UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ELECTION SYSTEMS & SOFTWARE, LLC
Petitioner,

v.

HART INTERCIVIC, INC,
Patent Owner.

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

PATENT OWNER'S AUTHORIZED REPLY TO PETITIONER'S OPPOSITION TO DISCRETIONARY DENIAL

PATENT OWNER'S EXHIBIT LIST

EX2001	Memorandum, Interim Processes for PTAB Workload Management (Acting Director Stewart, March 2, 2025) retrieved from https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf ("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 https://www.uspto.gov/sites/default/files/documents/memo-101-20250804.pdf ("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 https://www.uspto.gov/sites/default/files/documents/aapa_memo_final__signed.pdf ("Permissible Use Memo")
EX2010 (new)	**April 9, 2019 Letter from Tom Burt to Senators Klobuchar, Peters, Reed, and Warner**

Petitioner's assertion that PO mischaracterized the contents of Petitioner's 2019 Letter during prosecution of the '319 patent family (see Paper 7, 10-12) is wrong and unsupported by the record. The letter in question, signed by Mr. Tom Burt, President & CEO of Petitioner, was addressed to Senators Klobuchar, Peters, Reed, and Warner of the United States Senate ("Letter") and is provided here as Exhibit 2010. As explained below, PO accurately quoted the Letter's contents. Any alleged "characterization" by PO during the prosecution of the '319 patent family was entirely faithful to the actual language of the Letter and, although presented in a different context than in the '966 PGR, was consistent with the findings of the Board in that proceeding. Furthermore, the Examiner was fully apprised of the Letter, and her treatment of it was entirely consistent with the Board's findings in the '966 PGR FWD. There is no mischaracterization, no inconsistency, and no error.

I. Patent Owner's quotations from the Letter are entirely factual.

PO's quotation from the Letter was entirely factual and faithful to the Letter's text. Petitioner points to a quotation included in PO's Office Action responses for the '319 patent family. *See* Paper 7, 11 (citing four prosecution histories: EX2003, EX2004, EX2006, EX2007). In each instance, PO's statements accurately reflected the Letter's content. Specifically, PO stated that Petitioner asserted in the Letter that "no voting system could 'use OCR to read [a candidate's name] and record a vote reliably[.]' Exhibit 2, p. 6." EX2003, 324-325; EX2004, 306-307; EX2006, 593;

EX2007, 339 (brackets in original quotations from Letter, Exhibit 2 providing Letter). This is a direct and accurate quotation from the Letter, with only a fictious name replaced in the original text. *Compare* EX2010, 6 ("Even tabulation systems that utilize Optical Character Recognition (OCR) incorporate the use of a barcode to count the vote.… The system cannot use OCR to read 'Jane Doe' and record a vote reliably because it would have to know for what race the vote for 'Jane Doe' should be counted. Thus, the barcode is used to tell the tabulation machine for what race Jane Doe should receive a vote.").[1] There is no misrepresentation.

Instead, PO's quotation recognizes the thrust of the Letter's representation that no system uses OCR to *both* read a candidate's name *and* record a vote from it. Indeed, the Letter argues that all tabulation systems, even those that use OCR, rely on a barcode to determine how to count the vote. EX2010, 6 ("all tabulation machines that count paper ballots use a barcode to determine how to properly and accurately count the vote."). That is exactly how the Board characterized the Letter during the

[1] As demonstrated by the Letter itself, the quotation is from Petitioner's response to Question 8 regarding risks of ballot marking machines that store voter choice information in non-transparent forms that cannot be reviewed by voters (i.e., such as barcodes or QR codes), noting that errors in the printed vote record could potentially evade detection by voters. EX2010, 5-6.

'966 PGR. *See* '966 PGR, FWD, 25 (Board finding that "ES&S's response [in the Letter] explains that barcodes can be used to determine how to count the vote after a name is recognized by OCR."). There is no inconsistency.

II. The Letter was raised in the context of secondary considerations, which were not at issue in the prosecution of the '319 patent or its predecessors.

The context in which the Letter was discussed in the '966 PGR is different from its use during the prosecution of the '319 patent family. In the '966 PGR, PO raised the Letter as evidence of secondary considerations of non-obviousness specifically related to claims reciting an "election dictionary." The Board found that unpersuasive, explaining that the Letter did not support the notion that "OCR could not be relied on in voting machines" as the prior art (Brockhouse) included OCR.[2] EX1015, '966 PGR FWD, 25, 33. The Board concluded that the Letter did not demonstrate skepticism or that the "election dictionary" claimed in the '966 patent solved a known problem where others had failed to do so.

Petitioner now attempts to conflate the Board's findings in the '966 PGR arguments with PO's quotation from the Letter during the prosecution of the '319

[2] Whether this characterization of PO's arguments is correct is moot here. As the Board itself opined, Brockhouse disclosed OCR "*as an alternative* to decoding vote selection barcodes." *Id*., 33 (emphasis in original).

