

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ASSA ABLOY GLOBAL SOLUTIONS, INC., HID GLOBAL CORP.,  
Petitioners,

v.

URBAN INTEL INC,  
Patent Owner

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**PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION  
FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 9,373,205**

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<b>Exhibit</b>	<b>Description</b>
2001.	Complaint filed in <i>Liberty Access Technologies Licensing LLC v. Marriott Int'l, Inc.</i> , E.D. Tex. No. 2:22-cv-00318-JRG (filed Aug. 18, 2022; the “ <i>Marriott</i> Litigation”)
2002.	Docket Control Order for <i>Marriott</i> Litigation, {Dkt. No. 27 (Dec. 5, 2022)} (“ <i>Marriott</i> DCO”)
2003.	Docket Control Order for <i>ASSA</i> Litigation, {Dkt. No. 39 (June 21, 2023)} (“ <i>ASSA</i> DCO”)
2004.	Invalidity Contentions served in the <i>ASSA</i> Litigation (May 15, 2023)
2005.	Invalidity Contentions served in the <i>Marriott</i> Litigation (November 15, 2023)
2006.	Letter dated December 1, 2022 (the “First Letter”)
2007.	Letter dated December 16, 2022 (the “Second Letter”)
2008.	Letter dated December 23, 2022 (the “Third Letter”)
2009.	20 House Report No. 96-1307, 96th Cong., 2d Sess. (1980)
2010.	Declaration of C. Matthew Rozier

## I. INTRODUCTION

Urban Intel Inc. (“Patent Owner”) respectfully submits this Preliminary Response (the “Response”) to Petition for *Inter Partes Review* No. IPR2023-00815 (Paper 1) (the “Petition” or “Pet.”) of U.S. Patent No. 9,373,205 (the “’205 patent”) filed by ASSA ABLOY Global Solutions, Inc. and HID Global Corp.’s (“ASSA” or “Petitioners”). The Petition identifies ASSA ABLOY AB, ASSA ABLOY Mobile Services AB, ASSA ABLOY Global Solutions, Inc., ASSA ABLOY Global Solutions AB, ASSA ABLOY Inc., HID Global Corp. (collectively, “ASSA”), and Marriott International, Inc. (“Marriott”) as real parties-in-interest.

Institution should be denied because the Petition has failed to demonstrate a reasonable likelihood that any claim of the ’205 patent is unpatentable. The Petition challenges two independent claims, claims 1 and 13, based on two different §103 Grounds. Ground 1 challenges claims 1 and 13 on the basis of Knutsson. Ground 4 challenges claims 1 and 13 on the basis of Elfstrom in view of Woodard. But the Petition fails to establish that the asserted references, taken alone or in combination with the knowledge of a person of ordinary skill in the art (“POSITA”) and the applied secondary references, would have rendered obvious independent claims 1 or 13, or any of the challenged dependent claims. The Board should also exercise its discretionary power to deny institution under 35 U.S.C. ¶ 314(a). Finally, the Board should exercise its discretion to deny the Petition because Petitioners have abused

the *inter partes* review process such that granting the Petition would run counter to the fundamental purposes and goals of the *inter partes* review regime.

For these reasons, institution should be denied.

## **II. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Patent Owner requests that the Board deny institution of the Petition with respect to all challenged claims and all asserted grounds. A full statement of the reasons for the relief requested is set forth in Sections III and IV of this Response.

## **III. THE PETITION SHOULD BE DENIED UNDER 35 U.S.C. § 314(a)**

The Board should exercise its discretion to deny the Petition pursuant to 35 U.S.C. § 314(a) because each of the six *Fintiv* factors favors denial.<sup>1</sup> Petitioners and real party-in-interest Marriott are separately challenging the exact same claims in two separate parallel district court litigations<sup>2</sup> asserting, among other references, the *exact combinations of references and invalidity grounds* presented by this Petition. The *Marriott* Litigation and *ASSA* Litigation are pending separately before the same court, and that court is highly unlikely to stay the litigation under the current case posture. Both *ASSA* and *Marriott* have filed Motions to Stay Pending a decision on

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<sup>1</sup> See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 2020 Pat. App. LEXIS 13179, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020) (setting out and applying the six factors; designated precedential on May 5, 2020) (“*Fintiv*”)

<sup>2</sup> *Liberty Access Technologies Licensing LLC v. Marriott Int’l, Inc.*, E.D. Tex. No. 2:22-cv-00318-JRG (filed Aug. 18, 2022; the “*Marriott* Litigation”) and *Liberty Access Technologies Licensing LLC v. ASSA ABLOY AB*, E.D. Tex. No. 2:22-cv-00507-JRG (filed December 30, 2022; the “*ASSA* Litigation”)

this Petition, and both of those motions have already been denied without prejudice. The *Marriott* Litigation will be tried to a jury a full eight months before any final written decision would issue here.

