

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADOBE INC.,
Petitioner,

v.

JONATHAN E. JAFFE,
Patent Owner.

IPR2024-01352
Patent 6,757,828 B1

Before TINA E. HULSE, STEVEN M. AMUNDSON, and
BACH V. HOANG, *Administrative Patent Judges*.

HOANG, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

On August 28, 2024, Adobe Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–6 (i.e., all claims) of U.S. Patent No. 6,757,828 B1 (Ex. 1001, “the ’828 Patent”). Paper 2 (“Pet.”). Jonathan E. Jaffe (“Patent Owner”) timely filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2024).

Having reviewed the parties’ papers and the evidence of record, we are not persuaded to discretionarily deny institution, and we determine that Petitioner has shown a reasonable likelihood it will prevail in establishing the unpatentability of at least one challenged claim.

A. *Real Parties in Interest*

Petitioner identifies itself as the real party in interest. Pet. x. Patent Owner identifies itself as the real party in interest. Paper 6, 1.

B. *Related Matters*

The parties indicate that the ’828 Patent has been asserted in a district court lawsuit: *Jonathan E. Jaffe v. Adobe Inc.*, Case No. 2:23-cv-06224 (C.D. Cal.) (the “District Court proceeding”). Pet. x; Paper 6, 1.

C. *Asserted References*

Petitioner’s unpatentability challenges rely on five references:

- Glass et al., US 6,332,193 B1, issued Dec. 18, 2001. Ex. 1005 (“Glass”).

- Bernd Rieger & Harry Rode, *Digital Image Recording for Court-Related Purposes* (IEEE 1999). Ex. 1006 (“Rieger”).
- Japan Electronic Industry Development Association, *Digital Still Camera Image File Format Standard (Exchangeable Image File Format for Digital Still Cameras: Exif) Version 2.0* (JEIDA Nov. 1997). Ex. 1008 (“Exif 2.0”).
- Japan Electronic Industry Development Association, *Digital Still Camera Image File Format Standard (Exchangeable Image File Format for Digital Still Cameras: Exif) Version 2.1* (JEIDA June 1998). Ex. 1009 (“Exif 2.1”).
- Serret-Avila, US 6,959,384 B1, issued Oct. 25, 2005. Ex. 1011 (“Serret-Avila”).

D. Testimonial Evidence

Petitioner submits declarations from Dr. Zixiang Xiong (Ex. 1003), Rachel J. Watters (Ex. 1007), and Kenneth Parulski (Ex. 1010).

E. The Petition’s Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 1):

Claims Challenged	35 U.S.C. ¹ §	Reference(s)/Basis²
1–6	103(a)	Glass

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of § 103.

² Petitioner appears to incorporate alternative references using slashes (‘/’) or “or.” *See, e.g.*, Pet. 1 (“Glass and Exif 2.0 or Exif 2.1”), 62 (“the

Claims Challenged	35 U.S.C. ¹ §	Reference(s)/Basis ²
1–6	103(a)	Rieger
1–6	103(a)	Glass, Exif 2.0
1–6	103(a)	Glass, Exif 2.1
1–6	103(a)	Rieger, Exif 2.1
1–6	103(a)	Rieger, Exif 2.1
1–6	103(a)	Glass, Serret-Avila
1–6	103(a)	Rieger, Serret-Avila
1–6	103(a)	Glass, Exif 2.0, Serret-Avila
1–6	103(a)	Glass, Exif 2.1, Serret-Avila
1–6	103(a)	Rieger, Exif 2.0, Serret-Avila
1–6	103(a)	Rieger, Exif 2.1, Serret-Avila

F. The '828 Patent (Ex. 1001)

The '828 Patent describes techniques and devices to capture and create a digital photograph or image having an associated digital signature that is used to verify that the image is unaltered, i.e., authentic. Ex. 1001, 1:8–19, 1:52–62, 2:59–64. Figure 2A, reproduced in relevant part below, shows a schematic diagram of a self-contained digital camera which captures and creates an image with such a digital signature. *Id.* at 2:15–17, 4:52–54.

combination of Glass with Exif 2.0/2.1 or Rieger with Exif 2.0/2.1”). We understand Petitioner’s use of alternative references to be separate grounds and reproduce Petitioner’s grounds accordingly in this table.

