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Paper 9
Date: December 20, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
Petitioner,
v.

WEPAY GLOBAL PAYMENTS LLC,
Patent Owner.

PGR2022-00045
Patent D930,702 S

Before GRACE KARAFFA OBERMANN, SCOTT A. DANIELS, and MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

Per curiam.

DECISION
Granting Institution of Post-Grant Review
35 U.S.C. § 324

Granting Motion for Joinder
35 U.S.C. § 325(c); 37 C.F.R. § 42.222

I. INTRODUCTION

A. BACKGROUND

Samsung Electronics Co., Ltd. ("Petitioner") filed a Petition requesting post-grant review of the sole claim of U.S. Patent No. D930,702 S (Ex. 1001, "the '702 patent"). Paper 1 ("Pet."). The '702 patent also is the subject of PGR2022-00031 filed by Early Warning Services, LLC. *See Early Warning Services, LLC v. WePay Global Payments LLC*, PGR2022-00031, Paper 1 (PTAB Apr. 5, 2022) ("PGR 031"). On October 7, 2022, the Board entered a decision to institute review in PGR 031. PGR 031, Paper 22. Petitioner timely filed a Motion for Joinder within one-month of the institution decision in PGR 031. *See* Paper 8 ("Mot."). WePay Global Payments LLC ("Patent Owner"), in this case, did not file a preliminary response or an opposition to Petitioner's Motion for Joinder.[1]

For reasons discussed below, we institute a post-grant review of the challenged claims and grant Petitioner's Motion for Joinder.

B. RELATED PROCEEDINGS

In addition to PGR 031, Petitioner identifies twelve (12) district court cases as related to this proceeding and involving the '702 patent (Mot. 3–4): (1) *WePay Global Payments LLC v. Samsung Electronics Co., Ltd. et al*., 6:2021-cv-01095 (W.D. Tex.); (2) *WePay Global Payments LLC v. Amazon.com, Inc.*, No. 1:2022-cv-01061 (N.D. Ill.); (3) *WePay Global Payments LLC v. Bank of America, N.A.*, 1:2022-cv-00105 (N.D. Ill.); (4) *WePay Global Payments LLC v. JPMorgan Chase Bank, N.A*., 1:2022-cv- 00103 (N.D. Ill.); (5) *WePay Global Payments LLC v. McDonald's Corporation*, 1:2022-cv-01064 (N.D. Ill.); (6) *WePay Global*

[1] Patent Owner filed a preliminary response and sur-reply in PGR 031. *See* PGR 031, Papers 12, 17.

Payments LLC v. PayPal, Inc., 6:2021-cv-01094 (W.D. Tex.); (7) *WePay Global Payments LLC v. PNC Bank, N.A*., 2:22-cv-00592 (W.D. Pa.); (8) *WePay Global Payments LLC v. PNC Bank, N.A*., 1:2021-cv-05052 (N.D. Ill.); (9) *WePay Global Payments LLC v. Apple Inc*., No. 6:2022-cv-00223 (W.D. Tex.) (dismissed); (10) *WePay Global Payments LLC v. Tesla, Inc*., 6:2022-cv-00224 (W.D. Tex.); (11) *WePay Global Payments LLC v. Wal-Mart Stores, Inc*., 1:2022-cv-01062 (N.D. Ill.) (dismissed); and (12) *WePay Global Payments LLC v. Wells Fargo Bank, N.A*., 6:22-cv-00363 (W.D. Tex.).

C. Real Parties-in-Interest

Petitioner identifies Samsung Electronics Co., Ltd. and Samsung Electronics America Inc. as real parties-in-interest. Pet. 9.

Early Warning Services, LLC identifies itself as a real party-in-interest in its petition. PGR 031, Paper 1 at 7. Early Warning Services further identifies "Bank of America, N.A., JPMorgan Chase Bank, N.A., and PNC Bank, N.A." as customers of Early Warning Services. *Id*.

Patent Owner identifies WePay Global Payments LLC as "the real party in interest" and owner of the '702 patent. Paper 4, 1 (Patent Owner's Mandatory Notices).

D. Overview of the '702 Patent and Asserted Grounds of Unpatentability

The '702 patent claims "[t]he ornamental design for a display screen portion with animated graphical user interface, as shown and described." Ex 1001, code (57). We reproduce below Figures 1 and 2 of the '702 patent, which make up the first claimed embodiment. *Id.* at Figs. 1, 2.

