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Paper No. 8
Entered: August 17, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINGSTON TECHNOLOGY COMPANY, INC.,
Petitioner,

v.

SPEX TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-00824
Patent 6,088,802

Before LYNNE E. PETTIGREW, DANIEL N. FISHMAN, and CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Kingston Technology Company, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–3, 6–8, 11–15, 23–28, and 36–39 of U.S. Patent No. 6,088,802 (Ex. 1001, "the '802 patent"). Paper 2 ("Pet."). SPEX Technologies, Inc. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp.").

Under 35 U.S.C. § 314, 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." 35 U.S.C. § 314(a). For the reasons that follow, we are not persuaded, on this record, that Petitioner has established a reasonable likelihood of prevailing in showing the unpatentability of any of the challenged claims on the asserted grounds. Accordingly, we *deny* the Petition and decline to institute an *inter partes* review of claims 1–3, 6–8, 11–15, 23–28, and 36–39 of the '802 patent.

II. BACKGROUND

A. Related Matters

The parties indicate that the '802 patent is involved in *SPEX Technologies, Inc. v. Kingston Technology Co. Inc.*, No. 8:16-cv-01790 (C.D. Cal. Filed Sept. 27, 2016); *SPEX Technologies, Inc. v. Western Digital Corp.*, No. 8:16-cv-01799 (C.D. Cal. Filed Sept. 28, 2016); *SPEX Technologies, Inc. v. Toshiba America Electronics Components Inc.*, No. 8:16-cv-01800 (C.D. Cal. Filed Sept. 28, 2016); *SPEX Technologies, Inc. v. CMS Products, Inc.*, No. 8:16-cv-01801 (C.D. Cal. Filed Sept. 28, 2016); *SPEX Technologies, Inc. v. Integral Memory, PLC*, No. 8:16-cv-01805 (C.D. Cal. Filed Sept. 28, 2016); and *SPEX Technologies, Inc. v.*

Apricorn, No. 2:16-cv-07349 (C.D. Cal. Filed Sept. 28, 2016). Pet. 2; Paper 3, 2–3.[1]

The ’802 patent also was the subject of a petition for *inter partes* review filed December 14, 2016, by Unified Patents Inc. Case IPR2017-00430, Paper 2. A decision denying institution of *inter partes* review in that case was entered on July 5, 2017. Case IPR2017-00430, Paper 8.

B. The ’802 Patent

The ’802 patent is directed to a peripheral device that may be connected to a host computer, where the peripheral device performs security operations such as encryption and decryption on data communicated between the peripheral device and the host computer. Ex. 1001, 1:17–27, 1:35–38, 4:49–5:4. Figures 1, 2, and 3A of the ’802 patent are reproduced below.

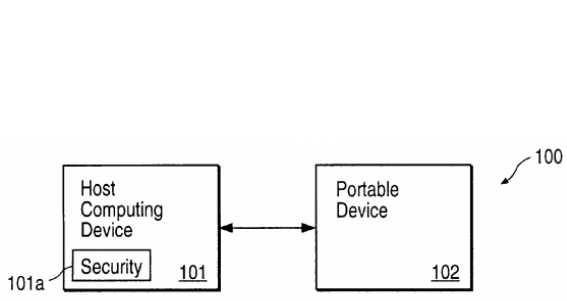

FIG. 1
(PRIOR ART)

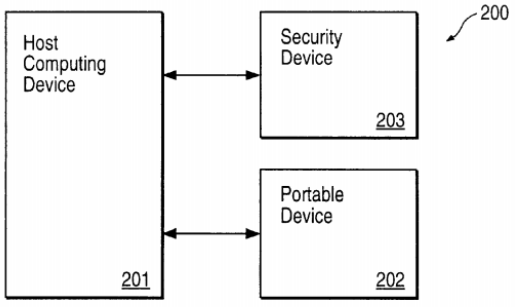

FIG. 2
(PRIOR ART)

[1] We note that Patent Owner’s Mandatory Notices Pursuant to 37 C.F.R. § 42.8(a)(2) (Paper 3) does not include page numbers. For ease of reference, the Parties are advised to include page numbers in all filings.

