UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

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IPR2024-00233
Patent 8,886,954 B1

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Before THU A. DANG, KEVIN F. TURNER, and DAVID C. McKONE,
Administrative Patent Judges.

McKONE, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I.   INTRODUCTION

A.   *Background and Summary*

Google LLC ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–7, 10, 12–19, and 22–27 of U.S. Patent No. 8,886,954 B1 (Ex. 1001, "the '954 patent"). Pet. 5. Proxense, LLC ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). With our authorization, Petitioner filed a Preliminary Reply (Paper 7, "Prelim. Reply") and Patent Owner filed a Preliminary Sur-reply (Paper 9, "Prelim. Sur-reply").

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2016); 37 C.F.R. § 42.4(a) (2020). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons explained below, we institute an *inter partes* review of the '954 patent.

B.   *Related Matters*

The parties advise us that the '954 patent is involved in two district court cases, including *Proxense, LLC v. Google LLC*, No. 6:23-CV-00320 (W.D. Tex.) ("the Texas case"). Pet. 70; Paper 4, 2. Petitioner also has filed petitions for *inter partes* review of patents related to the '954 patent, including IPR2024-000232 (challenging U.S. Patent No. 8,352,730 B2 ("the '730 patent")) and IPR2024-00234 (challenging U.S. Patent No. 9,298,905 B1 ("the '905 patent")). Patent Owner states that patents related to the '954 patent are the subject of *ex parte* reexaminations in Application

No. 90/015,052, reexamining the '730 patent, Application No. 90/015,053, reexamining the '905 patent, and Application No. 90/015,054, reexamining U.S. Patent No. 10,698,989. Prelim. Resp. 14.

C. The '954 Patent

The '954 patent discloses systems for "authentication responsive to biometric verification of a user being authenticated," using "an integrated device [that] includes a persistent storage to persistently store[] a code such as a device identifier (ID) and biometric data for a user in a tamper-resistant format." Ex. 1001, 1:60–65. The '954 patent states that "[c]onventional user authentication techniques," such as requiring input of a password, were deficient because they "require[d] the user to memorize or otherwise keep track of the credentials" and "it can be quite difficult to keep track of them all." *Id.* at 1:26–35. Other techniques, such as "provid[ing] the user with an access object . . . that the user can present to obtain access," were inadequate because "authentication merely proves that the access object itself is valid; it does not verify that the legitimate user is using the access object." *Id.* at 1:36–46. According to the '954 patent, there was a need in the art for a system for "verifying a user that is being authenticated that does not suffer from [such] limitations" and "ease[s] authentications by wirelessly providing an identification of the user." *Id.* at 1:52–56.
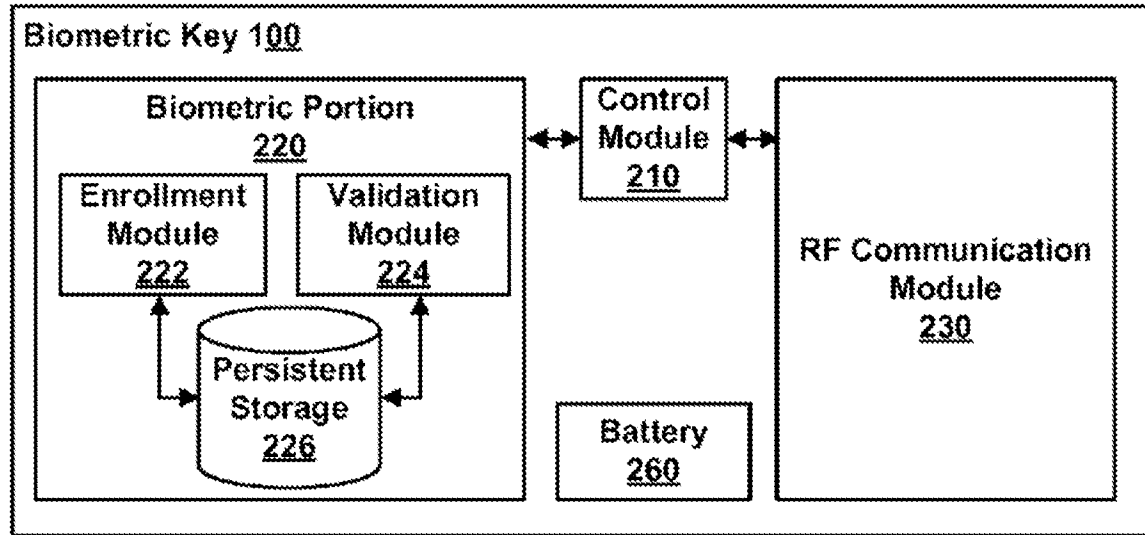
Figure 2 of the '954 patent is reproduced below.