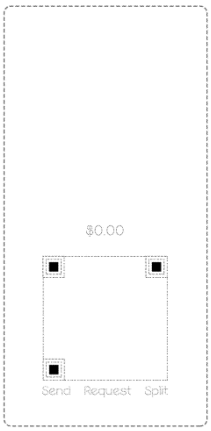


FIGURE 1

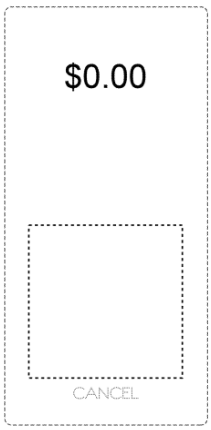


FIGURE 2

Ex. 1001, Figs. 1, 2. Figure 1 displays a first broken line square within the lower half of a large broken line rectangle; within the top two and bottom left corners of the square are smaller broken line squares, and inside the smaller squares are solid black squares. *Id*. at Fig. 1. Immediately above the first square is broken line text "$0.00," and below the first square is broken line text that reads, from left to right, "Send," "Request," and "Split." *Id.* Figure 2 includes the same first square and rectangle, but the first square is empty and the broken line text below it reads "Cancel." *Id*. at Fig. 2. The "$0.00" text of Figure 2 is in the upper half of the rectangle and in solid lines, instead of "$0.00" being located immediately above the square and in broken lines. *Id.* Reproduced below are Figures 3–5 of the '702 patent, which make up the second claimed embodiment. *Id.* at Figs. 3–5.

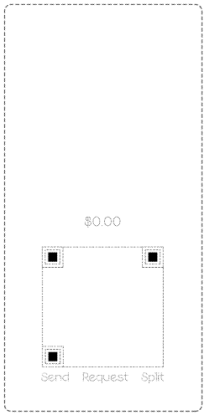


FIGURE 3

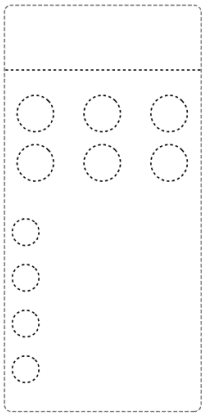


FIGURE 4

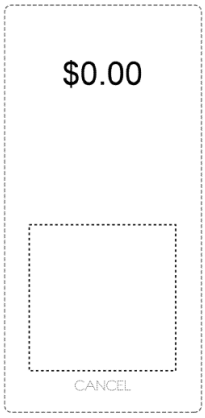


FIGURE 5

Ex. 1001, Figs. 3, 4, 5. Figures 3 and 5 are identical to Figures 1 and 2, respectively. *Id.* at Figs. 3, 5. Figure 4 displays the same rectangle but includes a broken line across the top of it. *Id.* at Fig. 4. In the upper half of the rectangle but under the broken line, there are two rows of broken line circles. *Id.* Within the lower half of the rectangle, there is a column of four circles on the left side. *Id.*

The broken lines represent unclaimed matter, and "[t]he process or period in which one image transitions to another image forms no part of the claimed design." *Id.* at Description.

We reproduce the asserted grounds in the following chart.

Claim Challenged	35 U.S.C. §[2]	Reference(s)
1	102	Reddy[3]
1	103	Reddy
1	103	Reddy, SGQR[4]
1	102	GrabPay[5]

[2] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Given that the application from which the '702 patent issued was filed after this date, the current versions of §§ 102 and 103 apply. Neither party directs us to information indicating that the result would change based on which version of the provisions is applied in this proceeding. Nor is there any dispute, on this record, that the '702 patent is eligible for post-grant review.

[3] U.S. Patent Application Pub. No. 2018/0260806 A1, published Sept. 13, 2018 (Ex. 1004).

[4] Screenshots of YouTube video, "SGQR—Singapore Quick Response Code," https://www.youtube.com/watch?v=1VmJm9imBp4 (Ex. 1005). Petitioner asserts a publication date of September 16, 2018. Pet. 25.

[5] Screenshots of YouTube video, "GrabPay Standalone," https://www.youtube.com/watch?v=bc84snlxTRc (Ex. 1006). Petitioner asserts a publication date of March 20, 2020. Pet. 32.

Claim Challenged	35 U.S.C. §[2]	Reference(s)
1	103	Digital Debit Video,[6] Digital Debit Patent[7]

Pet. 13.[8]

II. ANALYSIS

Before deciding joinder questions, the Board first determines whether the petition "warrants the institution of a post-grant review under section 324." *See* 35 U.S.C. §§ 325(c), 324(a) (stating that the petition "would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable"); *see also Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (interpreting joinder requirements in *inter partes* review under 35 U.S.C. §§ 314(a), 315(c)). When a second petition is a "me-too" or "copycat" petition, the institution analysis may include a *General Plastic* analysis. *See Apple, Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (designated as precedential on December 4, 2020) ("*Uniloc*"); *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i).

