

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

RFCYBER CORP.,
Patent Owner.

PGR2021-00028
Patent 10,600,046 B2

Before PATRICK R. SCANLON, KEVIN W. CHERRY, and
JAMES A. WORTH, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION
Granting Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

Google LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting post-grant review of claims 1–17 of U.S. Patent No. 10,600,046 B2 (Ex. 1001, “the ’046 patent”). RFCyber Corp. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 8, “Prelim. Reply”), and Patent Owner filed a Sur-reply (Paper 9, “Prelim. Sur-reply”). Patent Owner also filed a statutory disclaimer of claims 6–11, 15, 16, 19, and 20 of the ’046 patent. Ex. 2002.

Under 35 U.S.C. § 324(a), a post-grant review may not be instituted “unless . . . the information presented in the petition . . . , if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” After considering the Petition, Patent Owner’s Preliminary Response, Petitioner’s Reply, and Patent Owner’s Sur-reply, as well as all supporting evidence, we determine that Petitioner has satisfied the burden under 35 U.S.C. § 324(a) to show that it is more likely than not that at least one of the challenged claims is unpatentable.

II. BACKGROUND

A. *Related Matters*

The parties identify the following proceedings as related matters involving the ’046 patent: *RF Cyber Corp. v. Google LLC*, Case No. 2:20-cv-00274 (E.D. Tex.); *RF Cyber Corp. v. Samsung Electronics Co. Ltd.*, Case No. 2:20-cv-00335 (E.D. Tex.); and *RF Cyber Corp. v. LG Electronics, Inc.*, Case No. 2:20-cv-00336 (E.D. Tex.). Pet. 2–3; Paper 5, 1. In addition, Petitioner indicates it has filed another petition for post-grant review challenging the ’046 patent (i.e., PGR2021-00029). Pet. 3.

B. Real Parties in Interest

Petitioner identifies itself and Google Payment Corp. as the real parties in interest. Pet. 2. Petitioner indicates that Google LLC is a subsidiary of XXVI Holdings Inc., which is a subsidiary of Alphabet Inc., but states that XXVI Holdings Inc. and Alphabet Inc. are not real parties in interest to this proceeding. *Id.* n.1. Patent Owner identifies itself as the real party in interest. Paper 5, 1.

C. The '046 Patent

The '046 patent relates to electronic commerce and, more particularly, to settling payments “using a mobile device reading electronic bills or invoices off from another mobile device in a near field communication range.” Ex. 1001, 1:16–21. In general, the invention includes a first mobile device that generates an electronic invoice and can be part of a point of sale (“POS”) machine. *Id.* at 1:56–58, 2:1–3. The first mobile device is embedded with a secure element and executes a software module. *Id.* at 1:57–58, 2:55–59. When the first mobile device is brought to a consumer using a second mobile device, the electronic invoice is read wirelessly into the second mobile device. *Id.* at 1:59–63. The second mobile device is a near field communication (“NFC”) device “configured to execute an application that communicates with the software module in the first mobile device to read the data off from the first mobile device.” *Id.* at 2:28–30, 2:65–3:1.

The user is then able to verify the amount charged and authorize payment, after which the second mobile device “communicates with a payment gateway or network for payment that is configured to proceed with the payment in accordance with a chosen payment method.” *Id.* at 1:63–67, 2:61–64. That is, the gateway receives the payment request from the second

mobile device, verifies the payment request, and sends a payment response to the user of the first mobile device after the payment request is processed. *Id.* at 3:17–31.

Figure 1A of the '046 patent is reproduced below.