FIG. 2A

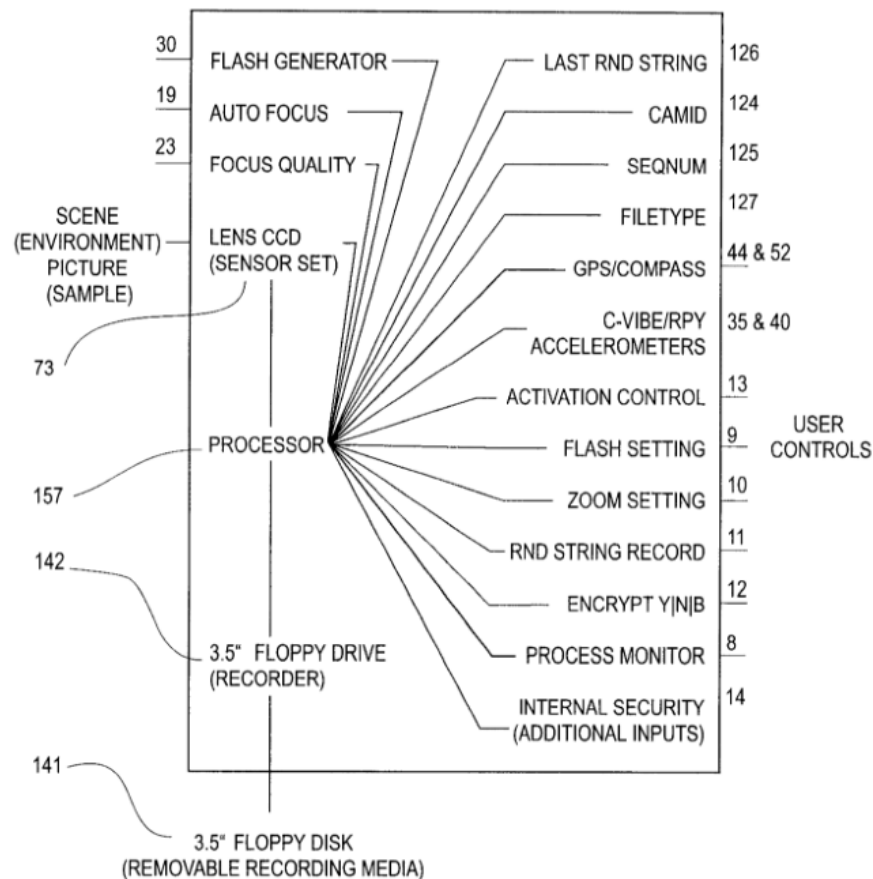


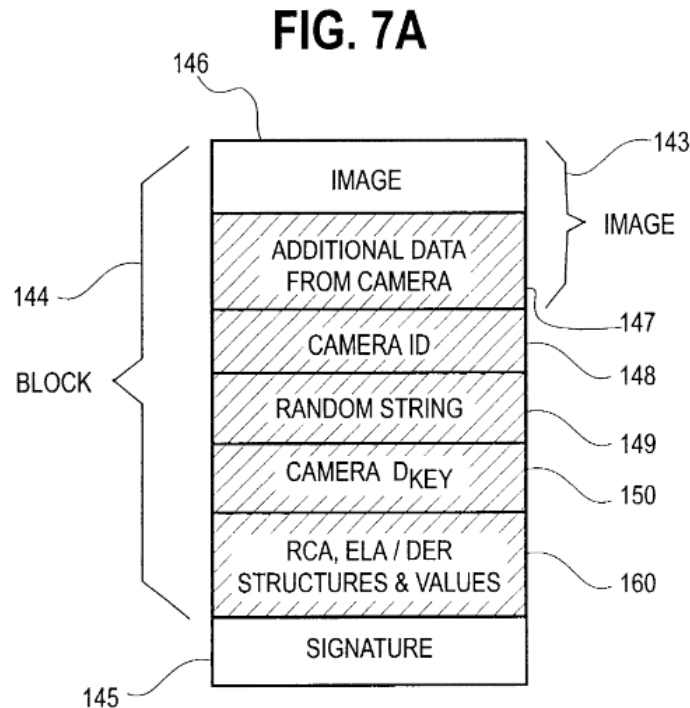
Figure 2A shows components within the self-contained digital camera including sensor set 73 (which captures an image), which is connected to processor 157 (which processes the captured image), which in turn is connected to recorder 142 (which stores the processed image). Ex. 1001, 4:52–61; *see id.* at 4:37–51, 5:1–7, 7:43–52, 8:12–14, Fig. 3. Additional components are connected to the processor and include camera identifier (CamID) 124, image sequence number 125, current random string 126, global positioning system (GPS) unit 44, and internal security system 14. *Id.* at 6:60–62; *see id.* at 4:45–51, 5:30–31.

The creation of an image having a digital signature for authentication starts with capturing an image using sensor set 73. *Id.* at 6:47–50; *see id.* Fig. 6. The captured image has information from the additional components

noted above appended to it, e.g., a camera identifier, a random string, and GPS values. *Id.* at 6:50–67, Fig. 6. The captured image also appends an indication that a security violation has occurred. *Id.*

A security violation occurs when there is a “breach of security” which compromises the internal security system. *Id.* at 5:44–49; *see id.* at Fig. 4A2. In particular, “[d]uring the operation of the camera, internal security 14 is monitored to detect the integrity of the tight coupling of the sensor set and the recorder 6.” *Id.* at 4:65–67. The ’828 Patent explains that “[a] key to verifiable authenticity is to [e]nsure that the authentication information generation is tightly coupled to the sensor set and recorder. There can be nothing that can possibly alter the recording before the authentication information is generated.” *Id.* at 3:16–20. But, “[i]f internal security is compromised 60 a security violation 61 [indicating the image is unverified] is appended 123 to the image.” *Id.* at 6:64–67, 8:45–49.

Next, a digital signature, used for subsequently authenticating the image, is created based on the captured image and its appended information. *Id.* at 7:27–35. Figure 7A, reproduced in relevant part below, is a diagram of a file format for a “signed digital image,” which includes the captured image, appended information, and a digital signature. *Id.* at 2:37–38.



The file structure of Figure 7A shows digital signature 145 and block 144; block 144 encompasses captured image 146 and its appended information 147–160. *Id.* at 8:1–58. Digital signature 145, “which is a function of the signature protocol (SP) being used and the block, is computed and made part of the file.” *Id.* at 7:27–30. That is, “[e]verything inside the ‘Block’ is what is signed.” *Id.* at 8:7–8. The file formed by block 144 and digital signature 145 may then be used to subsequently authenticate the image. *See id.* at 7:62–8:8.

Authentication is performed, e.g., on the file of Figure 7A, by separating block 144 from the original signature 145 and then recalculating a signature using the separated block. *Id.* at 9:13–15, 9:43–45. A mismatch between the recalculated signature and the original signature indicates that the image has been damaged or altered, and the image is not authenticated. *Id.* at 9:50–59; *see id.* Fig. 9. On the other hand, if the recalculated signature matches original signature 145, the image is marked as authenticated. *Id.* at 9:45–49; *see id.* Fig. 9.

G. Challenged Claims

Petitioner challenges claims 1–6 of the '828 Patent. Of these, claim 1 is independent. Claim 1 is reproduced below, incorporates changes from an August 17, 2021 Certificate of Correction, and includes Petitioner's bracketed annotations for discussion purposes:

1. [1pre] A method for authenticating a data stream stored in a data file in memory, said method comprising the steps of:

[1a] storing a data stream in a data file in a memory;

[1b] utilizing a sensor, which is tightly coupled to said memory, to generate at least one internal and unique parameter;

[1c] monitoring the integrity of the tight coupling between said memory and said sensor when said at least one internal and unique parameter is generated, and, if said integrity is compromised, then also providing an indication of said compromised integrity;

[1d] utilizing a signature protocol to generate a first signature based on said data stream and said at least one parameter, said first signature being generated without altering said data stream and being appended to said data file in said memory;

[1e] utilizing said signature protocol to generate a second signature based on said data stream;

[1f] comparing said first signature to said second signature,

[1g] if said first and second signatures are not the same, then generating an error signal that is displayed to a user to indicate that said stored data stream is not authentic, and

[1h] if said first and second signatures are the same, then generating an ok signal that is displayed to a user to indicate that said stored data stream is authentic.

Pet. 7–8; Ex. 1001, 20:59–21:18; *see id.* at 34 (Certificate of Correction).

II. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314

Patent Owner contends that we should exercise our discretion to deny the Petition in light of the status of the District Court proceeding. Prelim. Resp. 33–34. Petitioner contends we should not. Pet. 72–74.

The Board’s precedential decision in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”), sets forth six factors that we consider when determining whether to exercise our discretion to deny institution due to the state of a co-pending proceeding:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. at 6. In evaluating these factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*; see Trial Practice Guide³ 58 & n.2.

³ Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

In its Petition, Petitioner discusses all six *Fintiv* factors. *See* Pet. 72–74. Patent Owner responds by addressing factors 3, 5, and 6. Prelim. Resp. 33–34. We address all six *Fintiv* factors below.

A. Factor 1 – Whether a Stay Exists or Is Likely to Be Granted if a Proceeding Is Instituted

We have no evidence of record showing a stay has been issued or requested in the District Court proceeding. Petitioner asserts neither party has requested a stay in the District Court proceeding. Pet. 72. Patent Owner does not contest this. *See* Prelim. Resp. 33–34. We do not attempt to predict how the District Court will proceed. *Sand Revolution II, LLC v. Cont’l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 7 (PTAB June 16, 2020) (informative). We therefore determine this factor is neutral.

B. Factor 2 – Proximity of the Court’s Trial Date to the Board’s Projected Statutory Deadline

We have no evidence of record showing the District Court proceeding has set a trial date. Petitioner asserts trial has not been scheduled in the District Court proceeding. Pet. 72. Petitioner further asserts that the District Court has not issued a scheduling order setting a trial date or any post-claim-construction deadlines. *Id.* at 72–73. Although Patent Owner argues the median time-to-trial for the judicial district is 27.7 months and extrapolates that the District Court proceeding will be tried “near the end of 2025” (Prelim. Resp. 33–34), that estimate appears optimistic as the deadlines for fact and expert discovery have apparently not yet been scheduled. *See* Pet. 72–73; Prelim. Resp. 33–34. In fact, it appears the District Court proceeding has already extended the timeline in its proceeding, postponing its claim

construction hearing to August 6, 2024 from the original hearing date of July 16, 2024. *See* Ex. 2002, 3; Ex. 1020, 2. As the District Court has previously extended its schedule and there is no trial date scheduled, let alone a schedule for fact and expert discovery or motions practice, we determine this factor does not weigh in favor of denial.

