

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JPMORGAN CHASE BANK, N.A.
Petitioner

v.

DYNAPASS IP HOLDINGS LLC,
Patent Owner

Case No. – *Not Yet Assigned*
U.S. Patent No. 6,993,658

**PETITIONER’S MOTION FOR JOINDER UNDER
37 C.F.R. §§ 42.22 AND 42.122(b)**

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I. STATEMENT OF RELIEF REQUESTED

JPMorgan Chase Bank, N.A. (“JPMorgan” or “Petitioner”) respectfully requests that the Board grant JPMorgan’s concurrently filed petition (the “Petition”) for *inter partes* review of U.S. Patent No. 6,993,658 (“the ’658 Patent”) and join, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), the instituted proceeding with *Unified Patents, LLC v. Dynapass IP Holdings LLC*, IPR2023-00425 (the “Unified Patents IPR”), which the Board instituted on July 18, 2023.

This is JPMorgan’s first time challenging the patentability of the ’658 Patent before the Board. JPMorgan’s Petition is substantively identical to the petition in the Unified Patents IPR—challenging the same claims of the ’658 Patent on the same grounds while relying on the same prior art, arguments, and evidence. *See* Ex. 1017 (redline comparison). This Motion for Joinder and accompanying Petition are timely, being filed within the one-month time limit set forth in 37 C.F.R. § 42.122(b).

Joinder is appropriate here because (i) JPMorgan’s Petition is substantively identical to the petition in the Unified Patents IPR with respect to the asserted grounds, are based on the same prior art combinations and supporting evidence, and asserted against the same claims, and (ii) JPMorgan agrees to an “understudy role” and will not assume an active role unless Unified Patents ceases to actively prosecute the Unified Patents IPR. Joinder will not unduly complicate the Unified Patents IPR

nor adversely impact its schedule, and instead will promote judicial efficiency in determining the patentability of the '658 Patent.

Accordingly, JPMorgan respectfully requests that the Board grant this Motion for Joinder.

II. STATEMENT OF MATERIAL FACTS

1. Dynapass IP Holdings LLC (“Dynapass” or “Patent Owner”) filed a Complaint for patent infringement of the '658 Patent on June 17, 2022, against JPMorgan, JPMorgan Chase & Co, and Chase Bank USA, N.A. (now known as JPMorgan Chase Bank N.A.) in the Eastern District of Texas. That case is styled *Dynapass IP Holdings LLC v. JPMorgan Chase & Co., JPMorgan Chase Bank, National Association, and Chase Bank USA National Association*, Case No. 2:22-cv-00212 (E.D. Tex.). JPMorgan was served with the Complaint on June 22, 2022.

2. Patent Owner has also asserted the '658 Patent in the following cases:

- a. *Dynapass IP Holdings LLC v. Bank of America Corporation et al.*, Case No. 2:22-cv-00210 (E.D. Tex.) (filed June 17, 2022);
- b. *Dynapass IP Holdings LLC v. BOKF, National Association*, Case No. 2:22-cv-00211 (E.D. Tex.) (filed June 17, 2022);
- c. *Dynapass IP Holdings LLC v. PlainsCapital Bank et al.*, Case No. 2:22-cv-00213 (E.D. Tex.) (filed June 17, 2022);

