

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL
BOARD

SQUARE, INC.
Petitioner

v.

J. CARL COOPER
Patent Owner

Case IPR2014-00157
Patent No. 7,828,207

NOTICE OF APPEAL TO THE FEDERAL CIRCUIT (35 U.S.C. § 141(c))

To: Office of the General Counsel
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Patent Owner hereby provides notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141 and 142 from the final written decision of the Patent Trial and Appeal Board dated May 14, 2015.

Pursuant to 37 C.F.R. § 90.2(a)(3)(ii) the expected issues on appeal will include

1. Whether *Inter Partes* Review proceedings (namely IPR2014-00157) violate the United States Constitution, Article III, based on the Separation of Powers doctrine, as well as Patent Owner's Seventh Amendment right to a jury trial on adjudications of patent validity.

2. Whether Petitioner has shown by a preponderance of the evidence that claims 1 and 8-14 of U.S. Patent No. 7,828,207 are unpatentable.

Patent Owner has electronically filed this notice with the Patent Trial and Appeal Board, pursuant to 37 C.F.R. § 90.2(a)(1), 37 C.F.R. § 42.6(b)(1) and Federal Circuit Rule 15(a)(1).

Simultaneously herewith, patent owner is providing the Federal Circuit an electronic copy of the present Notice of Appeal (pursuant to 37 C.F.R. § 90.2(a)(2)(i) and 15(a)(1)) together with a \$500 fee (pursuant to 37 C.F.R. § 90.2(a)(2)(ii) and Federal Circuit Rule 52(a)(3)(A)).

All copies include a copy of the final written decision.

Date: July 13, 2015

Respectfully submitted,

/Robert P. Greenspoon/

Robert P. Greenspoon

Reg. No. 40,004

Flachsbart & Greenspoon, LLC

333 N. Michigan Ave., Suite 2700

Chicago, IL 60601

Phone: 312-551-9500

Fax: 312-551-9501

Email: rpg@fg-law.com

***Counsel Patent Owner J. Carl Cooper
and Exclusive Licensee eCharge Licensing
LLC***

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing NOTICE OF APPEAL TO THE FEDERAL CIRCUIT (35 U.S.C. § 141(c)) was filed on July 13, 2015 with the United States Patent & Trademark Office, and served electronically on July 13, 2015 on the following counsel of record for Petitioner at the below-listed email address:

Erika Arner
Aaron Capron
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
email: Square_v_eCharge_IPR@finnegan.com

Date: July 13, 2015

By: /Robert P. Greenspoon/
Robert Greenspoon
Reg. No. 40,004

Flachsbart & Greenspoon, LLC

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner

v.

J. CARL COOPER,
Patent Owner

Case IPR2014-00157
Patent 7,828,207 B2

Before JAMESON LEE, GEORGE R. HOSKINS, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Square, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1 and 8–14 of U.S. Patent No. 7,828,207 B2 (Ex. 1001, “the ’207 patent”). Paper 1 (“Pet.”). J. Carl Cooper (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). We instituted trial on Petitioner’s asserted ground that 1 and 8–14 were anticipated by Pitroda.¹ Paper 8 (“Dec.”).

During trial, Patent Owner filed a Patent Owner Response (Paper 18, “PO Resp.”), which was accompanied by a Declaration from J. Carl Cooper (Ex. 2004). Petitioner filed a Reply to the Patent Owner Response. Paper 20 (“Pet. Reply”). A consolidated oral hearing for IPR2014-00156 and IPR2014-00157, each involving the same Petitioner and Patent Owner, was held on January 9, 2015. A transcript of the consolidated hearing has been entered into the record. Paper 35 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. We determine that Petitioner has shown by a preponderance of the evidence that claims 1 and 8–14 of the ’207 patent are unpatentable. Patent Owner’s Motion to Exclude (Paper 22) is dismissed-in-part and denied-in-part.

B. Related Proceedings

Petitioner represents that the ’207 patent is the subject of pending lawsuits (1) in the Northern District of Illinois (filed by eCharge Licensing LLC against Petitioner, No. 1:13-cv-06445), Ex. 1003; and (2) in the District

¹ U.S. Patent No. 5,590,038, issued Dec. 31, 1996 (Ex. 1004).

of Massachusetts (filed by SCVNGR, Inc. against eCharge Licensing LLC, No. 1:13-cv-12418). Pet. 6.

