

Filed: May 25, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BANK OF AMERICA, N.A.; TRUIST BANK; BOKF, N.A.; WELLS FARGO
BANK, N.A.; AND PNC BANK, N.A.,
Petitioners,

v.

DYNAPASS IP HOLDINGS LLC,
Patent Owner.

IPR2023-00367
U.S. Patent 6,993,658

**PETITIONERS' REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit	Description
Ex. 1001	U.S. Patent No. 6,993,658 B1 to Engberg et al. (“the ’658 Patent”)
Ex. 1002	Declaration of Dr. Peter Lawrence Reiher (“Reiher”)
Ex. 1003	Curriculum Vitae of Dr. Peter Lawrence Reiher
Ex. 1004	Prosecution History of the ’658 Patent
Ex. 1005	Japanese Patent Application Publication No. JP2000-10927 (Japanese language document) to Kato, filed June 25, 1998, published January 14, 2000 (“Kato”)
Ex. 1006	English Translation of Japanese Patent Application Publication No. JP2000-10927
Ex. 1007	U.S. Patent No. 6,161,185 to Guthrie et al., filed March 6, 1998, published December 12, 2000 (“Guthrie”)
Ex. 1008	U.S. Patent No. 5,060,263 to Bosen et al., filed March 9, 1988, published October 22, 1991 (“Bosen”)
Ex. 1009	U.S. Patent No. 6,609,206 B1 to Veneklas, filed February 5, 1999, published August 19, 2003 (“Veneklas”)
Ex. 1010	U.S. Patent No. 5,604,803 to Aziz, filed June 3, 1994, published February 18, 1997 (“Aziz”)
Ex. 1011	U.S. Patent No. 6,078,908 to Schmitz, filed April 22, 1998, published June 20, 2000 (“Schmitz”)
Ex. 1012	International Patent Application Publication No. WO 95/19593 to Kew et al., filed January 12, 1995, published July 20, 1995 (“Kew”)
Ex. 1013	U.S. Patent No. 5,153,919 to Reeds et al., filed September 13, 1991, published October 6, 1992 (“Reeds”)

Exhibit	Description
Ex. 1014	U.S. Patent No. 6,662,300 B1 to Peters, filed June 29, 1999, published December 9, 2003 (“Peters”)
Ex. 1015	U.S. Patent No. 5,668,876 to Falk et al., filed June 24, 1994, published September 16, 1997 (“Falk”)
Ex. 1016	U.S. Patent No. 5,491,752 to Kaufman et al., filed September 2, 1994, published February 13, 1996 (“Kaufman”)
Ex. 1017	U.S. Patent No. 5,736,932 to Bulfer et al., filed July 3, 1996, published April 7, 1998 (“Bulfer”)
Ex. 1018	International Patent Application Publication No. WO 97/31306 to Sormunen et al., filed February 6, 1997, published August 28, 1997 (“Sormunen”)
Ex. 1019	U.S. Patent Application Publication No. 2001/0007817 to Odagiri et al., filed December 8, 2000, published July 12, 2001 (“Odagiri”)
Ex. 1020	International Patent Application Publication No. WO 01/16899 A2, filed August 17, 2000, published March 8, 2001 (“Shields”)
Ex. 1021	U.S. Patent No. 6,430,407 B1 to Turtiainen, filed February 4, 1999, published August 6, 2002 (“Turtiainen”)
Ex. 1022	U.S. Patent No. 6,731,731 B1 to Ueshima, filed March 29, 2001, published May 4, 2004 (“Ueshima”)
Ex. 1023	U.S. Patent No. 6,259,909 B1 to Ratayczak et al., filed July 8, 1998, published July 10, 2001 (“Ratayczak”)
Ex. 1024	U.S. Patent Application Publication No. 2003/0046083 A1 to Devinney et al., filed November 21, 1997, published March 6, 2003 (“Devinney”)
Ex. 1025	U.S. Patent No. 6,535,855 B1 to Cahill et al., filed March 31, 1998, published March 18, 2003 (“Cahill”)