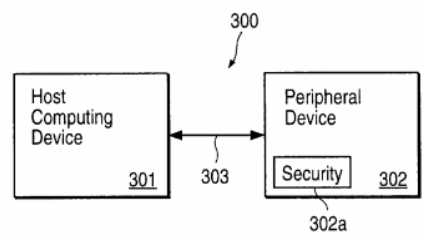

FIG. 3A

Figures 1 and 2 are block diagrams of prior art systems described in the ’802 patent. *Id.* at 1:52–3:14, 4:14–19. Figure 3A is a block diagram of a system according to the claimed invention of the ’802 patent. *Id.* at 4:20–21. The ’802 patent explains that in the prior art, such security operations were either performed by the host computer, as illustrated in Figure 1 with security mechanism 101a included in host computing device 101, or by a standalone security device, as illustrated by security device 203 in Figure 2. *Id.* at 1:58–59, 2:22–32. According to the ’802 patent, both of those arrangements were deficient in various ways. *Id.* at 2:10–21, 2:58–3:14.

C. Illustrative Claims

Of the challenged claims, claims 1, 6, 11, 23, 24, 36, 37, 38, and 39 are independent. Claims 1, 38, and 39, reproduced below, are illustrative of the claimed subject matter:

1. A peripheral device, comprising:

security means for enabling one or more security operations to be performed on data;

target means for enabling a defined interaction with a host computing device;

means for enabling communication between the security means and the target means;

means for enabling communication with a host computing device;

means for operably connecting the security means and/or the target means to the host computing device in response to an instruction from the host computing device; and

means for mediating communication of data between the host computing device and the target means so that the communicated data must first pass through the security means.

38. For use in a peripheral device adapted for communication with a host computing device, performance of one or more security operations on data, and interaction with a host computing device in a defined way, a method comprising the steps of:

receiving a request from a host computing device for information regarding the type of the peripheral device; and

providing to the host computing device, in response to the request, information regarding the type of the defined interaction.

39. For use in a peripheral device adapted for communication with a host computing device, performance of one or more security operations on data, and interaction with a host computing device in a defined way, a method comprising the steps of:

communicating with the host computing device to exchange data between the host computing device and the peripheral device;

performing one or more security operations and the defined interaction on the exchanged data; and

mediating communication of the exchanged data between the host computing device and the peripheral device so that the exchanged data must first [pass] through means for performing the one or more security operations.

Ex. 1001, 18:55–19:4, 22:13–38.

D. References Relied Upon

Petitioner relies on the following references:

Exhibit	Reference
1003	PCT Application WO 95/16238, published June 15, 1995 ("Jones")
1004	U.S. Patent No. 5,675,645, issued Oct. 7, 1997 (filed Apr. 18, 1995) ("Schwartz")
1005	U.S. Patent No. 5,237,609, issued Aug. 17, 1993 ("Kimura")
1007	U.S. Patent No. 5,465,338, issued Nov. 7, 1995 ("Clay")
1008	*Common Interface Specification for Conditional Access and Other Digital Video Broadcasting Decoder Applications*, Digital Video Broadcasting, DVB Document A017, dated May 31, 1996 ("Common Interface Specification")

Pet. 4–5. Petitioner also relies on a declaration of Roy A. Griffin III, P.E. (Ex. 1009).

E. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–3, 6–8, 11–15, 23–28, and 36–39 under 35 U.S.C. § 103(a) on the following grounds:

Reference(s)	Claims Challenged
Jones	1–3, 6–8, 11–15, 23–28, and 36–39
Jones and (Schwartz and/or Kimura)	1, 11, 23, 36, and 39
Jones and Common Interface Specification	3, 8, 15, and 28
Jones and Clay	14 and 27

Pet. 5.