C. Factor 3 – Investment in the Parallel Proceeding

Although the parties have invested some effort in the District Court proceeding, much work remains. Preliminary infringement contentions have been exchanged, but Petitioner asserts that final infringement and invalidity contentions have not been exchanged. Pet. 72–73; *see also* Prelim. Resp. 33. Although the parties have briefed and argued claim construction and the district court has issued a tentative claim construction, a final claim construction order remains to be issued. Pet. 72; Prelim. Resp. 33; Ex. 1020. Petitioner also asserts that, aside from minimal discovery focused solely on claim construction, “fact discovery has not begun, expert discovery is far in the future, and there is no scheduling order setting a trial date or any post-claim-construction deadlines.” Pet. 73. Patent Owner does not contest Petitioner’s characterization of the case schedule in its Preliminary Response. *See* Prelim. Resp. 33–34. Due to the relatively limited investment in the parallel proceeding to date, we find that this factor weighs only marginally, if at all, in favor of exercising discretion to deny institution. *See Sand Revolution*, Paper 24 at 11.

D. Factor 4 – Overlap Between Issues Raised in the Petition and in the Parallel Proceeding

Petitioner “stipulates that if the requested review is instituted, Petitioner will not pursue in the related litigation the grounds raised or that

could have been raised in this petition.” Pet. 73 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to Section II.A)). Petitioner’s stipulation here mitigates any concerns of duplicative efforts between the District Court proceeding and the Board, as well as concerns of potentially conflicting decisions. *Sotera Wireless*, Paper 12 at 19. Thus, we find that this factor weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).⁴

E. Factor 5 – Whether the Petitioner and the Defendant in the Parallel Proceeding are the Same Party

Petitioner and Patent Owner acknowledge the parties are the same in this *inter partes* review proceeding and in the District Court proceeding. Pet. 73; Prelim. Resp. 34.

Our precedent takes varying approaches on how to weigh the fifth *Fintiv* factor when the parties in the two proceedings are the same. In *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15 (PTAB Oct. 21, 2020) (precedential as to Section II.A), the panel held that “we regard the consideration of the fifth *Fintiv* factor as neutral or, at most, weighing slightly in favor of exercising discretion to deny institution,” given the fact that the related litigation had been stayed (the first *Fintiv* factor) and there was not substantial overlap between issues (the fourth *Fintiv* factor). *Id.* at

⁴ Petitioner asserts its “stipulation alone should preclude discretionary denial.” Pet. 73 (discussing *USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (June 21, 2022) at 3, 7). The guidance Petitioner relies upon has since been rescinded in a February 28, 2025 USPTO announcement.

16. In *Sotera Wireless*, the panel held that the fifth *Fintiv* factor “supports denying institution.” Paper 12 at 19.

Under these circumstances, the fifth *Fintiv* factor is either neutral or weighs slightly in favor of denying institution, but we need not decide which, because based on a holistic view of the factors, we would reach the same conclusion even if we were to weigh the fifth factor as favoring denial. *See infra* Section II.G.

F. Factor 6 – Other Circumstances that Impact the Board’s Exercise of Discretion, Including the Merits

Petitioner and Patent Owner respectively argue this factor weighs against or in favor of discretionary denial by broadly referencing their arguments on the merits of Petitioner’s challenges. *See* Pet. 72; Prelim. Resp. 34.

As we detail below, on this preliminary record, we determine Petitioner has set forth a reasonable likelihood that the sole independent claim of the ’828 Patent would have been obvious. As discussed below, Patent Owner argues various limitations are not taught by the cited references, but we find on this record that the references themselves contradict Patent Owner’s arguments or Patent Owner’s arguments do not fully address Petitioner’s evidence. Further, Patent Owner’s argument that Serret-Avila is non-analogous art also appears at this stage to be unsupported by disclosures in Serret-Avila. Thus, this factor is neutral or, at most, marginally weighs in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).

G. Conclusion

When considered together, the *Fintiv* factors do not favor the exercise of discretion to deny institution under 35 U.S.C. § 314(a). As discussed above, factor 4 weighs strongly in favor of not exercising discretion to deny. Remaining factors 1, 2, and 6 are neutral or marginally favor not exercising discretion to deny. Factors 3 and 5 at most marginally favor exercising discretion to deny. Weighing the favors holistically, and even giving factors 3 and 5 their marginal weight, the factors favoring discretionary denial do not outweigh the strength of the reasons not to discretionarily deny institution. Accordingly, we do not exercise discretion to deny institution under 35 U.S.C. § 314(a).

III. ANALYSIS

A. Legal Standards

“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”)). This burden of persuasion never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

The legal question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence,

objective evidence of nonobviousness.⁵ *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966). One seeking to establish obviousness based on more than one reference also must articulate sufficient reasoning with rational underpinnings to combine teachings. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

B. Level of Ordinary Skill in the Art

Petitioner asserts a person of ordinary skill in the art (“POSITA”) “would have [had] an undergraduate degree (or equivalent) in electrical engineering, computer science, or a comparable subject and at least two years of work experience involving image processing. Alternatively, such a person would have [had] an advanced degree and at least one year of post-graduate research/work experience involving image processing.” Pet. 8 (citing Ex. 1003 ¶ 82). Petitioner further asserts the POSITA would have been “familiar with the design and implementation of systems and devices involving image processing, including image authentication,” and would have been “familiar with authentication fundamentals, including encryption, hashing, and signature principles and techniques.” *Id.* (citing Ex. 1003 ¶ 82).

At this stage, Patent Owner does not address the level of ordinary skill in the art. *See Prelim. Resp.*

For purposes of this Decision, we adopt Petitioner’s proposed level of ordinary skill, as articulated above. We are satisfied that Petitioner’s proposed definition generally comports with the level of skill necessary to

⁵ The current record does not include allegations or evidence of objective indicia of nonobviousness.

understand and implement the teachings of the '828 Patent and the asserted prior art. *Cf. Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (noting that the prior art itself may reflect an appropriate level of skill in the art). This definition is also supported by the testimony of Dr. Xiong. *See* Ex. 1002 ¶¶ 81–83. We note, however, that the open-ended language “at least” expands the range of education and experience indefinitely with no upper bound. Therefore, we do not adopt this aspect of Petitioner’s formulation.

To the extent the level of ordinary skill in the art is in dispute or makes a material difference in the obviousness analysis, the parties should brief their respective positions in this regard during trial.

C. Claim Construction

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2024). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

Petitioner proposes claim constructions for three limitations recited in independent claim 1: “a sensor, which is tightly coupled to said memory”; “monitoring the integrity of the tight coupling between said memory and said sensor”; and “based on.” Pet. 9–14. Although Patent Owner disagrees with Petitioner’s claim constructions, Patent Owner asserts that we need not

address claim construction for the purposes of institution. *See* Prelim. Resp. 4–10.

We address the construction of “a sensor, which is tightly coupled to said memory.” During the trial, the parties should directly address any claim construction still in dispute.

1. “a sensor, which is tightly coupled to said memory”

Limitation [1b] recites, in relevant part, “a sensor, which is tightly coupled to said memory.” Ex. 1001, 20:62–63. Petitioner proposes we should construe the limitation to mean “a sensor coupled to said memory via conductive traces or leads.” Pet. 10. For purposes of this Decision, we adopt Petitioner’s proposed construction.

