

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BANK OF AMERICA, N.A.,
Petitioner,

v.

WARD PARTICIPATIONS B.V.,
Patent Owner.

IPR2022-01076
Patent 10,992,480 B2

Before THU A. DANG, GEORGIANNA W. BRADEN, and JAMES J.
MAYBERRY, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review

35 U.S.C. § 314

Granting Motion for Joinder

35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

Bank of America, N.A. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 3, and 6–19 (the “challenged claims”) of U.S. Patent No. 10,992,480 B2 (Ex. 1001, “the ’480 patent”). Paper 1 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.122 and 42.122(b) (2022), seeking to be joined as a party to *Samsung Electronics Co., Ltd. v. Ward Participations B.V.*, Case IPR2022-00113 (“the Samsung IPR”), which also involves claims 1, 3, and 6–19 of the ’480 patent. Paper 3 (“Mot.”). Ward Participations B.V. (“Patent Owner”) did not file an opposition to the Motion for Joinder or a preliminary response pursuant to 37 C.F.R. § 42.107(b).

Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the Samsung IPR and we grant Petitioner’s Motion for Joinder.

B. Related Proceedings

Petitioner identifies the ’480 patent as the subject of *Ward Participations B.V. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, No. 6:21-cv-00806 (W.D. Tex.); *Ward Participations B.V. v. Bank of America, N.A.*, No. 6:21-cv-01191 (W.D. Tex.); *Ward Participations B.V. v. Wells Fargo Bank, N.A.*, No. 6:21-cv-01195 (W.D. Tex.); *Ward Participations B.V. v. JP Morgan Chase Bank*,

N.A., No. 6:21-cv-01193 (W.D. Tex.); and *Ward Participations B.V. v. Citibank, N.A.*, No. 6:21-cv-01194 (W.D. Tex.). Pet. 87.

Petitioner also identifies the '480 patent as the subject of the Samsung IPR, which was instituted on April 26, 2022, wherein this Petition is a “me-too” copy of the petition in the Samsung IPR and is accompanied by a Motion for Joinder. Pet. 87–88. According to Petitioner, Samsung Electronics Co., Ltd. (“Samsung”), the Petitioner of the Samsung IPR, also filed a petition for post grant review (PGR) of the '480 Patent in *Samsung Electronics Co., Ltd. v. Ward Participations B.V.*, PGR2022-00007 (PTAB Oct. 29, 2021) and an IPR petition for review of related parent patent U.S. Patent No. 11,063,766 in *Samsung Electronics Co., Ltd. v. Ward Participations B.V.*, IPR2022-00114 (PTAB Oct. 29, 2021), both of which were also instituted on April 26, 2022. Petitioner contends that it is also concurrently filing a “me-too” copy of the petition in Case IPR2022-00114, accompanied by a Motion for Joinder. Pet. 88.

C. The '480 Patent

The '480 patent, titled “Method and System for Performing a Transaction and for Performing a Verification of Legitimate Access to, or Use of Digital Data,” issued on April 27, 2021, from Application No. 16/597,773, with a filing date of October 9, 2019, which is a continuation of Application No. 10/560,579, filed as PCT Application No. PCT/NL2004/00042, with a filing date of June 14, 2004. Ex. 1001, codes (54), (45), (21), (22) (63) (30).

The '480 patent provides authentication data and authentication software to an electronic device that are stored in a secure storage location inaccessible to the user or the operating system of the device. *Id.* at

code (57). An illustration of the embodiment of the '480 patent's computer configuration is depicted in Figure 3, reproduced below:

