

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JPMorgan Chase Bank, N.A.
Petitioner

v.

Idetitii Limited
Patent Owner

Case Nos. IPR2024-00590, IPR2024-00593

U.S. Patent No. 10,984,413

PETITIONER'S NOTICE RANKING PETITIONS

I. INTRODUCTION

Concurrently herewith, Petitioner JPMorgan Chase Bank, N.A. (“Petitioner”) files two petitions for *inter partes review* (“IPR”) challenging all claims of U.S. Patent No. 10,984,413 (“’413 Patent”). The Board’s November 2019 Consolidated Office Patent Trial Practice Guide (“2019 Trial Practice Guide”) recognizes the need for two petitions where “there is a dispute about priority date requiring arguments under multiple prior art references.” (2019 Trial Practice Guide at 59). Here, Petitioner’s second petition is submitted for this very purpose, relying on prior-art grounds requiring a challenge to the priority date of the ’413 Patent.

Pursuant to the 2019 Trial Practice Guide, Petitioner submits this Notice with each petition to: (1) identify a ranking of the petitions in the order in which Petitioner wishes the Board to consider the merits, and (2) provides a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute both petitions.

II. RANKING OF PETITIONS

While Petitioner respectfully submits that both petitions are meritorious and should be instituted, Petitioner provides the following ranking pursuant to the 2019 Trial Practice Guide:

Rank	Petition	Challenged Claims and Different Prior Art Grounds
1	IPR2024-00590 ("Petition #1")	Claims 1-20 • Smith and Seger (claims 1-2, 5-20) • Smith and Seger and Yago (claim 3) • Smith and Seger and Kurani-274 (claim 4)
2	IPR2024-00593 ("Petition #2 based on priority challenge")	Claims 1-20 • Kennedy and Kurani-816 (claims 1-2, 4-20) • Kennedy and Kurani-816 and Yago (claim 3)

III. SUCCINCT EXPLANATION OF DIFFERENCES BETWEEN PETITIONS

A. Both Petitions Should be Instituted Because The Second Petition Challenges Priority Date

Pursuant to the 2019 Trial Practice Guide, Petitioner requests institution of both petitions because the second petition raises different prior-art grounds based on a dispute regarding the priority date of the '413 Patent. (2019 Trial Practice Guide at 59) (recognizing need for two petitions where "there is a dispute about priority date requiring arguments under multiple prior art references").

Petition #1 presents obviousness grounds based on prior-art references that pre-date the earliest possible priority date of August 14, 2015 for the '413 Patent, which is the filing date of the earliest provisional application in a series of three Australian provisional applications to which the '413 Patent claims priority.

Petition #2 is materially different from Petition #1 because both primary-applied prior art references in Petition #2—Kennedy and Kurani-816—constitute

prior art only assuming the '413 Patent is entitled to a priority date no earlier than January 27, 2016 (the filing date of the second provisional application in the series). Petition #2 establishes why the '413 Patent is not entitled to claim priority to the earlier claimed priority date of August 14, 2015. Institution of Petition #2 is warranted because it provides the opportunity for the Board to address priority date and apply materially different prior art based on the determination of priority date.

The Board's determination regarding priority date at the time of institution is preliminary and may change post-institution. It is possible that at the time of final written decision, the Board could change its mind on its initial priority date determination. If the Board had discretionarily denied institution of Petition #1, Petitioner's otherwise valid prior art grounds in Petition #1 would not have been considered. The result would be prejudicial to Petitioner and against public interest. On the other hand, Petition #2 serves the public interest in determining whether the '413 Patent is entitled to a priority date as early as it claims, and whether additional prior art is available against the '413 Patent. Institution of both petitions is thus necessary to ensure Petitioner's prior-art grounds are properly considered through final written decision and avoid prejudice to Petitioner.

**B. Both Petitions Should be Instituted Because They Present
Materially Different Grounds of Unpatentability**

The two petitions rely on materially different prior art and prior-art

combinations to show that the Challenged Claims would have been obvious. For example, Petition #1 relies on Smith as a primary reference, which is distinguishable from Petition #2's primary reference Kennedy. Kennedy discloses the use of blockchain, whereas Smith discloses all elements of the independent claims *except* blockchain (this element is rendered obvious by Smith in combination with Seger as established in Petition #1). Additionally, Kurani-274 (cited in Petition #1) and Kurani-816 (cited in Petition #2) are unrelated patents and are relied upon for different teachings (*e.g.*, the “digital title” of Kurani-816 and the “code/token” transmission methods of Kurani-274).

The secondary references and arguments for obviousness advanced in Petition #1 are also substantially different from those advanced in Petition #2. The Smith/Seger combination of Petition #1 demonstrates the obviousness of combining a financial transaction verification system (Smith) with a blockchain ledger (Seger). The Kennedy/Kurani-816 combination of Petition #2 demonstrates the obviousness of combining a blockchain-enabled transaction processing system (Kennedy) with the Kurani-816's teachings of a digital title/token to improve identification and tracking of transaction information. The two petitions provide materially different arguments to challenge the '413 Patent claims, using different prior-art references and combinations. The two petitions are not redundant, duplicative, or substantially similar.

Finally, presenting all the foregoing challenges in a single petition would not have been feasible in view of the 14,000-word limit, particularly given that Patent Owner has not specified which particular claims out of a total of 20 claims in the '413 Patent for which Patent Owner intends to assert in the parallel district court litigation. Thus, institution of Petition #1 and Petition #2 are both warranted.

IV. CONCLUSION

In view of the material differences shown above, the Board should exercise its discretion to institute trial on both Petition #1 and Petition #2.

Date: February 20, 2024

Respectfully submitted,

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioners' Notice Ranking Petitions for U.S. Patent 10,984,413 was served on February 20, 2024 via Express Mail delivery to the attorneys of record for the patent at the following address:

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A courtesy copy was also served on litigation counsel for Identitii Limited at the following email:

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