

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 IPR2024-01264
Patent 10,791,808

**PETITIONER'S RESPONSE TO
PATENT OWNER'S MEMORANDUM**

This paper is submitted in accordance with the Board's authorization.

I. ARGUMENT

Patent Owner contends that “calendar dates do not matter” as it proceeds to treat the '692 IPR as Petitioner's second petition, despite the '692 IPR being the first IPR filed by Petitioner and the '1264 IPR being a joinder petition in which Petitioner has stipulated to an understudy role. Patent Owner's approach is unprecedented. The *General Plastic* factors were formed as a framework to analyze petitions in accordance with the chronological order in which they are filed.

However, regardless of which petition is treated as first/second, the *General Plastic* factors weigh in favor of granting institution of the '692 IPR and the Motion for Joinder accompanying the '1264 IPR. Notably, in none of the petitions against the '808 Patent has there been an opportunity for the petitioner to use prior decisions as a roadmap to remedy a deficient challenge.

A. First, Second, and Third *General Plastic* Factors

Director Vidal has articulated that “*General Plastic* factor 1 must be read in conjunction with factors 2 and 3. Where the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits, factors 1-3 only weigh in favor of discretionary denial when there are ‘road-mapping’ concerns under factor 3 or other concerns under factor 2.” *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 5 (PTAB Aug. 23, 2022) (precedential). Further,

“‘road-mapping’ concerns are minimized when, as in this case, a petitioner files a later petition that raises unpatentability challenges substantially overlapping with those in the previously-filed petition and the later petition is not refined based on lessons learned from later developments.” *Id.* at 5.

Regardless of which petition is treated as first/second, factors 1 and 2 have little relevance as the Petitioner had no control over the content or timing of the '1264 IPR. The '1264 IPR is a joinder petition, the content of which was entirely controlled by an unrelated third party (“Shenzhen”). Likewise, Shenzhen controlled the timing of the '340 IPR, and Petitioner could only file the joinder petition within one month from the institution decision of the '340 IPR, as the PTAB rules permit (*see* C.F.R. § 42.122, stating “Any request for joinder must be filed... no later than one month after the institution date of any *inter partes* review for which joinder is requested.”). Further, despite due diligence by the USPTO Examiner, and multiple prior art searches by the Petitioner, references Pelz and Matthews were not discovered until after the filing of the '340 IPR (by Petitioner's expert).

Most notably, regardless of which petition is treated as first/second, the content of the second petition was drafted without any guidance from the Patent Owner or Board. For example, the '340 IPR was the first petition challenging the '808 Patent, and the '1264 joinder petition is a “me too” petition that is nearly identical thereto. Further, the '692 IPR was filed March 15, 2024, which is prior to

the POPR submitted April 18, 2024, in the '340 IPR, and also prior to the Board's decision to institute the '340 IPR that issued on July 12, 2024. Thus, *General Plastic* factors 1-2 have little relevance, and factor 3 weighs against discretionary denial. *See T-Mobile USA, Inc., v. VOIP-Pal.com, Inc.*, IPR2023-00641, Paper 11 at 8-9 (PTAB Jul. 28, 2023) ("any guidance provided by Patent Owner or the Board could not have influenced the content of the Petitions at issue in this proceeding. For this reason, we determine that the third *General Plastic* factor weighs against discretionarily denying institution.")

B. Fourth and Fifth *General Plastic* Factors

Where the '1264 IPR is treated as the second petition, *General Plastic* factor 4 has little relevance here due to at least the substantial overlap between the '1264 IPR and the '340 IPR. *See* IPR2022-00861, Paper 17 at 14 (PTAB Jul. 25, 2022) ("because the asserted prior art is the same as the earlier-asserted art, we see no prejudice to Patent Owner due to the timing of the Petition.") Regarding the fifth *General Plastic* factor, Petitioner filed the '1264 IPR and motion for joinder without delay, well within the statutory one month deadline. *See Id.*, IPR2023-00641, Paper 11 at 11 ("Once the Petitioner... decided to file the 'me too' Petitions at issue here, we discern no meaningful delay because a one-month window for filing a non-bared petition opened for Petitioner... Under factor 5, Petitioner need not explain why it used the entire one-month time period set by our Rules to file the Petitions and

Motions. For these reasons we determine this fifth *General Plastic* factor weighs against denying institution.”)

Where the '692 IPR is treated as the second petition and the '1264 joinder petition is treated as a first petition filed on January 2, 2024, as Patent Owner proposes; there is a mere three month delay between petitions, and both petitions are filed within the one year statutory deadline. Further, the references Pelz and Matthews (constituting two-thirds of the '692 IPR) were not discovered until February and March of 2024, respectively, about 1-2 months after the '340 IPR was filed and about a month prior to the '692 IPR being filed. As such, the fourth and fifth *General Plastic* factors weigh against denying institution.

C. Sixth and Seventh *General Plastic* Factors

Regardless of which petition is treated as first/second, there is only one petition against the '808 Patent in which Petitioner currently has an active role (*i.e.*, Petitioner has stipulated to an understudy role in the '1264 joinder petitioner). Further, the Board's analysis of credible challenges to the '808 Patent is of particular importance to the public interest in patent quality given that the '808 Patent is the basis for a General Exclusion Order¹. Moreover, Patent Owner, in its Memo, admits

¹ The GEO arose from an ITC proceeding where no invalidity contentions were considered. *See Certain Compact Wallets and Components Thereof*, ITC Inv. No.

that the “Board should not have a problem issuing any necessary final written decisions within one year of any institution.”

II. CONCLUSION

In sum, a holistic weighing of the *General Plastic* factors favors institution of the '692 IPR and the '1264 IPR. *See* IPR2022-00861, Paper 18 at 6 (PTAB Aug. 23, 2022) (“Given that (1)... the Board did not substantively address the merits of the prior petition; (2) there is no evidence of ‘road-mapping’ related to factor 3 or other concerns of fairness related to factor 2; (3) factors 2, 4, and 5 were found to have limited relevance when it comes to a determination as to whether arguments should have been raised earlier and (4) I find factor 7 to have limited relevance and factor 6 to be outweighed by the Board’s mission to improve patent quality... concerns of fairness are outweighed by the benefits to the patent system of improving patent quality by reviewing the merits of the challenges raised in the petitions....”)

Dated: September 16, 2024

Respectfully Submitted

/s/ /Jacob Busch /
Jacob M. Busch (Reg. No. 70,830)
Lead Counsel for Petitioner

337-TA-1355, EDIS No. 816751 at 67 (Mar. 25, 2024) (“The Participating Respondents stipulated that they would not present any arguments or evidence regarding validity or enforceability.”)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on counsel for Patent Owner a true and correct copy of the foregoing Petitioner's Response to Patent Owner's Memorandum on September 16, 2024, by email on the following counsel of record for the Patent Owner:

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Dated: September 16, 2024

Respectfully Submitted,

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