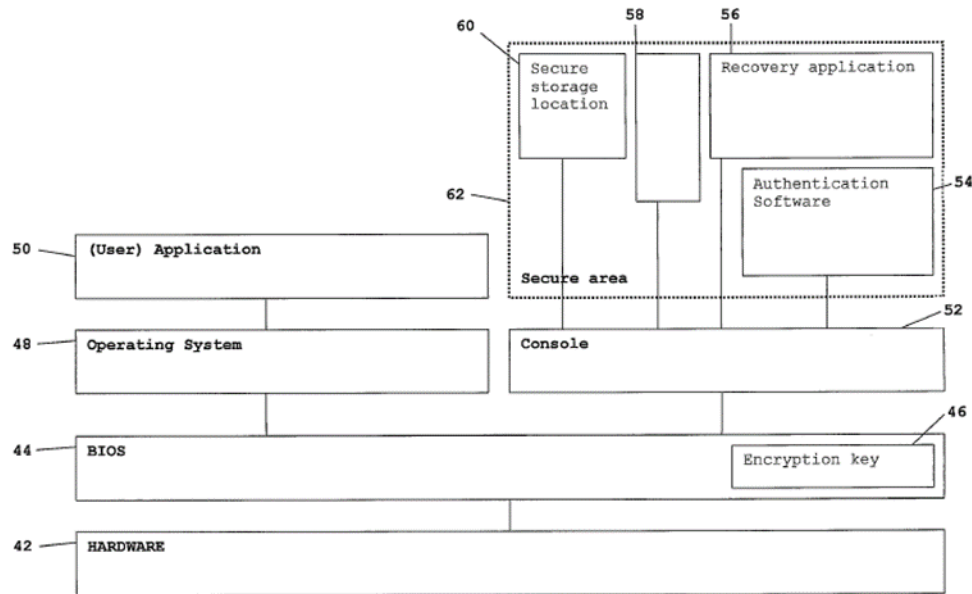


FIG. 3

Figure 3 is a schematic diagram of a configuration of a device having authentication software and an authentication table installed in the Basic In Out System (BIOS). *Id.* at 3:14–16. As shown in Figure 3, the device consists of hardware 42, examples of hardware components being a processor, a hard drive, or other memory and a keyboard. *Id.* at 8:14–17. The hardware devices are controlled by BIOS 44, BIOS 44 being a software package stored in a read-only-memory (ROM) located on a main board, which is one of the hardware components of an electronic device. *Id.* at 8:18–21.

BIOS 44 controls most of the instructions and data flowing from one component to another, wherein BIOS 44 checks whether the instructions to the other component are allowed or not. *Id.* at 8:22–28. As shown in Figure 3, BIOS 44 may comprise encryption key 46 used to encrypt data and

only another party who knows encryption key 46 may be able to decrypt the data. *Id.* at 8:29–32.

Operating system 48 creates a run-time environment for any user application, and is an interface between the user and hardware 42. *Id.* at 8:33–36. When a user instructs operating system 48 to run application 50, application 50 requests data from operating system 48, and operating system 48 in turn requests the data through BIOS 44 from hardware 42, i.e., the hard drive, wherein the data coming from hardware 42 pass through BIOS 44 and operating system 48 before they arrive at requesting application 50. *Id.* at 8:36–43. Accordingly, BIOS 44 controls the accessibility of certain data or devices of hardware 42 and thus the use of particular software, wherein it may prohibit, for example, operating system 48 to access certain parts of a hard drive or start certain applications. *Id.* at 8:44–48.

Console 52 is an environment that runs all the processes in the computer, wherein, at start-up of the computer, console 52 instructs devices of hardware 42 via BIOS 44 to start and report their status, and in case of errors, BIOS 44 sends error messages coming from hardware 42 to console 52, which then handles and correct the errors. *Id.* at 8:49–56. Any instruction coming from operating system 48 intended for console 52 may be blocked by BIOS 44. *Id.* at 8:59–61.

In Figure 3, in or behind console 52, there is secure area 62 only accessible to BIOS 44, secure area 62 comprising applications and storage locations not reported to operating system 48, and thus, operating system 48 does not know that the applications and data in the storage locations are present and maybe even running in a separate environment. *Id.* at 8:62–9:1.

As shown in Figure 3, secure area 62 comprises secure storage location 60, recovery application 56, and authentication software 54, wherein an authentication table may be securely stored in secure storage location 60 in a part of the computer commonly seen as part of BIOS 44 but the authentication table is unreachable for operating system 48, and thus for a user. *Id.* at 9:7–11. With the authentication table securely stored in secure storage location 60, authentication software 54 should run in an environment in BIOS 44, thus preventing the authentication table from being accessible to operating system 48 at any time. *Id.* at 9:12–16. Therefore, authentication software 54 may be installed in an application environment in secure area 62 such that it may obtain the authentication table without passing through an unsecured part of the device. *Id.* at 9:16–19. Authentication software 54 preferably has its own unique serial number, software identification (ID) and/or private encryption key. *Id.* 39–40.