The *ASSA* Litigation will be tried to a jury a full month before any final written decision would issue here, and the court in that litigation will have already determined the meaning of the claim terms. Fact and expert discovery in the *ASSA* Litigation will conclude four months prior to any final written decision, and the parties' opening dispositive motions will be filed four months before any final written decision here. Institution of *inter partes* review would only ensure duplicitous parallel litigation before the PTAB and in two separate parallel district court litigations, and cause all parties to expend vast resources unnecessarily.

The Petition also fails on the merits because the cited references do not disclose or suggest key limitations of the challenged claims.

**A. *FINTIV* FACTOR #1 (LIKELIHOOD OF STAY)**

This factor weighs strongly in favor of denial. Dueling Motions to Stay Pending a decision on this Petition filed by Marriott and ASSA have already been denied without prejudice by the court in each underlying litigation, and given the late stage of both cases, particularly the *Marriott* Litigation, the district court is highly unlikely to stay the litigations even if *inter partes* review is instituted.

A stay is especially unlikely where, as here, both the *Marriott* Litigation and the *ASSA* Litigation will be at an advanced stage by the time of a decision on institution—on or around December 14, 2023 (*see* 35 U.S.C. § 314(b)(1)). In the *Marriott* Litigation, claim construction will be completed in October 2023, and fact and expert discovery will be completed prior to any institution decision here. *See* Docket Control Order for *Marriott* Litigation, Exhibit 2002 (Dkt. No. 27 dated Dec. 5, 2022; “*Marriott* DCO”). Opening dispositive motions are due December 21, 2023—the vast majority of work on those will therefore have been completed before the decision on institution here. *See id.* And ***the Marriott Litigation will be tried to a jury in April 2024, a full eight months*** before any final written decision would issue in this case. *See* 37 C.F.R. § 42.100(c); *Marriott* DCO. The court presiding over the *Marriott* Litigation routinely denies motions to stay under such circumstances. *See, e.g., Solas OLED Ltd. v. Samsung Display Co.*, No. 2:19-CV-00152-JRG, 2020 U.S. Dist. LEXIS 125973, \*7 (E.D. Tex. 2020) (denying motion to stay in part because, where fact discovery and expert discovery had closed, “due to the extremely advanced stage of this case, the Court finds that this factor weighs against granting a stay.”).

Similarly, in the *ASSA* Litigation, claim construction will be completed in May 2024, and fact discovery, expert discovery, and opening dispositive motions will all be completed by early August 2024, four months before any final written



decision would issue. See Docket Control Order for *ASSA* Litigation, Exhibit 2003 (Dkt. No. 39 dated June 21, 2023; “*ASSA* DCO”). And the *ASSA* Litigation will be tried to a jury a full month before any final written decision would issue in this case. See 37 CFR § 42.100(c); *ASSA* DCO. As noted above, the District Court Judge presiding over the *ASSA* Litigation routinely denies Motions to Stay under such circumstances.

This factor weighs strongly in favor of discretionary denial because instituting *inter partes* review will only serve to guarantee that all parties incur increased costs from litigating parallel IPR and district court litigation proceedings.

**B. *FINTIV* FACTORS #2 AND #3 (TRIAL DATE PROXIMITY TO FWD AND INVESTMENT IN PARALLEL PROCEEDINGS)**

As detailed above in Section 3A, the schedule for the Petition is far behind the schedules for both the *ASSA* Litigation and the *Marriott* Litigation.

Any final written decision stemming from the Petition would be unlikely to issue before December 2024 (see 35 U.S.C. § 314(b)(1); 37 C.F.R. § 42.100(c)). The *Marriott* Litigation is scheduled for trial in April 2024, a full *eight months* earlier. See *Marriott* DCO. The *ASSA* Litigation is scheduled for trial in November 2024, also before any final written decision would be expected to issue. See *ASSA* DCO.

**C. *FINTIV* FACTOR #4 (ISSUE OVERLAP)**

The Petition’s exact challenges to the ’205 patent are also being advanced in both the *ASSA* Litigation and the *Marriott* Litigation. Both primary references asserted in the Petition, *i.e.*, Knutsson and Elfstrom, are asserted as both anticipatory references and single-reference obviousness combinations in the invalidity contentions served in the *ASSA* Litigation (served May 15, 2023; *see* Exhibit 2004) and the *Marriott* Litigation (served November 15, 2023; *see* Exhibit 2005), and both of those primary references are also asserted in the same combinations with the same secondary references asserted in the Petition against the same claims. *See* Petition, §§ VI – XI. Put simply, every claim challenged in the Petition is also being challenged in not one, but two, district court litigations in view of the exact same references and combinations of references presented in the Petition.

*Fintiv* Factor #4 weighs heavily in favor of denial.

