

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

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	Defendant 2985 LLC's Motion for Stay in View of Inter Partes Review Petitions in Case No. 23-cv-00407

The Petition for *Inter Partes* Review (“Petition,” Paper 1) in *this proceeding* should not be instituted, and the Motion for Joinder (Paper 2) should be denied, for a number of reasons.

I. THE INSTANT PETITION IS A SERIAL PETITION

The instant Petition is serial petition, and the Petitioner has adopted the petition it filed in IPR2024-00692 (which has now been instituted) as its highest-ranked petition. Without adequate reason to institute a second, serial, petition on U.S. Patent No. 10,791,808, the instant petition should be denied.

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 putative “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. 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 as a “me too” joinder petition, 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. Ex. 2001. Briefing of that motion is complete, as is briefing on all pretrial dispositive motions (e.g., summary judgment and *Daubert* motions). As of the date of the submission of this Patent Owner Preliminary Response (“POPR”), the Colorado Court has not yet rendered a decision as to whether to stay that case.

On September 6, 2024, without authorization, Petitioner filed a Notice of Ranking Petitions. -01264 IPR at Paper 10; -00692 IPR at Paper 15.

Also on September 6, 2024, and with authorization from the Board, 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.

On October 1, 2024, the Board instituted the -00692 IPR, stating that “[w]e note, however, that the Preliminary Response in the 1264IPR is not due until November 26, 2024 and Mountain Voyage’s Motion for Joinder cannot be decided until the Preliminary Response in 1264IPR is filed (or explicitly waived) or the time for filing such a response has expired. See 35 U.S.C. § 315(b). Therefore, we do not consider Patent Owner’s Memorandum or Petitioner’s Response to Patent Owner’s Memorandum because Mountain Voyage may not be joined as a party to the Shenzhen IPR at this time. *Id.*” -00692 IPR, Paper 18 at 4.

Patent Owner submits that in deciding the outstanding Motion for Joinder, and in ultimately determining whether to institute this IPR, the Board should properly consider Patent Owner’s Memorandum (Paper No. 9) and should decline to institute what is tantamount to a second, serial petition that Petitioner has now officially ranked behind the (now instituted) -00692 IPR. The reasons for this outcome are set forth in detail in Patent Owner’s prior Memorandum Regarding Serial Petitions. Paper 11.

Lastly, the supporting declaration of Dr. Kimberly Cameron, on which the Board relied in instituting review of the -00340 IPR (*see generally* -00340 IPR, Paper 18) has now been stricken from the -00340 IPR (-00340 IPR, Paper 25). This means that this IPR is no longer a “me too” IPR, so the arguments in the

Motion for Joinder are based on an even further false premise.

II. THE INSTANT PETITION IS TIME BARRED UNDER 35 U.S.C. §315(b)

The instant Petition is no longer a “me too” Petition – instead, it is a new Petition filed approximately five (5) months after the one-year anniversary of Petitioner being served with a complaint for patent infringement. Dr. Cameron’s declaration in *this IPR* (Ex. 1003) is new evidence not currently of record in the -00340 IPR. Ex. 1003. Patent Owner submits that as a result, this Petition is no longer a “me too” petition, meaning the entire premise for Petitioner’s Motion for Joinder is eliminated. And because Petitioner waited so long to file the instant Petition, there is no question that *this Petition*, with the evidence on which *this Petition* relies, is time-barred. Paper 2 at 2 (“Mountain Voyage was served with Ridge’s complaint on March 15, 2023”); Paper 1 (filed on August 6, 2024); 35 U.S.C. § 315(b). Denial is warranted for this reason alone.

III. INSTITUTION OF THIS PETITION WOULD BE UNWORKABLE

Finally, given the advanced stage of the -00340 IPR (Due Date 1, extended as far as it can be to December 3, 2024, *see* -00340 IPR, Paper 23 at 4), it would be impossible for Mountain Voyage to become involved in that proceeding at this point; any attempt to do so would carry with it substantial prejudice to Patent Owner. This underscores the same theme throughout this Preliminary Response:

Petitioner is no longer a “me too” petitioner with respect to the -00340 IPR, so instituting this IPR and granting the Motion for Joinder would be erroneous.

For the reasons given above, this Petition should be denied institution and the Motion for Joinder should likewise be denied.

Date: November 26, 2024

Respectfully Submitted,

/s/ Benjamin E. Weed

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CERTIFICATION UNDER 37 C.F.R. §42.24(d)

Under the provisions of 37 C.F.R. §42.24(d), the undersigned hereby certifies that the word count for the foregoing Patent Owner's Preliminary Response to Petition totals 1,037, which is less than the 14,000 allowed under 37 C.F.R. §42.24(b)(1).

Respectfully submitted,

Date: November 26, 2024

/Benjamin E. Weed/
Benjamin E. Weed
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Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on November 26, 2024, a complete and entire copy of this Patent Owner's Preliminary Response was provided, via email, to the Petitioner by serving the correspondence address of record as follows:

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