C. The '207 Patent

The '207 patent “relates to the use of devices having information or patterns carried in or on some storage media, examples of which include photographic patterns, keys or the magnetic strip on credit cards.” Ex. 1001, 1:18–21. Figure 2 of the '207 patent is reproduced below.

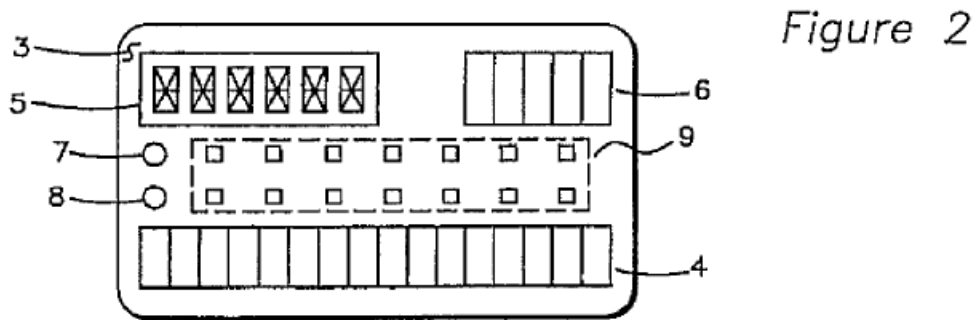


Figure 2 is a diagram of the preferred embodiment of the '207 patent's invention, dubbed a multi-card by the inventor, having plastic substrate 3, on which programmable magnetic strip 4, LCD display 5, solar cell power source 6, infrared emitter 7, infrared sensor 8, and key pad 9 are mounted suitably. *Id.* at 2:54–60.

Figure 3 of the '207 patent is reproduced below:

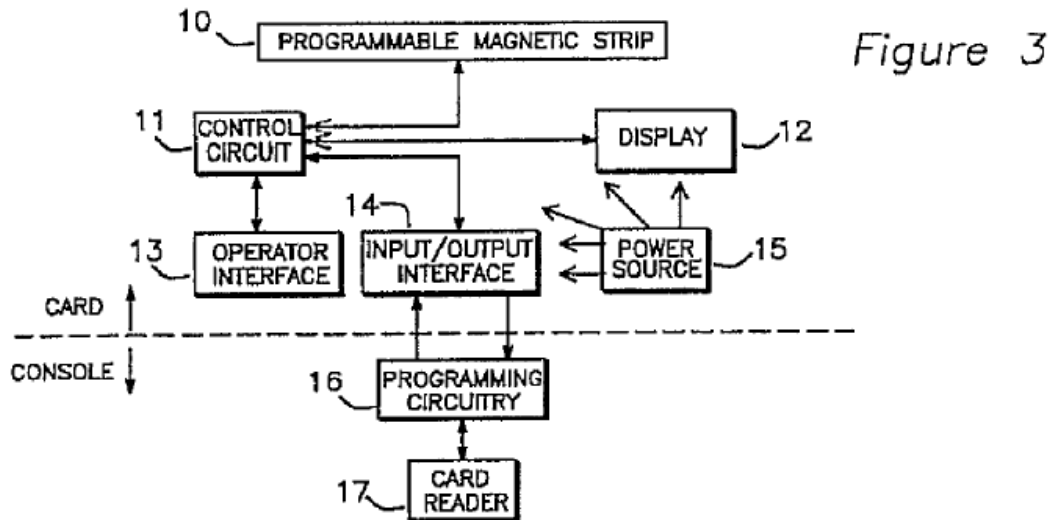


Figure 3 is a drawing explaining the operation of the preferred embodiment. *Id.* at 2:32–33. Figure 3 “includes a console comprised of programming circuitry 16 and card reader 17.” *Id.* at 5:48–49. According to the Specification: “Control circuit [11] operates interactively with the input/output interface 14, examples including those associated with 7 and 8 of FIG. 2, to communicate with the console.” *Id.* at 5:35–38.

D. Illustrative Claim

Of the challenged claims, claims 1, 8, 13, and 14 are independent. Dependent claims 9–12 depend, directly or indirectly, from claim 8.

Claim 1 of the '207 patent is reproduced below:

1. A universal credit card apparatus for providing and receiving account data including account information from a host system comprising:
 - a carrier having a planar surface said carrier supporting the components of the apparatus;
 - at least one memory device, chosen from the group consisting of volatile memory and nonvolatile memory, affixed

to said carrier, for storing account data including account information for at least one account;

an emitter device, affixed to said carrier, programmed with account identifier information for wirelessly transmitting account identifying information to said host system; wherein the emitter device is configured to identify a user selected account to the host system;

a receiver device, affixed to said carrier, for receiving account data including account information from said host system;

a display device, affixed to said carrier, for selectively displaying account information;

a control circuit, affixed to said carrier, coupled to said memory, to said display device and to said receiver device and which is operable to store account data including account information received by said receiver device from the host system into said memory and to cause said account information stored in said memory to appear on said display device;

a power source, affixed to said carrier, and coupled to at least one of said memory, said receiver device, said display device and said control circuit.

