

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BITSGAP HOLDING OU,
PAYBIS LTD., CRYPTOHOPPER BV and CRYPTENSE SAS,
Petitioners,

v.

INTERCURRENCY SOFTWARE LLC,
Patent Owner.

IPR2024-01278
Patent No. 10,776,863 B1

PETITIONER’S MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)

I. STATEMENT OF PRECISE RELIEF REQUESTED

Bitsgap Holding Ou, Paybis Ltd., Cryptohopper BV. and Cryptense SAS (“Petitioners”) respectfully submit this Motion for Joinder concurrently with a Petition (“Bitsgap Petition”) for *inter partes* review of U.S. Patent No. 10,776,863 (“the ’863 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Petitioners request institution of an *inter partes* review and joinder with IPR2024-00375 (*Askeladden LLC v. Intercurrency Software LLC* “Askeladden IPR”), instituted on July 9, 2024. Askeladden LLC does not oppose Petitioner’s joinder to the Askeladden IPR. This Bitsgap petition is substantively the same as the Askeladden IPR petition. It challenges the same claims, on the same grounds, relies on the same prior art, and includes the exact same substantive prior art arguments as the Askeladden IPR¹ and therefore would create no additional burden for the Board, the Askeladden IPR Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’863 patent.

Petitioners are currently named as a defendants in *Intercurrency Software LLC v. Bitsgap Holding OU* EDTX-2-24-cv-00392 filed May 30, 2024;

¹ The Bitsgap Petition includes additional arguments regarding discretionary denial under *Fintiv* based on the specific facts relevant to Bitsgap.

Intercurrency Software LLC v. Paybis Ltd. EDTX-2-24-cv-00253 filed April 17, 2024, *Intercurrency Software LLC v. Cryptohopper BV* EDTX-2-24-cv-00393 filed May 30, 2024 and *Intercurrency Software LLC v. Cryptense SAS* EDTX-2-24-cv-00395 filed May 30, 2024. The Petitioners have been accused of infringing the '863 patent. The Petitioners have not previously filed a petition for IPR challenging the validity of the '863 patent.

Petitioners stipulate that if joinder is granted, they will act as an “understudy” and will not assume an active role unless the Askeladden IPR Petitioner ceases to participate in the proceeding. The Askeladden IPR Petitioner will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Petitioners also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because Petitioners agree to be bound by the scheduling order in the Askeladden IPR proceeding.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Askeladden IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner, if any, will be minimal. On the other

hand, denial of joinder would prejudice Petitioners. Petitioners' interests may not be adequately protected in the Askeladden IPR, particularly if the Askeladden IPR Petitioner settles with Patent Owner and ceases to participate. Petitioners should be allowed to join in a proceeding affecting a patent asserted against it.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by Petitioners' cooperative participation, in an understudy role, in the Askeladden IPR in the event that the Askeladden IPR Petitioner's participation terminates, the Board should institute IPR and grant Petitioners' Motion for Joinder.

II. ARGUMENT

A. Legal Standards and Applicable Rules

A petitioner may request joinder, without prior authorization, up to one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. See 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder

would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

B. Petitioners’s Motion for Joinder is Timely

Joinder may be requested “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). The Askeladden IPR was instituted on July 9, 2024. IPR2024-00375. Petitioners’ current motion is timely as it is being filed no later than 1 month after the institution date.

C. Petitioner Askeladden LLC Does Not Oppose Joinder

Petitioners have conferred with Petitioner Askeladden LLC, and Askeladden does not oppose Petitioners’ joinder to the Askeladden IPR.

D. The Four Factors Favor Joinder

Each of the four factors weighs in favor of granting Petitioner’s Motion for Joinder. The Bitgap Petition is substantively identical to the petition in the Askeladden IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the Askeladden IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

1. Joinder of Petitioners Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the ’863 Patent Without Prejudice to Any Party

Petitioners seek to join the Askeladden IPR in order to ensure that an accused

infringer with an active interest in the proceeding remains a party to this IPR if the Askeladden IPR Petitioner's participation is terminated prior to completion. Thus, joining Petitioners to the Askeladden IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the '863 patent. *See* 37 C.F.R. § 42.1(b).

If Petitioners are joined as a party, the validity of the grounds raised in the Askeladden IPR can be determined in a single proceeding. Joinder is also appropriate because Petitioners' petition challenges the validity of the same claims of the '863 patent on identical grounds to those in the Askeladden IPR. There are no substantive differences between the grounds in the Bitsgap and the Askeladden IPR Petition IPR2024-00375, Paper 2 (July 27, 2023). Petitioners also rely on the same supporting evidence in its Petition as is relied on in the Askeladden IPR. A consolidated proceeding, including Petitioners' and the Askeladden IPR Petitioner, will therefore be more efficient and less wasteful, as only a single trial on these common grounds would be required. *See, e.g., Oracle America Inc. v. Realtime Data LLC*, IPR2016-01672, Paper 13 at 7 (PTAB Mar. 7, 2017) (noting that "joining Oracle's identical challenges to those in the 1002 IPR will lead to greater efficiency while reducing the resources necessary from both Realtime and the Board"). The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the

existing proceeding.” *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016- 00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted).

