

**UNITED STATES PATENT AND TRADEMARK OFFICE**

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

ELECTION SYSTEMS & SOFTWARE, LLC  
Petitioner,

v.

HART INTERCIVIC, INC,  
Patent Owner.

---

PGR2025-00066  
U.S. Patent No. 12,125,319

**PATENT OWNER'S BRIEF IN SUPPORT OF  
DISCRETIONARY DENIAL**

**Table of Contents**

|                                                                                                                                                                                                    |    |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|
| PATENT OWNER’S EXHIBIT LIST .....                                                                                                                                                                  | ii |
| I. Introduction .....                                                                                                                                                                              | 1  |
| II. The Office already vetted the ’319 patent and its family.....                                                                                                                                  | 3  |
| A. Petitioner’s art and arguments were already considered.....                                                                                                                                     | 3  |
| B. The Office repeatedly found claims non-obvious where they<br>included a temporal limitation such as in the ’319 claims. ....                                                                    | 6  |
| III. The Petition should be denied.....                                                                                                                                                            | 8  |
| A. The Director should exercise discretion and deny institution<br>under § 325(d). ....                                                                                                            | 8  |
| 1. <i>Advanced Bionics</i> Part I—substantially the same prior art and<br>arguments were presented to, and considered by, the Office<br>during prosecution of the ’319 patent and its family. .... | 9  |
| 2. <i>Advanced Bionics</i> Part II—no material error.....                                                                                                                                          | 12 |
| B. Petition should also be denied under § 322(a)(4) and<br>Rule § 204(b)(4). ....                                                                                                                  | 12 |
| 1. Petition does not specify where the recited temporal limitation<br>is found in the prior art.....                                                                                               | 12 |
| C. Workload Memo supports discretionary denial. ....                                                                                                                                               | 17 |
| 1. The merits of the Petition are weak. ....                                                                                                                                                       | 17 |
| 2. The ’319 patent family is entitled to settled expectations.....                                                                                                                                 | 19 |
| 3. The Petition relies heavily on expert testimony.....                                                                                                                                            | 19 |
| IV. Conclusion.....                                                                                                                                                                                | 20 |
| Certificate of Service .....                                                                                                                                                                       | 22 |

**PATENT OWNER'S EXHIBIT LIST**

|        |                                                                                                                                                                                                                                                                                                                                                                                                   |
|--------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| EX2001 | Memorandum, Interim Processes for PTAB Workload Management (Acting Director Stewart, March 2, 2025) retrieved from <a href="https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf">https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf</a> (“Workload Memo”)                                          |
| EX2002 | Memorandum, Reminders on Evaluating Subject Matter Eligibility of Claims under 35 U.S.C. 101 (Deputy Commissioner for Patents Kim, August 4, 2025) retrieved from <a href="https://www.uspto.gov/sites/default/files/documents/memo-101-20250804.pdf">https://www.uspto.gov/sites/default/files/documents/memo-101-20250804.pdf</a> (“101 Memo”)                                                  |
| EX2003 | Prosecution History of Appl. No. 17/483,627 issuing as U.S. Patent No. 11,830,294                                                                                                                                                                                                                                                                                                                 |
| EX2004 | Prosecution History of Appl. No. 17/483,554 issuing as U.S. Patent No. 11,804,092                                                                                                                                                                                                                                                                                                                 |
| EX2005 | Prosecution History of Appl. No. 17/225,357                                                                                                                                                                                                                                                                                                                                                       |
| EX2006 | Prosecution History of Appl. No. 16/919,267 issuing as U.S. Patent No. 11,004,292                                                                                                                                                                                                                                                                                                                 |
| EX2007 | Prosecution History of Appl. No. 16/745,621 issuing as U.S. Patent No. 10,950,078                                                                                                                                                                                                                                                                                                                 |
| EX2008 | Statutory Disclaimer Pursuant to 35 USC 253 and 37 CFR 1.321(d) of Selected Claims of U.S. Patent No. 12,125,319, filed September 25, 2005.                                                                                                                                                                                                                                                       |
| EX2009 | Memorandum, Enforcement and Non-Waiver of 37 C.F.R. § 42.104(b)(4) and Permissible Uses of General Knowledge in Inter Partes Reviews (Acting Director Stewart, July 31, 2025) retrieved from <a href="https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf">https://www.uspto.gov/sites/default/files/documents/aapa_memo_final_signed.pdf</a> (“Permissible Use Memo”) |

Patent Owner Hart InterCivic respectfully requests that the PTAB exercise its discretion and deny institution of Petitioner Election Systems & Software's post-grant review of U.S. Patent No. 12,125,319 ("the '319 patent"). *See* EX2001. Petitioner repackages the same § 101 and § 103 arguments and the same prior art that the Office has already considered throughout examination of a chain of continuation applications culminating in the '319 patent. Thus, the Board should deny institution under 35 U.S.C. § 325(d) as Petitioner seeks to relitigate the same questions that the Office has repeatedly answered. The Petition should also be denied because it does not identify where the prior art teaches the temporal limitation of the '319 patent claims—the very same limitation that the Office found dispositive of non-obviousness during its previous analysis—instead relying on conclusory expert say-so that is no substitute for prior art.

