UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ASKELADDEN L.L.C.,
Petitioner,

v.

INTERCURRENCY SOFTWARE LLC,
Patent Owner.

_____

Case IPR2023-_____
Patent No. 10,776,863 B1

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DECLARATION OF GLENN J. PERRY

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I, Glenn J. Perry, do hereby declare that:

1. I am a member of Petitioner Askeladden, L.L.C.'s Patent Challenge Committee ("**PCC**"). I make this declaration in support of Petitioner's Petition for Inter Partes Review of Claims 1-12 of U.S. Patent No. 10,776,863 (the "'863 Patent")(EX1001).

I. Background Information

2. I earned a Bachelor of Science in electrical engineering from the University of Maryland, College Park in 1970, after which I worked as an engineer at the RCA Space Center designing communication equipment. One of the projects I worked on at that time was designing a transmitter for NASA's "Viking" program (sending photos from Mars). I then earned a law degree from the University of Maryland in 1974. After graduating law school, I practiced with various firms in the D.C. area, as well as provided legal support to the United States Navy. From 2009 to 2012, I served as an adjunct professor at both George Mason University School of Law and the University of Maryland School of Law, teaching patent drafting.

3. In 2012, I was appointed as a PTAB Judge and was sworn in on March 1, 2012. While at the PTAB, I presided over nearly 100 AIA trials. I left the PTAB in September of 2017.

4. After I left the PTAB, I returned to private practice, serving as an intellectual property legal consultant. EX1009

5. In May of 2020, I agreed to serve as a member of Petitioner's PCC, for an initial two year term, and executed a related Letter Agreement with Petitioner. In my capacity as a member of the PCC, I have acted, and continue to act, as an independent contractor of Petitioner.

6. Exhibit 1031 is a true and correct redacted1 copy of my May 20, 2020 Letter Agreement with Petitioner to serve on the PCC. Attached as Exhibit A to Exhibit 1031 is a true and correct copy of Petitioner's February 1, 2018 Amended and Restated Limited Liability Company Agreement of Askeladden L.L.C. ("**2018 Amended LLC Agreement**"). As set forth therein, the 2018 Amended LLC Agreement replaced the March 1, 2016 Amended and Restated Limited Liability Company Agreement ("**2016 Amended LLC Agreement**"), which in turn replaced the original Limited Liability Company Agreement ("**Original Agreement**"). The *Askeladden LLC v. Verify Smart Corp.*, IPR2017-00726, Paper 41 (PTAB Dec. 26, 2017), *aff'd* No. 2019-1076, 2020 U.S. App. LEXIS 24684 (Fed. Cir. Aug. 5, 2020) decision addresses only the 2016 Amended LLC

Agreement and the *Askeladden LLC v. McGhie et al.*, IPR2015-00122 *et al.*, Paper 30 (PTAB Mar. 6, 2015) decision addresses only the Original Agreement.[1]

II. The Patent Challenge Committee

7. It is my understanding that Petitioner has undertaken a number of strategic patent-related activities, including sponsoring educational research, coordinating financial services technology briefings for patent examiners, and filing amicus briefs that highlight issues critical to patent quality. Petitioner also petitions the United States Patent and Trademark Office ("USPTO") asking the Patent Trial and Appeal Board ("PTAB") to take a second look at patents that Petitioner believes are invalid.

8. In 2016, Petitioner formed the PCC to support its efforts to challenge the validity of low quality patents through the Inter Partes Review ("IPR") process at the USPTO. The PCC independently decides which patents Petitioner should challenge, and is solely responsible for directing IPR proceedings challenging the validity of those patents.

9. Since its creation in 2016, the PCC has had four members total:

[1] Certain personal information was redacted.

a. Hon. Roderick R. McKelvie, a former judge in the United States District Court for the District of Delaware and lead member of the PCC;

b. Professor John Thomas, a professor of patent law at Georgetown University;

c. Hon. Gerald Mossinghoff, former Assistant Secretary of Commerce and Commissioner of Patents and Trademarks; and

d. myself.

10. On March 20, 2020, Hon. Mossinghoff passed away leaving Prof. Thomas and the Hon. McKelvie as the two sole members of the PCC until a replacement for the late Hon. Mossinghoff had been identified. In May 2020, I was identified as the replacement for the late Hon. Mossinghoff.

11. I have agreed in writing to comply with relevant provisions of Petitioner's 2018 Amended Limited Liability Agreement and to consider the related Patent Challenge Guidelines. (EX1010 at 1). I have been informed that each of the other PCC members have entered agreements with those same obligations.

12. Among other things, the 2018 Amended LCC Agreement gives the PCC sole authority to:

a. "identify[] appropriate patents for challenge";

b. "direct[] the filing of petitions ... challenging the validity of patents selected by the [PCC]"; and

c. "oversee[] the prosecution, conduct and management of proceedings initiated by the PTAB to review the validity of challenged patents."

(EX1031 at 10).

