

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JPMorgan Chase Bank, N.A.
Petitioner

v.

Identitii Limited
Patent Owner

Case No. IPR2024-00590, IPR2024-00593
U.S. Patent 10,984,413

**PATENT OWNER'S RESPONSE TO PETITIONER'S
NOTICE RANKING PETITIONS**

Table of Contents

I.	Introduction.....	1
II.	The Board Should Exercise Its Discretion to Deny the -00593 Petition.....	2
III.	Conclusion	5

I. INTRODUCTION

Petitioner's parallel petitions are inappropriate here. As such, the Board should exercise its discretion to deny Petitioner's second petition. In its Notice Ranking Petitions, Petitioner asks the Board to first consider the merits of its petition in IPR2024-00590 challenging claims 1-20. Paper 3, at 2. Petitioner then seeks a second, substantive merits review of the same claims in a second petition in IPR2024-00593. *Id.* Petitioner's justification for the second petition is that it adds an additional issue based on the priority date of the challenged patent. However, as confirmed by Patent Owner's stipulation that the Board need not determine the priority date, there is no priority date issue as to Petitioner's first petition.

As the Board has recognized, parallel petitions may "place a substantial and unnecessary burden on the Board and the patent owner." November 2019 Consolidated Trial Practice Guide ("TPG"), 59. That is the case here. The Board will be required to devote resources to determine whether the -00590 petition presents a reasonable expectation of success on the merits. There is no reason for the Board to then perform a second analysis to determine whether the -00593 petition presents a reasonable expectation of success on the merits just because the second petition adds an additional issue based on priority. Under the TPG, there is no reason why Petitioner's first petition is insufficient. As such—and regardless of the Board's

decision regarding the -00590 petition—the Board should exercise its discretion under § 314(a) to deny Petitioner’s second petition in IPR2024-00593.

II. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE -00593 PETITION

The TPG provides the Board’s policy and a framework for analyzing parallel petitions. The TPG explains that “one petition should be sufficient to challenge the claims of a patent in most situations.” TPG, 59. Exceptions to this rule are “rare.” *Id.* Petitioners filing concurrent petitions must justify why multiple petitions are “necessary” and then “rank[] ...the petitions in the order in which it wishes the Board to consider the merits.” *Id.*, 59-60.

That a petitioner is generally allowed only one petition prevents “substantial and unnecessary burden on the Board and the patent owner” in addition to supporting “fairness, timing, and efficiency.” TPG, 59. Indeed, Congress intended IPRs to provide “quick and cost effective alternatives to litigation” and to “establish a more efficient and streamlined patent system that will improve patent quality[.]” *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1317 (Fed. Cir. 2018) (quoting H. REP. NO. 112-98, at 40, 48 (2011)). Furthermore, “Congress recognized the importance of protecting patent owners from patent challengers who could use the new administrative review procedures as ‘tools for harassment’” via “repeated

litigation and administrative attacks on the validity of a patent.”” *Id.* (quoting H. REP. NO. 112-98, at 40).

Importantly, as recognized by the TPG, parallel petitions are burdensome to the Board. TPG, 59. The Board must expend resources to analyze the substance of petitions for *inter partes* review to determine whether they satisfy § 314(a). The § 314(a) analysis is a burdensome inquiry, regardless of whether inter partes review is subsequently instituted. Recognizing this practical reality, the Board in both the precedential *General Plastic* and *Valve* decisions recognized that it is an inefficient use of the Board’s limited resources to perform multiple § 314(a) analyses for the same patent. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 5 (PTAB Apr. 2, 2019) (noting that multiple Petitions tend to waste Board resource); *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).

Here, Petitioner asks the Board to perform two distinct and burdensome § 314(a) analyses without sufficient justification. Petitioner asked the Board to first consider the merits of the -00590 Petition challenging claims 1-20. Paper 3, at 2. Petitioner then asks the Board to expend resources to perform a second analysis of the merits of the -00593 Petition, again challenging claims 1-20. *Id.* The purported justification for the separate review is that the **second** petition presents a new issue regarding the priority date of the challenged patent. *Id.* at 3.

However, Petitioner admits that the priority date issue is irrelevant to the first, -00590, petition. See Paper 3, at 2. Patent Owner further provides the following stipulation to remove any doubt: “If the Board declines to institute the -00593 IPR petition under § 314(a), Patent Owner will not challenge the prior art status of the references in the -00590 petition, i.e., Smith, Seger, Kurani-274, and Yago in the -00590 IPR.” As there is no issue of priority in Petitioner’s first petition, there is no justification for Petitioner’s second petition.

Indeed, the only hypothetical Petitioner presents for needing both petitions is that the Board could discretionarily deny the first petition. Paper 3, at 2. However, Patent Owner presents no argument that the Board should exercise its discretion to deny the first petition. Petitioner further states that the Board could “change its mind on its initial priority date determination.” Paper 3, at 3. This argument is unavailing because in view of Patent Owner’s stipulation, the Board need not make any priority date determination with respect to the first petition—either at the institution stage or at the final written decision, if any.

Finally, Petitioner argues that the Board should consider the merits of the second petition because it relies on “materially different prior art and prior-art combinations.” Paper 3, at 3-4. But this is a reason to **decline** to perform a second § 314(a) analysis to consider the merits of the second petition. By Petitioner’s own admissions the arguments and art are “materially different,” thus imposing a

substantial burden on both Patent Owner and the Board. *See id.* While Petitioner identifies deficiencies in each of its primary references, Petitioner does not explain how the combinations at issue are meaningfully different. Instead, Petitioner contends that both combinations render obvious the same concepts of the same claims under the same constructions. That Petitioner believes that different art and combinations render the same challenged claims obvious is not a justification for multiple petitions. Indeed, under the TGP, it is a reason to decline to consider the merits of the second petition. TGP, 59-60.

III. CONCLUSION

Petitioner's supposed justification for its second petition is that the Board should determine the priority date of the challenged patent. In view of Patent Owner's stipulation, there is no priority date issue with respect to Petitioner's first petition. A second petition to determine priority is unjustified. The Board should exercise its discretion to deny institution of the second petition in IPR2024-00593.

Dated: May 28, 2024

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CERTIFICATE OF SERVICE

Petitioner has consented to e-mail service in this proceeding. Pursuant to 37 C.F.R. §42.6, the undersigned certifies that on March 13, 2024, a copy of the foregoing document was served by email upon the following counsel at the below email addresses:

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