

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

CPC PATENT TECHNOLOGIES PTY, LTD.,
Patent Owner.

IPR2022-00601
Patent 9,269,208 B2

Before SCOTT A. DANIELS, BARRY L. GROSSMAN, and
AMBER L. HAGY, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background and Summary*

Apple Inc. (“Petitioner” or “Apple”) filed a Petition requesting *inter partes* review of claims 1, 3–7, 9–11, and 13 (collectively, the “challenged claims”) of U.S. Patent No. 9,269,208 B2 (Ex. 1001, “the ’208 patent”). Paper 1 (“Pet.”). CPC Patent Technologies PTY, Ltd. (“Patent Owner” or “CPC”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). With our authorization, Petitioner filed a Preliminary Reply (Paper 8 (“Prelim. Reply”)) addressing the issue of discretionary denial raised in the Preliminary Response and Patent Owner filed a Prelim. Sur-Reply (Paper 9 (“Prelim. Sur-Reply”)).

We concluded that Petitioner satisfied the burden, under 35 U.S.C. § 314(a), to show that there was a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. Accordingly, on behalf of the Director (37 C.F.R. § 42.4(a)), and in accordance with *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1353 (2018), we instituted an *inter partes* review of all the challenged claims, on the single asserted ground. Paper 11 (“Dec. Inst.”).

Patent Owner filed a Response. Paper 17 (“PO Resp.”). Petitioner filed a Reply. Paper 20 (“Reply”). Patent Owner filed a Sur-reply. Paper 26 (“Sur-reply”).

Petitioner submitted seventy-six exhibits. *See* Exs. 1001–1091¹ (some consecutive exhibit numbers were *not* used; *e.g.*, there are no exhibits

¹ Exhibit 1091 is a demonstrative exhibit used at the final hearing. It is not an evidentiary exhibit. *See* PTAB Consolidated Trial Practice Guide, 84 (Nov. 2019 (“TPG”)) (“Demonstrative exhibits used at the final hearing are aids to oral argument and not evidence.”).

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numbered 1056–1064); *see also* Paper 28 (Petitioner’s Updated Exhibit List stating that Exhibit numbers 1056–1064 were “Intentionally left blank.”). Petitioner relies on the Declaration testimony of Andrew Sears, Ph.D. *See* Exs. 1003, 1090.

Patent Owner submitted fourteen exhibits. *See* Exs. 2001–2014²; *see also* Paper 29 (Patent Owner’s Updated Exhibit List). Petitioner relies on the Declaration testimony of William C. Easttom III, D. Sc., Ph.D. *See* Exs. 2011, 2012.

A hearing was held June 29, 2023. *See* Paper 30 (“Transcript” or “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. We enter this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Petitioner has the burden of proving unpatentability of a claim by a preponderance of the evidence. 35 U.S.C. § 316(e).

Based on the findings and conclusions below, we determine that Petitioner has proven that claims 1, 3–7, 9–11, and 13 are unpatentable.

B. Real Parties-in-Interest

Apple identifies itself as the sole real party-in-interest. Pet. 72.

CPC also identifies itself as the sole real party-in-interest. Paper 4, 2.

There is no dispute between the parties concerning the real party-in-interest.

C. Related Matters

Petitioner and Patent Owner each identify the following two district court proceedings as related matters: (1) *CPC Patent Technologies Pty Ltd.*

² Exhibit 1014 is a demonstrative exhibit used at the final hearing. It is not an evidentiary exhibit. *See id.*

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v. Apple Inc., Case No. 6:21-cv-00165-ADA (W.D. Tex.); and (2) *CPC Patent Technologies Pty Ltd. v. HMD Global Oy*, Case No. 6:21-cv-00166-ADA (W.D. Tex.) (the “HMD Litigation”). Pet. 72; Paper 4, 2–3.

The first listed case, between the same parties involved in this *inter partes* review proceeding, however, has been transferred to the Northern District of California. See *In re Apple Inc.*, 2022 WL 1196768 (Fed. Cir. Apr. 22, 2022); see also Ex. 3002 (Text Order granting Motion to Change Venue). The case is now styled *CPC Patent Technologies Pty Ltd. v. Apple Inc.*, No. 5:22-cv-02553 (N.D. Cal.). See Ex. 3003 (PACER Docket for the transferred case); Prelim. Resp. 1, fn 1 (Patent Owner acknowledging the transfer from the Western District of Texas to the Northern District of California). Also, the ’208 patent is no longer involved in the Northern District of California case. Patent Owner states it “dismissed its infringement claim for the ’208 Patent in the district court action.” Prelim. Resp. 1.

