Filed on behalf of: Visa Inc.
By: Matthew A. Argenti (margenti@wsgr.com)
Michael T. Rosato (mrosato@wsgr.com)
Patrick M. Medley (pmedley@wsgr.com)
Joseph Baillargeon (jbaillargeon@wsgr.com)
WILSON SONSINI GOODRICH & ROSATI

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VISA INC.,
Petitioner,

v.

CORTEX MCP, INC.,
Patent Owner.

Case No. IPR2024-00487
Patent No. 9,251,531

PETITIONER'S EXPLANATION OF MULTIPLE PETITIONS CHALLENGING U.S. PATENT NO. 9,251,531

I. INTRODUCTION

Pursuant to the November 2019 Consolidated Trial Practice Guide ("Guide"), Petitioner Visa Inc. ("Visa") provides this explanation of multiple petitions challenging U.S. Patent No. 9,251,531 (the '531 patent). Visa presents two petitions, each of which applies the same core prior art references (i.e., grounds based on (1) Oborne; (2) Oborne and Purves; (3) Oborne and Neafsey; (4) Oborne, Purves, and Neafsey; (5) Stafford and Purves; and (6) Stafford, Purves, and Neafsey). The two petitions differ in respect to the particular claims challenged in each. The multiple petitions are justified by the number of claims in the '531 patent, the depth of analysis presented in the petitions, and the petition word limit.

A. Explanation of Material Differences and Reasons Why More Than One Petition Should Be Instituted

Each of the petitions is materially distinguishable from the other by virtue of challenging a distinct claim set. The petition in IPR2024-00486 challenges claims 1-20. The petition in IPR2024-00487 challenges claims 21-33. There are no overlapping claims challenged. Accordingly, the petitions present materially different challenges, each to a unique, nonoverlapping subset of '531 patent claims.

Patent Owner has not filed infringement contentions in the related district court limitation, nor has it limited its asserted claims to any subset of the '531 patent's claims. Moreover, the claims of the '531 patent are lengthy. For instance,

independent claim 1 has over 250 words, and the total number of words in all claims is 1,691.

Accordingly, two petitions are necessary in order to address each of the challenged claims in sufficient detail. Guide, 59 ("[T]here may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation."); *see Novartis Gene Therapies, Inc. v. Genzyme Corporation*, IPR2023-01045, Paper 10 at 3-5 (granting institution of multiple petitions due to claim number for patent with 34 claims, noting "If we 'discretionarily dismissed one petition or the other, some claims of the [] patent would be left uncovered by any ground alleged by Petitioner.'" (quoting *Marvell Semiconductor, Inc. v. Uniloc 2017 LLC*, IPR2019-01349, Paper 9 at 14)); *Apple, Inc. v. Seven Networks, LLC*, IPR2020-00157, Paper 10 at 23-28 (granting institution of multiple petitions for patent with 20 claims despite partial overlap in challenged claims). The second petition has been filed due to the word count limit for petitions, the number of claims, and the need to address each challenged claim in sufficient detail. Neither petition is submitted to present additional grounds of challenge or invalidity theories for the claims addressed in first petition.

Beyond the Guide, additional factors support institution of Visa's multiple petitions. Because the petitions are filed simultaneously, they will be able to track

the same schedule post-institution, maximizing the efficiency of depositions, briefing, and oral argument. In addition, Visa uses the same expert witness to support both petitions, meaning a single deposition should be sufficient. Both petitions also apply the same claim constructions.

B. Ordering of Petitions

For the reasons discussed above, the Board should grant institution for both petitions. Under the circumstances a ranking of petitions is not appropriate given that they challenge unique claim sets with no overlap. However, in view of the guidance in the consolidated trial practice guide (Guide, 60), Visa requests that the Board consider the petitions in the following order:

Order	IPR Case No.	Challenged Claims
1	IPR2024-00486	1-20
2	IPR2024-00487	21-33

II. CONCLUSION

Visa requests that the Board grant institution for both petitions.

Respectfully submitted,

Dated: January 25, 2024

/Matthew A. Argenti/
Matthew A. Argenti, Lead Counsel
Reg. No. 61,836

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), this is to certify that I caused to be served a true and correct copy of the foregoing Petitioner's Explanation of Multiple Petitions Challenging U.S. Patent No. 9,251,531 by overnight courier (Federal Express or UPS), on this 25th day of January, 2024, on the Patent Owner at the correspondence address of the Patent Owner as follows:

K&L Gates LLP-Pittsburgh
210 Sixth Avenue
Pittsburgh, PA 15222-2613

Dated: January 25, 2024

/Matthew A. Argenti/
Matthew A. Argenti, Lead Counsel
Reg. No. 61,836