UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PROMETRIC INC.,
Petitioner,

v.

I.Q.S. SHALEV LTD.,
Patent Owner.

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Case IPR2017-00767
Patent 7,773,779 B2

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Before WILLIAM V. SAINDON, MATTHEW R. CLEMENTS, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

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

This case concerns U.S. Patent No. 7,773,779 B2 (Ex. 1001, "the '779 patent"). Petitioner, Prometric Inc., filed a Petition seeking *inter partes* review of claims 1–6, 10, 11, and 14–18 of the '779 patent (Paper 1, "Pet."). Patent Owner, I.Q.S. Shalev Ltd., filed a Preliminary Response. Paper 8 ("Prelim. Resp.").[1]

We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may be authorized only if the information presented in the Petition and the Preliminary Response shows that there is a reasonable likelihood that Petitioner would prevail with respect to at least one claim challenged in the Petition. 35 U.S.C. § 314(a). Applying that standard, we institute an *inter partes* review of claims 1–6, 10, 11, and 14–18 of the '779 patent for the reasons and on the grounds set forth below.

Our determination is based on the record developed thus far, before the filing of Patent Owner's Response. This is not a final decision as to the patentability of any challenged claim. Any final decision will be based on the full record developed during the trial.

I. BACKGROUND

A. Related Matters

Pursuant to 37 C.F.R. § 42.8(b)(2), the parties identify the following civil action involving the '779 patent: *IQS US Inc. et al. v. Calsoft Labs*

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[1] Patent Owner represents that I.Q.S. Shalev Ltd. is the owner of the '779 patent and IQS US Inc. is the exclusive licensee of the '779 patent. Paper 6, 2 (Patent Owner's Mandatory Notices). Consistent with Patent Owner's representation, we modify the case caption provided in the Notice of Filing Date Accorded to Petition (Paper 3) to remove IQS US Inc. from the identification of Patent Owner. All future filings shall conform to the case caption provided in this decision.

Inc., No. 1:16-cv-07774 (N.D. Ill., filed August 2, 2016). Pet. 73; Paper 6, 2 (Patent Owner's Mandatory Notices).

B. Petitioner's References

Petitioner's patentability challenges are primarily based on the following references:

Cohen et al., US 2006/0110011, published May 25, 2006 (Ex. 1005, "Cohen");

Cassandra M. Carrillo, Continuous Biometric Authentication for Authorized Aircraft Personnel: A Proposed Design (June 2003) (unpublished master's thesis, Naval Postgraduate School) (Ex. 1006, "Carrillo");[2]

Gatto et al., US 6,945,870 B2, issued Sept. 20, 2005 (Ex. 1009, "Gatto");

Demere, US 2004/0140354, published July 22, 2004 (Ex. 1010, "Demere"); and

Fraenkel et al., US 6,738,933 B2, issued May 18, 2004 (Ex. 1011, "Fraenkel").

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[2] The designation, "unpublished," follows Bluebook Rule 17.2.2. and is not decisive as to whether Carrillo qualifies as a printed publication under 35 U.S.C. § 102(b) and § 311(b).

C. Petitioner's Asserted Grounds of Unpatentability

	References	**Basis**	**Claim(s)**
1	Cohen and Carrillo	§ 103(a)	1–5, 10, 11, 14, 17 and 18
2	Cohen, Carrillo, and Gatto	§ 103(a)	6
3	Cohen, Carrillo, and Demere	§ 103(a)	15
4	Cohen, Carrillo, and Fraenkel	§ 103(a)	16

D. The '779 Patent (Ex. 1001)

The '779 patent was issued on Application No. 11/583,044, filed October 19, 2006. Ex. 1001, [21], [22].

The '779 patent relates to a system for providing global biometric identification services to a plurality of remote parties. *Id.* at Abstract, 3:22–24. According to the '779 patent, the global biometric identification services may be provided over the Internet to remote subscribers, which are typically small businesses or organizations that lack a full end-to-end biometric identification system of their own. *Id.* at 5:60–6:3, 6:64–67; *see also id.* at 2:61–15 (explaining that a complete biometric system may be too expensive to buy and maintain for a small business, such as a small drugstore chain).

Figure 1 of the '779 patent is reproduced below:
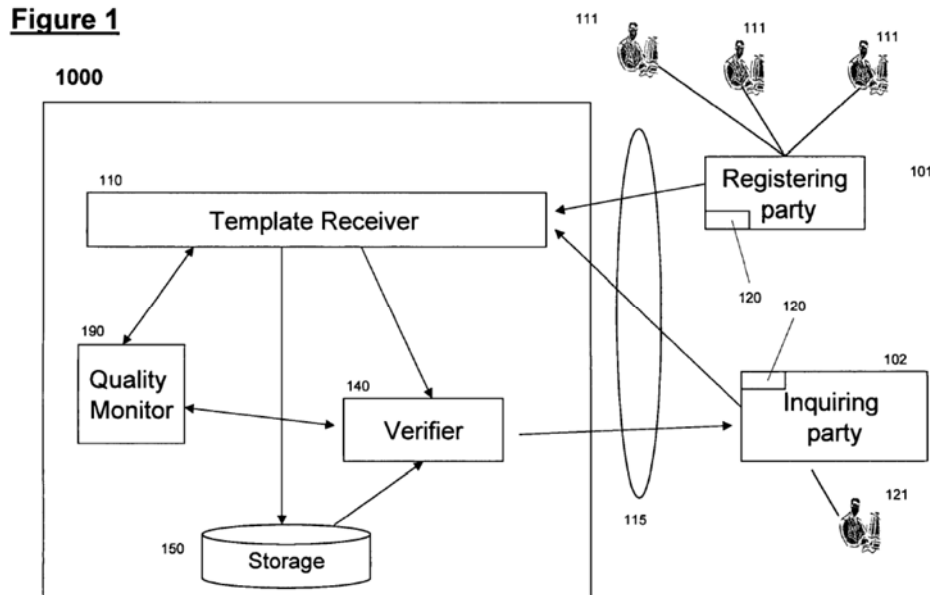
Figure 1

Figure 1 of the '779 patent is a block diagram illustrating a system for providing global biometric identification services to a plurality of remote parties, which subscribe to the services. Ex. 1001, 5:15–18, 5:64–67, 6:49–52. In Figure 1, system 1000 includes template receiver 110, template extractor 120, verifier 140, storage 150, and quality monitor 190. *Id.* at 6:61–63, 8:7–8, 8:25–26, 8:29–30, 9:40–43.

Via a registration input, template receiver 110 receives from remote registering party 101 registration templates of biometric samples of end users 111, e.g., workers or customers, of remote registering party 101. *Id.* at 7:1–9, 7:36–42. Each template is received with a tag, e.g., a user number. *Id.* at 7:52–55. Storage 150 stores the registration templates associated with the tags. *Id.* at 8:26–28.

Via an inquiring input, template receiver 110 receives from inquiring party 102 test templates of biometric samples taken from person 121 to be verified or identified as an end user of inquiring party 102. *Id.* at 7:1–2,

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