Petitioner and Patent Owner also each identify the following two pending *inter partes* review proceedings as related matters: (1) IPR2022-00600, challenging claims in Patent 8,620,039; and (2) IPR2022-00602, challenging claims in Patent 9,665,705, which is based on a continuation of the application that matured into the ’208 patent in the proceeding before us. See Ex. 3001, code (63). A final written decision in the 00600 IPR is due October 17, 2023. A final written decision in the 00602 IPR is being issued simultaneously with this Decision in the case before us.

D. The ’208 Patent

We make the following findings concerning the disclosure of the ’208 patent.

The '208 patent discloses a system “for providing secure access to a controlled item.” Ex. 1001, Abstr. Examples of a “controlled item” include “a door locking mechanism on a secure door, or an electronic key circuit in a personal computer” that can be accessed only by an authorized user. Ex. 1001, 6:13–16. The system uses a database of “biometric signatures,” such as a fingerprint, for determining authorized access. *Id.* at 1:29–30; 5:63–65 (“the user database [] contains biometric signatures for authorised³ users against which the request [] can be authenticated”).

Figure 2 from the '208 patent is reproduced below.

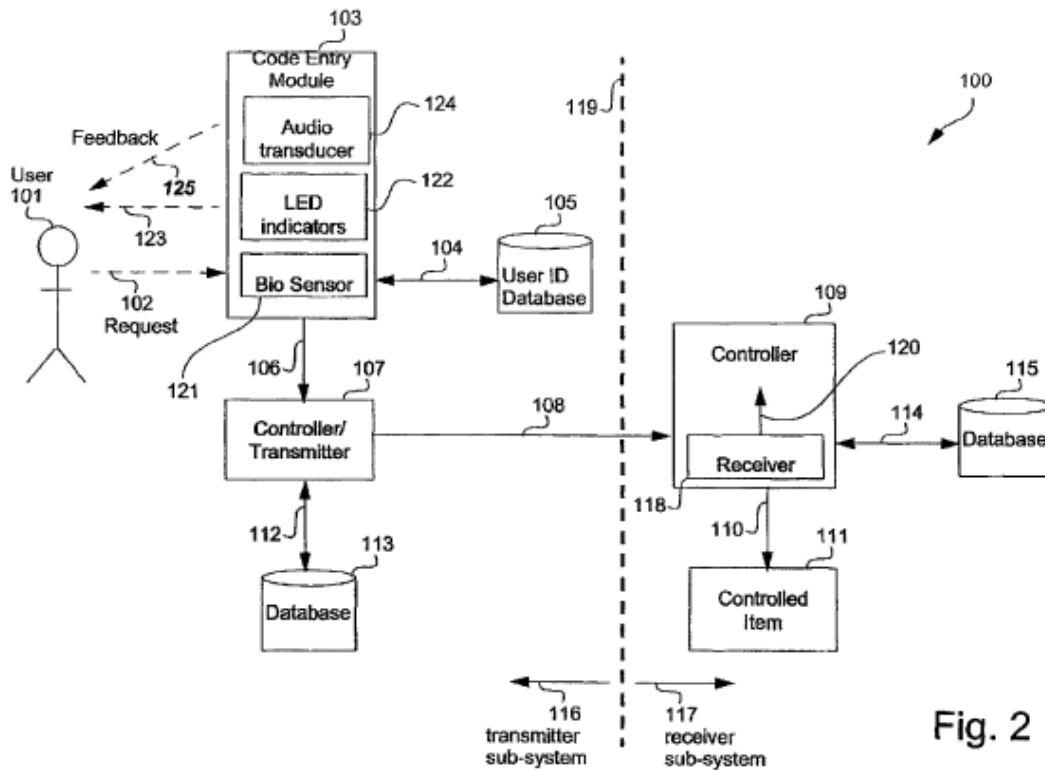


Fig. 2

³ The Specification uses the British spelling, which we also use when quoting the Specification.

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