Joining Petitioners as a party to the Askeladden IPR would promote the public interest relating to the unpatentability of the ’863 patent and not cause any undue prejudice to Patent Owner or the Askeladden IPR Petitioner. The Patent Owner must respond to the common invalidity grounds identified in the Askeladden and Bitsgap’s Petitions regardless of joinder.

2. Bitsgap’s Petition Does Not Raise Any New Grounds of Unpatentability and Therefore Does Not Add Additional Complexity to the Grounds in the Askeladden IPR Petition

The Bitsgap Petition challenges the validity of the ’863 patent on identical grounds to those in the Askeladden IPR. *See* IPR2023-01242, Paper 2 (July 27, 2023). Petitioner’s supporting materials—including its supporting expert declaration, exhibits, and exhibit numbering—are identical to those presented in the Askeladden IPR. *See supra* n.2. Accordingly, no new grounds are being introduced. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 5-6 (PTAB Oct. 5, 2015).

Therefore, consolidation of this proceeding with Askeladden’s via joinder of Bitsgap’s Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or Patent Owner, or add additional complexity to the case.

3. Joinder Will Not Affect the Schedule in the Askeladden IPR

Given that the Board only recently instituted the Askeladden IPR, joinder of Petitioners will not affect the schedule in any potential forthcoming trial. Petitioner's participation should result in no changes to the schedule.

Petitioners agree to adhere to all applicable deadlines set forth in the Askeladden IPR Scheduling Order.

4. Joinder Will Simplify Briefing Because Petitioners have Agreed to Consolidated Filings and an Understudy Role if the Askeladden Petitioner Remains

To further prevent joinder from imposing any burden on the Askeladden IPR Petitioner, Patent Owner, or the Board and to further ensure that there are no changes in the potential trial schedule, Petitioners agree as long as the Askeladden IPR Petitioner remains a party to the Askeladden IPR, to take an understudy role, which will simplify briefing and discovery. In this role, Petitioners agree to the following conditions:

(a) Petitioners shall not make any substantive filing and shall be bound by the filings of the Askeladden IPR Petitioner, unless a filing concerns termination and settlement, or issues solely involving one or more of the Petitioners;

(b) Petitioners shall not present any argument or make any presentation at oral hearing unless an issue solely involves one or more of the Petitioners, or

when addressing Board-approved motions that do not affect the Askeladden IPR Petitioner, or its respective position;

(c) Petitioners shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving one or more of the Petitioners;

(d) Petitioners shall not seek discovery from Patent Owner on issues not solely involving one or more of the Petitioners;

(e) Petitioners will not rely on expert testimony beyond that submitted by the Askeladden IPR Petitioner unless the Askeladden IPR Petitioner is terminated from the case. If the Askeladden IPR Petitioner is not terminated from the case, Petitioners agree to rely entirely on, and be bound by, the expert declarations and depositions in the Askeladden IPR. Unless and until the current petitioner in IPR2024-00375 ceases to participate in the instituted Askeladden IPR, Petitioners will not assume an active role.

Accordingly, due to Petitioners taking only an “understudy” role, Patent Owner and the Askeladden IPR Petitioner will only need to respond to one principal set of papers, will not require additional time to address additional arguments raised by Petitioners, and can thus proceed with the existing trial schedule. These steps will minimize or eliminate any potential complications or delay that could potentially result from joinder. *See Sony*, Paper No. 11 at 6-7

(granting motion because “joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board” where second petitioner agreed to “understudy” role). Petitioners will also abide by any additional conditions the Board deems appropriate for an “understudy” role.

5. Joinder Will Result in No Prejudice to Patent Owner

As noted above, Petitioners’ joining of the Askeladden IPR proceeding should not result in any prejudice to Patent Owner. No additional grounds or arguments are being introduced, no new evidence or issues are being added, and no additional discovery or briefing or oral argument should be necessary as a result of Petitioner’s joinder. Thus, Patent Owner would not need to expend any additional resources beyond those required in the current Askeladden IPR.

III. CONCLUSION

For the foregoing reasons, Petitioners respectfully requests that its Petition for *Inter partes* review of the ’863 Patent be instituted and that Petitioners be joined to the Askeladden IPR proceeding IPR2024-00375.

Respectfully submitted,

Dated August 9, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on August 9, 2024, a complete and entire copy of this Petitioner's Motion for Joinder was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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