**D. *FINTIV* FACTOR # 5 (IDENTITY OF PARTIES)**

Petitioner ASSA ABLOY Global Solutions, Inc. and real parties-in-interest ASSA ABLOY Global Solutions AB, ASSA ABLOY Inc., and Marriott International, Inc. are all parties in copending litigations in which they are challenging the validity of the ’205 patent.<sup>3</sup> The remaining Petitioner, HID Global

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<sup>3</sup> 1) *ASSA ABLOY Global Solutions, Inc. v. Liberty Access Technologies LLC*, N.D. Ill. No. 1:23-cv-00756 (filed Feb. 7, 2023 – *see* Exhibit 1017; the “ASSA NDIL Litigation”; transfer to E.D.

Corp., is “an ASSA ABLOY group company,”<sup>4</sup> and its interests are therefore fully aligned with the other ASSA ABLOY entities.<sup>5</sup> The *ASSA* Litigation and *Marriott* Litigation are against Liberty Access Technologies Licensing LLC (“Liberty”), which is the exclusive licensee of Patent Owner Urban Intel Inc. with respect to the ’205 patent. *See e.g.*, *ASSA* Litigation, Complaint at ¶ 4; *see* Exhibit 1016. The interests of Liberty and Urban Intel Inc. are also therefore fully aligned, and they are functionally the same parties for the purposes of this Petition.

This factor weighs heavily in favor of denial.

**E. *FINTIV FACTOR #6 (MERITS AND OTHER CIRCUMSTANCES)***

*Fintiv* Factor 6 weighs heavily in favor of denial for at least two reasons. ***First***, the Petition does not disclose or suggest key limitations of each of the challenged claims, and therefore does not establish a reasonable likelihood that the Petitioners would prevail with respect to at least one of the claims challenged in the Petition. ***Second***, Petitioners’ abuse of the IPR process as it relates to the ’205 patent also weighs heavily against institution. Long before any dispute or litigation existed between Petitioners and Patent Owner or its exclusive licensee, Liberty—indeed, before Liberty had had any communication whatsoever with Petitioners—

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Tex. pending); 2) *ASSA* Litigation; and 3) *Marriott* Litigation. *See also*, Petition at § XIII.B; Patent Owner’s Mandatory Notices at ¶ 2.

<sup>4</sup> <https://www.hidglobal.com/about/privacy> (visited September 13, 2023)

<sup>5</sup> Lead counsel for HID Global Corp. and ASSA ABLOY Global Solutions, Inc. is also lead counsel in the *ASSA* Litigation and the *Marriott* Litigation

Petitioners attempted to use the IPR process as a sword in an effort to extract a free license to the '205 patent from Liberty. Petitioners' actions fly in the face of the purpose of the post-grant review process. Rewarding those actions would encourage others to pursue the same abusive strategies, increasing costs for all parties involved.

On August 18, 2022, Liberty filed a complaint against Marriott alleging that Marriott infringes U.S. Patent Nos. 9,373,205, 10,657,747, and 11,373,474 (the "Asserted Patents") by providing and using its "website [www.marriott.com](http://www.marriott.com) and associated hardware, software, and functionality that among other features, allows users to use a mobile device running the Marriott Bonvoy® Mobile Application to use the "Mobile Key" feature as a key to a hotel room. *See Marriott* Litigation, Complaint at ¶ 17; *see Exhibit 2001*. At the time, Liberty was unaware that ASSA provided certain lock hardware to Marriott, and the complaint filed in the *Marriott* Litigation contained no mention of ASSA.

On December 1, 2022, ASSA, through its current IPR counsel, Mr. Lionel Lavenue of Finnegan, Henderson, Farabow, Garrett & Dunner LLP, contacted Liberty, unsolicited, with a demand that Liberty grant a free license to the Asserted Patents. *See Exhibit 2006* (the "First Letter"). Liberty had never before had any communication with ASSA or any attorney representing ASSA. Liberty also had no plans to initiate litigation or otherwise engage with ASSA in any way, whether related to the Asserted Patents or otherwise.

In that First Letter, ASSA requested a license to the Asserted Patents from the Marriott Litigation “in exchange for ASSA’s agreement not to file post-grant invalidity proceedings or declaratory judgment actions against any of Liberty’s Access Control Portfolio based, at least in part, on technology and prior art uniquely in ASSA’s possession.” Ex. 2006, at 1. In order for Liberty to have access to that prior art, ASSA ABLOY insisted that Liberty execute a non-disclosure agreement (“NDA”). *Id.* at 2. ASSA requested a response to the First Letter by December 8, 2022. *Id.*

At ASSA’s request, Counsel for Liberty conducted a telephone conference with Mr. Lavenue, counsel for ASSA, on December 15, 2022. *See* Declaration of C. Matthew Rozier (hereinafter, “Rozier Decl.”), ¶ 2. During this call, Mr. Lavenue stated in clear terms that ASSA was not interested in negotiating any payment for the demanded license to the Asserted Patents, but instead demanded a ***royalty-free license*** to the Asserted Patents. Rozier Decl., ¶ 3. He then informed undersigned counsel that if Liberty did not immediately grant the demanded royalty-free license, ASSA would “***rain down an avalanche of IPRs***” on the Asserted Patents. Rozier Decl., ¶ 4. Counsel for Liberty refused Mr. Lavenue’s demand. Rozier Decl., ¶ 5.

