

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

2985 LLC d/b/a MOUNTAIN VOYAGE COMPANY, LLC
Petitioner

v.

THE RIDGE WALLET LLC
Patent Owner

Case No. IPR2024-01264
Patent No. 10,791,808

**PATENT OWNER'S RESPONSE TO PETITIONER'S
MOTION FOR JOINDER UNDER
35 U.S.C. § 315 (c), 37 C.F.R. §§ 42.22, and 42.122(b)**

CASE NO. IPR2024-01264
RESPONSE TO MOTION FOR JOINDER

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	Defendant 2985 LLC's Motion for Stay in View of Inter Partes Review Petitions, filed August 9, 2024 in Case No. 23-cv-00407-CNS-SBP in the District of Colorado (without attachments).

Patent Owner The Ridge Wallet LLC (“Patent Owner”) hereby submits the following Response to Petitioner’s Motion for Joinder Under 35 U.S.C. § 315 (c), 37 C.F.R. §§ 42.22, and 42.122(b) (Paper 2, the “Motion”).

Patent Owner does not oppose the Motion so long as the Board denies Petitioner 2985, LLC d/b/a Mountain Voyage Company LLC’s (“Petitioner”) Petition in IPR2024-00692 (the “-00692 IPR”) under 35 U.S.C. § 314. This properly reflects Petitioner’s ordering of what have become serial petitions challenging U.S. Patent No. 10,791,808 (“‘808 Patent”).

I. INTRODUCTION

The Motion (and this proceeding in general) is a quintessential “have your cake and eat it” filing by Petitioner. Petitioner waited until the last day it was statutorily authorized to file an IPR petition and on that day filed IPR2024-00692, challenging the patentability of the ‘808 Patent. (Motion at 1 (March 15, 2023 service date); -00692 IPR, Paper 1 (March 15, 2024)). Petitioner filed the -00692 IPR with full knowledge of, and having reviewed the content of, IPR2024-00340 (the “-00340 IPR”), the proceeding it now seeks to join. *See, e.g.*, IPR2024-00692, Paper 1 at 92. Importantly, the -00692 IPR did not incorporate the same arguments from the -00340 IPR, nor did it rely on the same expert or combination rationale.

Instead, Petitioner forged its own path in the -00692 IPR, forcing Patent Owner to respond to a second set of arguments (two thirds of which were new

grounds), all while happily arguing that the -00692 IPR “is the only IPR petition filed against the Challenged Claims by Petitioner and is not a serial petition under any of the factors in *General Plastic*.” IPR2024-00692, Paper 1 (Petition) at 91 (March 15, 2024).

Now, with a trial date approaching in a co-pending district court case, and with knowledge that the -00340 IPR was instituted (but without agreeing to be bound by any estoppel prior to the statutory attachment of that estoppel), Petitioner asks to be joined to the -00340 IPR while also continuing to pursue the -00692 IPR. Patent Owner respectfully submits that the appropriate outcome here is granting the joinder motion and denying the -00692 IPR as a serial petition under 35 U.S.C. § 314(a).¹

II. ARGUMENT

Patent Owner has no problem in concept with Petitioner joining the -00340 IPR as a “me too” or “understudy” petitioner. Patent Owner also agrees that “joinder will provide for a just, speedy, and inexpensive determination of related proceedings” (Motion at 2), but notes that it will only do so if the -00692 IPR is denied. If the Motion is granted and if the -00692 IPR is instituted, joinder will have the exact opposite effect: the Board will be FORCED to adjudicate the

¹ Patent Owner will be requesting leave to file a short paper in IPR2024-00692 to make that merits panel aware of Patent Owner’s tactic, and to explain the change in Petitioner’s position on the -00692 IPR as a “serial petition.”

arguments in both the -00340 and -00692 IPRs, and settlement with or other non-participation by the petitioner in the -00340 IPR will not permit the Board to conserve its resources by focusing only on the arguments Petitioner made in the -00692 IPR.

A. The Joinder Factors under *Kyocera*

Petitioner spends several pages arguing about the factors set forth under *Kyocera Corp. v. Softview LLC*. IPR2013-00004, Paper 15 at 4 (April 24, 2013). Motion at 3-10. Patent Owner does not dispute that the Motion is timely (Motion at 4), or that the factors weigh in favor of joinder to the extent that they do not complicate or potentially delay the -00340 IPR (Motion at 5-10). Patent Owner's only observation is that the -00340 IPR presents almost completely different Grounds than the -00692 IPR and relies on a different expert witness (and, where the combination is the same, different combination analyses) in support of those Grounds. Thus while Petitioner is trying to make it seem to the Board as if it is doing something noble, what it is in fact doing is ensuring it has a third bite at the invalidity apple: (1) this Petition (which mirrors the -00340 IPR), (2) the -00692 IPR, and (3) Petitioner's invalidity defenses in the District of Colorado. Joinder is appropriate, but three bites at the apple is not.

B. 35 U.S.C. § 314 Favors Granting the Motion, and Discretionarily Denying Institution of the -00692 IPR

Discretionary denial of the -00692 IPR is the appropriate outcome if the

Board grants the relief Petitioner requests in the Motion. Petitioner's fourth footnote reveals exactly "have your cake and eat it too" tactic it pursues here.

Motion at 14 FN 4. The Board's Consolidated Trial Practice Guide, to which the Motion cites, states as follows:

To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) 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 additional petitions if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a). The Board encourages the petitioner to use a table to aid in identifying the similarities and differences between petitions.

Consolidated Trial Practice Guide, November 2019, 59-60 (footnotes omitted).

Petitioner has not provided the ranking of petitions that it now seeks to pursue, in parallel, against the '808 Patent.

Instead, Petitioner filed the Motion, after waiting (without risk) for institution of the -00340 IPR, and in the face of arguments against institution of the -00692 IPR. It has also done so in parallel with briefing a Motion to Stay the pending Colorado litigation based on the institution of the -00340 Patent. Ex. 2001. From the facts, and in particular from the fact that the Motion was filed *after* the -00692 IPR (and the fact that Petitioner did not rank the petitions), the Board should infer that Petitioner is ranking the -00340 IPR (and its joinder of the same)

over the -00692 IPR in filing the Motion only AFTER institution of the -00340 IPR.

Patent Owner does not have an objection to the Motion so long as the -00692 IPR is also denied based on 35 U.S.C. § 314(a). That denial is appropriate given that Petitioner has failed to make any showing whatsoever that serial petitions are appropriate in this situation.

III. CONCLUSION

For the foregoing reasons, Patent Owner does not oppose the Motion so long as the Board correspondingly declines to institute IPR2024-00692. Patent Owner submits that Petitioner should not be given the windfall benefit of being involved in two petitions without providing Patent Owner an opportunity to argue, for the later-filed petition, that that petition is a serial petition and warrants denial under 35 U.S.C. § 314(a).

Respectfully submitted,

Date: September 6, 2024

/Benjamin E. Weed/
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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on September 6, 2024, a complete and entire copy of this PATENT OWNER'S RESPONSE TO PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315 (c), 37 C.F.R. §§ 42.22, and 42.122(b).

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