UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUMIO CORPORATION,
Petitioner,

v.

FACETEC, INC.,
Patent Owner.

Patent No. 11,874,910

Inter Partes Review No. IPR2025-00109

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Jumio replies to two of the POPR's many meritless arguments as permitted by the Board. First, although in moving to dismiss the California case (EX1046), FaceTec stated "Jumio remains free to [file an IPR]" (EX1045, 2), it now argues Jumio is time-barred. But iProov is not an RPI or privy of Jumio. It did not direct, control, fund, or work on the Petition at all, and the two companies have a typical supplier-customer relationship. Second, Tanii (Petition art) is not cumulative of Todoroki (prosecution art) as FaceTec claims. Todoroki teaches 2D features and differences in tilt. Tanii teaches accounting for distortions in 3D faces based on differences in focal lengths—concepts at the heart of the '910 Patent.

I. IPROOV IS NOT TIME-BARRED, AN RPI, OR A PRIVY OF JUMIO

A. iProov Is Not Itself Time-Barred As to the '910 Patent

The '910 patent is not asserted in the Nevada case (EX2024) so iProov is not barred. Section 315(b) does not extend to all patents in a family. (POPR, 5-6.)

B. iProov Does Not "Desire[] Review" (*AIT* Factor 1)

FaceTec argues iProov must "desire[] review" because iProov challenged the invalidity of *a parent and aunt* ('471 and '606 patents) of the '910 patent in the Nevada case. (POPR (Paper 6), 13.) This is specious because there iProov could have filed an IPR for the parent and aunt, but did not.

C. Jumio Did Not File the Petition at iProov's "Behest", and Is Not "Act[ing] as a Proxy", nor Is iProov "Assum[ing] Control" of the Petition (*AIT* Factor 2, *Taylor* Factors 4, 5)

iProov did not direct, control, fund, or work on the Petition. (EX1049, ¶4.)

That iProov counsel represented Jumio in opposing a subpoena in the Nevada case is of no moment. (POPR, 10.) Jumio never discussed the Petition or its substance with iProov. (EX1049, ¶4.) *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1320 (Fed. Cir. 2018) (party "did not control or direct the IPR petitions" was not RPI/privy). Jumio did not look to the Nevada invalidity contentions for the Petition either. (POPR, 13; EX1049, ¶6.) FaceTec alleges Jumio and iProov "coordinated on sets of invalidity contentions." (POPR, 14.) Any such work occurred *after* the Petition was filed. (EX1049, ¶6.)

D. iProov's "Interest in and Benefit From" the IPR Is That of a Typical Customer-Supplier Relationship (*AIT* Factors 3, 4)

iProov and Jumio have an arms-length business relationship with standard indemnity. (POPR, 7-13.) Such a relationship does not result in RPI/privity. *See, e.g.*, *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1341 (Fed. Cir. 2018) (affirming decision that Petitioner's customer was not RPI). *Ventex* and *Ericsson* are inapplicable: in both, the supplier filed the Petitions to protect the customers. Here, Jumio is the customer filing to protect itself. *Ventex Co., Ltd. v. Columbia Sportswear N. Am., Inc.*, IPR2017-00651, Paper 152, 6 (PTAB 2019); *Ericsson Inc. v. Regents of the Univ. of Minn.*, IPR2017-01186, Paper 58, 8 (PTAB 2020).

FaceTec cites to Ex. 2001 to argue that Jumio's relationship with iProov was not "arms-length." (POPR, 9.) But Ex. 2001, "10 Reasons to Become an iProov Partner," is simply a marketing document that quotes various iProov "partners." It

in no way suggests that there was any legal partnership. Business "partners" of this type are not RPIs. *Google LLC v. CyWee Group Ltd.*, IPR2018-01257, Paper 91, 28 (PTAB 2020) (not RPI despite preexisting business relationship).

E. There is No "Agree[ment] to Be Bound" or "Pre-existing Substantive Legal Relationship" (*Taylor* Factors 1, 2)

FaceTec's speculation is wrong: iProov is not funding the IPR. (EX1049, ¶4.) That the district court and PTAB both address invalidity does not create an agreement to be bound or a substantive legal relationship.

F. Jumio Does Not "Adequately Represent" iProov (*Taylor* Factor 3)

FaceTec cannot use iProov's attempt to intervene in district court to argue Jumio is adequately representing iProov before the PTAB. iProov moved to intervene because "[its] interest is not adequately protected by the existing parties." (EX2009, 5.) The district court agreed, granting iProov's motion because "Jumio may have diverging interests from iProov," including because Jumio has its own liveness technology that does not rely on iProov technology. (EX1048, 5.)

