopt the Patent Owner’s construction of “activation cue” in view of no construction provided by Petitioner in their Petition.

Dated: January 24, 2025

Respectfully Submitted

By: /Robert Hart/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies Patent Owner DH International Ltd. served this PATENT OWNER'S PRE-INSTITUTION SUR-REPLY on the counsel of record for Petitioner Google LLC by filing this document through the P-TACTS, as well as delivering a copy via electronic mail to the following:

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Date: January 24, 2024

By: /s/ Robert Hart/

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