- d. *Dynapass IP Holdings LLC v. PNC Financial Services Group, Inc. et al.*, Case No. 2:22-cv-00214 (E.D. Tex.) (filed June 17, 2022);
- e. *Dynapass IP Holdings LLC v. Regions Financial Corporation et al.*, Case No. 2:22-cv-00215 (E.D. Tex.) (filed June 17, 2022);
- f. *Dynapass IP Holdings LLC v. Truist Financial Corporation*, Case No. 2:22-cv-00216 (E.D. Tex.) (filed June 17, 2022);
- g. *Dynapass IP Holdings LLC v. Wells Fargo & Company et al.*, Case No. 2:22-cv-00217 (E.D. Tex.) (filed June 17, 2022);
- h. *Dynapass IP Holdings LLC v. Woodforest National Bank et al.*, Case No. 2:22-cv-00218 (E.D. Tex.) (filed June 17, 2022);
- i. *Dynapass IP Holdings LLC v. Amazon.com, Inc.*, Case No. 2:23-cv-00063 (E.D. Tex.) (filed Feb. 20, 2023);
- j. *Dynapass IP Holdings LLC v. The Charles Schwab Corporation et al.*, Case No. 2:23-cv-00064 (E.D. Tex.) (filed Feb. 20, 2023);
- k. *Dynapass IP Holdings LLC v. East West Bancorp, Inc. et al.*, Case No. 2:23-cv-00065 (E.D. Tex.) (filed Feb. 20, 2023);
- l. *Dynapass IP Holdings LLC v. Experian Information Services, Inc.*, Case No. 2:23-cv-00066 (E.D. Tex.) (filed Feb. 20, 2023);

m. *Dynapass IP Holdings LLC v. First Citizens Bancshares, Inc. et al.*, Case No. 2:23-cv-00067 (E.D. Tex.) (filed Feb. 20, 2023);

n. *Dynapass IP Holdings LLC v. Simmons First National Corporation et al.*, Case No. 2:23-cv-00068 (E.D. Tex.) (filed Feb. 20, 2023).

3. Cases (c), (e), (h), (k), and (m) have been voluntarily dismissed.

4. On April 5, 2023, Jack Henry & Associates, Inc. filed an action for Declaratory Judgment of Non-infringement and Invalidity of the '658 Patent against Dynapass in the District of Delaware, in a case styled *Jack Henry & Associates, Inc. v. Dynapass IP Holdings LLC*, Case No. 1:23-cv-00388 (D. Del.).

5. On January 3, 2023, Bank of America, N.A., Truist Bank, BOKF, N.A., Wells Fargo Bank, N.A., and PNC Bank, N.A. filed a Petition for *inter partes* review challenging claims 1-3 and 5-7 of the '658 Patent ("Bank of America Petition"). On July 18, 2023, the Board instituted a Decision Denying Institution of the Bank of America Petition. *Bank of America, N.A. et al. v. Dynapass IP Holdings*, IPR2023-00367, Paper 13 (PTAB July 18, 2023). Neither JPMorgan, JPMorgan Chase & Co, nor Chase Bank USA, N.A. was a party to the Bank of America Petition.

6. On January 6, 2023, Unified Patents, LLC, filed a Petition for *inter partes* review challenging claims 1 and 3-6 of the '658 Patent (“Unified Patents Petition”). On July 18, 2023, the Board issued a Decision Granting Institution of the Unified Patents Petition and instituted the Unified Patents IPR. *Unified Patents, LLC v. Dynapass IP Holdings LLC*, IPR2023-00425, Paper 9 (PTAB July 18, 2022).

7. This petition asserts the same grounds of unpatentability against the same claims, and relies on the same expert declaration and evidence as asserted and relied upon on in the Unified Patents IPR.

III. STATEMENT OF REASONS FOR REQUESTED RELIEF

A. Legal Standards

The Leahy-Smith America Invents Act (AIA) permits joinder of *inter partes* review (IPR) proceedings. Joinder is governed by 35 U.S.C. § 315(c), which states:

(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.

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.” *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

B. JPMorgan’s Motion is Timely

A Motion for Joinder is timely if the moving party files within one month of institution of the *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). The Unified Patents IPR was instituted on July 18, 2023. Because JPMorgan files this motion within one month of the institution of the Unified Patents IPR, this motion is timely.