Petitioner’s construction is reasonably based on remarks made during prosecution of the ’828 Patent by Applicant in Applicant’s December 3, 2003 Amendment. Pet. 9–10 (citing Ex. 1002, 277). In that Amendment, Applicant stated

[e]xemplary structure or method steps corresponding to this claim feature is shown in Fig. 2A of the subject application, which illustrates a processor 157 which is “tightly coupled” to a memory. . . . Because the processor is “tightly coupled” to the memory, it will be virtually impossible for a user to supply false information to the memory by breaking the conductive trace or lead between the memory and the processor. This means, for example, that there is no possibility for altering the image before the authentication information is generated.

Ex. 1002, 277. In discussing the difficulty “to supply false information to the memory *by breaking the conductive trace or lead* between the memory and the processor” (*id.* (emphasis added)), Applicant implies that “tightly coupled” components are connected using a conductive trace or lead.

Petitioner notes that the Specification does not describe any particular means

for coupling components such that they are “tightly coupled.” Pet. 10 (citing Ex. 1003 ¶ 94). As such, Petitioner’s proposed construction is at least suggested by the intrinsic record, and we adopt it for the purposes of our decision on institution.

Although Patent Owner disagrees with Petitioner’s proposed construction and appears to suggest its own construction, Patent Owner only analyzes the claims under Petitioner’s proposed construction. Prelim. Resp. 5, 7 n.2, 13. As such, we do not offer an advisory opinion on Patent Owner’s suggested constructions at this stage in the proceeding because those suggestions are not material to our decision on institution. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” and “we need not construe [claim limitations] ‘where the construction is not ‘material to the [obviousness] dispute’” (alteration in original) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Accordingly, as Patent Owner argues patentability based on Petitioner’s construction, in order to reach our decision on institution, based on the current record, we preliminarily adopt Petitioner’s proposal that “a sensor, which is tightly coupled to said memory,” should be construed to mean “a sensor coupled to said memory via conductive traces or leads.” We apply that construction in our analysis of Petitioner’s challenges, below.⁶

⁶ During prosecution, Applicant’s March 16, 2004 Preliminary Amendment asserted “in accordance with the present invention, the claimed ‘tight coupling’ requires that the connections between the sensor and the memory

2. *Other Terms/Phrases*

Petitioner proposes we construe the portion of limitation [1c] reciting “monitoring the integrity of the tight coupling between said memory and said sensor” to mean “determining whether physical access has been gained to the coupling between said memory and said sensor.” Pet. 11 (citing Ex. 1003 ¶ 99). Petitioner also proposes we construe the phrase “based on,” as recited in limitations [1d] and [1e], “to be open-ended.” *Id.* at 11–12 (citing Ex. 1003 ¶ 102).

Patent Owner states that it disagrees with Petitioner’s proposed constructions, but offers no alternative constructions for these particular terms. *See* Prelim. Resp. 8–10. Instead, Patent Owner asserts that we need not resolve these constructions for the purposes of our decision on institution. *Id.* Indeed, Patent Owner’s discussion of Petitioner’s challenges are not contingent on Petitioner’s proposed constructions. *See id.* at 11–32.

At this stage, we determine that it is not necessary to address the construction of any of these other claim terms or phrases. *See Nidec Motor*, 868 F.3d at 1017; *Vivid Techs.*, 200 F.3d at 803. As discussed below, our analysis of Petitioner’s challenges does not depend on adopting Petitioner’s proposed constructions for these terms.

During the trial, the parties should directly address any claim construction adopted in this Decision if the party contends we should not adopt that construction in the final written decision. However, if Patent

not be physically accessible to a user.” Ex. 1002, 292. Should the construction of “tight coupling” continue to be an issue during trial, we invite the parties to address its construction in consideration of the intrinsic evidence in the manner asserted in the March 16, 2004 Preliminary Amendment.

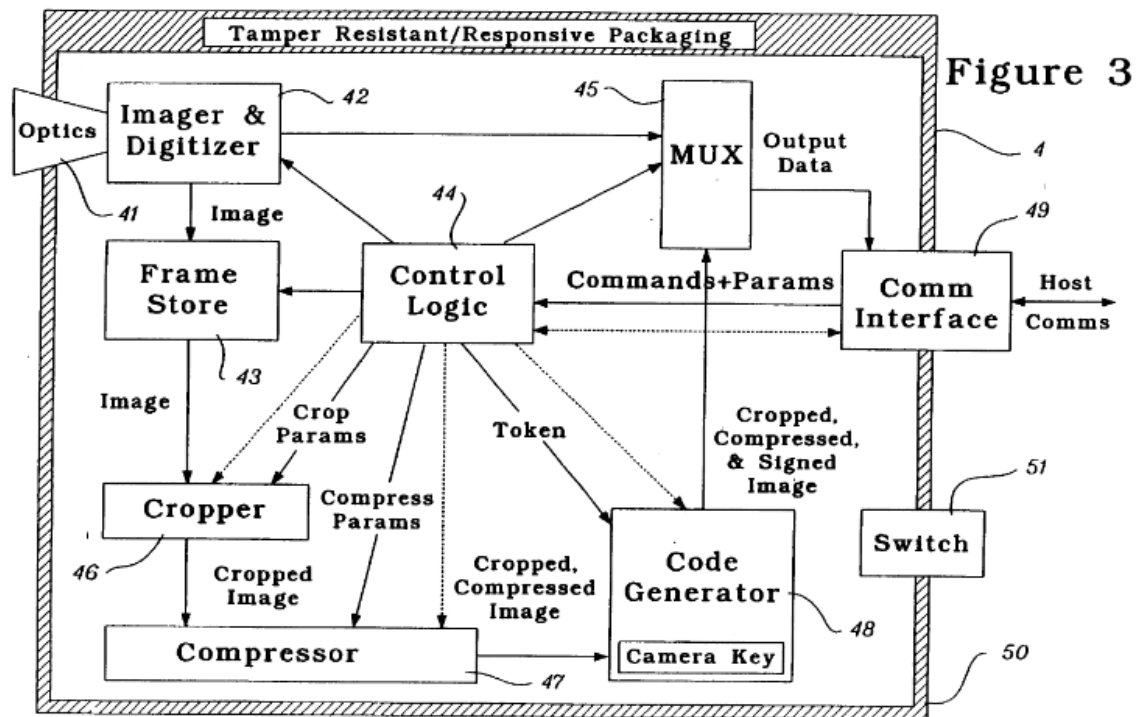
Owner believes the Petition is premised on an understanding of a claim term or phrase that is erroneous in a way material to this proceeding, then it should specifically identify the claim construction dispute, articulate its contrary understanding, and support its position with argument and evidence.

D. Summary of Asserted Prior Art References

Below we summarize the asserted references. We discuss any additional pertinent details of the references in our patentability analysis.

1. Glass (Ex. 1005)

Glass describes techniques to provide secure transmission and subsequent authentication of biometric data, e.g., image data. Ex. 1005, 3:45–53, 4:58–60. In one example, Glass describes an “imaging system” that uses a camera to collect biometric data. *Id.* at 4:54–60. The imaging system embeds information into the image such that the image can be subsequently authenticated. *Id.* at 4:60–5:3. Figure 3, reproduced below, is a functional block diagram of such an imaging system. *Id.* at 4:30–32.



As shown in Figure 3, tamper resistant package 50 encloses imaging system 4 which includes Image & Digitizer 42 connected to frame store memory 43 via a data path shown in a solid line. *Id.* at 5:13–22, 5:46–53. Image & Digitizer 42 creates a digital image that is stored in frame store memory 43. *Id.* at 5:49–55. Glass then applies a cryptographic technique to create a digital signature for the image data. *Id.* at 5:62–65. The digital signature is created using image data and a key which may be hidden in the imaging system. *Id.* at 5:67–6:3.

