Director_PTABDecision_Review@uspto.gov
571-272-7822

Paper 49
Date: March 15, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

ASSA ABLOY AB, ASSA ABLOY INC.,
ASSA ABLOY RESIDENTIAL GROUP, INC., AUGUST HOME, INC.,
HID GLOBAL CORPORATION, and
ASSA ABLOY GLOBAL SOLUTIONS, INC.,
Petitioner,

v.

CPC PATENT TECHNOLOGIES PTY, LTD.,
Patent Owner.

IPR2022-01006 (Patent 9,665,705 B2)
IPR2022-01045 (Patent 9,269,208 B2)
IPR2022-01089 (Patent 9,269,208 B2)[1]

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*.

DECISION
Granting Director Review, Vacating the Final Written Decision, and
Remanding to the Patent Trial and Appeal Board Panel
for Further Proceedings

---

[1] This Decision applies to each of the above captioned proceedings.

I. INTRODUCTION

On May 31, 2022, ASSA ABLOY AB, ASSA ABLOY Inc., ASSA ABLOY Residential Group, Inc., August Home, Inc., HID Global Corporation, and ASSA ABLOY Global Solutions, Inc. (collectively, "Petitioner") filed a Petition requesting an *inter partes* review of claims 1–17 of U.S. Patent No. 9,665,705 B2 (Ex. 1001, "the '705 patent").[2] IPR2022-01006, Paper 2 ("Pet."). On June 3, 2022, Petitioner filed two separate Petitions requesting *inter partes* reviews of claims 1–13 of U.S. Patent No. 9,269,208 B2 ("the '208 patent").[3] IPR2022-01045, Paper 3 (claims 1–9); IPR2022-01089, Paper 3 (claims 10–13). On December 1, 2022, the Board instituted *inter partes* review (Paper 23) of the -1006 IPR and, on January 3, 2023, the Board instituted *inter partes* reviews (IPR2022-01045, Paper 21; IPR2022-01089, Paper 21) of the -1045 and -1089 IPRs.

On November 30, 2023, the Board issued a Final Written Decision (Paper 47, "Final Dec.") in the -1006 IPR and, on December 20, 2023, the Board issued a single, combined Final Written Decision in the -1045 and -1089 IPRs (IPR2022-01045, Paper 42; IPR2022-01089, Paper 42). The Final Written Decisions determined that Petitioner had not shown by a preponderance of the evidence that any challenged claim of the '705 patent

[2] Unless otherwise noted, all citations are to papers and exhibits in IPR2022-01066 ("the -1006 IPR"). Petitioner filed similar papers in IPR2022-01045 ("the -1045 IPR") and IPR2022-01089 ("the -1089 IPR") (collectively, "the -1045 and -1089 IPRs").

[3] The '705 patent and '208 patent are both continuation applications from U.S. Patent Application No. 10/568,207, now issued as U.S. Patent No. 8,266,442 B2. *Compare* Ex. 1001, code (63), *with* Ex. 1007, code (63).

or the '208 patent was unpatentable.[4] Final Dec. 86; IPR2022-01045, Paper 42, 92.

On December 22, 2023 and January 18, 2024, Petitioner filed requests for Director Review of the Board's Final Written Decisions. Paper 48, Ex. 3100; IPR2022-01045, Paper 43, Ex. 3100; IPR2022-01089, Paper 43, Ex. 3100 (collectively, "Requests"). Petitioner raises three issues in its Requests: (1) whether the Board's construction of "biometric signal" adds a limitation "[f]or the first time, using language neither side proposed" (Paper 48, 2, 6–7); (2) whether the Board's construction of "biometric signal" is erroneous (*id.* at 2–4, 6–13); and (3) whether the Board inconsistently addressed the claim limitation "receive a series of entries of the biometric signal[] . . . " between the captioned proceedings and IPR2022-00601 and IPR2022-00602 (*id.* at 4–6, 10, 14–15). *See Apple Inc. v. CPC Patent Techs. Pty, Ltd.*, IPR2022-00602, Paper 31 (PTAB Sept. 27, 2023) (challenging the '705 patent); *Apple Inc. v. CPC Patent Techs. Pty, Ltd.*, IPR2022-00601, Paper 31 (PTAB Sept. 27, 2023) (challenging the '208 patent).

I have reviewed Petitioner's Requests, the Board's Final Written Decisions, and the Papers and Exhibits of record in the captioned proceedings. I determine that Director Review of the Board's Final Written Decisions is appropriate. *See Revised Interim Director Review*

[4] The Board made similar determinations in each captioned proceeding. My reasoning and the determinations made in this Decision apply equally to all captioned proceedings.

Process[5] §§ 4.B, 5.A. For the reasons discussed in further detail below, I vacate the Board's Final Written Decisions and remand for further proceedings consistent with this Decision.

II. BACKGROUND

Independent claims 1 of the '705 and '208 patents recite, in part, "A system for providing secure access to a controlled item, the system comprising: . . . a biometric sensor configured to receive *a biometric signal*." Ex. 1001, 15:62–16:23 (emphasis added); Ex. 1007, 15:42–16:3.

Prior to institution, neither Petitioner nor CPC Patent Technologies Pty Ltd. ("Patent Owner") offered a construction for the term "biometric signal," and the Board stated that it construed the claims according to their "plain and ordinary meaning" in its decisions granting institution. *See* Paper 27 (Corrected Decision), 41.

After institution, Patent Owner argued that "biometric signal" means a "physical attribute of the user (i.e., fingerprint, facial pattern, iris, retina, voice, etc.)."[6] Paper 31 ("PO Resp."), 8–19; Paper 41 ("PO Sur-reply"), 7–

[5] Available at www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process.

[6] Patent Owner's proposed claim construction is the same one offered by petitioner Apple in IPR2022-00601 and IPR2022-00602. *See* IPR2022-00601, Paper 1, 9; IPR2022-00602, Paper 1, 6. In those IPRs, the Board adopted Apple's unopposed construction in its institution decisions (*see* IPR2022-00601, Paper 11, 13; IPR2022-00602, Paper 11, 13), and the parties did not propose any constructions for the term during trial (*see* IPR2022-00601, Papers 17, 20; IPR2022-00601, Papers 17, 20). The Board did not further address the construction of "biometric signal" in its final written decisions in those cases. *See* IPR2022-00601, Paper 31, 21–22; IPR2022-00602, Paper 31, 17–18.

11. In contrast, Petitioner responded that "biometric signal" means "the input and output of the biometric sensor." Paper 35 ("Pet. Reply"), 7–11.

In its Final Written Decisions, the Board determined that a dispute existed as to the meaning of "biometric signal" and construed the term to mean "a physical or behavioral biometric attribute that provides secure access to a controlled item." Final Dec. 54–68, 79 ("We note that our construction of the claim term 'biometric signal' . . . is different from the construction proposed by Patent Owner.").

III. DISCUSSION

"[T]he Board [is] permitted to issue a new construction in the final written decision given that claim construction was a disputed issue during the proceedings." *See WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1328 (Fed. Cir. 2018). However, "under the APA, the Board 'may not change theories midstream' by adopting a different claim construction in the final written decision than that adopted in the institution decision 'without giving respondents reasonable notice of the change and the opportunity to present argument under the new theory.'" *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1381–1382 (Fed. Cir. 2023) (citing and discussing *SAS Inst., Inc. v. ComplementSoft, LLC*, 825 F.3d 1341, 1351 (Fed. Cir. 2016), *rev'd and remanded on other grounds, SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018)).[7] Further, the Federal Circuit has found there

[7] The *WesternGeco* court also observed that where the construction in a final written decision "is *sufficiently similar* to a construction disputed by the parties, the Board need not give the parties prior notice of the exact construction the Board adopts." *Axonics*, 75 F.4th at 1381 n.7 (emphasis added) (citing *WesternGeco*, 889 F.3d at 1328). The Federal Circuit has not,

to be inadequate notice and opportunity to respond to a claim construction contained in a final written decision even though the Board had not previously adopted a construction, where circumstances made it "difficult to imagine" that parties would expect the Board's *sua sponte* construction. *See Qualcomm Inc. v. Intel Corp.*, 6 F.4th 1256, 1263 (Fed. Cir. 2021).

Here, the parties' proposed constructions for "biometric signal" focus on user attributes or the biometric signal's connection to another claimed component. *See, e.g.*, PO Resp. 9–12; Pet. Reply 8. The Board's construction of "biometric signal" in its Final Written Decisions, however, requires that the biometric signal "provides secure access to a controlled item." Final Dec. 68. Neither party's proposed construction includes a requirement of "provid[ing] secure access to a controlled item." *See, e.g.*, PO Resp. 9–12; Pet. Reply 8. Nor was this requirement articulated in the Board's preliminary construction in its institution decision, where it afforded the term its "plain and ordinary meaning." *See* Paper 23, 41; Paper 27, 41.

I determine that further briefing is warranted regarding the Board's claim construction of "biometric signal" in the Final Written Decisions based upon the unique facts of this case. The Board's Final Written Decisions employ a construction for "biometric signal" that was not proposed by either party. Furthermore, Patent Owner's proposed construction here is identical to that offered by petitioner Apple in IPR2022-00601 and IPR2022-00602. In those IPRs, the Board adopted this construction in its institution decisions and did not further construe the claim

---

to the best of my knowledge, relied upon this observation to find a lack of notice or opportunity to respond in a given case.

language in its final written decisions. Indeed, Patent Owner here argued that the Board's earlier preliminary claim construction should apply. PO Resp. 9–10. Accordingly, the parties may wish to address whether it is appropriate to continue to use that construction here.

Therefore, I vacate the Board's Final Written Decision in each of the captioned proceedings and remand to the Board for further proceedings. For each proceeding, the Board shall authorize Petitioner to file supplemental briefing addressing: (1) the Board's construction for the term "biometric signal" in the Final Written Decision and the application of the asserted art to the Board's claim construction, and (2) perceived inconsistencies between the Final Written Decisions in these proceedings and those in IPR2022-00602 or IPR2022-00601, as applicable. The Board shall also authorize Patent Owner to file a supplemental response to Petitioner's supplemental brief. After considering such briefing, the Board shall issue a new Final Written Decision in each of the captioned proceedings that considers the parties' supplemental briefing when resolving the claim construction of "biometric signal," the applicability of the prior art, and arguments as to inconsistency with IPR2022-00602 or IPR2022-00601, as applicable.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Board's Final Written Decision in each captioned proceeding is *vacated*; and

FURTHER ORDERED that each captioned proceeding is remanded to the Board for further proceedings consistent with the instructions above.

IPR2022-01006 (Patent 9,665,705 B2)
IPR2022-01045 (Patent 9,269,208 B2)
IPR2022-01089 (Patent 9,269,208 B2)

FOR PETITIONER:

Dion Bregman
Andrew Devkar
James Kritsas
MORGAN, LEWIS & BOCKIUS LLP
dion.bregman@morganlewis.com
andrew.devkar@morganlewis.com
james.kritsas@morganlewis.com

FOR PATENT OWNER:

Andrew Ryan
CANTOR COLBURN LLP
ryan@cantorcolburn.com