## **I. Introduction**

Petitioner's prior art and arguments were first presented to the Office in a review of U.S. Patent No. 10,445,966 (the "'966 patent"), the first-filed patent of the '319 patent family. *See* PGR2020-00031 (successfully challenging the '966 patent claims). Thereafter, Petitioner's prior art and arguments were presented and fully considered in six applications that led to five granted U.S. patents including the target of this latest challenge—the '319 patent. During the Office's consideration, the USPTO Examiner had before her not only the prior art, but also Petitioner's

arguments as detailed in the Board's decisions, the Petitioner's briefs, and the Petitioner's expert reports of the earlier PGR. After considering that prior art and those arguments, the Examiner found the '319 claims—appropriately tailored in light of that prior art and those arguments—to be patentable. Petitioner now seeks to relitigate this, asking the Office to set aside its thorough consideration of the new and appropriately tailored '319 patent claims and the settled expectations resulting from this thorough Office review.

In a transparent attempt to avoid denial under § 325(d), Petitioner adds one new reference (8 pages of Schneier's cryptography book) in its challenges. However, the citation to cryptography fundamentals is simply window dressing, adding cumulative teachings that do not alter the contours of the previously considered record. Indeed, the Petition addresses each claim element with the previously considered art (Brockhouse and Nadaf). And when faced with the temporal limitation the Office found dispositive of non-obviousness over this art, Petitioner—to the extent it engages at all with the temporal limitation—simply contends it would have been obvious to a POSITA. The Petition identifies no prior art—including nothing in its excerpt from the Schneier text—that teaches the temporal limitation.

Thus, the questions raised by the Petition (under § 103 and § 101) are simply those previously considered by the Office. Accordingly, the Director should exercise discretion and deny under § 325(d). *See infra* III.A. Moreover, because the Petition

fails to identify where the temporal limitation is found in the prior art, the Board must ultimately deny the Petition under § 322(a)(4).<sup>1</sup> *See infra* III.B. Additional factors listed in the Workload Memo (EX2001) also support discretionary denial. *See infra* III.C. For each of these reasons, the Petition should be denied.

## **II. The Office already vetted the '319 patent and its family.**

### **A. Petitioner's art and arguments were already considered.**

The '319 patent claims priority through five other continuation applications to the '966 patent. The '966 patent was the subject of PGR2020-00031 ("the '966 patent PGR"), which was requested by the same Petitioner as the present proceeding. The Final Written Decision (FWD) of the '966 patent PGR found all claims unpatentable in light of the prior art, which included Brockhouse, Nadaf and Heilper—the exact same references that form the basis of Petitioner's arguments here.<sup>2</sup> Patent Owner

---

<sup>1</sup> Petitioner's expert merely opines to conclusory, unsupported statements regarding a POSITA's motivations. As discussed below, and for reasons that the Director has explained with respect to analogous provisions of § 312(a)(4) and Rule 104(b)(4), such opinions are not *prior art* required by Rule 204(b)(4) and hence § 322(a)(4).

<sup>2</sup> Despite significant briefing and oral argument dedicated to the issue, the FWD did not adopt Petitioner's argument that the '966 patent claims were directed to ineligible subject matter. *See* PGR2020-00031, Paper 29 (FWD), 83.

accepted the FWD's conclusion, and all claims of the '966 patent—meaningfully broader than those claims considered here—were cancelled.

During and after the '966 patent PGR, Patent Owner engaged with the Office to prosecute six (6) subsequent applications of the '319 patent family, each claiming narrower embodiments of its inventions than the '966 patent. In prosecuting these applications, Patent Owner ensured that the relevant materials from the '966 patent PGR, including not only the prior art—Brockhouse, Nadaf and Heilper—but also the Petition, the Petitioner's expert reports, the Petitioner's responsive briefing, and the Board's Institution Decision (ID) and FWD were all made of record and considered by the Examiner.<sup>3</sup> *See* EX1002, 235-244; EX2003, 404-412; EX2004, 388-396; EX2005, 28-40; EX2006, 8-9, 29-30, 644-645, 651-660; EX2007, 389-391, 398-406, 412-413 (illustrating Examiner's signed PTO/SB/08a forms indicating consideration in each prosecution as the respective documents became available).<sup>4</sup>

