

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMPASS BANK, AMERICAN EXPRESS COMPANY, AMERICAN EXPRESS
TRAVEL RELATED SERVICES COMPANY, INC., DISCOVER FINANCIAL
SERVICES, DISCOVER BANK, DISCOVER PRODUCTS INC., NAVY FEDERAL
CREDIT UNION, AND STATE FARM MUTUAL AUTOMOBILE INSURANCE
COMPANY

Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.

Patent Owner.

Case No. To Be Assigned

Patent No. 6,105,013
SYSTEM FOR COMMUNICATING
DATA SECURELY

DECLARATION OF PETER ALEXANDER, PH.D.

Table of Contents

I.	QUALIFICATIONS	1
II.	MATERIALS CONSIDERED	3
III.	LEVEL OF ORDINARY SKILL AND RELEVANT TIME	4
IV.	LEGAL STANDARDS	5
	A. Anticipation.....	5
	B. Obviousness	5
V.	OVERVIEW OF THE '013 PATENT	6
VI.	CLAIM CONSTRUCTION.....	14
	A. “microcontroller based secure transaction integrated circuit” and “secure transaction integrated circuit”	15
	B. “modular exponentiation accelerator circuit...for performing encryption and decryption calculations”	15
	C. “script programming language”	16
	D. “transaction groups”	19
VII.	CERTAIN REFERENCES DISCLOSE OR SUGGEST ALL OF THE CLAIMED FEATURES OF THE '013 PATENT.....	19
	A. Prior Art Overview	19
	1. The Sudia Reference (Ex. 1005).....	19
	2. The Hawkes Reference (Ex. 1006).....	21
	3. The Axelson Reference (Ex. 1007).....	25
	4. The Lancaster Reference (Ex. 1008)	25
	5. The Lee Reference (Ex. 1009).....	26
	B. Sudia Renders Obvious Claims 1-4, 6-12 and 14-16 of the '013 Patent Under 35 U.S.C. § 103.....	26
	1. Motivation to Combine.....	26
	2. Claim Chart.....	30
	C. Hawkes Renders Obvious Claims 1-4, 6-12, and 14-16 of the '013 Patent Under 35 U.S.C. § 103.....	46
	1. Motivation to Combine.....	46
	2. Claim Chart.....	48
	D. Claim 5 is Obvious Under 35 U.S.C. § 103 in Light of Hawkes or Sudia Alone or in Combination with One or More of Axelson or Lancaster	62
	E. Hawkes and/or Sudia and Lee Render Obvious Claim 13 Under 35 U.S.C. § 103.....	65
	1. Motivation to Combine.....	65
	2. Claim Chart.....	66
VIII.	CONCLUDING STATEMENTS	69

I, Peter Alexander, declare and state as follows:

1. The petition names Compass Bank, American Express Company, American Express Travel Related Services Company, Inc., Discover Financial Services, Discover Bank, Discover Products Inc., Navy Credit Federal Credit Union, and State Farm Mutual Automobile Insurance Company as real parties-in interest. I have been retained by American Express Company, American Express Travel Related Services Company, Inc., Compass Bank, Discover Financial Services, Discover Bank, Discover Products Inc., Navy Credit Federal Credit Union, and State Farm Mutual Automobile Insurance Company (collectively “Petitioners”) as an expert witness in this case to offer my opinions on U.S. Patent No. 6,105,013 (“the ’013 Patent”). I am being retained at my customary rate of \$525/hour. I have no financial interest in, or affiliation with, the Petitioners, real parties-in-interest, or the patent owner, which I understand to be Maxim Integrated Products, Inc. My compensation is not dependent upon the outcome of the present covered business method patent review or any related litigation proceedings.

2. As preparation for forming opinions expressed in this declaration, I reviewed the ’013 Patent prosecution history, specification and claims, and the materials discussed below.

I. QUALIFICATIONS

3. My academic credentials include a Ph.D. from the Massachusetts Institute of Technology in Electrical Engineering, a Masters degree from the University of Illinois (Urbana) in Electrical Engineering, and a Bachelors degree in Electrical Engineering from the University of Canterbury (New Zealand). My Curriculum Vitae, attached separately as Ex. 1022 to the Petition, lists my prior engagements where I have testified as an expert witness for at least the last 4 years, and a list of my publications authored in at least the last 10 years.

4. My academic degrees are all in Electrical Engineering. While undertaking my Doctorate work at MIT I worked in the Research Lab. for Electronics that has for decades contributed to basic research in information theory, coding, and statistical estimation theory. My Ph.D. thesis was in the field of statistical estimation theory as applied to communications systems.

5. As indicated in my Curriculum Vitae, my experience in computer technology design and development spans more than 35 years. I have been a designer of computer systems for processing, storage and display of data since 1974. In the 1970s, I worked with, among others, products in Intel’s various lines of microprocessor and microcontrollers. In the first few years I was a university professor teaching graduate and undergraduate electrical engineering courses - including the design and programming of computers. Along with a group of young graduate students I developed a microprocessor system for industrial control applications in 1974 using the Intel 4004 CPU chip as the base component.

6. When I entered the computer industry in the mid-1970s I developed special software and custom hardware systems for government agencies such as the Defense Communications Agency, Naval Research Labs, and National Security Agency. For most of that period I held a Secret security clearance and programmed microprocessor computers for use in defense systems. Typically these systems were used for radar and sonar systems deployed by the military. My design efforts involved both software and computer hardware architecture and involved custom hardware implementations using commercial CPU and digital signal processing (“DSP”) chips.

