UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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JUMIO CORPORATION,
Petitioner

v.

FACETEC, INC.,
Patent Owner

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Case IPR2025-00107

U.S. Patent No. 11,157,606

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**SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE**

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## I. Jumio's Reply Highlights Why the Board Should Deny Institution

This case is one of four IPRs Jumio filed, each of which will require substantial resources from the Board due to the many unique and potentially thorny issues involved. Jumio's original IPR counsel, Perkins Coie, was disqualified from representing Jumio in district court due to the firm's ethical violations against FaceTec. Despite the disqualification, Jumio opted to provide a declaration from former lead IPR counsel at Perkins Coie. This is problematic for three reasons.

First, it means that Perkins continues to be involved in these proceedings, which is improper. If instituted, the Board will need to consider whether disqualification should extend to prohibit the Perkins declaration. Second, if instituted, FaceTec will seek to depose Jumio's former lead IPR counsel as part of routine discovery, likely leading to numerous disputed privilege issues that the Board would need to address. Third, the declaration makes assertions about sources of prior art, when communications did or did not occur, and whether iProov funded the petitions. However, it provides no documentary evidence to substantiate or refute those assertions. If instituted, it appears that FaceTec would need to pursue additional discovery, consistent with the Acting Director's recent decision in *Semiconductor Components Industries, LLC v. Greenthread, LLC*, IPR2023-01242, Paper No. 94 (PTAB Apr. 24, 2025) (reversing denial of additional discovery regarding privity).

In addition to these issues, in the California litigation, FaceTec has also moved to disqualify Jumio's replacement counsel Morrison & Foerster, in part because they served as co-counsel with Perkins. FaceTec has avoided burdening the Board with disqualification-related motions, but if Jumio's counsel refuses to withdraw, FaceTec may be forced to take up the issue with the Board.

These are all issues of Jumio's own making, and they add multiple layers of complexity that will likely require substantial resources from the Board and the parties. The better path is not to reward Jumio with institution of what would be messy proceedings, but to deny institution for the reasons provided in the Preliminary Response, none of which are undermined by Jumio's reply.

## II. iProov Is a Real Party in Interest

Jumio and iProov have a close relationship establishing that both are real parties in interest and that iProov is a privy of Jumio. This Petition is time-barred. POPR, 5-22. Jumio makes much of FaceTec's statement that Jumio would be "free" to file IPRs, but Jumio ignores two key facts. First, FaceTec made that statement in the context of a motion to dismiss the California litigation where FaceTec correctly explained that Jumio's ability to file IPRs was not affected by whether the California litigation remained pending. Ex. 1045, 2. As FaceTec explained, "Jumio's rights and ability to pursue such proceedings will not be changed by the dismissal without prejudice of FaceTec's claims." *Id.* FaceTec

was not acquiescing to Jumio filing time-barred petitions or failing to meet the statutory requirements; it merely stated that whatever rights Jumio had to file IPRs would be unchanged.

Second, information arising after FaceTec made that statement demonstrated a deeper connection between Jumio and iProov than FaceTec had previously known. For example: (1) FaceTec learned that Jumio and iProov have a Common Interest Agreement; (2) Jumio and iProov sought and received an extension to *coordinate on invalidity contentions* (Ex. 2008, 12-13); (3) *thirty-four* of iProov's forty-two listed references overlap with Jumio's contentions and each of iProov's overlapping "Primary References" are primary references in Jumio's contentions (*see* Ex. 2012, 18-22; Ex. 2011; 2); (4) by intervening in the case against Jumio, iProov is now challenging the validity of all four patents at issue in Jumio's IPRs; and (5) iProov recently moved to stay its *own* Nevada case based on Jumio's IPRs (Ex. 1029). Each point further demonstrates that iProov is an unnamed real party in interest, as it has benefitted and would benefit "from a practical and equitable standpoint" from these proceedings in many ways, including because of its admitted indemnification obligations to Jumio. Ex. 2006, 6.

## III. Jumio's "Differences" Between Tanii and Todoroki Are Irrelevant

Jumio identifies differences between Tanii and Todoroki. Reply, 4. None of

them are "material" under § 325(d). *Dropworks Inc. v. The University of Chicago*, IPR2021-00100, Paper No. 9, 12-13 (no material differences if previously presented secondary references have similar teachings as Petition references).

Jumio asserts Todoroki "relate[s] to 'two-dimensional' features." Todoroki actually refers to calculating a "two-dimensional *distortion*" between images. Ex. 2018, ¶ [0068]. Indeed, Tanii and Todoroki both correct distortion between two-dimensional images of the same three-dimensional objects: *faces*. Petition, 10-12; POPR, 27-29. Jumio also complains that Todoroki's distortion is "motion-induced" and does not look for "differences in distance." Reply, 4. Not so: the "motion vector" does not *cause* distortion but accounts for it. Paragraph [0064] discusses calculating "a motion vector (Mvec) of the input face region image 201 *with respect to* the average face image 220." This motion vector can indicate differences in distance, including "*forward and rearward* distortion." POPR, 28-29.

## IV. The Petition's Arguments Overlap with Prosecution Arguments

Jumio complains that the POPR points to parts of Todoroki beyond those cited by the Examiner. This is irrelevant to whether the Petition's use of Tanii overlaps with the Office's consideration of Todoroki. And it does. POPR 27-29.

## V. Jumio's "Same Field of Endeavor" Argument Is Late

Jumio now argues that Tanii is in the "same field of endeavor" as the challenged patents. As explained in the POPR, prior art is analogous if it is from

the "same field of endeavor" to a patent, **or** "reasonably pertinent to the particular problem" faced by the inventor. POPR, 37-38 (*quoting Sanofi-Aventis Deutschland GmbH v. Mylan Pharms.*, 66 F.4th 1373, 1377 (Fed. Cir. 2023)). While its expert asserted that other references were in the same field, he did not for Tanii. *Compare* Ex. 1003, ¶¶ 101, 116, 123 ("same field of endeavor") *with* ¶ 110 (Tanii).

FaceTec explained that Jumio's admitted problems faced by the inventor do not align with Tanii. POPR, 39-40. Jumio cannot now change its argument in response. Petitioners "may not submit new evidence or argument in reply that it could have presented earlier." Consolidated Trial Practice Guide, 73 (Nov. 2019).

## VI. Tanii's Non-Analogousness Is Irrelevant to Todoroki

Jumio asserts that Patent Owner "contends" Todoroki is analogous. Not so. Patent Owner argued that Tanii is *cumulative of* Todoroki. POPR, 27-29. Whether prior art references are analogous to each other is irrelevant to analogousness to a challenged patent. *Sanofi-Aventis*, 66 F.4th at 1378 (rejecting argument that "it is proper to compare a reference to other references for analogous art purposes").

## VII. The California Case Is Only Temporarily Delayed Due to Jumio's Counsel's Ethical Breaches

Jumio wrongly accuses FaceTec of failing to mention the stay in the California case. POPR, 54 n.6 ("district court recently issued a temporary stay"). The stay, caused by Jumio's counsel's ethical breaches, is only temporary. Ex. 1030 at 14. The Board should not reward Jumio under *Fintiv* for this delay.

Date: May 14, 2025

Respectfully submitted,

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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served on May 14, 2025, via email directed to counsel of record for the Petitioner at the following:

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Dated: May 14, 2025

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