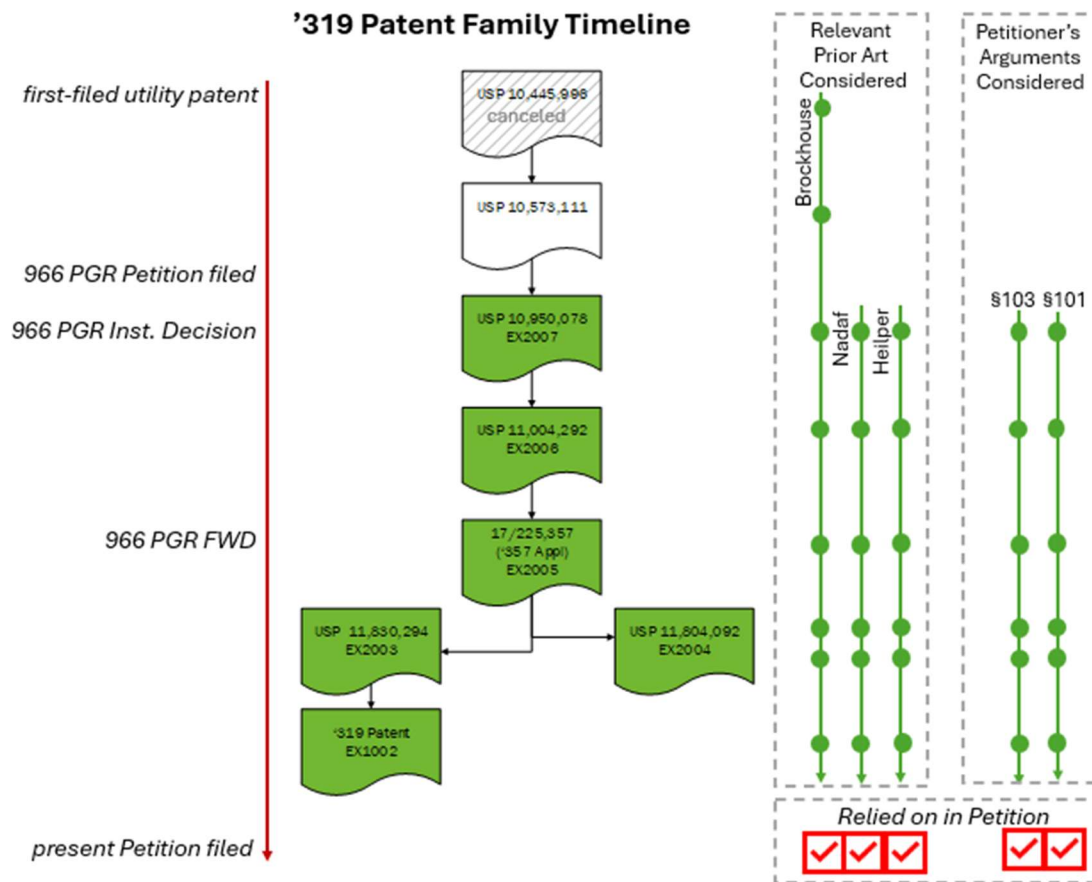
In those papers, the Examiner had the relevant prior art and arguments from

---

<sup>3</sup> Notably, the Patent Owner provided this information in the best light for the Office's critical review—without Patent Owner's corresponding papers.