13. The 2018 Amended LCC Agreement further specifies that the PCC "shall be solely responsible for carrying out" these activities and "shall operate independently of [Petitioner's] Executive Committee, [The Clearing House Payments Company L.L.C. ("TCH")] and any other Person that is affiliated with or otherwise related to [TCH]." (EX1031 at 10).

14. In accordance with the 2018 Amended LLC Agreement, Petitioner's Executive Committee "establish[es] an annual budget" to be used by the PCC. (EX1031 at 11). The PCC has "sole discretion regarding the use of the funds included in its annual budget, and sole discretion and responsibility for selecting and engaging any service providers, including, but not limited to, outside legal counsel, experts and prior art search firms, in connection with its activities." (*Id.*).

15. Consistent with the 2018 Amended LLC Agreement, an employee of TCH, Jim Howard, supports and assists the PCC at the PCC's discretion. (EX1031

at 10). I have been informed that Mr. Howard's services are provided pursuant to an Amended and Restated Services Agreement between Petitioner and TCH. Mr. Howard does not have any decision making authority with respect to the filing, conduct, maintenance or funding of IPR proceedings, including this proceeding. (*Id.*). As mentioned above, that authority remains solely with the PCC, and in this proceedings with the Hon. McKelvie, Prof. Thomas, and as of May 2020, Glenn Perry, the successor of the late Hon. Mossinghoff.

III. Modifications to 2016 Amended LLC Agreement

16. As noted above, on December 26, 2017, the Board issued a decision (Paper 41) in Askeladden LLC v. Verify Smart Corp., IPR2017-00726 (PTAB) ("December 2017 RPI Decision").

17. In the December 2017 RPI Decision, the Board found that TCH should be named as a real party in interest in that proceeding. That finding focused on a provision of the 2016 Amended LCC Agreement, Section 11(k), which read as follows:

> Any member of the Patent Challenge Committee, or the Executive Committee, may object to a decision by vote of the Patent Challenge Committee on the grounds that the decision contravenes the Purpose, the provision of this Section 11, and/or the Patent Challenge Guidelines or cannot be implemented with funds available to the

> Patent Challenge Committee. If such an objection is made regarding a decision by the Patent Challenge Committee and the Patent Challenge Committee is unable to resolve it, the Patent Challenge Committee shall not implement or execute its decision unless all three (3) member of the Patent Challenge Committee vote to overrule the objection.

18. The Board found that Section 11(k), as shown above, gave TCH's Executive Committee the ability to object to a decision of the PCC and veto a PCC decision unless all three members of the PCC vote to overrule the objection. (December 2017 RPI Decision at 8). I note that TCH's Executive Committee had never exercised its ability to object under this provision.

19. Patent Owner Verify Smart Corp. appealed the decision, and the Federal Circuit affirmed it. Verify Smart Corp. subsequently requested rehearing and rehearing *en banc* at the United States Court of Appeals for the Federal Circuit, which was denied on October 23, 2020. *Verify Smart Corp. v. Askeladden, L.L.C.*, No. 19-1076, ECF No. 127 (Fed. Cir. Oct. 23, 2020).

20. Following the December 2017 RPI Decision, the Section 11(k) of the 2016 Amended LCC Agreement was revised as shown in the 2018 Amended LCC Agreement, which is now the operative version. Significantly, the role of the Executive Committee was explicitly removed from the new Section 11(k). Under

the current version, **only members of the PCC** may now object to a decision of the PCC:

> Any member of the Patent Challenge Committee may object to a decision by vote of the Patent Challenge Committee on the grounds that the decision contravenes the Purpose, the provisions of this Section 11, and/or the Patent Challenge Guidelines, or cannot be implemented with funds available to the Patent Challenge Committee. If such an objection is made regarding a decision by the Patent Challenge Committee and the Patent Challenge Committee is unable to resolve it, the Patent Challenge Committee shall not implement or execute its decision unless all three (3) members of the Patent Challenge Committee vote to overrule the objection.

21. Accordingly, TCH's Executive Committee no longer has the ability to object to a decision of the PCC, or veto any decision by the PCC.

IV. The Instant IPR Petition

22. The PCC (including the Honorable McKelvie, Professor Thomas, and myself) received a proposal from the law firm of TOLLEFSON IP relating to the '863, the patent at issue in this proceeding.

23. TOLLEFSON IP confirmed to the PCC that the '863 Patent was identified by TOLLEFSON IP without any input from its clients, TCH, or any members of TCH.

24. The PCC reviewed the proposal and directed TOLLEFSON IP to prepare a petition for IPR of the ’863 Patent.

25. No other individual or party, besides the PCC participated in the decisions to prepare or file this IPR.

26. The PCC, at its own discretion, decided if and how much of its budget to allocate for this IPR. No other entity has decision making authority in this regard.

27. As required by our agreements with Petitioner, the members of the PCC continue to exercise exclusive control over this proceeding. No other individuals or entities direct or control this proceeding.

28. The PCC is the only entity that has the ability to decide whether to proceed, and how to proceed with the current petition, and how much money to spend and whether to settle, as well as the terms and conditions of any settlement.

29. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. These statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Date: 12/29/2023

Glenn J. Perry