

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 10,791,808

Title: COMPACT WALLET

Inter Partes Review No. IPR2024-00692, Filed March 15, 2024

Inter Partes Review No. IPR2024-01264, Filed August 6, 2024

PETITIONER’S NOTICE OF RANKING PETITIONS FOR *INTER PARTES*
REVIEW OF U.S. PATENT NO 10,791,808

On March 15, 2024, 2985 LLC d/b/a Mountain Voyage Co. (“Mountain Voyage” or “Petitioner”) filed IPR2024-00692 (the “’692 Petition”) challenging claims 1-9 and 11-21 of U.S. Patent No. 10,791,808 (the “’808 Patent”). On August 6, 2024, Petitioner filed IPR2024-01264 (the “’1264 Petition”) with a motion to join IPR2024-0340 (filed by a third party, Shenzhen Pincan Technology Co. Ltd) (the “*Shenzen* IPR”) challenging claims 1-24 of the ’808 Patent. Petitioner’s ’1264 Petition is substantially identical to the *Shenzen* Petition. This separate Notice of Ranking is submitted for the benefit of the Board upon receipt of an Official Filing Date in the ’1264 Petition, and consideration is respectfully requested.

This Notice is made in accordance with the Trial Practice Guide and provides a ranking of petitions, a succinct explanation of the differences between the petitions, and a discussion of why the issues addressed are material, such that the Board should exercise its discretion to institute each of the petitions.

I. Ranking of Petitions

Petitioner submits that each of the petitions merit institution. Nevertheless, should the Board elect to exercise its discretion to deny one of the petitions, Petitioner requests that the Board grant institution to the '692 Petition in accordance with the ranking:

Rank	Petition	Applied References (Base/Secondary)	Prior Art Type
1	IPR2024-00692 (Claims 1-9 and 11-21)	(1) Kane/Beckley (2) Kane/Pelz (3) Kane/Matthews	All 103 grounds
2	IPR2024-01264 (Claims 1-24)	(1A) Kane/Beckley (1B) Kane/Beckley+Minn (1C) Kane/Beckley+Preston-Hall (1D) Kane/Murphy (1E) Kane/Murphy+Minn (1F) Kane/Murphy+Preston-Hall (1G) Kane/Roman (1H) Kane/Roman+Minn (1I) Kane/Roman+Preston-Hall (2A) Minn/Podwika+Coates+ Beckley (2B) Minn/Podwika/Coates+ Beckley+Preston-Hall 2(C) Minn/Podwika+Coates+ Murphy 2(D) Minn/Podwika+Coates+ Murphy+Preston-Hall 3(A) Kane/Beckley+Singer	All 103 grounds

II. Material Differences Between the Petitions

Each of the Petitions present significant material differences which are not redundant and which demonstrate different substantive bases for rendering obvious each of the challenged claims of the '808 Patent.

A first material difference between the petitions is the relied upon prior art. As stated in the '692 Petition: “Nor are Pelz and Matthews cumulative prior art references in view of the *Shenzhen* IPR. Pelz and Matthews are not presented in the *Shenzen* IPR, and these prior art references disclose different structures and/or functions than the references presented in that IPR. While the prior art of Ground 1 has recently been presented to the Board in the *Shenzhen* IPR... said IPR was filed by a different, entirely unrelated petitioner.” IPR2024-00692, Paper 1 at 92.

A second material difference between the petitions is the active parties. Petitioner would have an active role in the '692 Petition, while adopting an understudy role in the '1264 Petition (should the motion for joinder in the '1264 Petition be granted). *See* IPR2024-01264, Paper 2 at 9-10.

A third material difference between the petitions is that institution of the '692 Petition would streamline issues in the parallel district court litigation; whereas institution of the '1264 Petition would not. As stated in the '692 Petition, “if trial is instituted, Petitioner stipulates that it will not argue the invalidity of the asserted claims in the case before the District Court on the same grounds as in the Petition or

on any grounds that could have been reasonably raised in the Petition.” IPR2024-00692, Paper 1 at 90. Petition has made no such stipulation in the ’1264 Petition.

For these reasons, and for the reasons presented in the Petitions themselves in each of the proceedings, Petitioner respectfully requests that the Board institute trial of each of the petitions and that it not exercise its discretion to deny any petition.

Date: September 6, 2024

Respectfully submitted,

/s/ Jacob Busch
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Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned “Petitioner’s
Notice of Ranking Petitions for *Inter Partes* Review of U.S. Patent No.
10,791,808” was served on the following via email:

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