UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNITED SERVICES AUTOMOBILE ASSOCIATION,
Petitioner

v.

NADER ASGHARI-KAMRANI and KAMRAN ASGHARI-KAMRANI,
Patent Owners

U.S. PATENT NO. 8,266,432
Case CBM2016-00064

PATENT OWNER'S EVIDENTIARY OBJECTIONS UNDER 37 C.F.R. § 42.64(b)

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United States Patent and Trademark Office
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Pursuant to 37 C.F.R. § 42.64(b), Patent Owner hereby objects as follows to ¶¶ 27-115 of Exhibit 1003, and ¶¶ 27-35 of Exhibit 1050 under Fed. R. Evid. 701/702/703. In particular, Exhibits 1003 and 1050 include opinions that are not admissible under FRE 701, 702, or 703, or *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579 (1993).

I. Person of Ordinary Skill in the Art

Mr. Nielson's definition of one of ordinary skill in the art is *legally* incorrect.

35 U.S.C. 103(a) (pre-AIA) states:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious *at the time the invention was made to a person having ordinary skill in the art* to which said subject matter pertains. (emphasis added).

Mr. Nielson states: "I believe that a person having ordinary skill in the art at the effective filing date of the '432 Patent ("PHOSITA") would have had a Bachelor of Science Degree in Electrical Engineering, Computer Engineering, or Computer Science with related work experience." Ex. 1003 at ¶ 26; Ex. 1050 at ¶ 26.

Since the pre-AIA 35 U.S.C. 103(a) applies to the '432 patent, the PHOSITA must have been defined at the time the invention was made. It is undisputable that the claimed invention of the '432 patent was made prior to *August 29, 2001* because the disclosure of the '926 application (the '432 patent) is identical to that of the '635 application (the '837 patent). Further, he admits that "I have applied a date of September 15, 2008, as the date of invention in my obviousness analyses." Ex. 1003 at ¶ 118.

Here, Mr. Nielson's definition of a PHOSITA is legally defective, and his application of September 15, 2008 as the date of invention of the '432 patent is a *critical error of fact and law*, and therefore his testimony on the obviousness of the claims of the '432 patent as presented in Exhibit 1003 should be excluded. Further, his testimony in ¶¶ 27-35 of Exhibit 1050 should be excluded.

Further, he states that "I have been informed that a patent claim is invalid as anticipated … if each and every element … and that the single reference enables the claimed invention to a PHOSITA." Ex. 1003 at ¶ 116.

Since he also analyzed the anticipation rejection based on the incorrect definition of PHOSITA, his testimony on the anticipation of the claims of the '432 patent as presented in Exhibit 1003 should be excluded.

Finally, Mr. Nielson failed to prove that he qualifies as a PHOSITA. He states that "I received a B.S. in Computer Science in 2000." *Id*. at ¶ 2. By his own definition, a PHOSITA would have had a Bachelor of Science Degree in Computer Science *with* related work experience. He failed to show that he had any related work experience prior to September 15, 2001, although he received a B.S. in Computer Science in 2000, and he stated that he worked as a software engineer at Metrowerks (formerly Lineo, Inc.) from 2001 through 2003. *See Id*. at ¶ 7. It was not specified when, after or before September 15, 2001, he started to work at Metrowerks, and moreover his work in 2001 at Metrowerks was not related to the authentication technology of the Internet users as claimed in the '432 patent. Thus, he failed to sufficiently show that he qualifies as a PHOSITA.

For the foregoing reasons, his testimony in ¶¶ 27-115 of Exhibit 1003 and ¶¶ ¶¶ 27-35 of Exhibit 1050 should be excluded.

II. Discussion of Priority Application

The test for determining compliance with the written description requirement is whether *the original disclosure of the prior-filed application* reasonably would have conveyed to a person having ordinary skill in the art that the inventor had possession of the claimed subject matter at the time of the prior-filed application's filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co*., 598 F.3d

1336, 1351 (Fed. Cir. 2010) (en banc); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

Mr. Nielson states: "Counsel has advised me that, for this claim of priority to be proper, the specification of the '676 Patent must support the '432 Patent's claims." Ex. 1003 at ¶ 37. In paragraphs 37-64, he consistently compared *the specification of the '676 patent* with the claims of the '432 patent.

Mr. Nielson's analysis on the priority date of the '432 patent was based on this incorrect legal standard, and therefore it is submitted that his testimony in ¶¶ 37-64 should be excluded.

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