Ex. 1001, 9:54–10:16.

II. ANALYSIS

For the challenged claims, Petitioner must prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). We begin with a claim construction analysis, and then follow with specific analysis of the prior art.

A. Claim Construction

The parties agree that the '207 patent expired on November 4, 2014, subsequent to the institution of trial in this proceeding. *See* Paper 15, 1. We construe expired patent claims according to the standard applied by the district courts. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012).

Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Only those terms which are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

In the Decision to Institute, we interpreted the term “emitter” as a device that transmits a signal conveying information to another device, and that is recognizable to one of ordinary skill in the art as an emitter. Dec. 9. We confirmed that applying the *Phillips* standard did not change this construction, in our Order dated June 23, 2014. Paper 17, 2–3.

Patent Owner provides additional discussion about the term “emitter” in its Response, namely, arguing that the claim term “emitter” necessarily connotes a wireless transmission. PO Resp. 4–6. Patent Owner argues that the term “for wirelessly transmitting” appears within the overall emitter claim limitation for independent claims 1 and 14, and thus these claims are limited to wireless transmissions. *Id.* Patent Owner also argues that the Board should find independent claims 8 and 13, which recite Markush groups that limit the emitter to “the group consisting of infrared LEDs, coils, antenna and transducers,” to be limited to wireless transmissions as well. *Id.* at 5.

Petitioner argues that the Board should maintain its claim construction of the term “emitter” Patent Owner’s arguments notwithstanding. First,

Petitioner argues that the Specification describes an emitter as being broad enough to encompass wired communication means. Pet. Reply 3 (citing Ex. 1001, 5:10–12 (“Emitter 7 may be the preferred infrared LED, antenna, coil, transducer, or any other device capable of conveying information or patterns from the invention or outside devices’’)). Second, Petitioner argues that Patent Owner’s arguments that an emitter is limited to wireless transmission would render the claim term “wirelessly” superfluous. Pet. Reply 4. Finally, Petitioner argues that during Mr. Cooper’s deposition, in response to the question of whether, in general, “transmission of information, does that include wired and wireless communication?”, Mr. Cooper responded “Yeah, information can be transmitted by wires or wirelessly.” *Id.* (citing Ex. 1011, 212:16–22).

Given the broad language of the Specification with respect to emitters, and the narrowing, qualifying language of the independent claims with respect to the particular emitter intended by each respective claim, we are unpersuaded that we should implement Patent Owner’s proposed construction of the term “emitter.” We see no reason based on the complete record now before us to alter the construction from the Decision to Institute. We maintain that construction for this Final Written Decision.

In our Decision to Institute, we construed “universal credit card” or “universal credit card apparatus” to mean “a card that allows access to more than one credit card account.” Dec. 7. Patent Owner asks that we “vacate [our] construction of ‘credit card apparatus’ to prevent its misuse in future proceedings.” PO Resp. 18. Patent Owner represents that the parties are in substantial agreement about the scope of the term. *Id.*

To read the claims onto prior art, we need to determine for ourselves

what claim terms mean. The Board construes claims and does not simply take any construction agreed to by the parties, which may be incorrect. Accordingly, “universal credit card” or “universal credit card apparatus” is construed to mean “a card that allows access to more than one credit card account.”

In the Decision to Institute, we also construed the term “transducer” to mean “a device recognizable to one of ordinary skill in the art as a ‘transducer’ and capable of converting energy from one form to another” and the term “host system” to mean “a system that receives account data from, and provides account data to, a universal credit card apparatus.” Dec. 7–9. Neither party now proposes a different construction of these terms. Based on the complete record now before us, we see no reason to alter our earlier constructions, and maintain the constructions for this Final Written Decision.

B. Anticipation by Pitroda

We have reviewed the Petition, the Patent Owner Response, and Petitioner’s Reply, as well as the relevant evidence discussed in those papers. The parties focus their arguments on several terms present in certain claims of the ’207 patent, namely, (1) in claims 1, 8, 13, and 14, the terms (a) “emitter” and (b) “control circuit;” (2) in claim 9, the terms “operator interface” and “account location;” and (3) in claim 10, the term “account identifier.” We address these arguments in turn.