ASSA sent a second unsolicited letter to Liberty on December 16, 2022, again threatening to pursue both post-grant challenges to the Asserted Patents and a declaratory judgment action unless Liberty entered into licensing discussions.

Exhibit 2007 (the “Second Letter”). The Second Letter again asserted that ASSA had proprietary art “only known to ASSA, and *ASSA looks forward to a response* to its proposal to enter into licensing discussions with Liberty *before AAAB files post-grant proceedings with ASSA’s art challenging the claims of or pursuing declaratory judgment actions* related to Liberty’s Access Control Portfolio.” *Id.* at pp. 2-3. Based on the parties’ December 15 teleconference, Liberty knew that Mr. Lavenue had no actual intention to enter into “licensing discussions,” but was instead insisting again that Liberty provide a royalty-free license at the threat of IPRs or a declaratory judgment action. Indeed, Mr. Lavenue’s careful choice to offer “licensing discussions” in his letters while, on the phone, demanding a royalty-free license or nothing, shows that he knew his demands were improper. Liberty, feeling as if it was being extorted, never responded to the Second Letter. Rozier Decl., ¶ 5.

On December 23, 2022, ASSA sent a third letter to Liberty. Exhibit 2008 (the “Third Letter”). The Third Letter stated that ASSA allegedly had “evidence of potential inequitable conduct committed during the prosecution and reexamination of U.S. Patent No. 9,373,205,” but provided no such evidence. *Id.* at 1. ASSA agreed it would not report the alleged inequitable conduct evidence under certain conditions, telling Liberty that:

in viewing the correspondence to be sent after you execute the NDA, you agree that neither *ASSA ABLOY nor its attorneys or affiliates are under any obligation to correct or otherwise address any potential*

*inequitable conduct* by Liberty or its affiliates in connection with U.S. Patent No. 9,373,205, or any other patents or applications owned by or licensed to Liberty or its affiliates[.]

*Id.* Liberty could not and did not enter into such an agreement because, if ASSA had evidence of actual inequitable conduct, Liberty's attorneys, who were not involved in prosecution of the '205 patent, could not agree to withhold any such information from the U.S. Patent and Trademark Office ("USPTO). *See* 37 C.F.R. § 11.803(a). Indeed, a registered patent attorneys' failure to report such information to the USPTO would be a direct violation of 37 C.F.R. § 11.803(a). To Liberty's knowledge, ASSA's counsel has not reported the alleged inequitable conduct allegations, much less any supporting detail for such a serious allegation, to the USPTO.

Faced with ASSA's repeated and escalating threats, Liberty investigated ASSA's product offerings and determined that ASSA infringed the three Asserted Patents. Faced with ASSA's threat of preemptive IPRs and a declaratory judgment action unless Liberty granted a royalty free license, Liberty felt that it had no choice but to institute district court litigation against ASSA directly, and did so on December 30, 2022. *ASSA* Litigation (filed December 30, 2022) ASSA subsequently did file a declaratory judgment action in a different district. *See* Exhibit 1017 (*ASSA* NDIL Litigation - Complaint filed February 7, 2023).

In short, ASSA, under no threat from Liberty or Patent Owner, unilaterally reached out to Liberty demanding a free license to Liberty's patents in exchange for not taking action to attempt to invalidate those patents. ASSA directly used the IPR process, the implied threat of the costs to Patent Owner of defending against those IPRs, as well as its offer to "bury" alleged inequitable conduct, in an attempt to extract a free license from Liberty. As a result of ASSA's repeated threats, ASSA and Liberty are now litigating the Asserted Patents in two different federal courts, and the litigation with real party-in-interest Marriott is also ongoing. ASSA's actions were, and continue to be, an abuse of the post-grant review process, and the inevitable result of that abuse of process is that ASSA and Liberty have incurred, and continue to incur, substantial costs to litigate the Asserted Patents in two district court cases and, now, potential IPRs on three Liberty patents.

More troublesome, it appears that running up Liberty's costs was ASSA's strategy all along. ASSA could have filed its IPRs in December 2022, when Liberty's informed ASSA that it would under no circumstances agree to a royalty free license in response to ASSA's threats. Instead, ASSA waited a full five months



before filing its IPRs, and in the interim chose instead to file a declaratory judgment action to further run up Liberty's litigation costs.<sup>6</sup>

ASSA's actions and the results of those actions run directly counter to the purpose and goals of the post-grant administrative challenge system. The goal of post-grant administrative patent challenges is to "permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation." 20 House Report No. 96-1307, 96th Cong., 2d Sess. (1980). Attached as Exhibit 2009 (*see* p, 2). Instead of limiting costs, Petitioners' actions have caused all parties to incur substantial costs in litigation.

