UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Bank of America, N.A.,
Petitioner

v.

Nant Holdings IP, LLC,
Patent Owner

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Case No. IPR2021-01080
U.S. Patent No. 8.463,030

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PATENT OWNER'S PRELIMINARY SURREPLY

Pursuant to the Board's email of October 14, 2021, Patent Owner Nant Holdings IP, LLC ("Patent Owner") submits this Preliminary Surreply to the Preliminary Reply (Paper 12) filed by Bank of America, N.A. ("Petitioner").

Patent Owner established in its preliminary response that Ogasawara's "advanced pattern recognition software" is not an enabling disclosure and cannot constitute anticipatory prior art. In its Reply, Petitioner argues that Ogasawara enables the advanced software because a POSITA would understand that Ogasawara's non-advanced software for identifying barcodes "works the same" as the advanced software that recognizes objects. Yet this is contradicted by Ogasawara's own disclosure and, moreover, Petitioner provides no explanation for how a POSITA could apply bar code identification to the recognition of objects. Petitioner also argues that Bolle would inform a POSITA's understanding of Ogasawara, yet Bolle's system uses a separate computer for recognition, which would not have enabled Ogasawara's advanced software that runs on a "wireless videophone."

I.   OGASAWARA'S DISCLOSURE IS NOT ENABLED

For a prior art reference to anticipate a claim, "***the reference*** must necessarily enable the relied-upon portion of its own disclosure." *Raytheon Techs. v. General Electric Co.*, 993 F.3d 1374, 1382 (Fed. Cir. 2021) (emphasis added). In other words, the reference must be "self-enabling." *Id.*

at 1380. An enabling disclosure "must teach[] one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation." *Elan Pharmaceuticals v. Mayo Foundation*, 346 F.3d 1051, 1054 (Fed. Cir. 2003).

Patent Owner's expert, Dr. Bajaj, testified that Ogasawara's scant, 19-line mention of an "[a]dvanced pattern recognition software" is not an enabling disclosure. Ex. 2002 at ¶¶31-34. Ogasawara only describes such software in terms of its capabilities—that it can capture items "not identified by either a bar code or an alpha-numeric label" if they have "a distinct or identifiable shape or other visually identifiable characteristic." Ex. 1005 at 23:14-19. However, Ogasawara simply does not "provide any detail as to what this software is, how it operates, or what its capabilities and limitations may or [may] not be." *Id.* at ¶30; *see* Ex. 1001 at 23:12-21. This testimony remains unrebutted.

Petitioner incorrectly asserts that "neither Patent Owner nor Dr. Bajaj address any of the *Wands* factors." Reply at 4. To the contrary, Dr. Bajaj's testimony provided evidence relevant to *Wands* factors 1-5. Dr. Bajaj's testimony that Ogasawara does not "provide any detail as to what this software is, how it operates, or what its capabilities and limitations may or [may] not be" speaks directly to *Wands* factors 2 and 3. Ex. 2002 at ¶30; *see also id.* at

¶33 ("Ogasawara's only substantive description of this purported software is couched in terms of its limitations, noting that the software only functions when an object contains a highly 'distinct or identifiable shape or other visually identifiable characteristic.'"). Dr. Bajaj further testified that "a POSITA would have understood that image processing technology was not yet sophisticated enough to engage in true object *recognition regardless of irregularities in the object, lighting, field of view, or viewing geometry as described as claimed* by the '030 patent," which is relevant to *Wands* factors 1, 4 and 5. *Id.* at ¶32.

By contrast, Petitioner only addressed *Wands* factors 2 and 5. And, as discussed below, Petitioner's treatment of these factors simply fails to establish enablement.

II. PETITIONER FAILS TO ESTABLISH ENABLEMENT

Petitioner raises two arguments in its claim that Ogasawara's advanced recognition software is an enabling disclosure. Petitioner first claims that "Ogasawara's '[a]dvanced pattern recognition software' works the same way as, and is thus enabled by, its disclosures that identify an object using a barcode." Reply 3 (quoting Pet. at 17-18 and citing Ex. 1003 at ¶¶70, 84-85, 127). Yet this is in direct contradiction to Ogasawara's teaching that its "[a]dvanced pattern recognition software" is for identifying "items that are

not identified by either a bar code or an alpha-numeric label." Ex. 1005 at 23:14-15. If Ogasawara's bar code identification "works the same way" as Ogasawara's advanced pattern recognition software, there would simply be no need for the latter.

Moreover, Ogasawara's disclosure of an identification of a bar code cannot so simply be applied to the recognition of objects. POPR at 48-51. Indeed, neither the petition nor Dr. Rodriguez's declaration explain how Ogasawara's system recognizes bar codes, much less how such recognition could be applied to Ogasawara's advanced pattern recognition. Ogasawara merely states that "[o]nce the bar code image has been captured, the program decodes the bar code image data to its corresponding numeric bar code data, by operating on the bar code image with pattern recognition software" with zero explanation as to how such software operates. Ex. 1005 at 21:17-20.

Dr. Rodriguez's testimony adds nothing of substance. Dr. Rodriguez merely opines that the advanced software may "us[e] a look-up table or file to associate the visually identifiable characteristics to a corresponding product," but otherwise provides no explanation for how such software uses such a table to *recognize* an object like an apple. Ex. 1003 at ¶85.

Petitioner next argues that "Dr. Rodriguez also explained how Bolle … would inform a POSITA's understanding of Ogasawara." Reply 3-4 (citing

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