With respect to the independent claims, Pitroda teaches a universal electronic transaction card (“UET card” or “UETC”). Ex. 1004, Abst. Figure 3 of Pitroda is reproduced below:

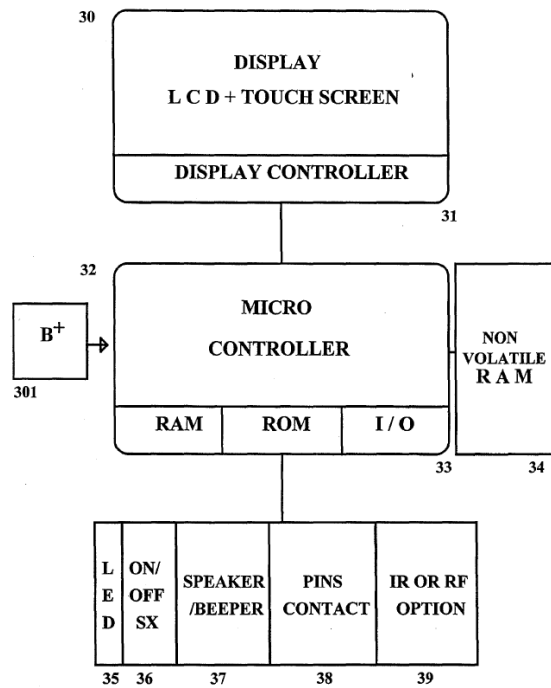


FIG. 3

Figure 3 shows a block diagram of one embodiment of the UET card. *Id.* at 8:28–29. The UET card has “a micro controller with associated RAM/ROM and Input/Output port management 33,” as well as non-volatile RAM 34. *Id.* at 11:20–21. The UET card further includes LCD and touch screen display 30, wherein the touch screen portion of display 30 is large enough to enable a user to operate touch controls. *Id.* at 11:14–19.

1. Claims 1, 8, 13, and 14

a. Emitter

Claims 1 and 14 require an emitter device “for wirelessly transmitting account identifying information to said host system.” Claims 8 and 13 require an emitter device “chosen from the group consisting of infrared LEDs, coils, antenna and transducers,” for transmitting account identifying information to said host system. Petitioner contends that Pitroda teaches each element of independent claims 1, 8, 13, and 14. Pet 12–21.

Specifically, Petitioner argues that Pitroda discloses an emitter, namely, pin contacts 13 or 38, or infrared (IR) or radio frequency (RF) option 39. Pet. 16–17; Ex. 1004, Fig. 3, element 38 (pins contact), element 39 (IR or RF option).

Patent Owner argues that the “emitter” limitation in the independent claims is not met by Pitroda. PO Resp. 4–10. Patent Owner notes that the term “for wirelessly transmitting” (relating to the emitter) appears explicitly in independent claims 1 and 14, and urges the Board to find that independent claims 8 and 13 likewise are limited to wireless transmissions. *Id.* at 4–5. Patent Owner relies on the Examiner’s Statement of Reasons for Allowance, which stated that the prior art fails to teach or suggest an emitter device for transmitting account information wirelessly, to support Patent Owner’s assertion that all of the claims are limited to wireless transmissions. *Id.* at 5–6 (quoting Ex. 1009, 115).

Having argued that the emitter is limited to wireless transmissions, Patent Owner further argues that because Pitroda does not disclose what structure the IR/RF communication would use or what information it communicates, Pitroda does not disclose explicitly wireless transmission to or from the UET of account data or account identifying information. *Id.* at 7–10. In sum, Patent Owner argues that “pin contacts 13 or 38 cannot qualify [as the emitter] because they are not wireless. And, the IR/RF option cannot qualify because Pitroda does not specify what data might travel that way.” *Id.* at 10–11 n.3.

Patent Owner also states that “Patentee includes its reasons and analysis in its Response in the two co-pending matters (IPR2014-00156 and IPR2014-00158), incorporating by reference those arguments here.” *Id.* at 6.

It is improper to incorporate by reference arguments from one document into another document. 37 C.F.R. § 42.6(a)(3). We decline to consider information incorporated by reference from IPR2014-00156 and IPR2014-00158.