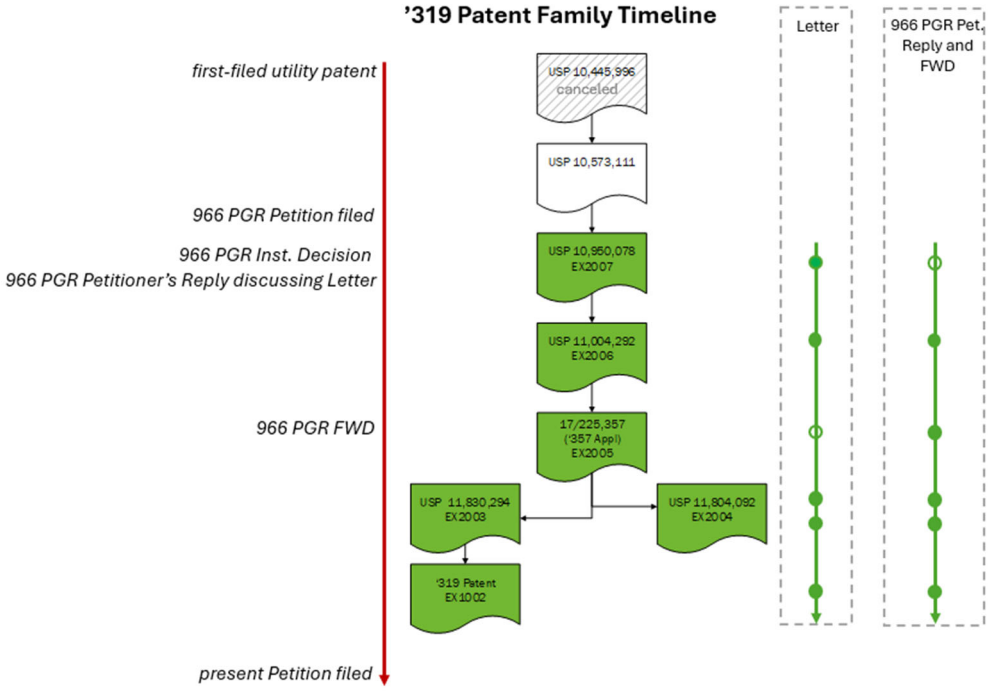
patent. However, PO did not raise any argument regarding secondary considerations during prosecution of the '319 patent or its predecessors (other than the '966 PGR itself).[3] The Examiner did not discuss or rely on any objective indicia of non-obviousness, nor did she withdraw any rejection based on secondary considerations. Instead, the Examiner's evaluation was entirely consistent with the Board's findings in the '966 PGR—neither relied on the Letter as persuasive evidence of skepticism or any other objective indicia of non-obviousness. There is no inconsistency.

III. The Letter, in its entirety, was presented to the Office in the prosecution of the '319 patent and its predecessors.

During prosecution of the '319 patent and its predecessors, the Examiner was fully informed of the Letter. The complete text of the Letter has been presented to the Office in each prosecution after the '966 PGR leading to patent. *See* EX2003, 302-310; EX2004, 285-293; EX2006, 346-354; EX2007, 59-67. The Examiner also had before her Petitioner's arguments related to the Letter and the Board's characterization in the '966 PGR as each came available. *See* EX2006, 9 (considering '966 PGR Petitioner's Reply, which discusses Letter); EX2005, 39; EX2004, 395;

[3] PO provided the quote from the Letter in a "Disclosed Technology" section of its responses explaining the "difficult[y]" of using OCR in cast vote record (CVR) process of voting. *See,* EX2003, 324; EX2004, 306-307; EX2006, 593; EX2007, 339.

EX2003, 411; EX1002, 242; EX2007, 11 (unsigned SB/08).



Petitioner provides no evidence that the Examiner erred in her consideration of the Letter, a proposition that is belied by the fact that Examiner's reliance on the Letter—or more accurately, lack thereof—is exactly the same as the Board in the '966 PGR. There is no error.

IV. Conclusion.

PO presented an accurate quotation from the Letter in both the '966 PGR and during the prosecution of the '319 patent family. The Board found the Letter unpersuasive as evidence of secondary considerations and did not rely on it. The Examiner did not rely on the Letter as evidence either. There is no mischaracterization, no inconsistency, and no error.

Respectfully submitted,

Date: November 10, 2025

/*David W. O'Brien*/

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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:	November 10, 2025
Manner of service:	Electronic Service: revans@lewisrice.com mhartley@lewisrice.com
Documents served:	**PATENT OWNER'S AUTHORIZED REPLY TO PETITIONER'S OPPOSITION TO DISCRETIONARY DENIAL**; and **EX2010**
Persons served:	Robert M. Evans, Jr. Michael J. Hartley LEWIS RICE LLC 600 Washington Avenue, Suite 2500 St. Louis, MO 63101

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