G. Jumio Is "Representing [Its Own] Interests" (*AIT* Factor 5)

Jumio found the art in the Petition independently. It did not review iProov's invalidity contentions in the Nevada case before filing the Petition. (EX1049, ¶6.) FaceTec speculates to the contrary—admitting it has no evidence—because iProov's contentions cite to a continuation of Derakhshani (Petition art) and Zhang. (POPR, 13.) But this minimal overlap is not surprising—particularly since Jumio

owns the Derakhshani patents. (EX1049, ¶5.) It was already aware of them. (*Id.*)

II. THE PETITION'S ART AND ARGUMENTS ARE MATERIALLY DIFFERENT FROM THOSE CONSIDERED BY THE OFFICE

A. The Teachings of Tanii and Todoroki Are Different (*Becton* Factors (a), (b))

Among the 400+ references cited, the Examiner never found or applied Tanii (Petition art). (EX1001, 1-5.) It is not cumulative of Todoroki (prosecution art). First, Tanii processes a face in an image that is 3D, whereas Todoroki's teachings relate to "two-dimensional" features. (Petition, 11, 25; EX1007, [0047]-[0048]; EX2018, [0068].) Second, Tanii's distortion is lens-induced. Todoroki's distortion is motion-induced. (*Id.*; Petition, 38; EX1007, [0007]; EX2018, [0068]-[0069].) Finally, Tanii looks for differences in distance between the camera and the face (focal length) in two captured images. (EX1007, [0048].) Todoroki looks for differences in position (tilt) of a face between a single captured image and a reference image. (EX2018, [0067]-[0069], Fig. 4.)

B. The Petition Arguments Do Not Overlap with the Prosecution Arguments (*Becton* Factor (d))

FaceTec argues the Petition arguments for Tanii are cumulative to the prosecution arguments for Todoroki. (POPR, 25-28.) But it points to teachings and paragraphs of Todoroki the Examiner did not cite or characterize. *Compare* EX2013, 408-409 (Examiner citing and characterizing EX2018, [0018]-[0019], [0064], [0089]) *with* POPR 24-26 (FaceTec citing and characterizing EX2018,

[0057], [0067]-[0069]).) This makes sense since Tanii's teachings (the Petition arguments) are not cumulative of Todoroki's teachings.

C. Tanii Is Analogous Art to the '910 Patent

Tanii is analogous because "both are concerned with identifying and accounting for distortions of [3D] faces in images captured using a camera" (same field of endeavor). (EX1003, ¶110; EX1001, Abstract; EX1007, Abstract, [0068]-[0069].) Further, both address the same lens-induced distortion problems known in the art. (EX1001, 28:57-60 ("images [] taken at [] close distances between the subject and the camera . . . are distorted through what is known as perspective distortion."); EX1007, [0005] ("image warp observed using a fish-eye lens, i.e., 'distortion', are conventionally known"), [0007] ("When the [] face is close to the camera …, the exaggeration warp becomes more noticeable."). FaceTec cannot argue Tanii is non-analogous (POPR, 33) when it contends Tanii is cumulative of Todoroki—which it claims *is* analogous (EX1002, 234).

III. UPDATE ON THE DISTRICT COURT SCHEDULE

FaceTec's *Fintiv* arguments (POPR, 49) fail to mention the California case was stayed on February 25. (EX1050, Dkt. No. 92.) The stay is still in place because FaceTec's disqualification motion was granted. The parties have yet to exchange Joint Claim Construction Statements and FaceTec is arguing no files can be transferred to new counsel. Trial is likely to be materially delayed.

Dated: April 30, 2025

By: */s/ Alex S. Yap*
Alex S. Yap
Reg. No.: 60,609
MORRISON & FOERSTER LLP
707 Wilshire Blvd., Suite 6000
Los Angeles, CA 90017
Email: AYap@mofo.com
Tel: 213-892-5200

Counsel for Petitioner

Certification of Page Count (37 C.F.R. § 42.24)

I hereby certify that the attached PETITIONER'S REPLY TO PATENT OWNER PRELIMINARY RESPONSE has five pages, exclusive of "a table of contents, a table of authorities, a listing of facts which are admitted, denied, or cannot be admitted or denied, a certificate of service or [page] count, or appendix of exhibits."

Dated: April 30, 2025

By */s/ Alex S. Yap*
Alex S. Yap

Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S REPLY TO PATENT OWNER PRELIMINARY RESPONSE was served on the below date via e-mail (by agreement) to the following counsel of record for the Patent Owner:

Joshua L. Goldberg (Reg. No. 59,369)
Christopher C. Johns (Reg. No. 68,664)
Chen Zang (Reg. No. 81,568)
Anthony Berlenbach (Reg. No. 77,963)
Finnegan, Henderson, Farabow, Garrett, & Dunner LLP
901 New York Avenue NW
Washington, DC 20001-4413
Email: Joshua.Goldberg@finnegan.com
Email: Christopher.Johns@finnegan.com
Email: Chen.Zang@finnegan.com
Email: Anthony.Berlenbach@finnegan.com
Email: FaceTec-Jumio-IPRs@finnegan.com

Jason Stach (Reg. No. 54,464)
Finnegan, Henderson, Farabow, Garrett, & Dunner LLP
271 17th Street, NW, Suite 1400
Atlanta, GA 30363-6209
Email: Jason.Stach@finnegan.com

Dated: April 30, 2025

/s/ Alex S. Yap
Alex S. Yap