III. DISCUSSION

A. Claim Construction

1. Applicable Standard and General Principles

Although the ’802 patent’s expiration date is not mentioned by either party, we note that the ’802 patent issued from an application filed June 4, 1997, and accordingly expired no later than June 4, 2017. 35 U.S.C. § 154(a)(2). Petitioner contends that, “[u]nder 37 C.F.R. § 42.100(b), a claim in *inter partes* review is given the ‘broadest reasonable construction’ in light of the specification” and that “for purposes of this *inter partes* proceeding only, that the broadest reasonable interpretation should govern the meaning of the claim terms.” Pet. 24–25. Petitioner disregards that section 42.100(b) states more specifically only that “[a] claim *in an unexpired patent that will not expire before a final written decision is issued* shall be given its broadest reasonable construction” (emphasis added), and that we instead construe claims of an expired patent according to the standard applied by the district courts. *See In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012) (“While claims are generally given their broadest possible scope during prosecution, *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000), the Board’s review of the claims of an expired patent is similar to that of a district court's review.”). Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc). Under that standard, the words of a claim are generally given their ordinary and customary meaning, which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *See Phillips*, 415 F.3d at 1312–13.

A claim limitation using the phrase "means for" creates a rebuttable presumption that the drafter intended to invoke 35 U.S.C. § 112 ¶ 6.[2] *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015). Section 112 ¶ 6 provides that:

> An element in a claim for a combination may be expressed as a means . . . for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Construing a means-plus-function claim term is a two-step process, wherein we first identify the claimed function and then determine what structure, if any, disclosed in the specification corresponds to the claimed function. *Id.* at 1351; *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1119 (Fed. Cir. 2002). Moreover, "structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim." *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1334 (Fed. Cir. 2004); *Cardiac Pacemakers*, 296 F.3d at 1113. This analysis applies similarly under both the broadest reasonable construction and district court-type claim construction standards. *See Williamson*, 792 F.3d at 1348 (affirming application of § 112 ¶ 6 in district court litigation); *In re Aoyama*, 656 F.3d 1293, 1297 (Fed. Cir. 2011)

[2] Section 4(c) of the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, § 4(c), 125 Stat. 284 (2011), re-designated 35 U.S.C. § 112 ¶ 6, as 35 U.S.C. § 112(f). Because the '802 patent has a filing date before September 16, 2012 (effective date of the statute), we refer to the pre-AIA version of 35 U.S.C. § 112.

("[T]he broadest reasonable interpretation . . . [of] means-plus-function language is that statutorily mandated in [Section 112] paragraph six." (quoting *In re Donaldson Co.*, 16 F.3d 1189, 1194–95 (Fed. Cir. 1994) (en banc))); *Donaldson*, 16 F.3d at 1193 ("[P]aragraph six applies regardless of the context in which the interpretation of means-plus-function language arises, i.e., whether as part of a patentability determination in the PTO or as part of a validity or infringement determination in a court.").

Our Rules specifically require that a petition for *inter partes* review identify how each challenged claim is to be construed, including identification of the corresponding structure for means-plus-function limitations. In particular, "[w]here the claim to be construed contains a means-plus-function . . . limitation as permitted under 35 U.S.C. 112 [¶ 6], the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function." 37 C.F.R. § 42.104(b)(3).

2. "security means for enabling one or more security operations to be performed on data" / "means for performing . . . one or more security operations"

The limitation "security means for enabling one or more security operations to be performed on data" is recited in each of independent claims 1, 6, 11, 23, 24, 36, and 37 of the '802 patent. The limitation "means for performing . . . one or more security operations" is recited in independent claim 39. Petitioner does not address these limitations—or any other claim terms—expressly in the "Claim Construction" portion of the Petition. *See generally* Pet. 24–25. In the discussion of its first asserted ground of

unpatentability, however, Petitioner contends as follows, with respect to the "security means" limitation of claim 1:

> The function recited by this mean-plus-function language is the function of enabling one or more security operations to be performed on data. The '802 patent describes a "security mechanism" that is used to perform a range of security operations on data, including cryptographic functions:
>
> > Generally, the security mechanism 302a can be configured to perform any electronic data security operation (herein, referred to simply as "security operation") including, for example, operations that provide one or more of the basic cryptographic functions, such as maintenance of data confidentiality, verification of data integrity, user authentication and user nonrepudiation. Particular security operations that can be implemented in a peripheral device according to the invention are described in more detail below.
> >
> > The security mechanism 302a can be, for example, embodied as a security token. Herein, "security token" refers to a device that performs security operations and that includes one or more mechanisms (such as, for example, use of a hardware random number generator and/or protected memory) to provide security for the content of those operations.