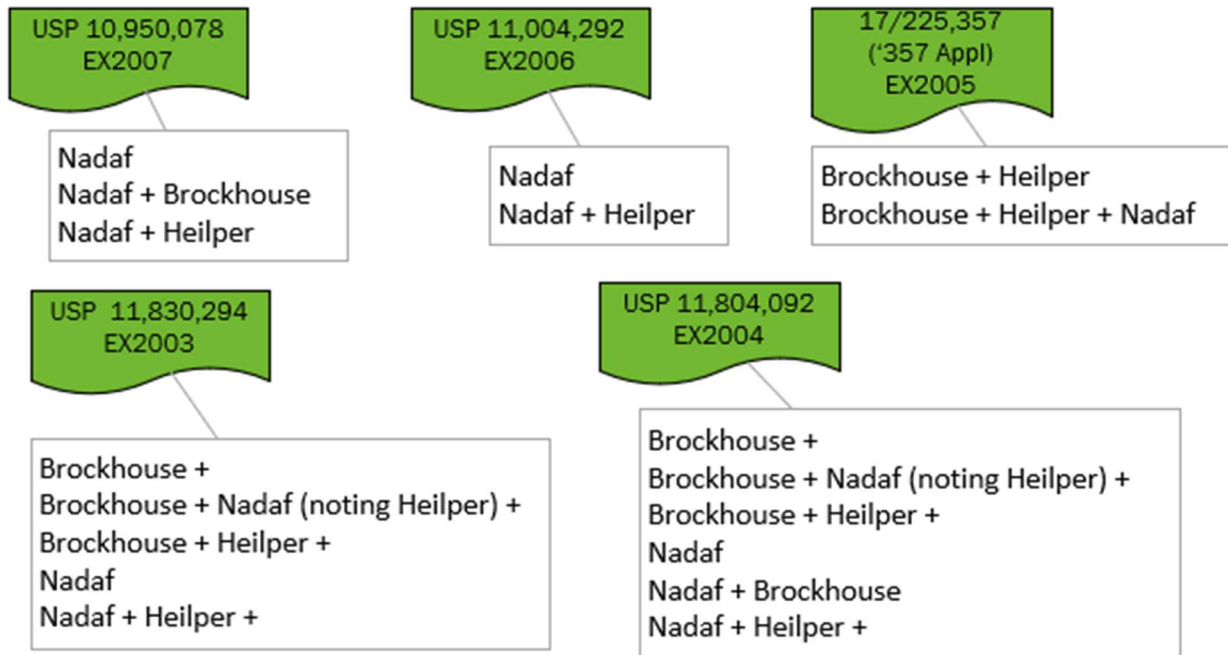
<sup>4</sup> EX2006 and EX2007 do not include FWD; EX2007 does not include Petitioner's Reply and Suppl. Decl; search notes indicate a specific review of the '966 patent PGR Petition occurred at least on "September 21, 2020." EX2007, 49, EX2006, 81, 642.

the '966 patent PGR before her—including those arguments directed to § 101 eligibility and obviousness, which are the same or substantially the same arguments Petitioner makes here.<sup>5</sup> Further, Brockhouse, Nadaf and Heilper were not merely presented, but extensively discussed and relied upon—including in combination—numerous times throughout the prosecution of the '319 patent family.



<sup>5</sup> See *supra*, at note 4. The Board's own § 101 analysis of the '966 patent spans nine pages of the institution decision that the Examiner also considered. See EX1002, 242; EX2007, 413; EX2006, 645; EX2005, 39; EX2003, 411; EX2004, 395.

The following chart summarizes the Brockhouse, Nadaf and Heilper-based rejections set forth by the Examiner. Each rejection was overcome during prosecution.



See EX2007, 377-386; EX2006, 624-640; EX2005, 3-21; EX2004, 319-331, 376-385; EX2003, 337-354, 382-398.

Thus, Petitioner's attempt to characterize the Office as not having reviewed these references in combination is specious (*see, e.g.*, Petition, 66-67); an Examiner does not consider the teachings of cited references in a silo, and the Examiner had used the references in combination throughout prosecution of the '319 patent family.

**B. The Office repeatedly found claims non-obvious where they included a temporal limitation such as in the '319 claims.**

Throughout the '319 patent family, the Examiner found claims that included a temporal limitation provided a non-obvious improvement over the prior art teachings

of Brockhouse, Nadaf and Heilper. This temporal limitation displays prominently in all of the '319 patent's claims: *e.g.*, “***prior to generating any cast vote record***...an accuracy of data to be cast is confirmed based at least in part on a comparison of the first data set and the second data set” in the context of claim 1. (Emphasis added) This dispositive temporal limitation provides that a comparison of data sets is performed “prior to” generating a cast vote record (CVR) in the context of the other claimed elements. The patentability of claims including such a temporal limitation has been confirmed by the Examiner numerous times throughout the '319 patent family. Exemplary Notices of Allowance are illustrative:

|                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                      |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                     |            |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------|
| <p>Electronically scanning the voter readable text on the printed vote record to create a first data set, the first data set based at least in part on the voter selection;</p> <p>Electronically scanning the encoded data on the printed vote record to create a second data set, the second data set based at least in part on the voter selection;</p> <p>Comparing the first data set and the second data set; and</p> <p>Generating a cast vote record indicating the voter's at least one vote selection, <u>wherein, <b>prior to generating the cast vote record</b>, confirming an accuracy of one or more voter selections to be cast based at least in part on a <b>comparison of the first data set and the second data set</b>.</u></p> | <p><u>providing a cast vote record which is to be a record of all of the voter's final vote selections and which is to be the voter's casted vote used for vote tabulation, the cast vote record indicating the voter's at least one vote selection as determined by the first data set, <b>the cast vote record being generated after the comparing the first data set and the second data set</b>, the cast vote record being utilized for vote tabulation purposes before vote auditing.</u></p>                                                                                                                 | EX2003, 34 |
| EX2007, 46                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                           | <p>Generating a cast vote record which is to be a stored record of the voter's final vote selection and which is to be the voter's casted vote used for vote tabulation, the cast vote record indicating the voter's at least one vote selection, wherein <b>prior to generating the cast vote record which is to be a stored record of the voter's final vote selection and which is to be the voter's casted vote used for vote tabulation</b>, confirming an accuracy of one or more voter selection to be cast based at least in part on a <b>comparison of the first data set and the second data set</b>.</p> | EX2004, 19 |

