

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASTERCARD INTERNATIONAL INCORPORATED & MASTERCARD
INCORPORATED

Petitioner,

v.

OV LOOP, INC.

Patent Owner.

IPR2023-001289
IPR2023-001290

Attorney Docket No.: 070457.2931

**PETITIONER'S EXPLANATION OF PARALLEL PETITIONS FOR
U.S. PATENT NO. 10,032,171**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

Submitted Electronically via the Patent Trial and Appeal Board End to End System

I. INTRODUCTION

Petitioner is requesting *inter partes* review (“IPR”) challenging all 33 claims of U.S. Patent 10,032,171 (“the ’171 Patent”) in two concurrently filed IPR petitions: IPR2023-001289 (the “1289 Petition”) and –001290 (the “1290 Petition”). Following the Consolidated Trial Practice Guide, Petitioner submits this explanation of the differences between, and ranking of, the petitions for the Board’s consideration.

Here, both petitions are necessary because there is a dispute regarding the priority date of the challenged claims of the ’171 Patent, and the petitions rely on different prior art references. The Board has recognized that “more than one petition may be necessary, including, for example . . . when there is a dispute about priority date requiring arguments under multiple prior art references.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, 84 Fed. Reg. 64280 (Nov. 14, 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>, at 59.

II. RANKING THE PETITIONS

Petitioner respectfully requests that the Board consider the petitions in the following order: (1) the 1289 Petition (which assumes Patent Owner OV Loop, Inc. (“OV Loop”) will be entitled to a later priority date, i.e., August 30, 2012) and (2) the 1290 Petition (which assumes that the Patent Owner OV Loop, Inc. is entitled to an earlier priority date based on a provisional application).

Ranking	Petition	Claims	Assumed Priority Date	Base References Used for Grounds
#1	1289	1–33	Aug. 30, 2012	Ground 1: Collinge Ground 2: Fiske
#2	1290	1–33	Aug. 30, 2011	Ground 1: White Ground 2: Mellqvist

III. DIFFERENCES BETWEEN THE PETITIONS AND THE MATERIALITY OF ISSUES ADDRESSED BY THE DIFFERENCES

OV Loop will likely contend that at least one of the provisional applications establishes the priority date of the '171 Patent. However, as discussed in Petition 1289, none of the three provisional applications to which '171 Patent claims priority (Provisional Patent Application Ser. Nos. 61/575,846 and 61/573,476 and 61/685,863) support the claims in the '171 Patent and should therefore not be used to set the priority date. Therefore, Mastercard submits two IPR petitions: (1) 1289 Petition supported by prior art before the priority date based on the non-provisional application, App. No. 13/599,647 dated Aug. 30, 2012, which issued as the '171 Patent; and (2) 1290 Petition supported by prior art references before the alleged priority date of the '171 Patent based on the earliest provisional application (No. 61/575,846, dated Aug. 30, 2011), without conceding that such alleged priority date is correct.

The 1289 Petition relies on U.S. Patent Pub. No. 2013/0262317 A1 ("Collinge") and U.S. Patent No. 11,080,693 ("Fiske") as primary references.

Collinge and Fiske are prior art to the challenged claims under their correct priority date of August 30, 2012.

The 1290 Petition relies on U.S. Patent No. 8,374,916 (“White”) and U.S. Patent Pub. No. 2010/0153721 A1 (“Mellqvist”) as primary references, which are two different references that qualify as prior art even under the alleged August 30, 2011 priority date.

In summary, there are material differences between each IPR petition because they rely on different prior art references based on different priority dates. Therefore, it is necessary for Mastercard to submit parallel petitions.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO INSTITUTE MULTIPLE PETITIONS.

A. The Petitions Use Different Priority Dates

Each petition addresses the same challenged claims under different priority dates. The 1289 Petition assumes that Claims 1–33 are not entitled to a priority date any earlier than August 30, 2012, the filing date of the non-provisional application for the ’171 Patent. By contrast, the 1290 Petition relies on references that qualify as prior art even assuming the alleged August 30, 2011 priority date, which is the filing date of the earliest provisional application (No. 61/575,846) for the ’171 patent, were correct.

B. The Petitions Rely on Different Prior Art

Because of the priority date dispute, each petition presents different primary prior art references of. The 1289 Petition relies on Fiske and Collinge, which is prior art to the challenged claims based on correct priority date, August 30, 2012. The 1290 Petition relies on White and Mellqvist, which are two different references that qualify as prior art even under the alleged August 30, 2011 priority date.

V. CONCLUSION

In conclusion, the Board should institute both petitions because they present materially distinct grounds with different prior art references based on the disputed priority date.

Respectfully submitted,

Date: September 6, 2023

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CERTIFICATE OF SERVICE

Under 37 C.F.R. § 42.6(e) and § 42.105, the undersigned hereby certifies that on this 6th day of September 2023, a copy of the foregoing **PETITIONER'S EXPLANATION OF PARALLEL PETITIONS FOR U.S. PATENT NO. 10,032,171** was served via overnight mail on OV Loop at the correspondence address of record for the subject patent as included below:

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with a courtesy copy via email to counsel for OV Loop in the district court litigation as follows:

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Date: September 6, 2023

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