Pet. 27–28 (quoting Ex. 1001, 5:23–39) (citing Ex. 1001, 15:63–67; Ex. 1009 ¶ 44). Petitioner does not identify expressly the function or any corresponding structure disclosed in the '802 patent with respect to the "means for performing . . . one or more security operations" recited in claim 39. *Id.* at 60–62.

In the Preliminary Response, Patent Owner argues that the recited "security means" and "means for performing the one or more security

operations," among other claim terms, are presumed to be means-plus-function terms. Prelim. Resp. 5–6. Patent Owner does not dispute Petitioner's contentions with respect to the functions of these limitations or the applicability of the disclosures of the '802 patent cited by Petitioner, but instead takes issue, *inter alia*, with Petitioner's failure to state explicitly that these limitations are governed by § 112 ¶ 6 or to advance constructions of any claim term in the Claim Construction section of the Petition. *Id.* at 6–7. Patent Owner further contends, "Petitioner failed to identify the corresponding structure disclosed in the '802 Patent that is clearly linked or associated with the function in the claim of 'enabling one or more security operations to be performed on data.'" *Id.* at 14. More particularly, Patent Owner argues, "[w]hile Petitioner states that the ''802 Patent describes a "security mechanism" that is used to perform a range of security operations on data,' Petitioner stops short of admitting that the security mechanism 302a is the corresponding structure and showing how the security mechanism is clearly linked to the claimed function." *Id.* As such, Patent Owner argues, "Petitioner has failed to carry its burden" of identifying the claimed function and the specific portions of the specification that describe the structure corresponding to the claimed function. *Id.*

Having considered the parties' arguments, we agree with Patent Owner that the recited "security means" and "means for performing the one or more security operations" are means-plus-function limitations subject to construction under 35 U.S.C. § 112 ¶ 6 and that the burden was on Petitioner under 37 C.F.R. § 42.104(b)(3) to identify the specific portions of the '802 patent specification that describe the structure, material, or acts corresponding to the claimed functions.

Although we further agree with Patent Owner that Petitioner "stops short" in the Petition of stating that "security mechanism 302a" disclosed in the '802 patent is the corresponding structure and showing how it is clearly linked to the claimed function (Prelim. Resp. 14), we are not persuaded that "security mechanism 302a," standing alone, provides sufficient structure to satisfy the requirements of 35 U.S.C. § 112 ¶ 6. As the Federal Circuit explained in *Williamson*, "[g]eneric terms such as 'mechanism,' . . . and other nonce words that reflect nothing more than verbal constructs may be used in a claim in a manner that is tantamount to using the word 'means' because they 'typically do not connote sufficiently definite structure' and therefore may invoke § 112, para. 6." *Williamson*, 792 F.3d at 1350 (quoting *Mass. Inst. of Tech. v. Abacus Software*, 462 F.3d 1344, 1354 (Fed. Cir. 2006)). Accordingly, merely replacing "means" with the similarly generic word "mechanism" would not discharge Petitioner's obligation under 37 C.F.R. § 42.104(b)(3) to identify the portions of the specification that describe the *structure* corresponding to the claimed function, even if Petitioner had been explicit in linking the disclosure of security mechanism 302a with the claimed function.

We note, however, that, as quoted above, Petitioner additionally cites the '802 patent as disclosing that "security mechanism 302a can be, for example, embodied as a security token," where "'security token' refers to a device that performs security operations and that includes one or more mechanisms (such as, for example, use of a hardware random number generator and/or protected memory) to provide security for the content of those operations." Pet. 28 (quoting Ex. 1001, 5:23–39). On the current record, we find such security token to be the only sufficiently definite

structure identified by the parties linked with the functions of the "security means" recited in independent claims 1, 6, 11, 23, 24, 36, and 37, as well as the "means for performing . . . one or more security operations" recited in independent claim 39 but not separately addressed by Petitioner. Accordingly, for purposes of this Decision, we construe both "security means for enabling one or more security operations to be performed on data" and "means for performing the one or more security operations" under 35 U.S.C. § 112 ¶ 6 to cover "a security token that performs security operations and that uses a hardware random number generator or protected memory, or both, to provide security for the content of those operations," as well as equivalents thereof.

3. Other terms

For reasons stated below, we determine that the construction of "security means" and "means for performing the one or more security operations" provided in the previous subsection is dispositive of all of Petitioner's challenges as to claims 1–3, 6–8, 11–15, 23–28, 36, 37, and 39 of the '802 patent. Moreover, the parties have not identified any dispute regarding the construction of any terms of the remaining challenged claim, i.e., claim 38. Accordingly, we need not construe any other terms on the present record. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) ("[C]laim terms need only be construed 'to the extent necessary to resolve the controversy.'" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

B. Analysis of Asserted Grounds of Unpatentability

1. General Principles

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter[,] as a whole[,] would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art[3]; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Our Rules require that a petition for *inter partes* review identify "[h]ow the construed claim is unpatentable under the statutory grounds identified" and must specify "where each element of [a challenged] claim is found in the prior art patents or printed publications relied upon." 37 C.F.R. § 42.104(b)(4). Moreover, "a challenger who seeks to demonstrate that a means-plus-function limitation was present in the prior art must prove that the corresponding structure—or an equivalent—was present in the prior art." *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1299 (Fed. Cir. 2009) (citing *Donaldson*, 16 F.3d at 1193).

[3] Petitioner proposes a definition for a person of ordinary skill in the art. Pet. 23; *see* Ex. 1009 ¶ 20. Patent Owner does not challenge this definition. For purposes of this Decision and to the extent necessary, we adopt Petitioner's definition.

2. Asserted Obviousness of Claims 1–3, 6–8, 11–15, 23–28, 36, 37, and 39 over Jones

Petitioner asserts that claims 1–3, 6–8, 11–15, 23–28, 36, 37, and 39 are unpatentable as obvious over Jones. Pet. 25–56, 58–62. Having reviewed the Petition and Preliminary Response, as well as the presented evidence, we determine that Petitioner has not established a reasonable likelihood of prevailing on its assertion that the subject matter of claims 1–3, 6–8, 11–15, 23–28, 36, 37, and 39 would have been obvious over Jones.

a. Overview of Jones

Jones, titled "Secure Computer Memory Card," describes a detachable memory card that may be interconnected with a host personal computer by means of a hardware and software interface in conformance with the Personal Computer Memory Card International Association (PCMCIA) standard. Ex. 1003, Title, Abstract, 4:3–7. Figure 1 of Jones is reproduced below.