timing of comparison relative to generation of cast vote record highlighted in each set of reasons for allowance

Thus, throughout the '319 patent family, claims that included a temporal limitation

were found non-obvious over the art and arguments now rehashed in this Petition. Patent Owner appropriately tailored its claims and ensured that these issues were vetted before the Office such that its '319 patent claims were born strong. Petitioner's request to relitigate should be denied.

**III. The Petition should be denied.**

**A. The Director should exercise discretion and deny institution under § 325(d).**

In determining whether to institute a PGR, the “Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). In doing so, a two-part framework is applied as set forth in *Advanced Bionics*: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

This Petition should be denied under *Advanced Bionics* because it presents the same arguments with respect to 35 U.S.C § 101 and substantially the same art and arguments with respect to 35 U.S.C § 103 that the Office has already fully considered.

1. **Advanced Bionics Part I—substantially the same prior art and arguments were presented to, and considered by, the Office during prosecution of the '319 patent and its family.**
  - a. **The same § 101 arguments were previously considered and the Office declined to find the claims subject matter ineligible.**

Regarding Ground 1 of the Petition (eligibility), subject-matter eligibility has repeatedly been considered by the Office, and the Office has made no rejection over § 101 of any claim of the '319 patent family. The Petitioner first raised these *same* arguments in its '966 patent PGR where subject-matter eligibility was a central issue. After extensive briefing and discussion at the oral hearing, the Board's FWD *declined* to find those claims were directed to ineligible subject-matter. *See* PGR2020-00031, Paper 29 (Final Written Decision), 83. The Office also reviewed compliance with § 101 during the prosecution of the '319 patent and its related applications. *See* MPEP 2103 (providing that an Examiner must determine compliance for all applications). Moreover, the Examiner here was presented with—and considered—the very same § 101 arguments raised by this Petition in the form of the extensive Petitioner's arguments from the '966 patent PGR. *See* EX1002, 235-243; EX2003, 404-412; EX2004, 388-396; EX2005, 32-40; EX2006, 9, 81, 642, 644-645, 651-658; EX2007, 49, 387, 405-406, 412-413 (illustrating Examiner's signed PTO/SB/08a form indicating consideration including Petition and PGR institution decision). And just like the Board, the Examiner declined to adopt those arguments. Since then, the Office has only reinforced its subject matter guidance on proper analysis under

§ 101.<sup>6</sup> Thus, the Petition fails to meet Prong One of *Advanced Bionics* as the Office previously considered in multiple contexts—and declined to adopt—Petitioner's now rehashed § 101 arguments.

**b. The § 103 arguments involve substantially the same references and substantially the same arguments over which the Office determined the '319 patent claims non-obvious.**

Regarding Grounds 2 and 4 of the Petition (obviousness), substantially the same prior art and substantially the same arguments were already considered by the Office. Ground 2 of the Petition relies on three references: Brockhouse, Nadaf and Schneier; Ground 4 relies on four references: Brockhouse, Nadaf, Schneier and Heilper. Three of these four references (Brockhouse, Nadaf and Heilper) are exactly the same prior art references as previously considered during the prosecution of the '319 patent and its related applications. And as discussed below, the fourth reference (Schneier) is mere window dressing, or at best cumulative, adding nothing new to the Office's previous considerations of obviousness.

The Office has considered Brockhouse, Nadaf and Heilper—as well as Patent

---

<sup>6</sup> EX2002, 101 Memo, *Reminders on Evaluating Subject Matter Eligibility of Claims under 35 U.S.C. 101* ; see, e.g., 101 Memo, 2-3 (addressing mental process grouping and distinguishing claims that *recite* a judicial exception from those that merely *involve* an exception).

Owner's arguments directed thereto—not only in the prosecution that led to the '319 patent itself, but throughout at least five other related applications. Throughout the Office's previous consideration, a temporal limitation—included in each of the '319 patent claims—has been found to be a non-obvious improvement over the prior art as discussed above. While cogent Petitioner argument with respect to the temporal limitation is elusive, it is clear that the Petition does not identify *any* prior art disclosure in Schneier for the temporal limitation. Schneier makes no such disclosure and does not address the deficiencies of Brockhouse, Nadaf and Heilper recognized by the Office during prosecution of the '319 patent and its predecessors.

