

IPR2017-00767
PRELIMINARY RESPONSE

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROMETRIC INC.
PETITIONER

V.

IQS US INC. AND I.Q.S. SHALEV LIMITED
PATENT OWNER

CASE No.: IPR2017-00767
U.S. PATENT No. 7,773,779

PATENT OWNER'S PRELIMINARY RESPONSE

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In accordance with 35 U.S.C. § 313 and 37 C.F.R. § 42.107, IQS US INC. and I.Q.S. Shalev Limited (collectively, “IQS” or “Patent Owner”), respectfully submit this Preliminary Response to the Petition for *Inter Partes* Review (“IPR”) of claims 1-6, 10, 11, and 14-18 of U.S. Patent No. 7,773,779 (“the ‘779 Patent”) filed by Prometric Inc. (“Prometric” or “Petitioner”). This Preliminary Response is timely under 37 C.F.R. § 42.107(b) because it is being filed within three months of the mailing date of the Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 3), which was mailed on February 8, 2017.

I. INTRODUCTION

In this Preliminary Response, Patent Owner only addresses a few select elements of the obviousness arguments presented in the Petition for *Inter Partes* Review of U.S. Patent No. 7,773,779 (Paper 1, hereinafter “Petition”). Patent Owner reserves the right to construe claim terms and address all grounds in Patent Owner’s Response, including Petitioner’s claim construction arguments raised in the Petition, should the Board institute IPR.

In the Petition, Petitioner alleges that various claims of the ‘779 Patent are obvious based on U.S. Patent Application Publication No. 2006/0110011 by Cohen (“Cohen”) in view of *Continuous Biometric Authentication for Authorized Aircraft*

Personnel: A Proposed Design by Carrillo (“Carrillo”) with U.S. Patent No. 6,945,870 issued to Gatto (“Gatto”), U.S. Patent Application Publication No. 2004/0140354 by Demere (“Demere”), and U.S. Patent No. 6,738,933 issued to Fraenkel (“Fraenkel”).

As discussed in detail below, the Board should decline to institute IPR proceedings because each of the above grounds suffers from one or more fatal defects. For example, *none* of Petitioner’s grounds constitutes a proper basis for requesting IPR because each ground in the Petition relies upon the alleged Carrillo reference, a military document with an unknown date of public release. *See* 35 U.S.C. § 311(b). Further, even ignoring this fatal shortcoming, none of the cited references disclose an “enquiry input, configured to receive ... at least one test template complete as originally extracted,” as required by each claim of the ‘779 Patent. The Board should accordingly deny the Petition in its entirety.

II. BACKGROUND

The ‘779 Patent teaches a novel and inventive system for providing global biometric identification services to a *plurality of remote parties*.

With the novel and inventive system of the ‘779 Patent, *a remote registering party communicates with the template*. The *remote registering party* sends a registration template *complete as originally extracted* from a respective biometric sample of an end user of the remote registering party – say from a fingerprint scan

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