[6] Screenshots of YouTube video, "Digital Debit App Preview," https://www.youtube.com/watch?v=tDqvQFJB8GA (Ex. 1007). Petitioner asserts a publication date of November 20, 2017. Pet. 39.
[7] U.S. Patent No. D857,054 S, issued August 20, 2019 (Ex. 1008).
[8] Although the Petition sets forth four numbered grounds, two distinct grounds are embedded within Petitioner's second-numbered ground. *See* Pet. 13 (asserting, in the second-numbered ground, obviousness over Reddy "alone or in view of" SGQR).

A. Decision to Institute Post-Grant Review

Petitioner contends that the "Petition is materially the same as the petition filed in the 031 proceeding." Mot. 1. Petitioner also asserts that the Petition "challenge[s] the same claim, on the same grounds, and rel[ies] on the same prior art and evidence, including an identical declaration from the same expert." *Id*. Our review of the petitions and the evidence that supports both petitions confirms Petitioner's representations. *Compare* Pet. 12–86, *with* PGR 031, Paper 1 at 10–88. For the same reasons discussed in our Decision on Institution in PGR 031, we find Petitioner has demonstrated that it is more likely than not that the challenged claim of the '702 patent is unpatentable. *See* PGR 031, Paper 22. Accordingly, we determine that the Petition warrants institution of post-grant review under 35 U.S.C. § 324.

B. General Plastic Analysis

The Board's decision in *General Plastic* articulates seven non-exhaustive factors to consider when deciding whether to discretionarily deny a petition, which challenges a patent previously challenged before the Board. These factors include:

> 1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
> 2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
> 3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
> 4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

> 5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
> 6. the finite resources of the Board; and
> 7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 9−10 (footnotes omitted).

Despite Petitioner's arguments otherwise, the Board finds it necessary to analyze the *General Plastic* factors under *Uniloc*. Mot. 9–10; *Uniloc*, Paper 9 at 5 (PTAB Oct. 28, 2020).

Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent

Petitioner has not previously challenged the '702 patent. Mot. 10–11. On this record, moreover, no evidence has been presented that Petitioner has a significant relationship with the petitioner in PGR 031. *See Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 9−10 (PTAB Apr. 2, 2019) (precedential). Thus, the Board finds that the same petitioner has not previously filed a petition related to the '702 patent, which weighs against discretionary denial.

Factor 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it

Because the petitioners are not the same, this factor is not applicable or, at minimum, weighs against discretionary denial. To the extent the factor is applicable, the asserted art in both petitions is the same. *Compare* Pet. 12–86, *with* PGR 031, Paper 1 at 10–88. The instant Petition "is a 'copy' of" the petition filed in PGR 031. Mot. 11. Thus, these facts do not raise concerns of a second petitioner

using a first petition as a roadmap. This factor is neutral or weighs slightly against discretionary denial.

Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition

Unlike Section 315(c), which applies to *inter partes* review, Section 325(c), applicable to this post-grant review proceeding, does not discuss preliminary responses in the context of joinder. Even so, the instant Petition was filed on June 9, 2022, approximately one month before Patent Owner filed a preliminary response in PGR 031. Pet. 88; PGR 031, Paper 12 (filed July 14, 2022). The Petitions are substantively identical; therefore, this is not an instance where Petitioner could have benefited from arguments made in a preliminary response or an institution decision. This factor weighs against discretionary denial.

Factors 4 & 5: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition, and the explanation of the time elapsed

Petitioner argues that these factors are inapplicable because Petitioner would take an "understudy role" in PGR 031. Mot. 12. The Board disagrees. These factors relate to the timing of Petitioner's discovery of the asserted prior art and filing of the Petition, not the level of involvement Petitioner will have if the proceedings are joined. Petitioner does not otherwise address these factors. *Id.*

Although the decision in *Uniloc* informs that a petitioner's failure to adequately address these factors may weigh in favor of discretionary denial, this case is distinguishable because Petitioner has not previously filed a petition challenging the validity of the '702 patent claim. *See, e.g.*, *Uniloc*, Paper 9 at 11.

The Petition is substantively the same as the petition in PGR 031 and includes notice of Petitioner's intention to file the joinder motion. *See* Pet. 1; Mot. 1–2. This factor is neutral given Petitioner's willingness "to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in" PGR 031. Mot. 1–2.

Factor 6: the finite resources of the Board

The Board finds this factor to weigh against discretionary denial because the petitions are identical and deciding them together would be a more effective use of the Board's resources.

Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

The Board sees no reason why institution in this case would affect the Board's ability to issue a decision within one year of the institution date of PGR 031. Petitioner has not sought to introduce a declaration of an expert different from the declaration submitted in support of the petition in PGR 031, and avers, moreover, that it "will not seek additional depositions or deposition time" should this proceeding be joined with PGR 031. Mot. 2; *see* Ex. 1002 (Declaration of Gonzalo R. Arce, Ph.D., as filed in PGR 031). Accordingly, at this juncture, we agree with Petitioner that "the proposed joinder will neither unduly complicate" PGR 031 "nor delay its schedule." Mot. 2.

