

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 IPR2024-00692
Case IPR2024-01264
Patent 10,791,808

**PATENT OWNER'S MEMORANDUM
REGARDING SERIAL PETITIONS**

This Memorandum addresses what have now become serial petitions by the same entity, 2985, LLC d/b/a Mountain Voyage Company (“Petitioner”).

I. STATEMENT OF RELEVANT FACTS

The first *Inter Partes* Review (“IPR”) petition filed against U.S. Patent No. 10,791,8080 (“the ‘808 Patent”) was filed on January 2, 2024 by Shenzhen Pinan Technology Co., Ltd. IPR2024-00340 (“-00340 IPR”).

Petitioner’s first ‘808 Patent petition was filed on its last statutorily available day: March 15, 2024, which is more than two months after the -00340 IPR. IPR2024-00692 (“-00692 IPR”). The -00692 IPR discusses the -00340 IPR, and argues that the -00692 IPR is not a serial petition (despite an overlap in Grounds) because it is the first ‘808 Patent petition filed by Petitioner. -00692 IPR, Paper No. 1 (Petition) at 91-92. In particular, the -00692 IPR states as follows:

While the prior art of Ground 1 has recently been presented to the Board in the Shenzhen IPR for which no institution decision has been rendered; ***said IPR was filed by a different, entirely unrelated petitioner.*** See *Frontier Therapeutics, LLC v. Medac Gesellschaft Für Klinische Spezialpräparate mbH*, No. IPR2016-00649, Paper 10 at 7 (P.T.A.B. Sept. 1, 2016).

Id. (emphasis added).

On August 6, 2024, Petitioner filed IPR2024-01264 (“-01264 IPR”) as a “me too” petition, moving to join it to the -00340 IPR. -01264 IPR, Paper No. 2 at 12. Petitioner intentionally did NOT provide a ranking as required by The Board’s

Consolidated Trial Practice Guide, November 2019, 59-60. *Id.* at 14 FN4.¹ The filing of the -01264 IPR rendered the above-emphasized portion of the -00692 IPR facially untrue.

On August 9, three days after filing the -01264 IPR, Petitioner moved to stay District of Colorado Case No. 23-cv-00407-CNS-SBP in which Patent Owner accuses Petitioner of infringing the ‘808 Patent. -01264 IPR, Ex. 2001. Briefing of that motion is complete (and is based on an instituted -00340 IPR, a pending -00692 IPR, and a pending Motion for Joinder in the -01264 IPR).

On September 6, 2024, Patent Owner filed a response to the Motion for Joinder in the -01264 IPR, arguing that joinder was proper because Patent Owner had implicitly ranked the -01264 IPR ahead of the -00692. -01264 IPR, Paper 9.

¹ On September 6, 2024, without authorization, Petitioner filed a Notice of Ranking Petitions. -01264 IPR at Paper 10; -00692 IPR at Paper 15. When Patent Owner asked for justification, Petitioner responded that “[t]he notice of ranking was filed in accordance with the recommendation set forth in the practice guide; which, to our understanding, does not mandate pre-authorization from the Board.” If the Board considers this unauthorized paper (it should not), it should be counted as Petitioner’s sole filing per the Board’s September 6, 2024 email authorization.

II. ARGUMENT

The *General Plastic* factors favor discretionarily denying the -00692 IPR under 35 U.S.C. § 314(b) and also denying joinder. *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017). By seeking to join the -00340 IPR, Petitioner has created a situation where the -00692 IPR is a second-filed petition filed by the same party. The calendar dates do not matter; Petitioner has the benefit of instituted -00340 IPR. And since Petitioner's recent, unauthorized ranking papers confirm that it prefers the -00692 IPR, its gamesmanship in moving to join the -00340 IPR (and making a motion to stay based on the same) is laid bare.

Factor 1 – Same Petitioner/Same Claims: The same Petitioner is involved in the -00340 IPR (by way of the requested joinder) and the -00692 IPR. The -00340 IPR challenges claims 1-9 and 11-24, while the -00692 IPR challenges a subset of these claims. As such, this factor favors denial of the -00692 IPR.

Factor 2 – Petitioner Knew or Should have Known of the Best -00692 IPR Art: When Petitioner filed the -00692 IPR (the second petition), it was aware of the art/arguments in the -00340 IPR (the first petition). Ground 1 in the -00692 IPR is an augmentation of grounds presented in the -00340 IPR. And the second and third Grounds in the -00692 Patent are based on readily available, and easily

searchable, patent prior art. Petitioner thus was actually aware, or should have been aware, of the art that makes up the -00692 IPR when that petition was filed.

Factor 3 – The First Petition Was Already Instituted: Given Petitioner’s approach (converting the -00340 IPR into a “first petition” by way of joinder), the first petition was instituted before the -00692 IPR will receive a decision on institution. Petitioner has the ability to choose between an instituted petition and the -00692 IPR (which it has belatedly tried to do in a way that supports denial of the Motion to Join in the -01264 IPR). At the time of filing of the -00692 IPR, Petitioner was aware of the arguments in the first petition, but had not seen the Preliminary Response or the decision on institution. Thus, while the -00692 IPR was not crafted to fill gaps identified by Patent Owner or the Board, discretionary denial of the -00692 IPR is warranted both because Petitioner augmented its Ground 1 analysis (which mirrors Grounds in the -00340 IPR) and also because not doing so would ensure Petitioner two bites at the apple in the PTAB.

Factor 4 –Elapsed Time: Petitioner filed the -00692 IPR on the last day it was statutorily able. Thus, the maximum possible amount of time that could have elapsed between the filing of the -00340 IPR and the -00692 IPR did elapse.

Factor 5 – Explanation for Elapsed Time: Because of Petitioner’s *post hoc* approach, and its declination to provide any argument why the -00692 IPR is NOT

a serial petition (indeed, Petitioner's statements in the -00692 IPR are now false), Petitioner has provided no explanation whatsoever for the delay. As noted, Petitioner's unauthorized ranking paper (-01264 IPR at Paper 10; -00692 IPR at Paper 15) should preclude it from making such explanations in a future filing.

Factor 6 – Board's Resources: Petitioner's gamesmanship is very much stretching the resources of the Board. Several additional papers have now been generated (some authorized, some not) based on Petitioner's strategy to create *post hoc* serial petitions. And given the fact that the Grounds largely do NOT overlap between the -00340 IPR and the -00692 IPR (nor do the experts, or the combination rationale), the Board will enjoy very few (if any) economies of scale if all three petitions are instituted.

Factor 7 – One Year to Decision: The Board should not have a problem issuing any necessary final written decisions within one year of any institution.

III. CONCLUSION

Petitioner's mess has made its prior statements about serial petitions false. Now that it has had the benefit of a fully briefed motion to stay in Colorado, and is on the eve of institution for the -00692 IPR, it seems to say it should not have filed the -01264 IPR at all. Petitioner's gamesmanship should not be countenanced—the Motion for Joinder AND the -00692 IPR should be denied.

Date: September 11, 2024

Respectfully Submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on September 11, 2024, a complete and entire copy of this PATENT OWNER'S MEMORANDUM REGARDING SERIAL PETITIONS, via email, to the Petitioner by serving the correspondence address of record as follows:

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