In a further embodiment, authentication software 54 may be provided with a system for signing a digital signature using a part of a software identification number (software ID) or any other application identifying character string, hereinafter, “private key.” *Id.* at 13:31–36. A digital signing algorithm is preferably stored in a secure part of BIOS 44, wherein this algorithm may be protected like the authentication table in secure storage location 60. *Id.* at 9:27–34.

D. The Challenged Claims

Of the challenged claims (claims 1, 3, and 6–19), claims 1, 16, 17, and 18 are independent. Independent claim 1 is illustrative of the challenged claims, and is reproduced below:

1. A method for performing an electronic transaction between a first transaction party and a second transaction party using an electronic device operated by the first transaction party, the electronic device having an operating system creating a run-time environment for user applications, the method comprising:

providing a private key in a memory of said electronic device, said memory being a secure part of a Basic In Out System or any other secure location in said electronic device, which private key is inaccessible to a user of said electronic device, wherein the private key is encrypted when the private key is stored in said memory, a decryption key for decrypting the private key being incorporated in the electronic device, said decryption key being inaccessible to said user, to any user-operated software and to said operating system, wherein said memory is inaccessible to said operating system of said electronic device, thereby rendering the private key inaccessible to said user, wherein the private key is decrypted in a secure processing environment inaccessible to said user and to any user-operated software;

providing authentication software in said electronic device, the private key being accessible to said authentication software, wherein authentication software is stored in said secure memory inaccessible to said operating system;

activating the authentication software to generate a digital signature from the private key, wherein the authentication software is run in a secure processing environment inaccessible to said operating system;

providing the digital signature to the second transaction party.

Ex. 1001, 17:64–18:29.

E. Asserted Challenges to Patentability

Petitioner challenges the patentability of claims 1, 3, and 6–19 of the '480 patent on the following basis (Pet. 1–2):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3, 6, 11, 14–19	103	Ellison ¹ , Muir ² ,
7, 9, 13	103	Ellison, Muir, Al-Salqan ³
8, 10, 12	103	Ellison, Muir, Searle ⁴

Petitioner relies on the Declaration of John R. Black, Jr., Ph.D. (Ex. 1003) in support of its unpatentability contentions.

II. ANALYSIS

A. Joinder Under 35 U.S.C. § 315(c)

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

(c) JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

¹ U.S. Patent No. 7,082,615 B1, issued July 25, 2006, filed September 22, 2000 (Ex. 1006, “Ellison”).

² PCT Patent Publication No. WO 01/93212 A2, published December 6, 2001, filed May 30, 2001 (Ex. 1008, “Muir”).

³ U.S. Patent No. 6,549,626 B1, issued April 15, 2003, filed October 20, 1997 (Ex. 1007, “Al-Salqan”).

⁴ U.S. Patent No. 6,683,954 B1, issued January 27, 2004, filed October 23, 1999 (Ex. 1009, “Searle”).

“To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). “First, the statute requires that the Director (or the Board acting through a delegation of authority) . . . determine whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* “Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to ‘join as a party’ the joinder applicant.” *Id.*

1. *Whether the Petition Warrants Institution*

Petitioner states that its Petition and accompanying declaration of Dr. Black (Exhibit 1003), are “substantively identical” to those filed by Samsung in the Samsung IPR, with the only differences being non-substantive introductory matters and mandatory notices. *See* Pet. 1; Mot. 6. We previously instituted an *inter partes* review in the Samsung IPR. *See* IPR2022-00113, Paper 8 (“Dec. on Inst.”).

We incorporate our previous analysis regarding the asserted grounds of unpatentability, and conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the ’480 patent challenged in the Petition for the same reasons. *See* Dec. on Inst. 28. Therefore, we determine that the Petition warrants institution of *inter partes* review on all claims and all challenges asserted in the Petition.