In any event, the one-year statutory deadline for a final written decision provided under Section 326(a)(11) may be adjusted in the case of joinder under Section 325(c). 35 U.S.C. § 326(a)(11). The Board may also adjust the time period in which Patent Owner's Response is due. *See* 37 C.F.R. § 42.220. Accordingly, this factor weighs against discretionary denial.

Conclusion on the General Plastic Factors

Based on the particular facts of this proceeding, we conclude that the *General Plastic* factors do not weigh in favor of exercising discretion to deny institution.

C. MOTION FOR JOINDER

Joinder in post-grant review is governed by 35 U.S.C. § 325(c), which provides:

> (c) JOINDER.—If more than 1 petition for a post-grant review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant review.

A motion for joinder must be filed "no later than one month after the institution date of any post-grant review for which joinder is requested." 37 C.F.R. § 42.222(b). Petitioner timely filed the Motion for Joinder on October 28, 2022, within one month of the Decision of Institution in PGR 031. *See* Mot. 14; PGR 031, Paper 22. The Petition indicates Petitioner's intent to file the Motion for Joinder. *See* Pet. 1. The Petition is substantively identical to the petition in PGR 031 and, accordingly, presents no new grounds. Mot. 6–8. Because Petitioner seeks only to join the first proceeding as a party, and makes no arguments in its Petition that differ from those already being addressed in PGR 031, we grant the Motion for Joinder. In so doing, we take account of Petitioner's assertions that joinder will not impact the trial schedule because there are no new grounds and, furthermore, Petitioner "consents to any trial schedule adopted in" PGR 031. Mot. 7–8. The Board agrees that joinder should not impact the trial schedule.

Petitioner also asserts that joinder will not add to the complexity of briefing or discovery. While accepting an "'understudy' role," Petitioner agrees that, unless

Early Warning Services is no longer a party in PGR 031, Petitioner will 1) join Early Warning Services' filings unless it solely concerns Petitioner; 2) not raise any new grounds or arguments; 3) be bound by any discovery agreements; and 4) not seek additional discovery beyond that permitted in 37 C.F.R. § 42.53.[9] Mot. 8–9. In view of those concessions, we find that joinder would not add to the complexity of briefing or discovery.

Patent Owner has filed two mandatory notices and a power of attorney in this proceeding. *See* Papers 4, 5, 6. The optional preliminary response was due in this proceeding on September 22, 2022, three-months after the Petition's accorded filing date. *See* 35 U.S.C. § 323; 37 C.F.R. § 42.207. Although Patent Owner has not substantively responded to the instant Petition or Motion for Joinder, Patent Owner did, however, file a preliminary response and sur-reply in PGR 031. *See* PGR 031, Papers 12, 17. We take note that Patent Owner's lead counsel in PGR 031, which is the same lead counsel identified in the instant proceeding, has sought to withdraw from representation in PGR 031. *See* PGR 031, Paper 27 (pending motion to withdraw); Ex. 1089 (transcript of teleconference explaining the reasons for counsel's motion to withdraw). On this record, we are directed to no reason why the pendency of lead counsel's motion to withdraw in PGR 031 tips the scales against a grant of the request for joinder.

The Board finds that consolidation of these proceedings should simplify the post-grant review process for the Board and the parties, including Patent Owner. Instead of responding in multiple proceedings that involve essentially the same petitions, joinder would allow both Petitioners and Patent Owner to focus on one proceeding.

[9] In the joined proceeding, Petitioner similarly shall be bound by the provisions of 37 C.F.R. § 42.224.

Thus, we find that joinder is warranted under 35 U.S.C. § 325(c). In reaching that decision, the Board recognizes that Patent Owner's lack of meaningful communication with its counsel may explain why Patent Owner did not file a response to Petitioner's Motion for Joinder or the instant Petition. *See* PGR 031, Ex. 1089, 6:7–14. However, even if Patent Owner had responded to those papers in the instant proceeding, joinder would be warranted for the reasons discussed above.

Accordingly, we *grant* Petitioner's Motion for Joinder.

III. ORDER

It is

ORDERED that, pursuant to 35 U.S.C. § 324, we institute a post-grant review of the '702 patent claim based on the grounds raised in the Petition;

FURTHER ORDERED that the Motion for Joinder with PGR2022-00031 is *granted*, and Petitioner is joined as a petitioner to PGR2022-00031;

FURTHER ORDERED that Petitioner's role shall be limited as stated by Petitioner in the Motion for Joinder;

FURTHER ORDERED that the case caption in PGR2022-00031 shall be changed to reflect joinder of Samsung, Electronics Co., Ltd. as a petitioner in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of PGR2022-00031.

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[Example Case Caption]

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Patent D930,702 S

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