With respect to Pitroda's disclosure of an emitter, Petitioner argues that Pitroda's IR/RF option embodiment satisfies the claimed emitter limitations. Pet. Reply 6–7. To support this contention, Petitioner relies on its expert's testimony that Pitroda's IR/RF option can be used to transmit account data to the communication interface unit ("CIU"). *Id.* at 7 (citing Ex. 1008 §§ VII.A.1, VII.A.2, VII.A.7, VII.A.8).

We are persuaded that the IR/RF option of Pitroda is an emitter. Patent Owner acknowledges that Pitroda discloses that its UET card transmits information. PO Resp. 9. Pitroda's IR/RF option is provided as an alternative means of communication of the information required to be communicated by the UET card to the CIU. *See* Ex. 1004, 9:55–59 (the CIU "interfaces with the UET card either through physical metallic contact—preferred for the touch memory devices—or infra red or radio frequency [IR/RF] based wireless transmit and receive units"); 9:59–63 ("The CIU includes means for receiving data from the UET card, such as metal contacts to connect to the metal contacts 13 of the UET card, or infrared or radio frequency [IR/RF] based wireless systems, depending on the system used by the UET card.") The use of the IR/RF option as an emitter is disclosed explicitly in Pitroda, and not merely a possibility or probability.

b. Control Circuit

Claims 1, 8, 13, and 14 all require a "control circuit" affixed to or carried by the carrier, coupled to said memory, to said display device, and to

said receiver device, and “operable to store account data including account information received by said receiver device from the host system into said memory and to cause said account information stored in said memory to appear on said display device.” Petitioner argues that the claimed control circuit reads on Pitroda’s microcontroller on the UET card, as shown in Figure 3, which microcontroller is coupled to said memory (RAM, ROM, or non-volatile RAM 34), said display (LCD display portion of LCD + touch screen display 30), and said receiver (IR or RF option 39, or pin contacts 13 or 38). Pet. 19–20; Ex. 1004, Fig. 3.

Patent Owner argues, with respect to the independent claims, that “the control circuit *inside the card apparatus* must act to do whatever storing from the host system is to be done.” PO Resp. 11 (emphasis in original). According to Patent Owner, Petitioner’s arguments “overlook that [in Pitroda] the connection to ‘non-volatile RAM 34’ bypasses this ‘micro controller.’” *Id.* at 12. In support, Patent Owner points to a portion of Pitroda that describes the UET card’s “non-volatile RAM 34 and or touch memories with direct contact to connect to the CIU.” *Id.* (citing Ex. 1004, 11:20–25). Thus, Patent Owner argues, “[in Pitroda] it is something *outside* the UET card (the CIU) that controls storage of account information.” *Id.* (emphasis in original). Patent Owner posits that there is no disclosure in Pitroda that suggests that the “UET micro controller does any memory storage, much less the particular storage of account information required by the claims.” *Id.* at 13.

At oral hearing, Patent Owner emphasized its position that, in Pitroda, “the CIU is the star of the show.” Tr. 33:12. Patent Owner pointed out that Pitroda’s Figure 7, which represents the software inside the CIU, includes

“card information read” and “card information write.” PO Resp. 13; Tr. 35:9–25. Thus, Patent Owner concluded that “there is utterly no question that the CIU plays the role of reading from memory and writing to memory.” Tr. 35:25–36:2. Patent Owner also stated that “the parties agree that the only part of Pitroda that could possibly store the account information that we’re all talking about is the NVM, the non-volatile memory [RAM 34 on the UET card].” *Id.* at 34:9–12.

Petitioner argues that Patent Owner overlooks “relevant teachings of *Pitroda* regarding the ‘control circuit’ of claims 1, 8, 13, and 14.” Pet. Reply 8. Petitioner cites a portion of *Pitroda* stating that “with respect to credit card transactions, the UET card of [Pitroda’s] invention may be used to store in memory each credit card or bank transaction for which it is used” and concluded: “So that’s the control circuit storing the transaction information in memory.” Tr. 19:10–14 (quoting Ex. 1004, 7:33–35). Petitioner relies on the testimony of its expert that the memory management and database management functions performed by the microcontroller of the UET card “manage the stored information, including credit card information and transaction information for each card.” Pet. Reply 8–9 (citing Ex. 2003, 145:4–152:7; Ex. 1004, 11:40–12:6). As summarized by Petitioner, “[c]onsidering that a microprocessor is a means for processing data, the microprocessor executes the instructions associated with processing and storing the incoming account data.” *Id.* (citing Ex. 1004, 18:18–20).