And the *Fintiv* analysis is designed to determine whether the integrity of the system would be furthered by instituting review. *Fintiv*, p. 6 ("the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review."). For the reasons detailed above, instituting *inter partes* review based on ASSA's Petition would subvert the intent and purpose of post-grant administrative patent challenges. Petitioners and their counsel have abused the IPR process in an attempt to extract an unpaid license to Patent Owner's valid patents, and have done so in a manner that flies in the face of Congress' intent.

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<sup>6</sup> ASSA's declaratory judgment action strategically excluded any invalidity claims, illustrating that ASSA knew all along it would later file IPRs. *ASSA NDIL Litigation.*; *see* Ex. 1017

Petitioners' actions have served only to cause all involved parties to incur substantial costs and additional litigation. This strategy should not be rewarded, and the Petition should be denied for this reason alone.

Because each and every *Fintiv* factor weighs heavily in favor of denial, the Board should exercise its discretionary power to deny the Petition.

In addition, or in the alternative, Patent Owner respectfully requests that the Petition be dismissed under the Board's general discretionary powers in view of Petitioners' abuse of the IPR process and to avoid the probability that, if permitted here, other parties will attempt Petitioners' strategy.

#### **IV. THE PETITION SHOULD BE DENIED BECAUSE IT DOES NOT ESTABLISH A REASONABLE LIKELIHOOD OF SUCCESS ON ANY CHALLENGED CLAIM**

As detailed below, the Petition fails to demonstrate a reasonable likelihood that the Petitioner would prevail with respect to any claim of the '205 patent. The Petition challenges independent claims 1 and 13 and several dependent claims through six §103 grounds, with further modifications based on the alleged knowledge of a POSITA. But the references and combinations thereof fail to disclose key limitations of each challenged claim. Trial should not be instituted.

##### **A. THE '205 PATENT**

The '205 patent is directed to systems and methods for using an access device in a computer-implemented system to enable a portable device, such as a

smartphone, to wirelessly transmit, *via* a communication module, a digital certificate that provides information to a door lock needed to activate a lock. '205 patent, Abstract; *see* Exhibit 1001. The '205 patent teaches a computer-system architecture associated with the claimed access device, integral to which are a specific processor, communication module, and digital certificate (in the example of claim 1, a “reservation certificate”) configured for specific tasks. '205 patent, Abstract.

The processor, for example, is coupled with a communication module and is configured not only to receive a reservation certificate, but also to compare the interval of the reservation certificate to a current time, determine whether the certificate is current, and control a door lock and unlock the door if certain criteria are met (*e.g.*, the reservation is current). '205 patent, Abstract; 6:6-24; Claim 1.

As shown in FIG. 4, the systems disclosed by the '205 patent can include “an Internet capable access device 11, in this example a hotel room lock, having connection 10 to Internet”:

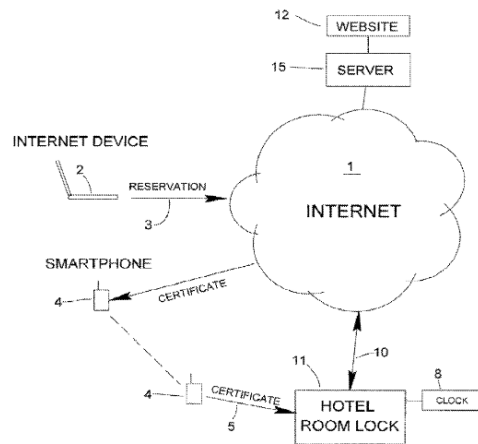
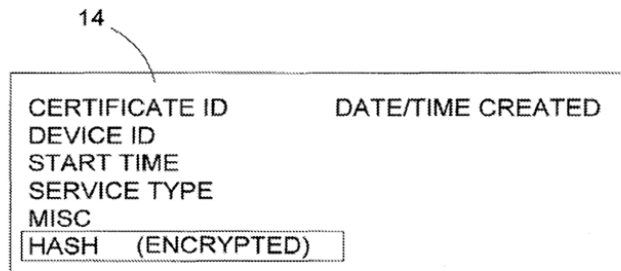


FIG. 4

'205 patent, FIG. 4; 5:54-57. The '205 patent specification further confirms that the claimed systems and devices include a particular type of communication module that enables the transfer of the digital certificate and/or information associated with the certificate (*see id.*, 6:6-24; FIGs. 4-6), and a reservation certificate configured for a specific role in the system. *See id.*, 4:1-6; 8:19-25.

The '205 patent describes various embodiments enabling encryption of the certificate, including with use of public or private keys, as well as embodiments containing specific identification information for both the certificate as well as the device or user of the system, and information about a reservation timeline. *See id.*, 2:5-17; 2:61-66; 4:26-33; 5:7-9; 5:20-26; FIG. 2. The '205 patent reflects these features, setting forth other embodiments in which the reservation certificate enables additional security through the use of digital signatures, data representative of the

identification made by the separate processor, and single use IDs to prevent hacking and spoofing, as illustrated in Figure 2, below:



**FIG. 2**

'205 patent, FIG. 2; 2:7-3:6.