The Petition explains that Schneier has a “hash function” that can be used to “confirm the accuracy” of a data set, but this is the same function for which the Petition relies on Nadaf. *See* Petition, 70 (recognizing the interchangeability of Schneier and Nadaf, stating that “[a]dding Schneier's hash function **and/or** Nadaf's comparison functionality to Brockhouse to confirm the accuracy of the OCR data before generating the CVR would have required nothing more than the combination of familiar elements according to known predictable results”) (Emphasis added). In other words, assuming the Petition's own characterization of Schneier is correct, Schneier merely provides another example of a technique of comparing data, a feature for which the Petition already relies on Nadaf. *See* Petition, 64-65 (alleging that Nadaf teaches the “comparing the first data set to [the] second data set” claim

element). Petitioner's expert reinforces the redundant nature of Nadaf and Schneier—"Schneier confirms that a long-known method to [confirm data], as also taught by Nadaf, is use of a hash function." EX1003, ¶263. Accordingly, Schneier adds nothing new to the Office's previous considerations of obviousness.

Thus, the § 103 arguments raised by the Petition devolve to substantially the same arguments and prior art that have been previously considered by the Office and found unpersuasive. Prong One of *Advanced Bionics* is met.

**2. *Advanced Bionics* Part II—no material error.**

The Petitioner has not identified material error by the Office, and the Office did not err in allowing the '319 patent claims. The Examiner found no prior art that discloses the temporal limitation in the context claimed. As Petitioner still has not produced any prior art that teaches the temporal limitation, it is clear that the Examiner's findings are not in error. Likewise, the Examiner's decision allowing the '319 claims as eligible subject-matter and declining to adopt Petitioner's § 101 arguments is not error, as the PTAB also declined to hold as much.

**B. Petition should also be denied under § 322(a)(4) and Rule § 204(b)(4).**

**1. Petition does not specify where the recited temporal limitation is found in the prior art.**

Each challenged claim of the '319 patent includes a temporal limitation that specifies *when* a cast record vote (CVR) is generated relative to a comparison of data

sets—*e.g.*, a comparison is performed “**prior to** generating any cast vote record.”<sup>7</sup>

These temporal limitations were not in the '966 patent claims and were repeatedly determined by the Office to be a non-obvious improvement over the prior art as discussed above. While Petitioner's argument related to this element lacks clarity, what is clear is that the Petition identifies **no prior art** that discloses the temporal limitation. Thus, the Petition should be discretionarily denied as it fails to meet the requirements of regulations (Rule 204(b)(4)) and ultimately, 35 U.S.C. § 322(a).

As best understood, the Petition depends on a scattershot of assertions related to this claim element—but **none** (alone or in combination) are sufficient to support institution. Specifically:

- conclusory, hindsight statements alleging that a POSITA would find obvious, even when parroted in expert testimony, do not establish “where [the temporal limitation] element of the claim is found in the prior art” as required by 37 C.F.R § 204(b)(4);
- Nadaf and/or Brockhouse, references that have already been fully

---

<sup>7</sup> '319 patent, Ex.1001, claims 1, 15 (emphasis added); *see also*, claims 29, 34 (“**after** confirming an accuracy of the at least one vote selection, generating a cast vote record which is to be a stored record of all of the voter's final vote selections and which is to be the voter's casted vote used for vote tabulation ...”) (emphasis added).

considered by the Office, do not teach the temporal limitation; and

- Schneier's description of a hash function, even in connection with "withdrawal of \$100," does not teach a temporal limitation.

First, the Petition's reliance on conclusory assertions that a POSITA would have found the temporal limitation obvious—with or without its expert's testimony—does not establish a *prior art* basis for a challenge that supports institution. *See* § 322(a) and Rule 204(b)(4).<sup>8</sup> Second, after recognizing that the Office found the temporal limitation lacking in the prior art, the Petition states that the Examiner did not "consider the combination of Brockhouse and Nadaf." *See* Petition, 66-67. This is incorrect; as shown above, the Examiner fully considered Brockhouse and Nadaf, including in combination, and neither teach as much.<sup>9</sup>

---

<sup>8</sup> *Cf.* EX2009, Permissible Use Memo (Director requiring the Board to deny an IPR petition that relies on evidence that is not prior art to supply a missing claim limitation based on the analogous provisions of § 312(a)(4) and Rule 104(b)(4)).

