

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.

IPR2023-01331
Patent 6,993,658 B2

Before KEVIN F. TURNER, KRISTEN L. DROESCH, and
LYNNE H. BROWNE, *Administrative Patent Judges*.

BROWNE, *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*

On August 16, 2023, JPMorgan Chase Bank, N.A. (“Petitioner”) filed a Petition (Paper 1, “Pet.” or “Petition”) requesting an *inter partes* review of claims 1 and 3–6 of U.S. Patent No. 6,993,658 (Ex. 1001, “the ’658 patent”). Concurrently, Petitioner filed a Motion for Joinder seeking to be joined as a party to *Unified Patents, LLC v. Dynapass IP Holdings LLC*, IPR2023-00425 (“the Unified Patents IPR”). Paper 2 (“Mot.”). Dynapass IP Holdings, LLC (“Patent Owner”) has not filed a Preliminary Response to the Petition. We have authority and jurisdiction under 35 U.S.C. §§ 6, 314 and 37 C.F.R. § 42.4.

For the reasons discussed below, we determine institution of *inter partes* review is warranted on the same grounds instituted in the Unified Patents IPR, and grant Petitioner’s Motion for Joinder.

B. *Real Parties in Interest*

Petitioner identifies itself as the real party-in-interest in this proceeding. Pet. 76. Patent Owner identifies itself as the real party-in-interest. Paper 5, 1.

C. *Related Matters*

The parties identify *Dynapass IP Holdings LLC v. JPMorgan Chase & Co., JPMorgan Chase Bank, National Association, and Chase Bank USA National Association*, 2:22-cv-00212 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Bank of America Corporation*, 2:22-cv-00210 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. BOKF, National Association*, 2:22-cv-00211 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. PlainsCapital Bank*, 2:22-cv-00213 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. PNC Financial Services*, 2:22-cv-00214 (EDTX 6-17-2022), *Dynapass IP*

Holdings LLC v. Regions Financial Corporation, 2:22-cv-00215 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Truist Financial Corporation*, 2:22-cv-00216 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Wells Fargo & Company*, 2:22-cv-00217 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Woodforest National Bank*, 2:22-cv-00218 (EDTX 6-17-2022), *Dynapass Inc. v. Mobile Authentication Corporation*, 8:18-cv-01173 (CDCA 7-3-2018), *Dynapass IP Holdings LLC v. Amazon.com, Inc.*, 2:23-cv-00063 (EDTX 2-20-2023), *Dynapass IP Holdings LLC v. The Charles Schwab Corporation et al.*, 2:23-cv-00064 (EDTX 2-20-2023), *Dynapass IP Holdings LLC v. East West Bancorp, Inc. et al.*, 2:23-cv-00065 (EDTX 2-20-2023) (voluntarily dismissed), *Dynapass IP Holdings LLC v. Experian Information Services, Inc.*, 2:23-cv-00066 (EDTX 2-20-2023), *Dynapass IP Holdings LLC v. First Citizens Bancshares, Inc. et al.*, 2:23-cv-00067 (EDTX 2-20-2023) (voluntarily dismissed), and *Dynapass IP Holdings LLC v. Simmons First National Corporation et al.*, 2:23-cv-00068 (EDTX 2-20-2023) as civil litigations involving the '658 patent. Pet. 76–77; Paper 5, 1–3.

The parties also identify *Unified Patents, LLC v. Dynapass IP Holdings LLC*, IPR2023-00425 (PTAB) as a proceeding involving the '658 patent. Pet. 78; Paper 5, 3. Petitioner also identifies *Bank of America, N.A. et al. v. Dynapass IP Holdings*, IPR2023-00367 (PTAB) (denied) as a proceeding involving the '658 patent. Pet. 78.