Other claims include further limitations such as the processor evaluating a reservation interval and predetermined duration information (claims 2-3), modifying the reservation certificate to include additional information and further configuring the processor to activate the door lock *via* a portable terminal in specific circumstances (claims 4-6), configuring the memory within the computer system architecture to include specific information associated with encryption, authorization, validation, and identification tasks (claims 7-11). *See* '205 patent.

**B. LEVEL OF ORDINARY SKILL IN THE ART**

For the purposes of this Response only, Patent Owner does not dispute the level of skill of a POSITA identified in the Petition.

**C. CLAIM CONSTRUCTION**

The Petition does not affirmatively offer a construction of any term of the '205 patent but does present arguments as to the proper interpretation of certain terms. *See* Pet., pp. 6-7. Patent Owner does not necessarily agree with Petitioner's proposed interpretations or their rationales and reserves the right to contest those interpretations in the future. However, because the Petition fails to raise a reasonable likelihood that any claim of the '300 patent is unpatentable even under Petitioner's proposed interpretations, this Response applies Petitioner's term interpretations to minimize the disputes to be resolved by the Board at this preliminary stage.

**D. GROUND 1 – KNUTSSON DOES NOT RENDER OBVIOUS CLAIMS 1-6, 8-10, 13-19, OR 20-22**

The Petition has, purportedly for ease of reference, numbered the limitations of the independent claims. Although Patent Owner has no general objection, the breakout of limitations [1C]-[1E] proposed in the Petition obscures the interrelation of the features recited in claim 1. The three limitations as presented in claim 1 read as follows (with Petitioner's limitation numbering added in brackets):

[1C] “wherein, *when a current reservation certificate that comprises an interval of a reservation is presented by the portable terminal*, [1D] the processor is configured to compare the interval of the reservation of the current reservation certificate to a current time accessible to the processor, determine the current time is within the interval of the reservation, *and* [1E] *activate the door lock* to allow the portable terminal to unlock the door lock during the interval of the reservation.”

'205 Patent, claim 1 (emphasis added). The limitations include a temporal limitation, i.e., limitation [1D] must be performed “when,” or at the same time, that limitation [1C] is performed]. *See, e.g.,* Merriam-Webster.com Dictionary, Merriam-Webster, <https://www.merriam-webster.com/dictionary/when>, accessed 13 Sep. 2023 (“at what time,” “at or during which time,” “at or during the time that”); Oxford English Dictionary, Oxford University Press, April 2023, <https://doi.org/10.1093/OED/6162952604>, accessed 13 Sep. 2023 (“With reference to a definite actual occurrence or fact, chiefly with verb in past tense: “at the time that”, “on the occasion that.”).

The Petition alleges that the data object 12 of Knutsson is a “current reservation certificate” as recited in claim one. Petition, p. 17. The Petition further argues that data object 12 comprises an interval of a reservation, and is presented to the portable terminal, as required by limitation [1C] *Id.*, pp. 16-19.

But Knutsson does not disclose that the processor (which is housed in the door lock) “is configured to compare the interval of the reservation of the current reservation certificate to a current time accessible to the processor, determine the current time is within the interval of the reservation” “**when** a current reservation certificate that comprises an interval of a reservation is presented by the portable terminal,” as required by the claim. Instead, in a first initial step, the system of Knutsson “forward[s] the attached vCard data object 12 through short-range wireless

data communication means 9 to the lock device 40, as seen at 14 in Fig 1 and in Fig 5b.”

A Bluetooth® link is then established between key device 1 and lock device 40, and the full data object 12 is transmitted by the key device 1 to the lock device 40 in step 538. *Id.*, p. 16, ll. 1-3. When data object 12 is received by lock device 40, “a database record is created for the key device 1 in the lock device's local access control database 42.” *Id.*, p. 16, ll.21-22. “Data fields of this database record are filled with the key device's Bluetooth® address (“KD addr”) as detected in step 540, with the temporary access defining data, and with other appropriate data from the received data object 12, such as the Name and Unique Identifier properties 14d and 14e. The database record is stored in step 552.” *Id.*, p. 16, ll. 22-26. But Knutsson does not disclose that the door lock is activated “when,” i.e., at the time, the data object 12 is transferred to and stored locally on lock device 40, as required by limitation [1E].

