Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED
Petitioner

v.

LEON STAMBLER
Patent Owner

Case Number CBM2015-00044
Patent 5,793,302

PETITIONER'S SUPPLEMENTAL BRIEF REGARDING THE BOARD'S REVISED CONSTRUCTION OF THE PREAMBLE OF CLAIM 51

The Board intends to revise its construction of "a credential being previously issued" to mean "a credential is issued before the completion of the step of determining whether at least a portion of the funds transfer information used to generate a VAN is authentic." The Board's revised construction fully supports the Board's proper conclusion in the Final Written Decision that Davies discloses "a credential being previously issued" as recited in the preamble of claim 51.

Moreover, even under Patent Owner's overly-narrow construction, Davies (both by itself, and when combined with Meyer) renders the claim unpatentable

I. The Board's Revised Construction Fully Supports the Board's Proper Conclusion That the Davies Reference Discloses "A Credential Being Previously Issued," As Recited In the Preamble To Claim 51.

The Board intends to issue its decision on Patent Owner's Request for Rehearing based on a revised construction of "a credential being previously issued" in the preamble of claim 51. (Paper 36). Particularly, the Board intends to revise its construction of "a credential being previously issued" to mean "a credential is issued before the completion of the step of determining whether at least a portion of the funds transfer information used to generate a VAN is authentic." (*Id.*) Without waiving its contention that the preamble is not limiting (*see* Paper 30), Petitioner respectfully submits that the Board's revised construction fully supports the Board's conclusion in the Final Written Decision that Davies

discloses "a credential being previously issued" (Paper 32 at 25-26) and properly eliminates any suggestion that claim 51 requires that the credential be issued after the claimed step of generating a VAN *using funds transfer information* is performed.

Under the Board's revised construction, Davies renders the claims unpatentable. In particular, Petitioner relies on the "blank check" of Davies (i.e., the non-variable items 1-8 of the electronic check of Fig. 10.22 — of which items 5-8 can also be referred to as the "customer's certificate"). (Paper 7, at 26-27; Ex. 2005, at 59:17-60:12). The Board correctly concluded that the credential of Davies is "previously issued." (Paper 32 at 25-26). That is, the information of the customer's certificate is stored on the token by the card issuing bank (i.e., it is "previously issued" by a "trusted party"). (Ex. 1004, Davies pp. 328-30 ("customers of the bank can carry their keys … in an intelligent token...."); *id.* at Fig. 10.22).

As the Board recognized from the Petition, "in Davies, the credential is issued when a public key (item 6 in Figure 10.22) is issued in a certificate before the key is used." (Paper 32 at 25-26) (citing Paper 7 at 25-27 and Paper 19 at 15-16). Indeed, the Board noted Petitioner's contention that "Davies teaches that the certificate containing the customer's identity and customer's public key are read by the terminal to form an electronic check message, which is then presented back to

the token (including that customer's identity) to be signed." (Paper 32 at 26) (citing Paper 19 at 16). The terminal then determines the authenticity of the funds transfer information. (*Id.*) Thus, as the Board properly found, Davies' credential is "previously issued," prior to the determining step performed by the terminal. (*Id.*).

As the Board further recognized in the Final Written Decision, the credential is issued after *a* VAN is generated. (Paper 32 at 12-13). The VAN in that instance is the VAN1 "used to secure at least a portion of the credential information to the at least one party" as recited in claim 56. Davies discloses the VAN1 as the bank's signature, which is generated and then stored in the customer's certificate to secure the customer's credential to the customer. (Paper 7 at 72-75).

Accordingly, Petitioner respectfully submits that the Board's revised construction fully supports the proper conclusion reached by the Board in the Final Written Decision that Davies discloses "a credential being previously issued" as recited in the preamble of claim 51.

II. Davies and Meyer Render The Claim Invalid Even Under the Patent Owners Proposed Construction

Patent Owner contended in its Supplemental Brief that the preamble of claim 51 requires that the credential be issued before the receiving step. (Paper 31 at 1). Even under this overly-narrow construction, Davies (both by itself, and

when combined with Meyer) renders the claim unpatentable.

With reference to Fig. 10.22 of Davies, the information found in items 1-8 of the electronic check (including item 5, "Customer identity") is stored in the memory of the token. (*See* Paper 16, at 36). Davies thus describes how the token stores a certificate (i.e., a previously-issued credential) before being inserted in a terminal for a transaction. Davies also discloses that the funds transfer data, including all of the check data, are received by the token at the time of the transaction. In particular, the terminal reads information from the token (including the constant information in items 1-8 that "appear on every cheque drawn"), as well as any variable information maintained by the token (such as the "cheque sequence number"). (Ex. 1004, Davies pp. 328, 330). The terminal assembles this information, with additional variable information about the transaction, to form the electronic check message sent to the token for signing. (*Id.* at 328-31). Specifically, the "customer's request is formed into a message and presented to the token," (*id.* at 330); the "'cheque' enters the card from the terminal" to be signed by the token, (*id.* at 331 and Fig. 10.23 (arrow from terminal to token)). Davies further describes that these electronic checks are then recorded on the token, functioning as an "electronic chequebook." (*Id.* at 329). Therefore, Davies teaches that the certificate containing the customer's identity and customer's public key are read by the terminal to form an electronic check message, which is then

presented to the token to be signed and subsequently stored for later reference in the token's "electronic chequebook". (*Id.* at 325-31).

Accordingly, Davies discloses that the credential is "previously issued" (*i.e.*, as the customer's certificate on the token) before the step of "receiving funds transfer information" occurs (*e.g.*, when the electronic check message formed by the terminal is received by the token).

Additionally, Davies in view of Meyer would entail all of the check information, including the signer's credential information, being signed by the token. That is, Meyer discloses that the entirety of the transaction data, including the customer's identity in the credential, is an input to the cryptographic authentication code calculated by the token. (Paper 7, at 39–45; Paper 29 at 89:12-90:9). Thus, Davies in view of Meyer entails a credential, including the customer's identity, being issued before the step of "receiving funds transfer information" occurs.

Accordingly, Davies, taken alone or in combination with Meyer, discloses that the "credential is previously issued" as recited in the preamble, even under the overly-narrow construction proposed by the Patent Owner.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PETITIONER'S SUPPLEMENTAL BRIEF REGARDING THE BOARD'S REVISED CONSTRUCTION OF THE PREAMBLE OF CLAIM 51 was filed and served electronically via e-mail on September 6, 2016, in its entirety on the following:

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