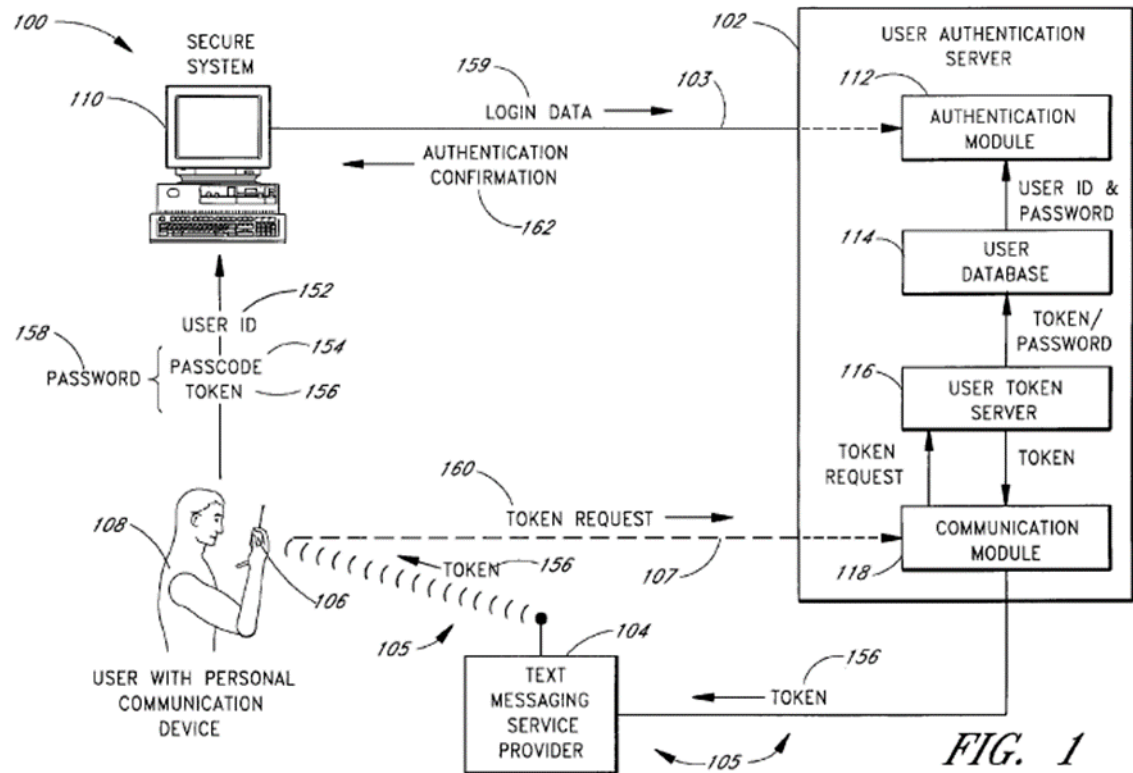
D. The '658 patent

The '658 patent is titled “Use of Personal Communication Devices For User Authentication.” Ex. 1001, code (54). The invention “relates generally to the authentication of users of secure systems and, more particularly, the invention relates to a system through which user tokens

required for user authentication are supplied through personal communication devices such as mobile telephones and pagers.” *Id.* at 1:7–11.

One embodiment of the invention provides a password setting system that includes a user token server and a communication module wherein a user token server generates a random token in response to a request for a new password from a user. Ex. 1001, 1:63–2:2. “The server creates a new password by concatenating a secret passcode that is known to the user with the token” and “sets the password associated with the user’s user ID to be the new password.” *Id.* at 2:2–6. A “communication module transmits the token to a personal communication device, such as a mobile phone or a pager carried by the user.” *Id.* at 2:6–8. Then, the user concatenates the secret passcode with the received token in order to form a valid password, which the user submits to gain access to the secure system. *Id.* at 2:8–11.

Figure, reproduced below, “illustrates an overview, including system components, of a user authentication system 100 according to a preferred embodiment of the present invention.” Ex. 1001, 4:2–4.



User authentication system 100 includes authentication Server 102, text messaging Service provider 104, personal communication device 106 carried by user 108, and secure system 110 to which the authentication system 100 regulates access. *Id.* at 4:9–13. “[P]ersonal communication device 106 is preferably a pager or a mobile phone having SMS (short message Service) receive capability.” *Id.* at 4:13–15. Secure system 110 can be “any system, device, account, or area to which it is desired to limit access to authenticated users.” *Id.* at 4:18–20.

User authentication server 102 is configured to require that user 108 supply authentication information through secure system 110 in order to gain access to secure system 110. Ex. 1001, 4:32–35. Authentication information provided by the user includes user ID 152, passcode 154 and user token 156. *Id.* at 4:36–37. User ID 152 may be publicly known and used to identify the user and passcode 154 is secret and only known to the

user 108, whereas token 156 is provided only to user 108 by user authentication server 102 through personal communication device 106. *Id.* at 4:39–44. To gain access to secure system 100, user 108 combines token 156 with passcode 154 to form password 158. *Id.* at 4:52–53. Thus, user 108 needs to have personal communication device 106 in order to gain access to secure system 110. *Id.* at 4:46–48. Further, token 156 has a limited lifespan, such as 1 minute or 1 day. *Id.* at 4:44–45.