FIG. 2

Figure 2 is a block diagram of the functional modules of a biometric key.
Id. at 3:28–30. Enrollment module 222 registers a user with biometric
key 100 by persistently storing biometric data associated with the user (e.g.,
a digital image of the retina, fingerprint, or voice sample) in persistent
storage 226. *Id.* at 4:64–5:21. Enrollment module 222 registers biometric
key 100 with a trusted authority by providing a code, such as a device ID, to
the trusted authority or, alternatively, the trusted authority can provide a
code to biometric key 100. *Id.* at 5:1–5. The code is stored in persistent
storage 226. *Id.* at 5:36–38. "Persistent storage 226 is itself, and stores data
in, a tamper-proof format to prevent any changes to the stored data." *Id.* at
5:29–31. "Tamperproofing increases reliability of authentication because it
does not allow any changes to biometric data (i.e., allows reads of stored
data, but not writes to store new data or modify existing data)." *Id.* at
5:31–34. In a fingerprint embodiment, validation module 224 uses scan
pad 120 (shown in Figure 1) to capture scan data from the user's fingerprint

and compares the scanned data to the stored fingerprint to determine whether the scanned data matches the stored data. *Id.* at 5:6–15.

The interaction of biometric key 100 with other system components is illustrated in Figure 3, reproduced below.
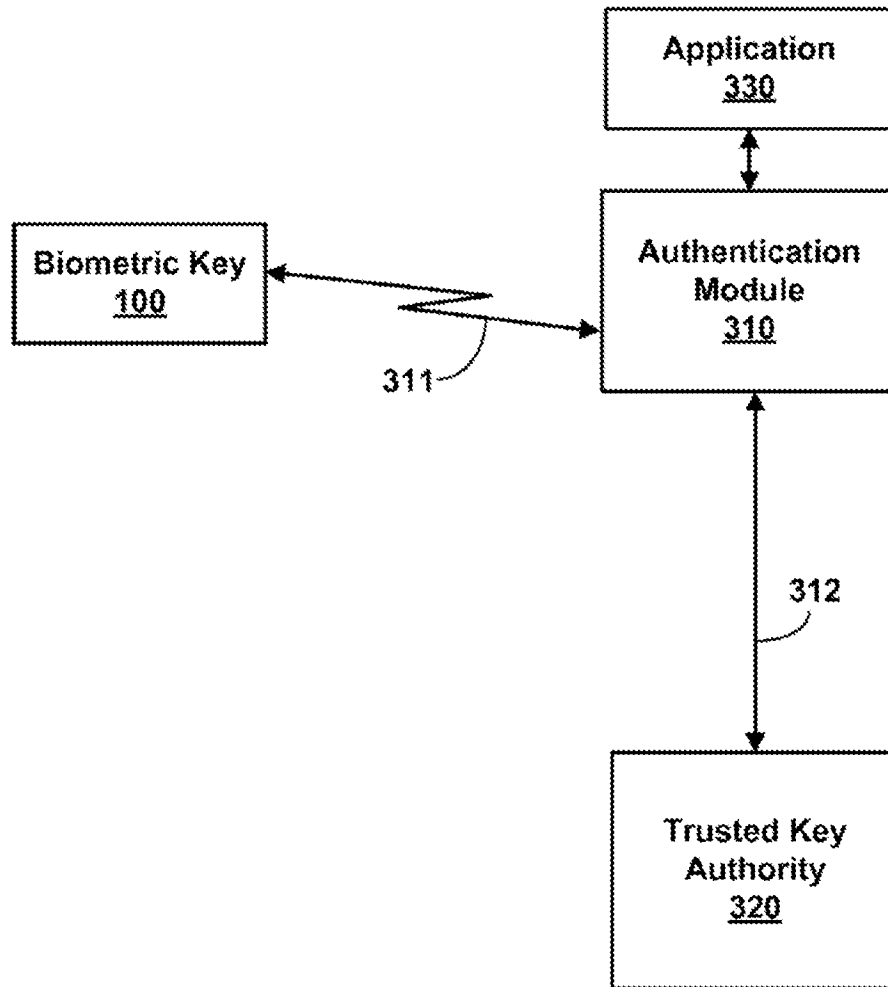

FIG. 3

Figure 3 is "a block diagram illustrating a system for providing authentication information for a biometrically verified user." *Id.* at 3:31–33. Authentication module 310 is coupled to biometric key 100 via line 311 (a wireless medium) and with trusted key authority 320 via line 312 (a secure

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