During this phase I developed many systems based on commercial microprocessor and DSP chips from Motorola, Intel and Texas Instruments.

7. My contract work with the DSP systems developed for the National Security Agency resulted in the commercialization of a high speed computer system. During the 1980s I founded a company that sold these high performance machines as commercial products, a company called Numerix Corporation. I formulated the system design and programmed a significant portion of the application software that ran on the machines. During this decade I was also spearheading efforts to migrate the discrete integrated circuits (“IC”) hardware implementations into gate arrays – a form of custom chip that was in vogue during that time period. I was the chief architect of the systems that we built and personally formulated all the key bus, memory and processor interconnections. At that time I had roughly 20 hardware engineers and 30 software engineers reporting to me.

8. The high-performance processor products were sold to companies like Standard Oil of Ohio in Dallas, Texas to process seismic field data collected for oil exploration as well as to US government agencies as commercial off-the-shelf products. For example, some of our systems provided processing for sonar systems used to track Soviet submarines in the Pacific Ocean. Others were used in military radar systems for missile tracking by RCA. Numerix Corporation was acquired in 1989 by a Boston company called Mercury Computer Systems that continues to sell digital signal processing solutions to US government agencies.

9. In the mid-1990s I focused my career more on business-oriented software development. For example I directed the efforts of approximately 100 software developers and Quality Assurance personnel while employed at Platinum Software in the mid to late 1990s. The software systems were “client-server” business applications such as finance, manufacturing and sales force automation. At that time those applications were being adapted to web server implementations in order to allow our customers to access the same content through a web browser running on a client computer.

10. Then in the period 1999-2003 I was responsible for teams of 50 or more web site developers at companies such as CareerPath.com (now merged with the CareerBuilder.com site). As such I have had a rich and in-depth exposure to many forms of computer applications involving the display of web pages on client computers. My work in web site design led to a hands-on knowledge of cryptographic systems for secure access and user authentication. My experience in this domain results from having designed and created two different commercial web sites that required extensive engineering effort to support secure e-commerce transactions. For example while running a development team of about 15 people at InfrastructureWorld.com as Chief Technology Officer I engineered a hardened web site that provided extraordinary levels of security for the high-dollar business transactions. The web server implementations were designed to support authentication through Public Key certificates, user access control via authenticated account login, Secure Sockets Layer (“SSL”) extranet connections, and document encryption.

11. Similarly, while at Syntricity, Inc. in San Diego, CA as Vice President, Technical Operations, I designed and developed a secure Application Services Provider (ASP) Internet system to host a hundred or so corporate customers, allowing them secure access to tools for

transfer of data files and analysis of semiconductor yield data. This web site used secure FTP for high-speed data transfers, SSL for secure web site access, and user authentication.

12. In addition I have served as a technical expert in several contract and patent lawsuits involving cryptographic components. Briefly, these include Dongjin Semichem Co., Ltd. v. EmailFund, Inc., which involved an effort to implement wireless security software technology in handheld wireless devices. The concept was to use the Elliptic Curve Digital Signature Algorithm (ECDSA) to perform the functions of user authentication, non-repudiation, integrity and cryptographic primitives in a single integrated circuit that could be integrated into a smart phone. I have also contributed as a technical expert in cases such as: Adobe Systems, Inc. v. Wowza Media Systems, Inc. that involved Diffie-Hellman key exchange for flash media delivery; VirnetX Inc. v. Cisco Systems, Inc. and Apple Computer, Inc. that involved the SSL protocol, IPSec Internet packet encryption, Public Key cryptography authentication and encryption techniques using Digital Certificates; and, Leon Stambler v. Amazon.com, Inc., et al. that involved Point of Sale authentication systems in the early 1990s.

13. In those efforts I frequently relied on documents referred to or directly related to those used to support this petition, namely Diffie-Hellman key exchange and the Diffie-Hellman U.S. Patent 4,200,770 from 1977 (“DH Key Exchange”), the Rivest Shamir Adleman (“RSA”) U.S. patent 4,405,829, also from 1977, and numerous documents and books published by Price and Davies, the British POS terminal authentication pioneers.

14. In summary, I believe I am qualified to testify on the subjects of secure financial transactions and the implementation of cryptographic applications such as authentication, non-repudiation, and message integrity programmed into physical devices such as smart cards and tokens using microprocessors or application specific ICs.

II. MATERIALS CONSIDERED

15. I have reviewed each of the following:

- a. U.S. Patent No. 6,105,013 (“the ‘013 Patent”) entitled “Method, apparatus, system and firmware for secure transactions” issued to Stephen M. Curry et al on August 15, 2000, including the claims, description and prosecution history (which are identified in the Petition respectively as Exhibits 1001 and 1002);
- b. U.S. Patent No. 6,237,095 (“the ‘095 Patent”), which is related to the ‘013 Patent and claims priority to the same application as the ‘013 Patent, including the claims, description and prosecution history of the ‘095 Patent (Exs. 1003 and 1004);
- c. U.S. Patent No. 5,799,086 entitled “Enhanced cryptographic system and method with key escrow feature” to Frank Wells Sudia issued on August 25, 1998 from an application filed on January 13, 1994 (Ex. 1005; hereinafter, “Sudia”);
- d. Integrated Circuit Cards, Tags, and Tokens by P.L. Hawkes, et al. (1990) (Ex. 1006; hereinafter “Hawkes”), which includes:
 - i. *Preface* by P.L. Hawkes (hereinafter, “Hawkes Preface”);

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.