2. *Whether to Join Petitioner as a Party to the Samsung IPR*

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. We determine

whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. When exercising that discretion, we are mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). As such, any motion for joinder must be filed “no later than one month after the institution date of any inter partes review for which joinder is requested.” 37 C.F.R.

§ 42.122(b). Here, as Petitioner points out, the Petition is filed within one month of the Decision on Institution in the Samsung IPR. Mot. 5. Thus, Petitioner timely filed its Petition and Motion for Joinder.

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); PTAB E2E Frequently Asked Question H5, *available at* <https://www.uspto.gov/patents/ptab/ptab-e2e-frequently-asked-questions>.

Petitioner argues that joinder is appropriate because it “challenges the same claims, relies on the same expert and expert declaration, and is based on the same grounds and combinations of prior art submitted in the Samsung Petition.” Mot. 6. Petitioner contends that joinder will not impact the trial schedule of the Samsung IPR in any meaningful way because the issues

presented are identical to the issues presented in the Samsung IPR, wherein “Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Samsung Petition.” *Id.* at 7–8. According to Petitioner, because the Petition relies on the same expert and an identical declaration in the Samsung IPR, “only a single deposition is needed for the proposed joined proceeding.” *Id.*

Furthermore, Petitioner agrees to assume an “understudy” role in the Samsung IPR and “will assume the primary role only if Samsung ceases to participate in the Samsung IPR.” *Id.* at 9. In particular, Petitioner states that it will take the understudy role, as described by the Board:

(a) ***all*** filings by [Petitioner] in the joined proceeding be consolidated with [the filings of the petitioner in the Samsung IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Samsung IPR]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Samsung IPR], or introduce any argument or discovery not already introduced by [the petitioner in the Samsung IPR]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Samsung IPR] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Samsung IPR] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Samsung IPR].

Id. at 8–9 (citing IPR2014-00550, Paper 38 at 5 (Apr. 10, 2015) (emphasis in original)). Patent Owner did not file an opposition to the Motion for Joinder.

Upon considering the parties’ arguments and the evidence presented, we are persuaded that it is appropriate under these circumstances to join Petitioner to the Samsung IPR. Petitioner challenges the same claims that are challenged in the Samsung IPR on the same grounds using the same

prior art and evidence. Petitioner explicitly agrees that it will take an understudy role in the Samsung IPR, and has shown that the trial schedule will not be affected at all by joinder. Thus, joinder to the Samsung IPR would result in the just, speedy, and inexpensive resolution of Petitioner's challenge. *See* 37 C.F.R. § 42.1(b).

Accordingly, for the reasons discussed above, we grant Petitioner's Motion for Joinder and join Petitioner as a party to the Samsung IPR.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted as to claims 1, 3, and 6–19 of the '480 patent with respect to all grounds set forth in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of a trial, which commences on the entry date of this Decision;

FURTHER ORDERED that Petitioner's Motion for Joinder with Case IPR2022-00113 is *granted*, and Petitioner is hereby joined with Samsung as petitioners in Case IPR2022-00113;

FURTHER ORDERED that the grounds on which trial in Case IPR2022-00113 were instituted are unchanged, and no other grounds are added in Case IPR2022-00113;

FURTHER ORDERED that the Scheduling Order entered in Case IPR2022-00113 (Paper 9) and schedule changes agreed by the parties in Case IPR2022-00113 (pursuant to the Scheduling Order) shall govern the trial schedule in Case IPR2022-00113;

FURTHER ORDERED that Petitioner's role in Case IPR2022-00113 shall be limited as stated by Petitioner in the Motion for Joinder (Mot. 8–9) unless and until Samsung is terminated from that proceeding;

FURTHER ORDERED that the case caption in Case IPR2022-00113 shall be changed to reflect joinder of Samsung Electronics Co., Ltd., and Bank of America, N.A., as petitioners in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision be entered into the record of Case IPR2022-00113; and

FURTHER ORDERED that all further filings shall be made in Case IPR2022-00113.

IPR2022-01076
Patent 10,992,480 B2

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Patent 10,992,480 B2

⁵ Bank of America, N.A. filed a motion for joinder and a petition in Case IPR2022-01076, which were granted, and, therefore, has been joined as petitioner in this proceeding.