Further, according to Glass, tamper resistant package 50 enclosing imaging system 4 makes it “extremely difficult to access the internal elements of the package without detection.” *Id.* at 5:13–16. In one embodiment, an intrusion detector or switch 51 sends a signal that places the imaging system in a non-functioning state. *Id.* at 5:25–30. Glass explains that “tampering of image data prior to application of security information would be extraordinarily difficult or impossible.” *Id.* at 5:37–41.

Furthermore, Glass describes techniques where the previously generated digital signature and image are subsequently used to authenticate the image. *Id.* at 3:53–57, 4:65–5:7. In one embodiment, the system authenticating the image receives the image, the imaging system’s key, and the previously generated digital signature. *Id.* at 7:3–7, 9:35–40, 10:30–35. The authenticating system then recomputes a digital signature for the image. *Id.* at 9:40–47, 10:40–45. If the previously generated digital signature matches the recomputed digital signature, the image is authenticated. *Id.* at 9:57–51, 10:45–50. Glass also states that it “log[s] each step of the transaction.” *Id.* at 9:61–10:34, 10:54–58; *see id.* Fig. 8.

2. Rieger (Ex. 1006)

Rieger describes techniques to “ensure the integrity and authenticity of the images produced” by a digital camera. Ex. 1006, 3. Figure 3, reproduced below, shows a “basic conceptual diagram” of such a digital camera.

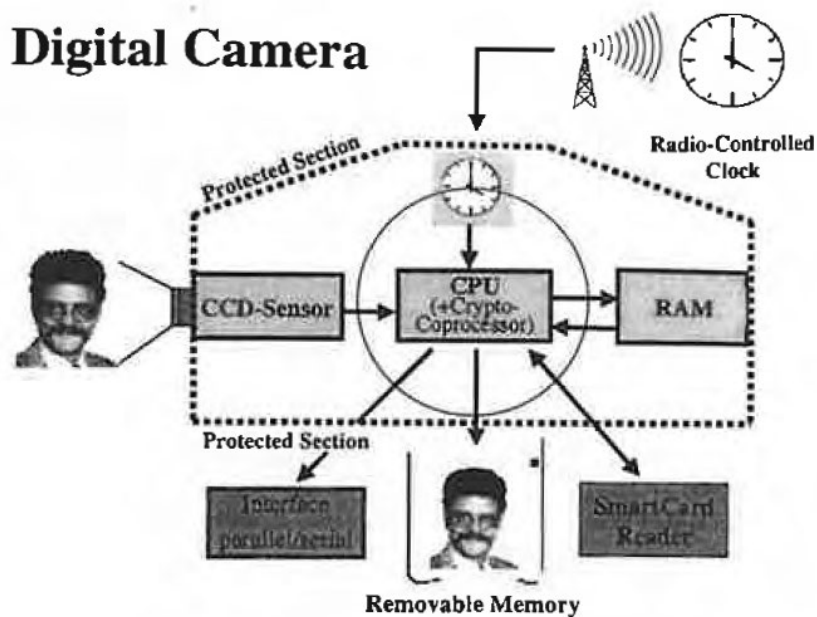


Figure 3 shows a digital camera having a “specially protected compartment in the camera housing” which encloses a CCD sensor, which is connected to a processor, which is connected to RAM. Ex. 1006, 4. Rieger explains the processor includes a signature chip with a secret key. *Id.* A verifiable image is created by hashing data to create a digital signature of the image. *Id.* at 3–4; *see id.* at 11.

Subsequently, a receiver of the image and associated signature can verify the integrity and authenticity of the image. *Id.* at 11–12. Verification is provided by re-hashing the image data. *Id.* If the resultant hash value matches the received digital signature, the integrity and authenticity of the image is verified. *Id.* at 12.

3. *Exif 2.0 (Ex. 1008)*

Exif 2.0 describes a standard file format for the image data recorded by digital still cameras to ensure data compatibility and exchangeability. Ex. 1008, 10.

4. *Exif 2.1 (Ex. 1009)*

Exif 2.1 describes a standard file format for the image data recorded by digital still cameras to ensure data compatibility and exchangeability. Ex. 1009, 7.

5. *Serret-Avila (Ex. 1011)*

Serret-Avila describes systems and methods for enabling a recipient of a cryptographically signed electronic communication to verify the authenticity of the communication. Ex. 1011, code (57). Serret-Avila authenticates data by comparing computed hash values from a received hash value and a calculated hash value. *Id.* at 10:16–27. Where the hashes

match, data is “deemed to be authentic” and “can be released for use.” *Id.* at 10:28–30. On the other hand, where data is judged to be unauthentic due to a mismatch in computed hashes, an “appropriate defensive action” is taken. *Id.* at 10:33–38. For example, the system may “display a warning or error message on [a] display.” *Id.* at 10:39–45.

E. Obviousness Based on Glass

Petitioner contends that the subject matter of claims 1–6 would have been obvious over Glass alone. Pet. 1, 22–41. Patent Owner opposes, contending Petitioner insufficiently shows that Glass teaches certain limitations recited in claim 1. Prelim. Resp. 11–20.

We have considered the parties’ arguments and the evidence presented at this stage, and we address them in the context of representative claim 1. For the reasons explained below, we determine that Petitioner has demonstrated a reasonable likelihood that it will prevail in showing that the subject matter of claim 1 would have been obvious over Glass.

1. Independent Claim 1

Below, we address the limitations recited in claim 1 and focus our discussion on the claim features Patent Owner asserts are not disclosed, taught, or obvious over Glass.

a) Preamble

Petitioner contends Glass discloses the preamble, i.e., “[a] method for authenticating a data stream stored in a data file in memory.” Pet. 23 (citing Ex. 1003 ¶¶ 157–161; Ex. 1005, code (57), 3:45–57, 4:1–8, 4:58–62).

Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Glass discloses the preamble.⁷

b) Limitation [1a]

Petitioner contends Glass discloses “storing a data stream in a data file in a memory.” Pet. 24–26 (citing Ex. 1003 ¶¶ 162–167; Ex. 1005, 3:50–52, 3:62–63, 4:30–32, 4:58–62, 5:46–48, 5:52–54, 11:19–22, 12:1–3, Figs. 2–3). Of particular relevance, Petitioner asserts that Glass’s system uses a camera to capture an image and then stores that image in digital form (“a data stream”) in a frame store (“a memory”). *Id.* at 24–25 (citing Ex. 1005, 4:58–62, Figs. 2–3); *see id.* at 26 (citing Ex. 1005, 3:50–52). Petitioner also asserts Glass’s digital image is stored in “a data file.” *Id.* at 25–26 (citing Ex. 1005, code (57), 3:50–52, 3:62–63, 11:19–22, 12:1–3). For the purposes of institution, Petitioner adequately shows that Glass’s disclosure of a digital image stored as a file in a frame store meets this limitation.

Patent Owner first argues that Glass does not store a digital image in “a data file” because column 4, lines 55–62 of “Glass does not mention files at all”; that argument, however, ignores other relied-upon and relevant disclosures in Glass which describe storing image data in data files. *See* Prelim. Resp. 11. In particular, Petitioner relies on portions of Glass describing “a camera . . . to collect the biometric data,” i.e., image data, and “[t]hat data is digitized *into a biometric data file.*” Pet. 25; Ex. 1005, 3:50–52 (emphasis added).