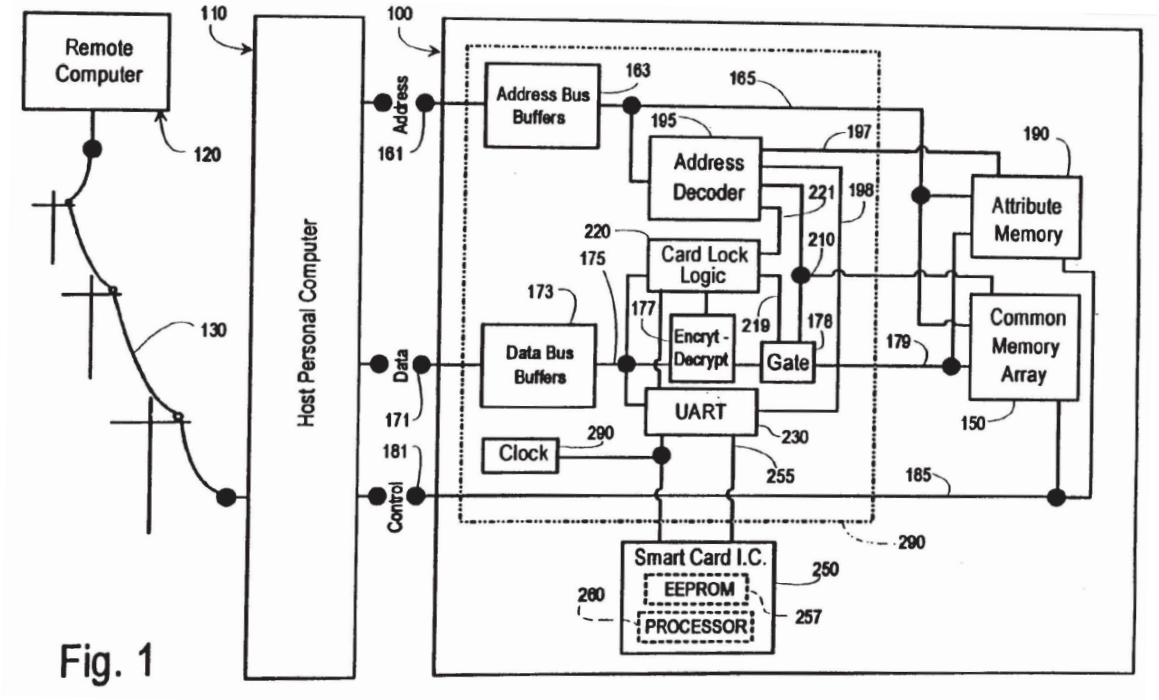

Fig. 1

Figure 1 is a block diagram of a memory card described by Jones, shown interconnected with a host computer that is, in turn, connected to other computers by telecommunications links. Ex. 1003, 3:26–29. As illustrated in Figure 1, memory card 100 includes smart card integrated circuit (I.C.) 250 for storing a password, as well as logic circuitry for preventing access to information stored on the memory card unless a user of host computer 110 to which memory card 100 is connected can supply a password matching the stored password. *Id.* at Abstract. Smart card I.C. 250 may also be used to store public and private key values used to encrypt and decrypt data stored on memory card 100, elsewhere on host computer 110, or exchanged with remote computer 120. *Id.*

According to Jones, memory card 100 stores data in common memory array 150, preferably implemented with non-volatile flash memory integrated circuits. *Id.* at 4:29–30. Data transfers between common memory array 150 and host computer 110 are accomplished via interface data terminals 171, data bus buffer 173, internal data bus 175, internal encryption/decryption unit 177, gate 178, and internal data bus 179. *Id.* at 5:1–4. Control signals are exchanged between common memory array 150 and host computer 110 via PCMClA interface control terminals 181 and internal control bus 185. *Id.* at 5:4–7.

b. Discussion

As stated in § III.A.2. *supra*, each of independent claims 1, 6, 11, 23, 24, 36, and 37 includes the limitation "security means for enabling one or more security operations to be performed on data," and independent claim 39 recites "means for performing . . . one or more security operations." Challenged claims 2, 3, 7, 8, 12–15, and 25–28 are dependent claims that

depend directly or indirectly from claim 1, 6, 11, or 24, and each accordingly also includes the same "security means" limitation. *See* 35 U.S.C. § 112 ¶ 4.

In support of its contention that claim 1 is unpatentable over Jones, Petitioner argues as follows with respect to the recited "security means" limitation:

> Jones's abstract states:
>
> > A detachable PCMCIA memory card incorporating a smartcard integrated circuit for storing a password value and logic circuitry for preventing access to information stored on the memory card unless the user of the host computer to which the memory card is connected can supply a password matching the stored password. . . .
>
> Jones discloses an encryption-decryption unit 177 and gate that perform cryptographic functions on data, and thus correspond to the security means claimed in the '802 patent. With regard to the encryption-decryption unit, Jones states: "To provide additional security, the data transferred over the 16-bit data bus between the data bus buffer 173 and the gate 178 is processed by the encryption-decryption unit 177 which preferably [i]mplements a symmetrical key algorithm . . . ." Ex. 1003 at page 8, lines 3–6. Further, "[g]ate 178 prevents the common memory array 150 from exchanging data with the host 150 via data bus 179 unless an authorization signal is supplied to the gate via a control line 219 from a card lock logic circuit 220." *Id.* at page 6, lines 5–7. Griffin Dec. (Ex. 1009), ¶¶ 45–46.

