

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN, L.L.C.,
Petitioner

v.

JABAA, L.L.C.,
Patent Owner

IPR2024-00915
IPR2024-00916
U.S. Patent No. 7,480,637

**PETITIONER'S RANKING OF PETITIONS AND
EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS**

TABLE OF CONTENTS

I.	Ranking of Petitions	1
II.	Material Differences and Reasons for Institution of Multiple Petitions	1
III.	Conclusion	5

Petitioner’s Ranking of Petitions and
Explanation of Material Differences Between Petitions
IPR2024-00915 & IPR2024-00916 / U.S. Patent 7,480,637

Petitioner filed two petitions challenging different, non-overlapping claims of U.S. Patent No. 7,480,637 (“the ’637 patent”). Petitioner provides the information below “to aid the Board in determining” why “more than one petition is necessary.” Consolidated Trial Practice Guide (“CTPG”) (November 2019) at 59-60. The Board should institute both petitions.

I. Ranking of Petitions

Each petition addresses different claims and both are meritorious and justified, as explained below. In accordance with the CTPG, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	Petition 1	1-6 and 21-24	<u>Ground 1</u> : Claims 1-6 and 21-42 obvious over Mathiassen in view of Ryan <u>Ground 2</u> : Claims 1-6 and 21-42 obvious over Mathiassen in view of Ryan and Lim
2	Petition 2	7-20	<u>Ground 1</u> : Claims 7-9 obvious over Rescorla in view of Mathiassen <u>Ground 2</u> : Claims 10-14 obvious over Rescorla in view of Mathiassen and Ryan <u>Ground 3</u> : Claims 15-20 obvious over Mathiassen in view of Rescorla and Ryan

II. Material Differences and Reasons for Institution of Multiple Petitions

The Board has recognized that “there may be circumstances in which more than one petition may be necessary.” CTPG at 59-60. Each petition presents

materially different challenges to different, non-overlapping claims. Accordingly, review of the challenged claims of the '637 patent warrants two petitions.

The '637 patent includes 5 independent claims: claims 1, 7, 15, 20, and 21. *See* Ex.1001, 8:43-12:25. Petition 1 challenges independent claims 1 and 21 and their dependent claims (claims 2-6 and 22-24) (collectively, "Petition 1 claims"). Petition 2 challenges independent claims 7, 15, and 20 and their dependent claims (claims 8-14 and 16-19) (collectively, "Petition 2 claims"). The Petition 1 claims and Petition 2 claims are directed to different concepts that necessitate two petitions having different grounds and prior art combinations.

The Petition 1 claims are directed to specific components of a biometric customer authentication apparatus for authenticating a user of the biometric customer authentication apparatus to conduct transactions (e.g., an enclosure including a fingerprint sensor as well as biometric fingerprint authentication software for authenticating a customer, and transaction authentication software for authenticating transactions).

On the other hand, the Petition 2 claims are directed to a type of cryptographic communications (e.g., "cryptographic encapsulation") between a generic customer authentication apparatus and a website for authenticating the customer. Unlike the Petition 1 claims, the Petition 2 claims are not directed to the specific hardware and associated software components (e.g., fingerprint sensor and biometric fingerprint

authentication software) for biometrically authenticating the customer. Instead, the Petition 2 claims are directed to a particular method of encrypting communications between a generic customer authentication apparatus and a third-party website.

Consequently, Petition 1 and Petition 2 rely on different grounds and different prior art combinations to show that the Petition 1 and Petition 2 claims are unpatentable. Petition 1 challenges the Petition 1 claims based on Mathiassen in view of Ryan (Ground 1) and Mathiassen in view of Ryan and Lim (Ground 2). Petition 2 relies on an entirely different primary reference, Rescorla, to teach the encrypted communication technique (e.g., “cryptographic encapsulation”) recited in the Petition 2 claims (Grounds 1 and 2 of Petition 2). Mathiassen and Ryan, which are asserted in Petition 1, are also asserted in Petition 2 to teach the generic features of the “customer authentication apparatus” recited in the Petition 2 claims. Accordingly, the Petition 1 and Petition 2 challenge different claims reciting unique features and are specifically tailored to address those unique features across the two petitions.

In this case, there was no practical way to sufficiently present the obviousness grounds for each claim in a single petition. As a result, institution of both Petition 1 and Petition 2 is warranted in this case. The Board has instituted multiple petitions for the same patent when the petitions challenge materially different claims. *See, e.g., Peloton Interactive, Inc. v. Ifit, Inc.*, IPR2022-00030, Paper No. 12 at 33-34

(PTAB Apr. 22, 2022) (finding “Petitioner’s filing of three petitions to challenge different claims of the ’062 patent...promotes efficiency” where the patent “include[s] five independent claims” that “differ[]...in various, potentially significant ways.”); *Novartis Gene Therapies v. Genzyme Corporation*, IPR2023-010145, Paper No. 10 at 3 (PTAB Jan. 17, 2024) (instituting multiple petitions for the same patent where the patent included seven independent claims with differing features and scope).

Additionally, Petitioner has filed Petition 1 and Petition 2 concurrently and has not sought “a timing advantage that might otherwise occur were the petitions filed serially,” which further supports institution. *Samsung Electronics Col., Ltd. v. Ryan Hardin*, IPR2022-01335, Paper 13, 22-23 (PTAB Feb. 8, 2023) (Institution Decision).

Furthermore, due to the significant differences in claim scope of the Petition 1 claims and the Petition 2 claims, there is little to no repetition of analysis between Petition 1 and Petition 2. Thus, institution of both petitions would not raise concerns of duplicative time and resources. Petitioner would not oppose consolidation of the two proceedings upon institution.

III. Conclusion

For the above reasons, the Board should institute both petitions.

Respectfully submitted,

Dated: May 24, 2024

/Jonathan R. Bowser/

Jonathan R. Bowser
Counsel for Petitioner
Reg. No. 54,574

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. §§ 42.105 and 42.6, that service was made on the Patent Owner as detailed below.

Date of service May 24, 2024

Manner of service Federal Express

Documents served **Petitioner's Ranking of Petitions and Explanation of
Material Differences Between Petitions**

Persons served Douglas Kozlay (Agent/Attorney of Record)
1101 E33rd Street, Suite E303
Baltimore, MD 21218

Jabaa, LLC (Courtesy Copy – Assignee)
12 Dexter Road
Garland, ME 04939

Cortney S. Alexander (Courtesy Copy – Litigation counsel)
Kent & Risley LLC
5755 North Point Parkway Suite 57
Alpharetta, GA 30022

/Jonathan R. Bowser/

Jonathan R. Bowser
Counsel for Petitioner
Reg. No. 54,574