<sup>9</sup> Examiner has explicitly confirmed that Brockhouse does not teach a comparison much less a timing thereof and that any comparison of Nadaf does not provide the temporal limitation. *See, e.g.,* EX2003, 386 ("Brockhouse does not teach comparing the first data set to [the] second data set..."); EX2006, 78 ("Nadaf fails to teach or fairly suggest comparing the first data set and the second data set before providing a

Finally, the Petition introduces Schneier and vaguely references it in discussion of the claim element that includes the temporal limitation. But Schneier says nothing about the temporal limitation the Office has already found missing from the other references of the Grounds. The Petition’s analysis contrives a few citations to Schneier’s disclosure at pages 30-31. *See* Petition, 66-70. However, none of these citations supplies the missing temporal limitation. Instead, the cited portion of Schneier simply describes a known cryptography technique of a “hash function” that can be computed over two instances of data to see if they are the same. *See* Petition, 68 (*citing* EX1017, 30-31). The Petition already relies on Nadaf as teaching a comparison of data sets. *See* Petition, 64-65 (alleging that Nadaf teaches the “comparing the first data set to [the] second data set” claim element). Even if Schneier also describes a technique for comparison that says nothing about the missing temporal limitation. It is lacking with or without Schneier.

The Petition casts Schneier’s use case for hash comparison in a financial context as a disclosure that comparison can be used to confirm accuracy “at any time.” *See* Petition, 68 (*citing* Schneier, 31). This is incorrect. Schneier is devoid of any description of a time at which its comparison is performed. Instead, the relied-

---

cast vote record...” (emphasis in original). Nadaf’s “comparison” occurs at a very different time—in a later audit function long after the claimed CVR is created.

upon portion explains:

...[i]f you want to verify that someone has a particular file [that you also have], but you don't want him to send it to you, then ask him for the hash value. If he sends you the correct hash value, then it is almost certain that he has the file. This is particularly useful in financial transactions, where you don't want a withdrawal of \$100 to turn into a withdrawal of \$1000 somewhere in the network.

EX1009, 31. This passage—like the rest of Schneier—says nothing about performing hash function comparison “at any time.”<sup>10</sup> Not wanting an error “somewhere in the network” merely recognizes a risk to transmission of a file in a financial network. It says nothing about *when* two data sets are compared, especially in the context of CVR generation from OCR of an electronically captured printed vote record (PVR), as claimed.<sup>11</sup> At bottom, the Petition identifies no prior art that provides the temporal

---

<sup>10</sup> Petitioner's expert summation that a hash function “can be used at any time” may go to expectation of success, but it is not a prior art teaching of the temporal limitation. The Petitioner's expert cites to Schneier pages 30-31 (Ex. 1003, ¶223 citing “Ex. 1009 at 30-31.”). These pages provide no such teaching. *See also*, EX1003, ¶257 (conclusory statement of Schneier's teachings without *any* attempt to cite to Schneier or other evidentiary support).

<sup>11</sup> Petitioner includes two (2) pages of Schneier on “secure elections” that discuss

limitation of the '319 claims, and it should be denied because, consistent with the Permissible Use Memo, the requirement of § 322(a)(4) is not met. *See supra* at n.8.

**C. Workload Memo supports discretionary denial.**

**1. The merits of the Petition are weak.**

Petitioner's § 101 arguments are weak: A proper analysis for determining patent eligibility is the two-step *Alice* framework, and the Office has indicated that the first step (Step 2A) requires a determination under both Prong One and Prong Two thereof. As discussed above, despite analysis of eight (8) applications leading to seven issued patents and a PGR, the Office has yet to find that any claims of the '319 patent family recite ineligible subject matter. Petitioner's rehashed arguments fare no differently here.

Moreover, as detailed in the POPR to follow, the Petition's § 101 arguments are substantively flawed, particularly when considered in light of the Deputy Commissioner for Patent's recent guidance (101 Memo) on subject matter analysis under Step 2A.<sup>12</sup> The Petitioner's assertion that "these claim elements—OCR'ing the

---

encrypting a vote for transit, which does not even address a comparison of different data sets much less the temporal element.

<sup>12</sup> *See* EX2002, 101 Memo, 2 (noting that "courts consider a mental process (thinking) that 'can be performed in the human mind, or by a human using a pen and paper,' to

PVR and confirming the accuracy of the PVR—are steps that can be performed in the human mind” (Petition, 34) is facially incorrect. And the 101 Memo specifically cautions against expanding the mental process grouping “in a manner that encompasses claim limitations that cannot practically be performed in the human mind.” *Id.*, 2-3; *see also ex parte Desjardins*, Appeal No. 2024-000567, Decision on Rehearing, 7-9 (PTAB Sep. 26, 2025) (Director Squires vacating 101 rejection and emphasizing “integrat[ion] into a practical application”). Accordingly, the Petition’s argument that ’319 claims recite ineligible subject matter under § 101 is weak, and discretionary denial is appropriate.