Instead, Knutsson discloses that, at some later time *after the data object 12 is stored*, the lock device 40 uses a “proximity sensor 324 to detect the presence of the user of key device 1 near the lock device 40 and in response generate the wake-up control signal 326 to the CPU 313.” Knutsson, p. 19, ll.24-26. “This causes CPU 313 to enter the first authentication stage 620. A step 622 **searches for Bluetooth®-enabled devices** by paging, i.e. sending inquiry requests at regular intervals. Each



Bluetooth®-enabled device within operating range . . . will transmit an inquiry response to the lock device.” *Id.*, p. 19, ll. 27-32 (emphasis added). After that, “[i]f an inquiry response was received, step 628 proceeds to determine the Bluetooth® address from the inquiry response” and “a current time is determined by reading a value from the real-time clock 304.” *Id.*, p. 20, ll. 1-3. Then the processor of lock device 4 checks the Bluetooth® address against the data object 12 with information previously stored on lock device 40 and, if the Bluetooth® address matches, the door lock is activated:

The CPU 313 proceeds in step 630 to check whether the determined Bluetooth® address of the responding device matches one of afore-described authentication data records in the LD-DB 42. In case of a match, it is also checked whether the current time falls within any stage-I time slot defined for that Bluetooth® address. If the outcome of these checks is fully positive, as checked in step 632, the CPU 313 proceeds to step 634 and generates the control signal 307a to the actuator controller 307. As described above, this will cause unlocking of the lock, etc, and allow opening of the door, etc, to the protected environment.

*Id.*, p. 20, ll. 4-11 (emphasis added). In short, Knutsson discloses activating a door lock based on a Bluetooth® address, not upon receipt of a reservation certificate. Further, the Bluetooth® address-based door lock activation taught by Knutsson occurs at some time after data object 12 is transmitted to the lock device 40, not “when” the data object 12 is transmitted to the lock device 40, as required by claim limitations [1C]-[1E]. For at least that reason, Knutsson fails to teach or disclose

“activat[ing] a door lock” “*when* a current reservation certificate that comprises an interval of a reservation is presented by the portable terminal,” and therefore fails to render obvious claim 1.

Knutsson fails to teach or suggest the limitations of [13C-13E] for similar reasons. Although claim 13 does not contain the term “when,” the language of the claim requires that the door lock activation occurs when “the reservation certificate” is “accepted” by the processor of lock device 40. ’205 patent, claim 13. Specifically, claim 13 requires that the lock is activated “on the basis of the reservation certificate being current.” *Id.*, limitation [13E]. Perhaps aware of this, the Petition does not present the full language of limitation [13E], and presents the limitation as: “[13E] “activating by the processor . . . a door lock to allow the portable terminal to unlock the door lock during the interval of the reservation.” Petition, p. 22. But the full limitation actually requires: “activating by the processor **on the basis of the reservation certificate being current**, a door lock to allow the portable terminal to unlock the door lock during the interval of the reservation.” ’205 patent, claim 13. As described above with respect to claim 1, Knutsson does not disclose such a feature because the lock is activated only after the data object 12 has been received, and is activated based solely based on verification that the Bluetooth® address transmitted is authorized to unlock the door. For at least that reason, Knutsson fails to teach or disclose “accepting a reservation certificate” and “activating by the

processor **on the basis of the reservation certificate being current**, a door lock,” and therefore fails to render obvious claim 13.

Claims 2-6 and 8-10 depend from and add limitations to claim 1, and are therefore patentable for at least the same reasons. Claims 14-19 and 20-22 depend from and add limitations to claim 13, and are therefore patentable for at least the same reasons.

**E. GROUND 2 – THE COMBINATION OF KNUTSSON AND DEBRY DOES NOT RENDER OBVIOUS CLAIMS 7, 11, 19, OR 23**

Claims 7 and 11 depend from and add limitations to claim 1, and claims 19 and 23 depend from and add limitations to claim 13. As noted above, Knutsson does not teach or suggest the limitations of claims 1 or 13, and therefore does not render obvious claims 7, 11, 19, or 23. Debry does not cure the deficiencies of Knutsson with respect to claims 1 or 13, and the Petition does not so assert. For at least that reason, the combination of Knutsson and DeBry does not render obvious claims 7, 11, 19, or 23.

**F. GROUND 3 – THE COMBINATION OF KNUTSSON AND WOODARD DOES NOT RENDER OBVIOUS CLAIMS 12 OR 24**

Claim 12 depends from and add limitations to claim 1, and claim 24 depend from and add limitations to claim 13. As noted above, Knutsson does not teach or suggest the limitations of claims 1 or 13, and therefore does not render obvious claims 12 or 24. Woodard does not cure the deficiencies of Knutsson with respect

to claims 1 or 13, and the Petition does not so assert. For at least that reason, the combination of Knutsson and Woodson does not render obvious claims 12 or 24.

**G. GROUND 4 – THE COMBINATION OF ELFSTROM AND WOODARD DOES NOT RENDER OBVIOUS CLAIMS 1-6, 9-10, 12-18, 21-22, OR 24**

The Petition makes artful use of ellipses when renumbering the limitations of the claims for its arguments for this Ground. *See, generally*, Pet., pp. 58-67. Patent Owner presents the full language of the relevant claims below to demonstrate that the combination of Elfstrom and Woodard does not teach or suggest the limitations of claims 1 or 13.