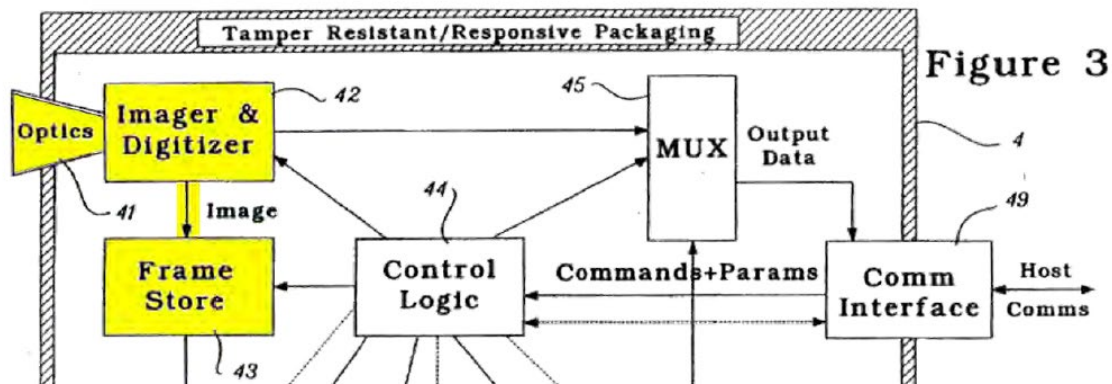
⁷ Generally, a preamble does not limit a claim. *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002). At this stage of the proceeding, we need not resolve whether the preamble is limiting because Petitioner shows sufficiently for purposes of institution that the prior art satisfies the recitation in the preamble.

Further, although Patent Owner asserts “biometric data is *based on* the image data, [but] it is not the *image data itself*,” the disclosure in Glass appears to contradict that assertion. Prelim. Resp. 12 (citation omitted). For example, Glass states “[t]ypically, the biometric data will be an analog representation of an image which is then digitized.” Ex. 1005, 4:58–60. Similarly, Glass describes using “a CCD camera, a CMOS device or other two dimensional imager which creates a digital image” and that “digital image is sent to a multiplexer 45 and/or a frame store memory 43.” *Id.* at 5:49–54. Furthermore, although Patent Owner discusses Glass’s biometric template feature (Prelim. Resp. 12 (citing Ex. 1005, 1:40–47)), that feature has little relevance to this issue because Petitioner does not appear to rely on biometric templates to teach this limitation (*see* Pet. 24–26).

Accordingly, Petitioner adequately shows Glass teaches this limitation.

c) Limitation [1b]

Petitioner contends Glass discloses “utilizing a sensor, which is tightly coupled to said memory, to generate at least one internal and unique parameter.” Pet. 26–30 (citing Ex. 1001, 6:60–61; Ex. 1002, 277, 292; Ex. 1003 ¶¶ 168–180; Ex. 1005, 4:6–8, 5:49–6:4, 6:12–13, 6:16–17, Figs. 2, 2A, 3; Ex. 1022, 15–16; 1023, 11). Of particular relevance, Petitioner supports its contention that Glass teaches a sensor tightly coupled to memory with highlighted components in Figure 3, reproduced in relevant part below. *Id.* at 26.



Petitioner's annotation of Figure 3 shows three components highlighted within imaging sensor 4: optics 41, imager & digitizer 42, and frame store 43; the annotation also highlights an arrow connecting imager & digitizer 42 and frame store 43. Pet. 26. Petitioner asserts optics 41 and imager & digitizer 42 teach a "sensor" and, further, frame store 43 teaches a "memory." *Id.* Petitioner, supported by the Declaration of Dr. Xiong, asserts that the arrow connecting imager & digitizer 42 and frame store 43 is a "data path" and "indicates that the components are electrically connected by conductive leads or traces within imaging system 4," thereby being "tightly coupled." *Id.* at 26–27 (citing Ex. 1003 ¶ 171). And, as such, Petitioner argues the components are "tightly coupled." *Id.*

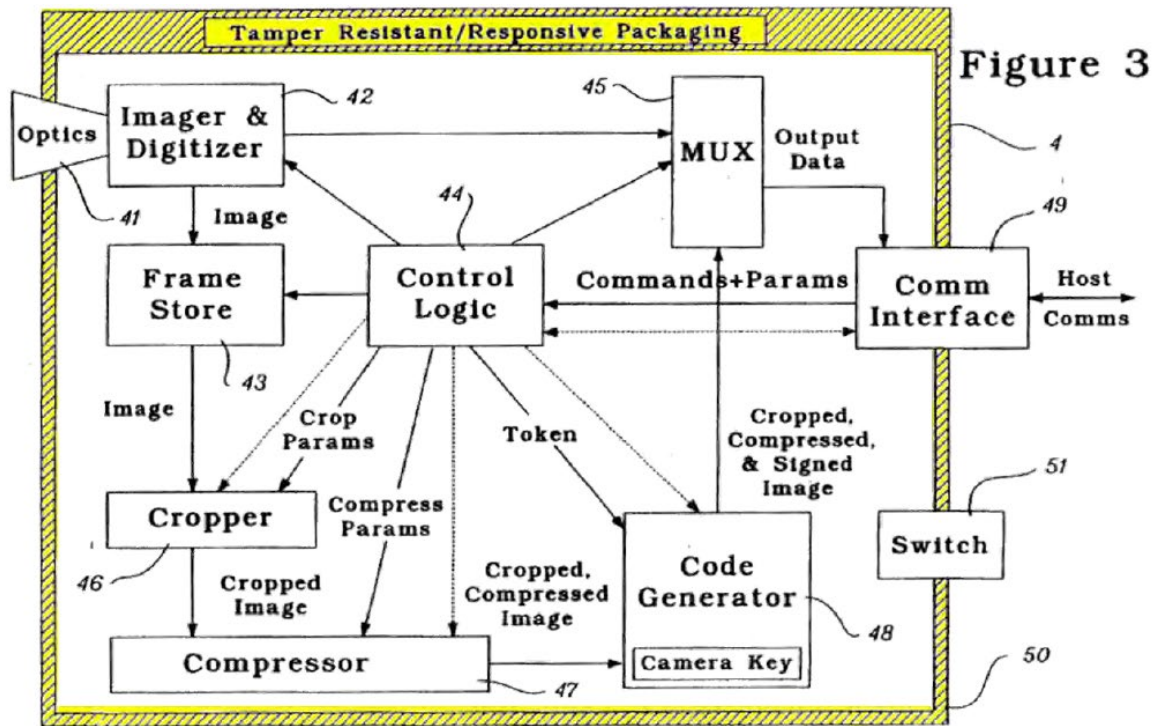
For institution purposes, we find Petitioner has shown sufficiently that a POSITA would understand Glass shows imager & digitizer 42 and frame store 43, connected by a "data path," "are electrically connected by conductive leads or traces within imaging system 4." Ex. 1003 ¶ 171 (citing Ex. 1005, 5:46–48). On this record, it appears reasonable that a POSITA would understand that Glass's interoperating components housed within a tamper-resistant enclosure for a digital camera would communicate with each other along conductive leads or traces.

Patent Owner's counter that Glass does not expressly describe conductive leads or traces (Prelim. Resp. 13–14) does not address Petitioner's evidence, in the form of Dr. Xiong's testimony, that a POSITA would understand that Glass's imager & digitizer 42 and frame store 43 are connected by conductive leads or traces. Further, Patent Owner's note that data can be communicated between computers over the Internet via WiFi is of limited moment here where this issue centers on a POSITA's understanding of Glass's digital camera and housed components. *See id.* at 14 n.4. As such, at this stage in the proceeding, Patent Owner has not provided persuasive competing evidence that discounts Dr. Xiong's testimony.