According to Petitioner’s expert, *Pitroda*’s account information can be stored in transaction memory area 410 of the UET card, either in non-volatile RAM 34 or in “volatile” RAM 33. Tr. 72:22–73:17; Ex. 2003, 147:23–148:8. Thus, Patent Owner’s assertion that there is agreement

between the parties that account information only can be stored in non-volatile RAM 34 is unsupported by the record.

Petitioner also relied on its expert's testimony to support the argument that the UET card, not the CIU, stores the information coming into the card. Tr. 73:18–74:8. Petitioner's expert pointed to Pitroda's disclosure of the UET card software, including its operating system, memory management, database management, and other utilities, and concluded that when Pitroda talks about performing database management and memory management, "I respectfully conclude that the UET card is performing those functions." Ex. 2003, 148:9–149:7; Ex. 1004, 12:7–12. More specifically, Petitioner argued that the microcontroller of the UET card runs the software. Pet. Reply 9 (citing Ex. 1004, 18:18–20); Tr. 74:22–25. Petitioner's expert, when asked for a disclosure of the microcontroller of Pitroda performing the memory storage for account information, cited to sections of Pitroda including column 12, starting at line 7, discussing the UET card software, column 2, lines 50 through 61, and column 3, lines 4 through 22. Ex. 2003, 148:9–149:7, 150:16–151:16.

Patent Owner's argument that only Pitroda's CIU directly contacts, reads from, and writes to the UET card's non-volatile RAM 34 disregards the disclosure of Pitroda as a whole. In the embodiment of Pitroda shown in Pitroda's Figure 3, the microcontroller 33 is located centrally, connected by a line to non-volatile RAM 34 and by a different line to elements 35–39, including pin contacts 38 and IR/RF option 39. Patent Owner was unable to explain the line connecting microcontroller 33 with non-volatile RAM 34 in Figure 3, other than to surmise that "it can only be a representation of co-occupying the same physical housing space." Tr. 36:15–17. Given the

diagrammatic representation of the embodiment shown in Figure 3, in conjunction with the passages relied upon by Petitioner in Pitroda's specification, information entering the UET card via IR/RF option 39 would be managed by microcontroller 33 to be stored in non-volatile RAM 34 or RAM 33. Patent Owner's argument that Pitroda's CIU must write directly to non-volatile RAM 34 is unpersuasive in view of Petitioner's showing that the UET card's microcontroller runs the software to write directly to transaction memory area 410.

Notwithstanding Patent Owner's argument and evidence to the contrary, we are persuaded by Petitioner's argument and supporting evidence that Pitroda expressly discloses a control circuit, i.e. microcontroller 33, that would cause account data including account information received by the receiver from the host system to be stored in the memory.

2. *Claim 9 – “operator interface” and “account location”*

Claim 9 requires an “operator interface device, affixed to said carrier, connected to said control device, operable by a user to select an account location in said memory in which account data including account information received from the host system is to be stored.” Petitioner argues that Pitroda discloses an operator interface affixed to the carrier and connected to the control circuit, namely, touch screen portion of LCD + touch screen display 30. Pet. 20; Ex. 1004, Fig. 3, element 30. Petitioner argues that the touch screen display allows the user to select an account location in the memory in which account data including account information received from the host system is to be stored. Pet. 21; Ex. 1004, Figs. 13, 14.

Patent Owner argues that Pitroda does not disclose user selection of an account location for storing account information. PO Resp. 14. Specifically, Patent Owner argues that Petitioner points to a different functionality within Pitroda, namely, picking an account for display, which is not the same thing as picking an account for storage. *Id.*

Referring *inter alia* to the touch screen display shown in Figures 13 and 14, Petitioner argues that Pitroda “discloses that the UET card includes a touch screen display that allows a user to select a credit card to make a transaction, resulting in the receipt of the credit card transaction information for that selected credit card.” Pet. Reply 10. Specifically, Petitioner argues that in order to provide the cardholder with the selected card’s information such as account summary and accounts payable, “the UET card has associated the credit card transaction information with the selected credit card.” *Id.* at 11–12. Petitioner refers to the account-by-account example given in Pitroda at column 6, lines 16–43 which begins with the user selecting from a UET card a service institution account, and ends with “storing the transactional information for the credit transaction in the universal electronic transaction card with respect to the service institution account.” Tr. 20:4–24; Ex. 1004, 6:41–43. Petitioner argues that, given the complete disclosure of Pitroda and the supporting evidence provided by its expert, “[o]ne of ordinary skill in the art would understand that *Pitroda* discloses storing records on an account-by-account basis.” Pet. Reply 12.