E. Illustrative Claim

Independent challenged claim 1 is reproduced below:

1. A method of authenticating a user on a first secure computer network, the user having a user account on said first secure computer network, the method comprising:

associating the user with a personal communication device possessed by the user, said personal communication device in communication over a second network, wherein said second network is a cell phone network different from the first secure computer network;

receiving a request from the user for a token via the personal communication device, over the second network;

generating a new password for said first secure computer network based at least upon the token and a passcode, wherein the token is not known to the user and wherein the passcode is known to the user;

setting a password associated with the user to be the new password;

activating access the user account on the first secure computer network;

transmitting the token to the personal communication device;

receiving the password from the user via the first secure computer network; and

deactivating access to the user account on the first secure computer network within a predetermined amount of time after said activating, such that said user account is not accessible through any password, via said first secure computer network.

Ex. 1001, 11:43–12:13.

F. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
5	103	Veneklase, ¹ Jonsson ²
1, 3–6	103	Kew, ³ Sormunen ⁴

Pet. 2.

II. ANALYSIS

A. Institution of Inter Partes Review

Petitioner asserts that the 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.” Mot. 1. Based on our independent review of the Petition, the petition filed in the Unified Patents IPR, and the evidence relied on in both petitions, we agree with Petitioner. *Compare* Pet. 1–76, with Unified Patents IPR, Paper 1 at 1–79.

We instituted *inter partes* review of claims 1 and 3–6 of the ’658 patent based on the petition filed in the Unified Patents IPR on July 18, 2023.

¹ EP 844,551 A2, published May 27, 1998 (Ex. 1005).

² WO 96/00485, published January 4, 1996 (Ex. 1006).

³ WO 95/19593, published July 20, 1995 (Ex. 1007).

⁴ WO 97/31306, published August 28, 1997 (Ex. 1008).

For the same reasons discussed in our Decision on Institution in the Unified Patents IPR, we find Petitioner has demonstrated a reasonable likelihood of showing at least one claim of the '658 patent is unpatentable. We, therefore, find that the instant Petition warrants institution of *inter partes* review of all challenged claims on all grounds raised.

B. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which states:

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.

Procedurally, a 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) (2019). Petitioner filed its Motion for Joinder on August 16, 2023, one month after our July 18, 2023 decision granting review of the challenged claims in the Unified Patents IPR that Petitioner seeks to join. Mot. 6; Unified Patents IPR, Paper 9.

To ensure the just, speedy, and inexpensive resolution of every proceeding, a motion for joinder should (1) set forth 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).

Petitioner argues joinder is appropriate in this proceeding because the 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.” Mot. 1. According to Petitioner, “[t]he 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.” *Id.* at 6–7 (citing Ex. 1017).

Petitioner asserts that if joinder is granted it “agrees to an ‘understudy role’ and will not assume an active role unless Unified Patents ceases to actively prosecute the Unified Patents IPR.” Mot. 1. Petitioner asserts further that “[j]oinder 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.” *Id.* at 1–2. In addition, Petitioner asserts that “[j]oinder 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.” *Id.* at 10.

Upon considering Petitioner’s arguments and the evidence presented, we are persuaded that it is appropriate under these circumstances to join Petitioner to the Unified Patents IPR. Petitioner challenges the same claims that are challenged in the Unified Patents IPR on the same grounds using the same prior art and evidence. *See* Pet. 1–76. Petitioner asserts it will take an “understudy” role in the Unified Patents IPR and only assume a primary role should Unified Patents cease participation in the Unified Patents IPR. *See* Mot. 1. Thus, joinder to the Unified Patents 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 to the Unified Patents 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 of claims 1 and 3–6 of the '658 patent is hereby instituted on the grounds presented in the Petition; and

FURTHER ORDERED that the Motion for Joinder with IPR2023-00425 is *granted*, and Petitioner is joined as a petitioner to IPR2023-00425;

FURTHER ORDERED that Petitioner's role in IPR2023-00425 shall be limited as stated by Petitioner in the Motion for Joinder unless and until Unified Patents ceases to participate in IPR2023-00425;

FURTHER ORDERED that the case caption in IPR2023-00425 shall be changed to reflect joinder of JPMorgan Chase Bank, N.A. as a petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-00425.

IPR2023-01331
Patent 6,993,658 B2

FOR PETITIONER:

How-Ying Liou
Vishal Khatri
Matthew Johnson
Evan Tassis
JONES DAY
aliou@jonesday.com
vkhatri@jonesday.com
mwjohnson@jonesday.com
etassis@jonesday.com

FOR PATENT OWNER:

John Wittenzellner
Todd E. Landis
Michael J. Fagan, Jr.
Mark McCarthy
WILLIAMS SIMONS & LANDIS PLLC
johnw@wsltrial.com
tlandis@wsltrial.com
mfagan@wsltrial.com
mmccarthy@wsltrial.com
IPRDYNAPASSWSL@wsltrial.com

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IPR2023-00425¹
Patent 6,993,658 B1

¹ JPMorgan Chase Bank N.A. was joined as a party to this proceeding via Motion for Joinder in IPR2023-01331.