Accordingly, on this record, we find Petitioner adequately shows Glass teaches this limitation.

d) Limitation [1c]

Petitioner contends Glass discloses “monitoring the integrity of the tight coupling between said memory and said sensor when said at least one internal and unique parameter is generated, and, if said integrity is compromised, then also providing an indication of said compromised integrity.” Pet. 30–32 (citing Ex. 1003 ¶¶ 181–186; Ex. 1005, 5:13–45, Fig. 3). Of particular relevance, Petitioner supports its contention that the integrity of the tight coupling is monitored with highlights to Figure 3, reproduced below. *Id.* at 31.



Petitioner's annotation of Figure 3 shows Glass's imaging system 4, containing imager & digitizer 42 and frame store 43, enclosed in highlighted tamper resistant/responsive packaging 50. Pet. 30–31; *see* Ex. 1005, 5:13–45, Fig. 3. Petitioner explains that if Glass's tamper resistant/responsive packaging is compromised, a “chassis intrusion detector or switch 51” causes Glass's imaging system to be placed in a non-functioning state. *Id.* at 31–32 (citing Ex. 1005, 5:16–19, 5:26–34, Fig. 3). As such, we understand Petitioner to assert that, by monitoring the integrity of the packaging which encloses imager & digitizer 42 and frame store 43, Glass monitors the integrity of the asserted tight coupling between imager & digitizer 42 and frame store 43, i.e., the asserted “sensor” and “memory.”

On this record, Petitioner has reasonably shown that monitoring the integrity of tamper resistant/responsive packaging thereby monitors the integrity of the tight coupling between imager & digitizer 42 and frame store

43 within that packaging. It reasonably follows that monitoring the integrity of a package monitors the integrity of the components within the package.

Patent Owner's argument that Glass monitors the tamper resistant/responsive packaging which houses the tight coupling rather than "specifically" monitoring the tight coupling itself imparts requirements that, at this stage, we determine the claim does not require. Prelim. Resp. 17–18 (citing Ex. 1005, 13–41). The claim does not specify any particular manner of "monitoring the integrity of the tight coupling." See Ex. 1001, 20:65–21:2. Nor does Patent Owner explain why the claim should be interpreted to require a particular manner of monitoring the integrity of the tight coupling, e.g., by discussing where the Specification explains that monitoring the integrity of the tight coupling requires some specific monitoring technique. See Prelim. Resp. 17–18.

Patent Owner's additional argument discussing Glass's passive tampering prevention embodiment unpersuasively discusses an embodiment Petitioner does not rely on, i.e., Patent Owner's argument does not address Glass's chassis intrusion detector or switch 51 embodiments. Prelim. Resp. 16–17 (citation omitted).

Accordingly, on this record, we find Petitioner adequately shows Glass teaches this limitation.

e) Limitation [1d]

Petitioner contends Glass discloses "utilizing a signature protocol to generate a first signature based on said data stream and said at least one parameter, said first signature being generated without altering said data stream and being appended to said data file in said memory." Pet. 32–34 (citing Ex. 1003 ¶¶ 187–193; Ex. 1005, 5:62–6:3, 6:57–65, 7:3–7, 9:37–40,

11:47–49). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Glass discloses this limitation.

f) Limitation [1e]

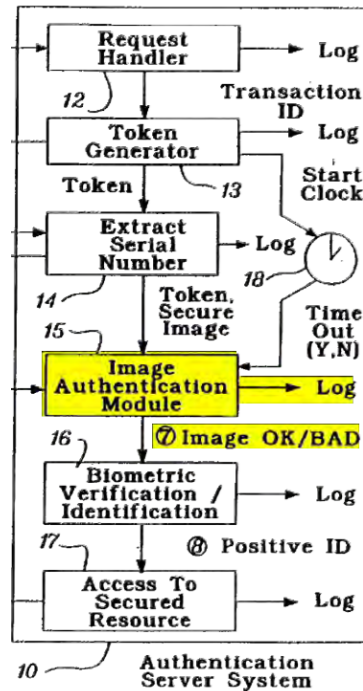
Petitioner contends Glass discloses “utilizing said signature protocol to generate a second signature based on said data stream.” Pet. 34–35 (citing Ex. 1003 ¶¶ 194–198; Ex. 1005, 6:40–65). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Glass discloses this limitation.

g) Limitation [1f]

Petitioner contends Glass discloses “comparing said first signature to said second signature.” Pet. 35–36 (citing Ex. 1003 ¶¶ 200–202; Ex. 1005, 6:50–56, 6:61–63, 9:40–47). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Glass discloses this limitation.

h) Limitation [1g]

Petitioner contends Glass discloses “if said first and second signatures are not the same, then generating an error signal that is displayed to a user to indicate that said stored data stream is not authentic.” Pet. 36–38 (citing Ex. 1003 ¶¶ 203–206; Ex. 1005, 6:61–63, 6:50–56, 9:40–47, 9:56–62, 10:54–58, Figs. 7–8). In support of its contention, Petitioner annotates Figure 8 of Glass, reproduced in relevant part, below.



Petitioner’s annotation of Figure 8 shows authentication server system 10 which includes, as highlighted by Petitioner, image authentication module 15 with two outputs: “Image OK/BAD” 7 and an output to “Log.” Pet. 37; *see* Ex. 1005, 10:40–45, 10:54–58. Petitioner asserts image authentication module 15 determines if an image is authenticated (“Image OK/BAD”) and adds that determination to a “Log.” Pet. 36–37 (citing Ex. 1003 ¶¶ 204–205; Ex. 1005, 9:60–62). Petitioner, relying on the testimony of Dr. Xiong, further asserts that a “POSITA would know that a primary reason for storing the *error signal* in a ‘Log’ is to present a record of the error to a system administrator or other *user*.” *Id.* at 37 (citing Ex. 1003 ¶ 205).

For the purposes of institution, we find Petitioner adequately shows a POSITA would understand that Glass’s image authentication result is logged and displayed to a user. Dr. Xiong testifies that Glass’s log files are “intended to be viewed and read by users.” Ex. 1003 ¶ 205. Glass supports that understanding, disclosing that it “log[s] each step of the transaction” and

“[t]his data can provide irrefutable evidence of the transaction.” Ex. 1005, 9:56–64, 10:54–58. Keeping a record of evidence, i.e., the logged authentication steps in the transaction, suggest that the log is meant to be reviewed.

Patent Owner’s argument that Glass logs “all transactions” but not an “error signal” appears contrary to Glass’s disclosure. Prelim. Resp. 19. Glass states that its image authentication module 15 “checks that the image has not been tampered with” using digital signatures and shows in Figure 8 that the result of the check is that the image is “OK/BAD.” Ex. 1005, 10:40–50, Fig. 8; *see id.* at 9:40–56, Fig. 7. That is, the result of the image authentication module is a signal that the image cannot be authenticated, i.e., an error (“BAD”), or a signal that the image is authentic (“OK”). *Id.* As Glass states that it logs each step of its transactions (*id.* at 9:56–64, 10:54–58), it follows that the authentication failure or success would be logged.

Patent Owner’s additional argument that Glass does not expressly describe displaying the result of Glass’s image authentication does not address Petitioner’s evidence, in the form of Dr. Xiong’s testimony, that a POSITA would have understood the result would have been displayed. *See* Prelim. Resp. 19. Thus, Dr. Xiong’s testimony is undisputed.