Exhibit	Description
Ex. 1026	U.S. Patent No. 7,260,221 B1 to Atsmon, filed May 15, 2001, published August 21, 2007 (“Atsmon”)
Ex. 1027	U.S. Patent No. 5,406,619 to Akhteruzzaman, filed March 31, 1994, published April 11, 1995 (“Akhteruzzaman”)
Ex. 1028	U.S. Patent No. 6,338,140 B1 to Owens et al., filed November 24, 1998, published January 8, 2002 (“Owens”)
Ex. 1029	U.S. Patent No. 5,887,065 to Audebert, filed October 2, 1997, published March 23, 1999 (“Audebert”)
Ex. 1030	U.S. Patent Application Publication No. 2002/0178370 A1 to Gurevich et al., filed December 29, 2000, published November 28, 2002 (“Gurevich”)
Ex. 1031	U.S. Patent No. 6,983,308 B1 to Oberhaus et al., filed December 22, 1998, published January 3, 2006 (“Oberhaus”)
Ex. 1032	U.S. Patent No. 6,035,406 to Moussa et al., filed April 2, 1997, published March 7, 2000 (“Moussa”)
Ex. 1033	Disclosure of Asserted Claims and Infringement Contentions, <i>Dynapass IP Holdings LLC v. JPMorgan Chase & Co. et al.</i> , Case No. 2:22-cv-00212 (Lead Case) (E.D. Tex. Sept. 8, 2022)
Ex. 1034	E-mail from the Board authorizing Petitioners’ Preliminary Reply dated May 18, 2023

The Board authorized reply on: 1) the Board's jurisdiction over expired patents and 2) the applicability of *Xerox Corp., et al. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 (Aug. 24, 2022). Ex. 1034.

First, in *Apple, Inc. v. Gesture Tech. Partners, LLC*, the Board correctly found that it has jurisdiction over expired patents for three reasons: (1) the Supreme Court has stated that IPR functions as “a second look at an earlier administrative grant of a patent;” (2) PTAB rules make clear that IPR covers expired patents; and (3) several statutes governing IPR do not expressly limit IPR to non-expired patents, despite imposing other limitations. IPR2021-00922, Paper 10 at 17-19, Paper 26 at 25-27.

Second, the expert's testimony here is supported by both explained reasoning and additional evidence. *Xerox* held that testimony that repeats conclusory assertions from a petition, *without citing supporting evidence or providing technical reasoning*, is entitled to little weight. *Xerox*, Paper 9 at 14-16. The Director also highlighted the lack of “*any ... explanation ... why the expert*” makes the determination **or** any “*facts and evidence in support.*” *Xerox*, Paper 12 at 5. Here, Dr. Reiher challenged testimony provides both an explanation why **and** supporting evidence. Reiher, ¶¶57, 64-70, 147-149 (citing Ratayczak(Ex. 1023), Guthrie(Ex. 1007), Sormunen(Ex. 1018), Veneklase(Ex. 1009), Kaufman(Ex. 1016), Bosen(Ex. 1008), Falk(Ex. 1015), Kato(Ex. 1005), Ueshima(Ex. 1022), Bulfer(Ex. 1017), Turtiainen(Ex. 1021), Odagiri(Ex. 1019), Oberhaus(Ex. 1031), Peters(Ex. 1014), Reeds(Ex. 1013)).

IPR2023-00367

U.S. Patent No. 6,993,658

Dated: May 25, 2023

Respectfully submitted,

/Lionel M. Lavenue/

Lionel M. Lavenue, Reg. No. 46,859

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
**PETITIONERS' PRELIMINARY REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE** was served on May 25, 2023, via email directed to
counsel of record for the Patent Owner at the following:

John Wittenzellner
johnw@wsltrial.com

Todd E. Landis
tlandis@wsltrial.com

Michael J. Fagan, Jr.
mfagan@wsltrial.com

Mark McCarthy
mmccarthy@wsltrial.com

IPRDYNAPASSWSL@wsltrial.com

Date: May 25, 2023

By: /Daniel E. Doku/
Daniel E. Doku
Litigation Legal Assistant
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP