

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

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

Pursuant to the Revised Interim Rules Governing the Director Review Process (Sept. 18, 2023), Patent Owner respectfully requests that the Commissioner review the Final Written Decision (“FWD”) finding all challenged claims of U.S. Patent No. 8,620,039 (“the ‘039 Patent”) invalid. The issue warranting such review is *whether the Panel ignored its own construction of the challenged claims in finding such claims obvious in light of the identified art.*

Representative claim 1 of the ‘039 Patent reads:

A method of ***enrolling*** in a biometric card pointer system, the method comprising the steps of:

receiving card information;

receiving the biometric signature;

defining, dependent upon the received card information, a memory location

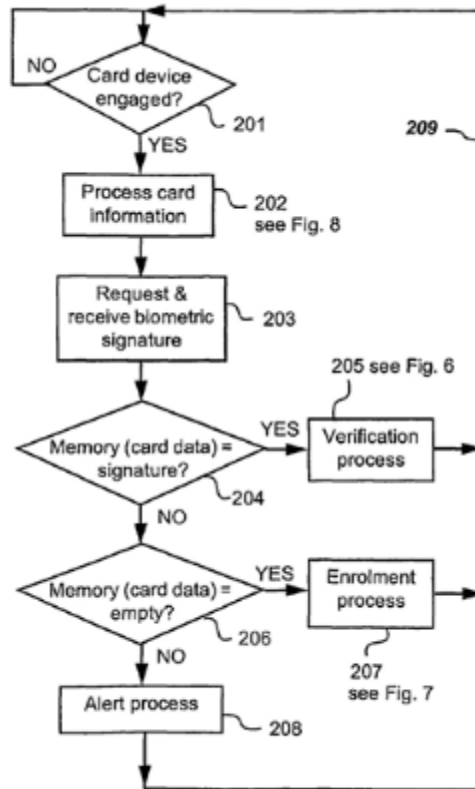
in a local memory external to the card;

determining if the defined memory location is unoccupied; and

storing, ***if the memory location is unoccupied, the biometric signature at the defined memory location.***

Ex. 1001, claim 1 (emphasis added).

The information flow during an enrollment process set out in that claim is graphically depicted in Figure 5 of the ‘039 Patent:



Ex. 1001, Fig. 5

As is clear from this figure and the accompanying text, as well as the claim language itself, biometric card information is processed first (step 202), a biometric signature is received next (step 203), and the enrollment process occurs thereafter, using a memory location that has been identified as being “empty” (steps 206 and 207). Ex. 1001, col. 8, lines 22-60. *See also* FWD at 3-4. As such, the Panel made clear that, “in the context of claim 1 and ‘a method of enrolling,’ is that during an enrollment process, the claimed ‘biometric signature,’ e.g., a fingerprint, is not yet stored in the memory and no memory location or address has been ‘set’ or

‘established’ for the fingerprint.”¹ FWD 30. *See also id.* at 36 (“[o]verall, in terms of ‘defining’. . . we understand that during an enrollment process, the claimed ‘biometric signature,’ *e.g.*, a fingerprint, is not yet stored in the memory, and no memory location or address has been ‘defined,’ as in ‘set’ or ‘established,’ in the memory for storing the fingerprint, until card information is received”).

The Panel recognized that “Petitioner’s expert, Dr. Sears, ‘testif[ied] that Bradford teaches a process in which the steps are *reversed* - a memory location is defined before any card information is received.’” FWD at 45, *quoting* Sur-Reply at 3 (emphasis added). The Panel does not take issue with Patent Owner’s characterization of Dr. Sears’ testimony on this point. Rather, it curiously states that such testimony does not conflict with claim 1, “as the creation of a player account . . . prior to receiving the card information does not preclude subsequently identifying a memory location . . . and establishing that memory location as the location where new biometric data, *e.g.*, a player’s fingerprint, is going to be stored.” FWD at 45.

And that brought the Panel to the *Foss* reference, which purportedly “teaches how, *i.e.*, using card data to define, that is—to establish or set a memory location,

¹ The Panel construed “defining” in the challenged claims to mean “sets” or “establishes.” FWD at 39.

e.g., the player’s user account, for storage of the biometric information in a local memory.” FWD at 46. The following, in fact, is the entirety of the Petition’s substantive discussion regarding the *Foss* reference in the context of the “defining” limitation:

Foss teaches a system and method for transferring funds between stored value card accounts. Foss teaches ‘an enrollment process...for enabling a primary account holder (i.e., an existing customer 610) to enroll additional new customer(s) in the family stored value card program.’ Thus, in this embodiment, an account already exists, and the customer is ‘initiat[ing] an enrollment process.’ To initiate enrollment, the customer is prompted ‘to swipe the *existing* stored value card’ to ‘*continue* the *enrollment* process.’ The system ‘identifies the stored value card account associated with the existing customer 610. The stored value card account may be identified based on the data read from magnetic stripe 710 via card reader 706.’ Thus, Foss teaches, during an enrollment process, identifying an account associated with a user by reading account information stored on a magnetic stripe of a card.

Petition at 27-28 (emphasis in original) (internal citations omitted).

Patent Owner addressed this discussion as follows – “[t]he portions of Foss quoted [in the Petition] describe ‘enabling a primary account holder (*i.e. an existing customer* 610) to enroll additional new customer(s) in the family stored value

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