Pet. 28–29. Petitioner relies on the same argument with respect to the "security means" limitations of claims 6, 11, 23, 24, 36, and 37. *Id*. at 41, 44, 48, 50, 54, 55. Petitioner does not separately address the "means for performing . . . one or more security operations" limitation of claim 39, but argues that Figure 1 of Jones "shows that the

exchanged data must first pass through Encrypt-Decrypt block 177 and gate 178 of security module 290/250" in arguing that Jones teaches the recited step of "mediating communication of the exchanged data between the host computing device and the peripheral device so that the exchanged data must first pass through means for performing the one or more security operations."

Patent Owner responds that, although Petitioner points to encryption-decryption unit 177 and gate 178 of Jones as corresponding to the "security means" and "means for performing the one or more security operations" of the challenged claims, "Petitioner, however, never performed the required structural analysis." Prelim. Resp. 15. More particularly, Patent Owner contends, "even if the 'security mechanism 302a' is the corresponding structure identified by Petitioner, Petitioner never compared the structure of the security mechanism 302a to the encryption-decryption unit 177 and gate 178 in Jones to show that the structures are the same." *Id.* at 16. Accordingly, Patent Owner concludes, Petitioner has failed to carry its burden to show where the claimed "security means" is disclosed in Jones, and Petitioner's challenge of claims 1–3, 6–8, 11–15, 23–28, 36, 37, and 39 should be denied. *Id.*

We agree with Patent Owner. An unpatentability determination with respect to claims subject to construction under § 112 ¶ 6 requires structural analysis demonstrating that the corresponding structure in the challenged patent specification—or an equivalent structure—is present in the prior art. *SpaceCo Bus. Sols., Inc. v. Moscovitch*, IPR2015-00127, slip op. at 25 (PTAB May 14, 2015) (Paper 16)

(citing *Fresenius*, 582 F.3d at 1299). Although for the reasons stated in § III.A.2 *supra* we are not persuaded that "security mechanism 302a" is the proper corresponding structure for the recited "security means" and "means for performing the one or more security operations" limitations, Petitioner's failure to perform any structural comparison of Jones's encryption-decryption unit 177 and gate 178 alleged to correspond to the claimed means limitations with *any* structure disclosed in the '802 patent is fatal to Petitioner's contentions. Accordingly, we do not institute an *inter partes* review of claims 1–3, 6–8, 11–15, 23–28, 36, 37, and 39 as unpatentable over Jones.

3. Asserted Obviousness of Claim 38 over Jones

Petitioner asserts that claim 38 is unpatentable as obvious over Jones. Pet. 56–58. Having reviewed the Petition and the Preliminary Response, as well as the presented evidence, we determine that Petitioner has not established a reasonable likelihood of prevailing on this assertion.

Claim 38 recites, in part, "*receiving a request* from a host computing device for information regarding the type of the peripheral device; and providing to the host computing device, *in response to the request*, information regarding the type of the defined interaction." Ex. 1001, 22:18–23 (emphasis added). In support of its contention that claim 38 is unpatentable over Jones, Petitioner quotes Jones as follows:

> To implement the PCMCIA interface standard, the secure memory card includes a non-volatile attribute memory 190 which stores information <u>enabling the host computer to automatically identify the particular PCMCIA card</u> as soon as the card and host are connected, and to automatically establish the

> appropriate hardware/software interface using suitable driver software which executes on the host computer 110.

Pet. 56–57 (quoting Ex. 1003, 5:24–29 (emphasis added by Petitioner)); *id*. at 58 (quoting the same passage). Petitioner further contends:

> This is consistent with the teachings of Jones that the host calls on various card functions when the host and peripheral device are connected:
>
> > Whenever a PCMCIA card is newly inserted into the socket of a running host computer, the Client Device Driver is notified by the Card Services software (via its CARD INSERTION callback function), so that it can process the card's CIS entries to identify each partition that may be password-protected. Similarly, when the host computer is first powered up and the Client Device Driver is initialized, the Client Device Driver calls Card Services functions to process the cards CIS entries to identify each partition that may be locked. The device driver software then attempts to access each identified partition.
>
> Ex. 1003 at page 10, lines 10–18 (emphasis added). Griffin Dec. (Ex. 1009), ¶ 124.

Pet. 57.