C. Joinder is Appropriate

Joinder is appropriate because the JPMorgan Petition “does not include any new issues beyond those raised in” the Unified Patents IPR, and joinder “will have minimal impact on the proceeding. *See STMicroelectronics, Inc. v. Monterey Research, LLC*, IPR2021-01230, Paper 7, at 5 (PTAB Nov. 18, 2021). The JPMorgan Petition is substantially identical to the Unified Patents Petition, challenging the same claims of the ’658 Patent on the same grounds and relying on the same expert declaration. The only differences between JPMorgan’s Petition and

the Unified Patents Petition are the sections on Real Party-In-Interest, Related Matters, Counsel, Service Information, and Discretionary Institution, which have been appropriately updated. *See* Ex. 1017. JPMorgan has also re-filed the same declaration of Bruce McNair. Joinder would therefore have little, if any, impact on the Unified Patents IPR because no new grounds would be added, the schedule would not be affected, no additional briefing or discovery would be required, and no additional burdens would be placed on the Patent Owner, as detailed below.

Accordingly, joinder is appropriate because it eliminates the possibility of duplicate efforts and ensures a just, speedy, and inexpensive resolution of these proceedings.

1. No New Grounds of Unpatentability in the Petition

The JPMorgan Petition does not assert any new grounds of unpatentability. It challenges the same claims (1 and 3-6) of the '658 Patent based on the same arguments, evidence, and grounds of unpatentability as the Unified Patents Petition.

2. No Impact on the Schedule for the Existing IPR Proceeding

Joinder should not impact the trial schedule for the Unified Patents IPR because the JPMorgan Petition presents no new issues or grounds of unpatentability. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments upon joinder.

JPMorgan will adhere to all existing deadlines set in the Scheduling Order for the Unified Patents IPR (IPR2023-00425, Paper 10). Additionally, no additional expert discovery will be needed because the JPMorgan Petition relies upon the same declaration testimony from the same expert as relied upon by the Unified Patents Petition. If joined, JPMorgan will not file additional briefs outside of the consolidated filings, will not request any additional deposition time, and will not request any additional oral hearing time. In the event that the Unified Patents IPR is terminated with respect to the petitioner, JPMorgan intends to “step into the shoes” of the dismissed petitioner and materially participate in the joined proceedings.

Accordingly, for the reasons stated above, joinder of JPMorgan to the Unified Patents IPR will not affect the Board’s ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

3. Briefing and Discovery Will be Simplified

JPMorgan agrees to an “understudy” role, which will simply briefing and discovery. In particular, JPMorgan agrees that, if joined, the following conditions will apply so long as Unified Patents remains an active party, as previously approved by the Board in similar circumstances:

(a) all filings by JPMorgan in the joined proceeding be consolidated with the filings of Unified Patents, unless a filing solely concerns issues that do not involve Unified Patents;

(b) JPMorgan shall not be permitted to raise any new grounds not instituted by the Board in the Unified Patents IPR, or introduce any argument or discovery not already introduced by Unified Patents;

(c) JPMorgan shall be bound by any agreement between the Patent Owner and Unified Patents concerning discovery and/or depositions; and

(d) JPMorgan at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for Unified Patents in this proceeding alone under wither 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Unified Patents.

See Mercedes-Benz USA, LLC v. Neo Wireless, LLC, IPR2023-00079, Paper 11 at 10, 13-14 (PTAB May 5, 2023) (finding joinder appropriate under similar conditions). JPMorgan would assume a primary role only if Unified Patents ceased to participate in the proceeding. Briefing and discovery will be simplified in that there will be no need for redundant depositions, briefing, or hearings. JPMorgan is further amenable to any other reasonable conditions the Board deems necessary.

4. No Prejudice to Patent Owner

Joinder of JPMorgan to the Unified Patents IPR will not create any additional burden on the Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current Unified Patents IPR.

IV. CONCLUSION

For the foregoing reasons, JPMorgan respectfully requests that its Petition for *Inter Partes* Review of the '658 Patent be granted and that the proceedings be joined with the Unified Patents IPR.

Dated: August 16, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on August 16, 2023, I caused a complete copy of this **Petitioner's Motion for Joinder Under 37 C.F.R. §§ 42.22 and 42.122(b)** to be served via USPS Priority Mail Express to the following correspondence address of record for the subject patent:

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