Claim 1 of the '205 patent requires, among other things:

- "a *processor (16) having control of a door lock (11)*; and a communication module (17) connected to the processor, *the processor is configured to receive a reservation certificate (5) presented by a portable terminal (4)* through the communication module; wherein, when *a current reservation certificate that comprises an interval of a reservation is presented by the portable terminal*, the processor is configured to compare the interval of the reservation of the current reservation certificate to a current time accessible to the processor, determine the current time is within the interval of the reservation, and activate the door lock to allow the portable terminal to unlock the door lock during the interval of the reservation."

The Petition argues that the credential 136 of Elfstrom corresponds to the claimed "portable terminal." Pet., p. 63. As seen in the claim excerpt above, the "processor" recited in claims 1 and 13 is required to be part of the access device that controls a door lock. The Petition argues that access modules 116 on the door of each room include a processor 204. Pet., p. 60 (citing Elfstrom, 5:60-61, FIG. 1).

Elfstrom does not teach or suggest that the processor 204 of Elfstrom receives a reservation certificate from the credential 136, much less a reservation certificate “that comprises the interval of the reservation,” as required by claims 1 and 13. The Petition argues that Elfstrom discloses that “access data images” may be “written to a credential 136,” and that the access data “may include . . . guest stay duration.” Pet., p. 63 (citing Elfstrom, 8:7-9, 8:20-34, 123-29-36). But the Petition does not argue, and Elfstrom does not disclose, that the guest stay duration is ever transmitted to the processor 204, *i.e.*, Elfstrom does not disclose that processor 204 receives “the interval of the reservation” from credential 136.

In the system of Elfstrom, each access control module has an independent connection to a communication network in communication with a central database 140. *See* Elfstrom, FIG. 1. The only information transmitted from credential 136 to access control module 116 is the “credential identification number 324.” Elfstrom, 11:53-61. Then, Elfstrom checks the “locally maintained check-in UID list 224” that was received through the communication network, and “compares the *credential identification number* . . . to the information maintained in the list 224 searching for matches (step 516). Elfstrom, 11:67 – 12:3, FIGS. 1 and 2. In short, all that credential 136 passes to processor 204 of the access control module 116 is an identification number, and the processor then looks that number up in a database

that it already has access to determine if that particular identification number has access to the room (and that, therefore, the door lock should be activated).

For at least these reasons, Elfstrom does not teach or suggest that “*the processor is configured to receive a reservation certificate . . . that comprises an interval of a reservation* is presented by the portable terminal,” as required by claim 1. Claim 13 recites similar features and Elfstrom therefore fails to teach or suggest all features of claim 13 for at least the same reasons.

Woodard does not cure these deficiencies of Elfstrom with respect to claims 1 or 13, and the Petition does not so assert.

Claims 2-6, 9-10, and 12 depend from and add limitations to claim 1, and are therefore patentable for at least the same reasons. Claims 13-18, 21-22, and 24 depend from and add limitations to claim 13, and are therefore patentable for at least the same reasons.

**H. GROUND 5 – THE COMBINATION OF ELFSTROM, WOODARD, AND DEBRY DOES NOT RENDER OBVIOUS CLAIMS 7, 8, 11, 19, 20, OR 23**

Claims 7, 8, and 11 depend from and add limitations to claim 1, and claims 19, 20, and 23 depend from and add limitations to claim 13. As noted above, the combination of Elfstrom and Woodard does not teach or suggest the limitations of claims 1 or 13, and therefore do not render obvious claims 7, 8, 11, 19, 20, or 23. Debry does not cure the deficiencies of the Elfstrom and Woodard with respect to

claims 1 or 13, and the Petition does not so assert. For at least that reason, the combination of Elfstrom, Woodard, and DeBry does not render obvious claims 7, 8, 11, 19, 20, or 23.

**I. GROUND 6 – THE COMBINATION OF ELFSTROM, WOODARD, AND MICALI DOES NOT RENDER OBVIOUS CLAIMS 3 OR 15**

Claim 3 depends from and add limitations to claim 1, and claim 15 depends from and add limitations to claim 13. As noted above, the combination of *Elfstrom* and Woodard does not teach or suggest the limitations of claims 1 or 13, and therefore do not render obvious claims 3 or 15. Micali does not cure the deficiencies of Elfstrom and Woodard with respect to claims 1 or 13, and the Petition does not so assert. For at least that reason, the combination of Elfstrom, Woodard, and Micali does not render obvious claims 12 or 24.

**V. CONCLUSION**

Patent Owner requests that the Board deny institution of the Petition.

**CERTIFICATE OF COMPLIANCE**

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that the foregoing Patent Owner's Preliminary Response contains 6284 words as measured by the word processing software used to prepare the document, excluding the cover page, signature block, and portions exempted under 37 C.F.R. § 42.24(a) or (b).

DATED: September 14, 2023

Respectfully submitted,

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Counsel for Patent Owner



**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on September 14, 2023, the foregoing document was served on counsel of record for Petitioners by filing this document through the End-to-End System, as well as *via* electronic mail to counsel of record for Petitioners at the following address:

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