Patent Owner responds that Petitioner fails to show that the step of "receiving a request from a host computing device for information regarding the type of the peripheral device" is disclosed by Jones, as the passages of Jones quoted by Petitioner do not teach "receiving a request from a host computing device," and also fails to show that Jones discloses "providing to the host computing device, in response to the request, information regarding the type of the defined interaction." Prelim. Resp. 24–25. With regard to the first passage from Jones quoted by Petitioner, Patent Owner argues that

passage "states that the PCMCIA card contains information 'enabling the host computer to automatically identify the particular PCMCIA card . . . and establish the appropriate driver software,'" but "does not disclose that the PCMCIA card 'receives a request from a host computing device.'" *Id.* at 24. Regarding the second quoted passage, Patent Owner contends the passage "fails to teach a request for information 'regarding the type of the peripheral device,'" and instead "teaches that the client device driver, which is executed on the host computer, calls card services software, which is also stored on the host computer . . . to process the card's CIS entries to identify partitions which may be password protected or locked." *Id.* (citing Ex. 1003, 8:34–9:4, 10:10–18; Pet. 57).

We agree with Patent Owner. Petitioner does not sufficiently, persuasively explain how Jones's disclosure of a memory card that "stores information enabling [a] host computer to automatically identify the particular . . . card as soon as the card and host are connected, and to automatically establish [an] appropriate hardware/software interface" teaches or suggests "*receiving a request* from a host computing device for information regarding the type of the peripheral device; and providing to the host computing device, *in response to the request*, information regarding the type of the defined interaction," as recited in claim 38. Indeed, Jones's statement that the card includes information enabling the host to "automatically" identify the card "as soon as the card and host are connected" suggests not only that receipt of a request is unnecessary, but also that the information is not provided "in response to [a] request." Our Rules require that a petition for *inter partes* review "specify where each element of [a challenged] claim is found in the prior art patents or printed

publications relied upon." 37 C.F.R. § 42.104(b)(4). Because Petitioner has not shown that Jones teaches or suggests either "*receiving a request* from a host computing device for information regarding the type of the peripheral device" or "providing to the host computing device, *in response to the request*, information regarding the type of the defined interaction," as recited in claim 38, we do not institute an *inter partes* review of that claim as unpatentable over Jones.

4. Remaining Grounds

Petitioner asserts that independent claims 1, 11, 23, 36, and 39 also are unpatentable over the combination of Jones and Schwartz and/or Kimura; that dependent claims 3, 8, 15, and 28 (which depend from claims 1, 6, 11, and 24, respectively) are unpatentable over the combination of Jones and Common Interface Specification; and that dependent claims 14 and 27 (which depend indirectly from claims 11 and 24, respectively) are unpatentable over the combination of Jones and Clay. Pet. 62–67. Petitioner does not rely in the Petition on Schwartz, Kimura, Common Interface Specification, or Clay to teach or suggest the "security means" limitation of independent claims 1, 6, 11, 23, 24, and 36 or the "means for performing the one or more security operations" limitation of claim 39, but instead continues to rely on Jones for those limitations.[4] Accordingly, for

[4] Petitioner asserts that "Figures 1 and 2 of Schwartz show an arrangement of a cartridge whereby communications from a bus must pass through a security chip before accessing a [read-only memory]." Pet. 63 (citing Ex. 1004, 6:53–7:23; Ex. 1009 ¶ 135). Nonetheless, Petitioner does not allege that Schwartz's "security chip" corresponds to the claimed "security means" or "means for performing the one or more security operations," let alone

the same reasons as set forth in § III.B.2 with respect to the alleged ground based on Jones alone, we conclude that Petitioner has not established a reasonable likelihood that it would prevail in showing that claims 1, 3, 8, 11, 14, 15, 23, 26–28, and 39 are unpatentable on the remaining proffered grounds, and we do not institute an *inter partes* review on any of those grounds.

C. Conclusion

For the reasons discussed above, Petitioner has not established a reasonable likelihood that it would prevail with respect to any of the claims challenged in the Petition.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no *inter partes* review is instituted on any asserted ground.

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offer any structural analysis comparing Schwartz's chip to any corresponding structure in the '802 patent.

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