

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMARTMATIC USA CORPORATION

Petitioner,

v.

ELECTION SYSTEMS & SOFTWARE, LLC,

Patent Owner

Case – IPR2019-00531

Patent 8,096,471 B2

PETITIONER'S NOTICE OF APPEAL

Pursuant to 37 C.F.R. § 90.2(a), Petitioner Smartmatic USA Corporation (“Petitioner”) hereby gives notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Patent Trial and Appeal Board’s July 17, 2020 Final Written Decision (Paper No. 40) and all underlying orders, decisions, rulings, and opinions regarding U.S. Patent No. 8,096,471 (the “’471 Patent”).

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Petitioner states that anticipated issues on appeal include, but are not limited to:

- 1) Whether the Board erred in determining that Petitioner did not show by a preponderance of evidence that the ’471 patent’s claim 16 is unpatentable under 35 U.S.C. § 103 in light of the combination of U.S. Patent No. 7,077,314 (“Johnson”) and U.S. Patent Application Publication No. 2004/0016802 (“Cummings”).
- 2) Whether the Board erred in determining that Petitioner did not show by a preponderance of evidence that the ’471 patent’s substitute claims 21-29 are unpatentable under 35 U.S.C. § 103 in light of the combinations of Johnson, Cummings, and U.S. Patent Application Publication No. 2008/0079210 (“Nakada”).
- 3) Whether the Board erred in finding substitute claims 21-29 as meeting statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121.

Petitioner reserves the right to challenge any finding or determination supporting or relating to the issues listed above and to challenge any other issues decided adversely to Petitioner in the Final Written Decision and/or any orders, decisions or rulings underlying the Final Written Decision.

A copy of this Notice of Appeal is being filed with the Patent Trial and Appeal Board. In addition, this Notice of Appeal and the required docketing fees are being filed with the Clerk's Office for the United States Court of Appeals for the Federal Circuit.

Dated: February 1, 2021

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Respectfully Submitted,

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Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that, in addition to being electronically filed through the PTAB E2E system, a true and correct copy of this Notice of Appeal is being provided on this date via Priority Mail Express® to the Director of the United States Patent and Trademark Office at the following address:

Office of the General Counsel
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

The undersigned also hereby certifies that a true and correct copy of this Notice of Appeal is being filed on this date via the CM/ECF filing system with the Clerk's Office for the United States Court of Appeals for the Federal Circuit.

Dated: February 1, 2021

/Aaron G. Fountain/
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Respectfully Submitted,

/Timothy Lohse/
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CERTIFICATE OF SERVICE

The undersigned certifies that service of the foregoing document was made on Patent Owner's counsel of record by filing this document through the PTAB E2E system and via email to the following addresses:

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