Accordingly, on this record, we find Petitioner adequately shows Glass teaches this limitation.⁸

i) Limitation [1h]

Petitioner contends Glass discloses “if said first and second signatures are the same, then generating an ok signal that is displayed to a user to

⁸ Petitioner also asserts the combination of Glass and Serret-Avila teaches this limitation. Pet. 67–72. We discuss that combination below.

indicate that said stored data stream is authentic.” Pet. 38 (citing Ex. 1003 ¶¶ 207–210; Ex. 1005, 6:61–63, 6:50–56, 9:40–47, 9:56–62, Figs. 7–8).

Relying on similar evidence and reasoning as it did in limitation [1g], Petitioner asserts that a POSITA would have understood Glass’s successful authentication log entries would be displayed to a user. *Id.* Patent Owner relies on similar arguments as it did in limitation [1g] in refuting Petitioner’s assertion. *See* Prelim. Resp. 19–20. For the same reasoning discussed above in limitation [1g], we find on this record that Petitioner adequately shows Glass teaches this limitation.

j) Conclusion as to Claim 1

For the reasons discussed above and based on Petitioner’s contentions and evidence, summarized above, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claim 1 would have been obvious over Glass.

2. Institution of Inter Partes Review

Because we are persuaded that Petitioner has shown a reasonable likelihood of prevailing in demonstrating that the subject matter of claim 1 would have been obvious over Glass, we institute an *inter partes* review of all claims and all challenges raised in the Petition. *See SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 365 (2018) (stating 35 U.S.C. § 314 “simply requires [the Director] to decide whether the petitioner is likely to succeed on ‘at least 1’ claim. Once that single claim threshold is satisfied, it doesn’t matter whether the petitioner is likely to prevail on any *additional* claims; the Director need not even consider any other claim before instituting review.”); 37 C.F.R. § 42.108(a).

F. Remaining Grounds

Petitioner asserts seven additional grounds challenging claims 1–6. Pet. 1. Although it is sufficient to institute based on Petitioner’s obviousness challenge of claim 1 over Glass, in order to further guide the parties after institution, we provide additional observations regarding the parties’ arguments for the other grounds and challenged claims below. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide 6, 64 (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>. We focus on issues raised by Patent Owner’s arguments in those grounds.

1. Obviousness Based on Rieger

Petitioner contends claim 1 would have been obvious over Rieger. Pet. 1, 41–61. Petitioner supports its contention based on disclosures in Rieger which are similar to disclosures in Glass. *Compare* Pet. 22–38, *with id.* at 41–57 (citations omitted). Moreover, Petitioner offers very similar analyses and explanations as to why claim 1 would have been obvious over Rieger as the analyses and explanations offered for Glass. *Compare id.* at 22–38, *with id.* at 41–57 (citations omitted).

Patent Owner, correspondingly, counters Petitioner’s challenge based on Rieger by referencing and relying on very similar arguments it made in its counter to Petitioner’s challenge based on Glass in limitations [1b], [1c], [1g], and [1h]. *Compare* Prelim. Resp. 11–20, *with id.* at 20–28 (citing earlier arguments directed to Glass).

As the parties’ arguments and evidence regarding Rieger mirror those previously made for Glass, for similar reasons as discussed above in our analysis of Glass, we determine Petitioner shows a reasonable likelihood of

prevailing in demonstrating that claim 1 would have been obvious over Rieger.

2. Obviousness Based on Glass or Rieger and Serret-Avila

Petitioner contends the combination of Glass and Serret-Avila or Rieger and Serret-Avila teaches limitations [1g] and [1h], “if said first and second signatures are not the same, then generating an error signal that is displayed to a user to indicate that said stored data stream is not authentic” and “if said first and second signatures are the same, then generating an ok signal that is displayed to a user to indicate that said stored data stream is authentic.” Pet. 67–72.

As discussed above, Petitioner asserts both Glass and Rieger describe matching a first and second hash, i.e., comparing whether first and second signatures are the same, for authentication. Pet. 33, 36–38, 53–57 (citations omitted). Petitioner further asserts Serret-Avila provides authentication by matching hashes. Pet. 69–72 (citing Ex. 1003 ¶¶ 292–294; Ex. 1011, 5:39–40, 5:64–67, 9:61–10:1, 10:24–45, 17:35–53, Figs. 5, 14). Furthermore, Petitioner asserts Serret-Avila describes displaying a warning or error message on a display upon a failed authentication and informing a user of successful authentication. Pet. 70–71 (citing Ex. 1011, 10:28–45, Fig. 5). Petitioner argues a POSITA would have been motivated to combine Glass and Serret-Avila or Rieger and Serret-Avila for similar reasons: providing “an indication to a user that the image is either authentic or not” (1) allows users to “respond appropriately” and to “take immediate remedial action” upon failed authentication and (2) upon successful authentication, can “reassure a user that the system is operating as intended and is free of fraudulent activity.” Pet. 68–69 (citing Ex. 1003 ¶¶ 287, 290). On this

record, Petitioner’s motivations to combine Glass and Serret-Avila or Rieger and Serret-Avila rationally support the combinations.

Patent Owner counters Petitioner’s combination by arguing Serret-Avila is non-analogous art and, as such, does not qualify as prior art usable in Petitioner’s obviousness challenges. Prelim. Resp. 29–31. We disagree. The scope of analogous art includes references “from the same field of endeavor” and references “reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). On the record before us, Serret-Avila is analogous art under at least the second prong of the analogous-art test. *See In re Clay*, 966 F.2d 656, 658–59 (Fed. Cir. 1992) (stating prior art is analogous and can be applied in an obviousness combination if it “is reasonably pertinent to the particular problem with which the inventor is involved”). Patent Owner appears to state that the relevant problem the ’828 Patent addresses in these limitations “is to inform the user whether or not the images include either errors or if security has been compromised.” Prelim. Resp. 31 (citing Ex. 1001, 8:45–50). But informing users whether data has been compromised due to mis-matched hashes is the same problem Petitioner asserts Serret-Avila addresses. As Petitioner points out, Serret-Avila’s solution to the problem of data which is “judged to be unauthentic” is to “display a warning or error message on display 262.” Pet. 68; Ex. 1011, 10:33–45. Patent Owner’s suggestion that Serret-Avila’s solution is not a solution specific to image authentication (Prelim. Resp. 31) focuses narrowly on the type of data authenticated, rather than Serret-Avila’s solution to the problem of authentication notification. As such, for the purposes of institution, we determine Serret-Avila’s system appears

reasonably pertinent to the problem of informing a user that image data has been compromised.

Accordingly, on this record, we find Petitioner adequately shows that a POSITA would have combined Glass and Serret-Avila or Rieger and Serret-Avila to reach limitations [1g] and [1h] and that claim 1 would have been obvious over Glass and Serret-Avila or Rieger and Serret-Avila.

IV. CONCLUSION

As explained above, we determine that Petitioner has established a reasonable likelihood of prevailing in its challenge to at least one claim of the '828 Patent, and we decline exercising the discretion to deny institution. Thus, we institute an *inter partes* review of all challenged claims on all asserted grounds.

The factual findings and conclusions of law in this Decision are preliminary and based on the current record. They are made for the sole purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision as to the patentability of the challenged claims will be based on the full record developed during trial, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in such a response may be deemed forfeited.

V. ORDER

It is:

ORDERED that an *inter partes* review is instituted on all challenged claims, i.e., claims 1–6 of the '828 Patent, on all grounds of unpatentability specified in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), an *inter partes* review of the '828 Patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial.

IPR2024-01352
Patent 6,757,828 B1

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