Pitroda allows a “user to review . . . a record of transactions with a service institution [i.e. including a credit card issuing entity].” Ex. 1004, 4:12–15, 3:6–11. Pitroda’s example of user selection of a particular service institution credit card uses an American Express card as an example. *Id.* at

16:21–49, Figs. 13, 14. If the user were to choose the American Express card from the display shown in Figure 13, the display shown in Figure 14 would appear. *Id.* at 16:21–24. On the Figure 14 display, the user “can have access to the information related to account summary (AS), account payable (AP), weekly (W), monthly (M), yearly (Y) details. *Id.* at 14:2–4. The card holder can also ask for help (H), security (S), last use (LU) credit limit (CL), balance (BL), and load PC (LP).” *Id.* at 14:4–6.

Finally, Pitroda states that “*corresponding to each card*, a transaction memory area 410 is provided to store all transaction receipts in electronic form to eliminate or reduce paper receipts.” *Id.* at 12:1–4 (emphasis added), Fig. 4. The existence of a transaction memory area corresponding to each card supports the position that the user of Pitroda can, by selecting a particular card such as an American Express card, complete a transaction using that card. Further, upon completion of the transaction, the account information would be stored in the transaction memory area corresponding to the American Express card. The user also could review an account summary or other details particular to the American Express card via the Figure 14 display, which would require accessing information that is specific to the American Express card. We are not persuaded by Patent Owner’s argument that transaction memory area “corresponding to each card” means “corresponding to each UET card.” Tr. 60:14–23. The paragraph in which transaction memory area 410 is described begins: “*Corresponding to each card*, a data area 409 is provided for transient information related to the date of issue, date of expire, credit limit, etc.” and continues: “*Also corresponding to each card*, a transaction memory area 410 is provided” Ex. 1004, 11:65–67, 12:1–4 (emphases added). The totality

of the language supports a reading that Pitroda has a transaction memory area 410 corresponding to each of the credit cards 404, bank cards 405, ID cards 406, and health cards 407 on its UET card. *Id.* at 11:39–58; Fig. 4.

Although Patent Owner argues that Pitroda does not differentiate its incoming credit card transactions, such a conclusion is based on a hypothetical presented to Petitioner’s expert, and presents a strained reading of Pitroda in view of its complete disclosure. The expert’s testimony cited by Patent Owner states that Pitroda’s UET card could store sales receipts in the American Express records within that card, or equivalently in a part of the UET card’s memory that is “just a stack of sales receipts undifferentiated by account.” Ex. 2003, 164:14–165:6. The argument is misplaced because it does not diminish Pitroda’s express disclosure of the use of transaction memory area 410 in a manner that “corresponds” to each card, as we have already discussed. In other words, even if information also could be stored differently, i.e., without differentiation based on accounts, that does not negate or take away from the actual disclosure of storing information, separately, for different cards. Patent Owner does not explain why the existence of possible additional configurations defeats a finding of express anticipation based on an already disclosed embodiment.

3. *Claim 10 – “account identifier”*

Claim 10 requires “at least one account identifier associated with and stored in said memory with reference to each account stored in said memory for allowing the selection of an account which is to be the subject of the use by selecting anyone of said account identifiers for the chosen account,” wherein “the user of the universal credit card can select the account to be used to receive, store and display account information by specifying the

account identifier of the account.” Petitioner alleges that Pitroda discloses at least one account identifier associated with and stored in the memory, namely, the graphical images of Figure 13 tied to different credit card accounts. Pet. 21–22; Ex. 1004, Fig. 13. Petitioner further argues that the user can select the account to be used by specifying the account identifier of the account, namely, the images shown in Figure 13, resulting in displaying of account information as shown in Figure 14. Pet. 22; Ex. 1004, Figs. 13, 14, 16:21–25.

Patent Owner argues that Pitroda does not disclose referring to an account identifier through an operator interface to direct receipt and storage of account information. PO Resp. 15–17. Specifically, Patent Owner argues that Petitioner points to a different functionality within Pitroda, namely, picking an account for display and for point of sale purchasing, which is not the same thing as picking an account identifier for receipt and storage. *Id.* at 16.