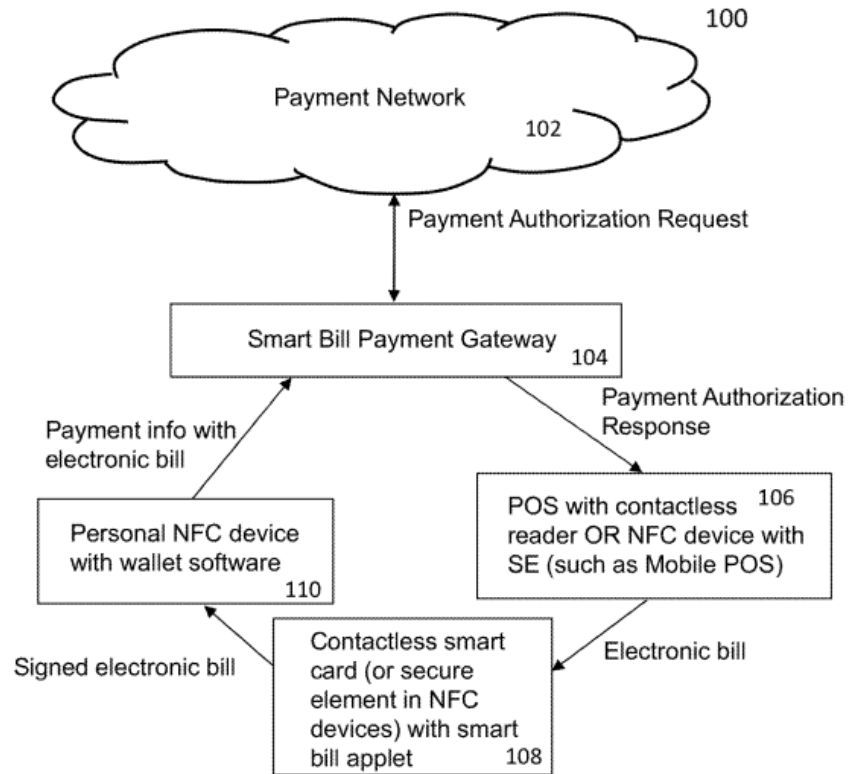


FIG. 1A

Fig. 1A shows system configuration 100, which is one embodiment of the invention. Ex. 1001, 5:29–30. System configuration 100 includes network 102, which provides services by a financial institution to electronically transfer money or settle payments. *Id.* at 5:30–34. Payment gateway 104 comprises one or more servers configured to provide an application that may be installed on a user's mobile device. *Id.* at 5:52–56. The application allows a user to authorize payment of an electronic invoice. *Id.* at 5:60–62.

System configuration 100 also includes POS device 106 at a point of sale. *Id.* at 6:6–7. POS device 106 generates an electronic bill or invoice that is loaded onto portable device 108, such as a contactless card or an NFC device, which contacts a user’s NFC device. *Id.* at 6:10–14. In one embodiment, “the POS device is a single device embedded with a secure element. The single device may be an NFC device that is used to enter information to generate an invoice.” *Id.* at 6:15–18. This device is brought to the customer for authorization and payment. *Id.* at 6:22–23.

Alternatively, “the POS device includes a stationary device corresponding to 106 of FIG. 1A and one or more contactless cards corresponding to 108 of FIG. 1A.” *Id.* at 6:23–26. In this case, “[t]he stationary device is used by the cashier to enter charging information to generate an invoice. A contactless card is loaded with the electronic invoice and brought to the customer for authorization and payment.” *Id.* at 6:26–30.

Device 110 is a personal NFC device with wallet software. *Id.* at Fig. 1A. Specifically, device 110 “is configured to function as an electronic purse or e-purse that may be used to directly settle a charge being displayed on a display screen thereof.” *Id.* at 8:25–28.

To settle a payment, the merchant, such as a waiter or cashier at a restaurant, causes POS device 106 to generate an electronic bill that is transported to a contactless card. *Id.* at 7:19–22. The contactless card is then presented to the customer who uses his or her mobile device to read the contactless card. *Id.* at 7:24–26. Upon detecting the contactless card in the near field, the application on the user’s mobile device reads data pertaining to the electronic bill from the contactless card and subsequently displays the electronic bill on a screen of the mobile device for the customer to verify. *Id.* at 7:28–33. The customer then chooses a method for settling the bill,

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