Petitioner’s § 112 arguments are moot: Regarding Ground 3 (written description), the challenged claims were part of the originally filed application No. 18/381,091 that led to the ’319 patent. EX1002, 20-27. *See in re Koller*, 613 F.2d 819, 823-24 (CCPA 1980) (original claims self supporting). Nonetheless, to simplify issues before the Board, Patent Owner has disclaimed the claims challenged under Ground 3, while reserving the right to reissue with claim language unambiguously

---

be an abstract idea.”) (internal citations omitted). But the claims at issue are not of this character—they include electronically capturing information and using optical character recognition (OCR) on the electronically captured information. Such steps are not performed in the human mind, or by a human using a pen and paper.

supported as of the very earliest filing date. EX2008. Ground 3 is therefore moot.

Petitioner's § 103 arguments are weak: Rule 42.204(b)(4) states that a petition for post grant review “must specify where each element of the claim is found in the prior art.” As detailed above, the Petition fails to do so and is weak for at least this reason. Discretionary denial is appropriate for this reason as well.

**2. The '319 patent family is entitled to settled expectations.**

As discussed above, the '319 patent claims priority through a chain of applications including the '966 patent, the claims of which were canceled by the prior PGR. Patent Owner accepted that decision by the PTAB. With full disclosure of the Board's decision and of all of the Petitioner's art and arguments, Patent Owner engaged with the Office to narrow the scope of its claims through numerous continuation applications. Patent Owner did everything correctly in pursuing its inventions before the Office, and in doing so has developed settled expectations that its patents will not be subject to continued, repetitive challenges by Petitioner raising the same questions. Discretionary denial is appropriate for this reason as well.

**3. The Petition relies heavily on expert testimony.**

Petitioner's § 103 challenges rely heavily on expert testimony discussing what constitutes the relevant knowledge of a POSITA and how a POSITA would have been motivated to make its three or four reference combinations. Most tellingly, with reference to the temporal limitations added during post-PGR prosecution, the Petition

relies not on any demonstrated teaching in the prior art but instead relies *solely* on expert testimony. Petition, 70 (*citing* EX1003, ¶¶262-63 (expert discussing hash conventionality and Nadaf)). In other words, the Petitioner relies upon its prior art references—Schneier and Nadaf—as providing a hash or comparison but turns *only* to its expert for unsupported assertions regarding *when* such a comparison is performed. This is the very limitation that the Patent Office found to be a non-obvious enhancement in the context of generating a cast vote record (CVR) to be stored as the final vote selections and to be used for vote tabulation. Petitioner's over-reliance on the expert testimony is not only improper under Rule 204(b)(4) but also supports discretionary denial under the factors set forth in the Workload Memo.

#### **IV. Conclusion**

Extensive Office resources have already been expended in the review of the same questions the Petitioner raises here. Prosecutions of the application that led to the '319 patent—and four other issued continuation patents of the family—have considered the art and arguments raised here. It would be inefficient use of the Board's resources to ignore the work already done and revisit the same issues, particularly where (as here) the very limitation recognized by the Examiner as missing from the prior art remains missing in the Petition. Thus, for the reasons detailed herein, Patent Owner respectfully requests that the Director exercise her discretion to deny this petition.

Respectfully submitted,

Date: September 30, 2025  
HAYNES AND BOONE, LLP  
2801 N. Harwood Street, Ste 2300  
Dallas, Texas 75201

/David W. O'Brien/  
David W. O'Brien, Reg. No. 40,107  
Lead Counsel for Petitioner

**CERTIFICATE OF SERVICE**

The undersigned certifies that, in accordance with 37 C.F.R. §42.6(e) and 37 C.F.R. §42.105, service was made on Petitioner as detailed below.

Date of service: September 30, 2025

Manner of service: Electronic Service: [revans@lewisrice.com](mailto:revans@lewisrice.com)  
[mhartley@lewisrice.com](mailto:mhartley@lewisrice.com)

Documents served: **PATENT OWNER'S BRIEF IN SUPPORT OF  
DISCRETIONARY DENIAL; EXHIBITS  
EX2001-EX2009**

Persons served: Robert M. Evans, Jr.  
Michael J. Hartley  
LEWIS RICE LLC  
600 Washington Avenue, Suite 2500  
St. Louis, MO 63101

/David W. O'Brien/

David W. O'Brien, Reg. No. 40,107  
Lead Counsel for Petitioner