UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CPC PATENT TECHNOLOGIES PTY, LTD.,
Patent Owner.

Case IPR2022-00600
U.S. Patent No. 8,620,039

PRELIMINARY PATENT OWNER'S RESPONSE

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I. Introduction

Petitioner, Apple Inc. ("Apple") offers up a single obviousness challenge ground for claims 1, 2, 19 and 20 of U.S. Patent No. 8,620,039 ("the '039 Patent") over the primary Bradford reference in view of Foss, and in further view of Yamane. Apple's challenge relies upon a fundamental misreading of the teachings of its primary Bradford reference – a reference that fails to teach the limitation "defining, dependent upon the received card information, a memory location in a local memory external to the card" where a "biometric signature" is to be stored. Indeed, Bradford teaches away from that limitation insofar as it teaches only a limited use of a card that does not include defining memory locations for other data. Given the absence of any teaching of this limitation, which appears in each challenge claim, Apple's Petition must fail at the institution stage.

II. The References in the Single Challenge Ground Fail to Teach the "Dependent Upon the Received Card Information"

Of the four challenged claims of the '039 Patent, claims 1 and 19 are the independent method and apparatus claims, respectively. Both claims require, *inter alia*: 1) defining, dependent upon the received card information, a memory location in a local memory external to the card; 2) determining if the defined memory location is unoccupied; and 3) storing, if the memory location is unoccupied, the biometric

signature at the defined memory location. *See* Ex. 1001, claims 1 and 19. The following shows a comparison of those two independent claims (emphasis added):

Claim 1	**Claim 19**
A method of enrolling in a biometric card pointer system, the method comprising the steps of:	A non-transitory computer readable medium having recorded thereon a computer program for directing a processor to execute a method of enrolling in a biometric card pointer system, the program comprising:
receiving card information;	code for receiving card information;
receiving the biometric signature;	code for receiving the biometric signature;
defining, ***dependent upon the received card information***, a memory location in a local memory external to the card;	code for defining, ***dependent upon the received card information***, a memory location in a local memory external to the card;
determining if the defined memory location is unoccupied; and	code for ***determining if the defined memory location is unoccupied***; and
storing, if the memory location is unoccupied, the biometric signature at the defined memory location.	code for ***storing, if the memory location is unoccupied, the biometric signature at the defined memory location***.

The following is a graphic depiction of the invention claimed:

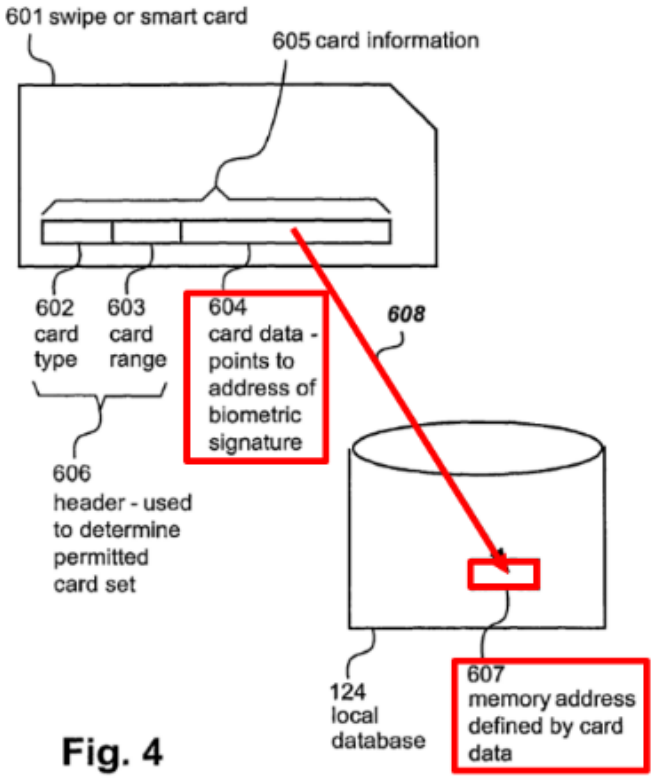

Fig. 4

Ex. 1001, Fig. 4 (highlights added).

According to the teachings of the '039 Patent specification, in Figure 4, "the card data 604 acts as the memory reference which points, as depicted by an arrow 608, to a particular memory location at an address 607 in the local database 124." Ex. 1001, col. 7, lines 31-34. Further, "[i]n an initial enrolment phase, the card user couples their card 601 . . . to the card reader 112. The card user is then required to input a biometric signature." *Id.* at col. 7, lines 43-46. In other words, the plain language of both claims 1 and 19, when read in light of the specification's teachings, requires that the claimed system receives the card information before the biometric

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