Petitioner argues that “the portion of the touch screen display area for selecting each credit card in Figure 13 would constitute the account identifier.” Pet. Reply 13. This account identifier, according to Petitioner, would allow an individual credit card to be selected for a transaction, resulting in the receipt of transaction information that is associated with the selected credit card. *Id.*

Pitroda’s display configurations, as depicted in Figures 13 and 14, function as account identifiers associated with each account. As discussed above, Pitroda discloses a credit card transaction that begins with the user selecting from a UET card a service institution account, and ends with “storing the transactional information for the credit transaction in the

universal electronic transaction card with respect to the service institution account.” Ex. 1004, 6:41–43; Tr. 20:4–24. We are persuaded by Petitioner’s reasoning that Pitroda discloses the account identifier of claim 10.

4. Remaining Claim Elements; Dependent Claims 11 and 12

As discussed, we find that Petitioner has established, by a preponderance of the evidence, that Pitroda anticipates claims 1, 8–10, 13, and 14 as to the claim elements discussed with particularity above. We have reviewed the arguments presented in the Petition and the supporting evidence regarding the anticipation of the remaining elements of claims 1, 8–10, 13, and 14, which were not disputed by Patent Owner in its Response. Pet. 11–24. Petitioner further contends Pitroda discloses the subject matter recited in claims 11 and 12, each of which depends indirectly from claim 8. *Id.* at 22–24. We also have reviewed the Petition and supporting evidence presenting arguments that the additional subject matter of claims 11 and 12 is disclosed in Pitroda. *Id.* Patent Owner, in its Response, relies solely on its arguments and evidence concerning the disputed terms in claims 1, 8–10, 13, and 14. *See generally* PO Resp. In the Scheduling Order, we cautioned Patent Owner that any arguments for patentability not raised in the Response would be deemed waived. Paper 9, 3. After reviewing the arguments and evidence presented concerning the remaining claim elements of claims 1, 8–10, 13, and 14, and dependent claims 11 and 12, we find a preponderance of the evidence establishes that Pitroda expressly discloses the remaining elements of 1, 8–10, 13, and 14, and each and every limitation of dependent claims 11 and 12. We conclude that claims 1 and 8–14 are unpatentable as anticipated by Pitroda.

C. Patent Owner's Motion to Exclude

Patent Owner filed a Motion to Exclude (Paper 22, "Mot. to Excl."), to which Petitioner responded (Paper 26, "Resp. to Mot. to Excl.") and on which Patent Owner filed a Corrected Reply (Paper 28, "Reply on Mot. to Excl."). Patent Owner's motion seeks to exclude Exhibit 1012 as irrelevant, Exhibit 1013 as not properly authenticated and as calling for hearsay, and Exhibit 1014 as not properly authenticated and as calling for hearsay.² Mot. to Excl. 1–3. The moving party has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

We do not rely upon Exhibits 1012 and 1013 in our present determination. The Motion to Exclude therefore need not be decided as to these Exhibits.

Petitioner alleges that Exhibit 1014 was not objected to prior to filing the Motion to Exclude. Resp. to Mot. To Excl. 3–4. Patent Owner must object timely to the evidence it seeks to exclude. 37 C.F.R. § 42.64(b)(1). Once an objection is filed, a motion to exclude "must be filed to preserve any objection." *Id.* § 42.64(c). The motion to exclude must identify the prior objection. *Id.* There is no record that Patent Owner objected to Exhibit 1014 prior to filing the Motion to Exclude, as required by Rule 42.64.

Accordingly, the Motion to Exclude is *dismissed* as to Exhibits 1012 and 1013 and *denied* as to Exhibit 1014.

² The Motion to Exclude also seeks to exclude Ex. 1016 in the IPR2014-00158 proceeding. As that document is not part of this proceeding, however, it is unsuitable for consideration here.

III. SUMMARY

Petitioner has demonstrated, by a preponderance of the evidence, that claims 1 and 8–14 of the '207 patent are unpatentable as anticipated by Pitroda. This is a Final Written Decision of the Board under 35 U.S.C. § 318(a).

IV. ORDER

For the reasons given, it is

ORDERED that Patent Owner's Motion to Exclude is *dismissed* as to Exhibits 1012 and 1013 and *denied* as to Exhibit 1014;

FURTHER ORDERED that claims 1 and 8–14 of the '207 patent are *unpatentable*; and

FURTHER ORDERED that parties to the proceeding seeking judicial review of this final written decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2014-00157
Patent 7,828,207 B2

FOR PETITIONER:

Erika Arner

Aaron Capron

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP

erika.arners@finnegans.com

aaron.capron@finnegans.com

FOR PATENT OWNER:

Robert P. Greenspoon

Joseph C. Drish

FLACHSBART & GREENSPOON, LLC

rpg@fg-law.com

jcd@fg-law.com