

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: David Wyatt
U.S. Patent No.: 11,328,286 Attorney Docket No.: 39843-0147PS1/PS2
Issue Date: May 10, 2022
Appl. Serial No.: 16/854,829
Filing Date: April 21, 2020
Title: MULTI-FUNCTION ELECTRONIC PAYMENT CARD AND
DEVICE SYSTEM

Mail Stop Patent Board

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PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR POST-GRANT REVIEW OF
U.S. PATENT NO. 11,328,286

Petitioner is filing two petitions (PGR2023-00012 and PGR2023-00013) challenging U.S. Patent No. 11,328,286 (the “**’286 Patent**”).

I. Ranking of Petitions

Both petitions are meritorious and justified, particularly in view of their complementary nature, with one presenting prior art based grounds under § 103 and the other challenging claims under §§ 101 & 112. Petitioner has filed two PGR petitions due to the strict estoppel provisions of 35 U.S.C. § 325(e)(2), which bars Petitioner from challenging any of the Challenged Claims in another proceeding based “on any ground that the petitioner raised or reasonably could have raised during that post-grant review.” Although Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Asserted Grounds
1	PGR2023-00012	§ 103
2	PGR2023-00013	§§ 101 & 112

II. Material Differences that Compel Permitting Multiple Petitions

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” TPG, 59. One of the examples provided by the Board for justifying the institution of multiple petitions is “when the patent owner has asserted a large number of claims in litigation.” *Id.* In these proceedings, not only has the Patent Owner asserted all 27 claims of the ’286

Patent, but the claims are long, with multiple wordy limitations, and generally include distinct limitations that are required to be addressed individually with respect to the cited prior art references. SAMSUNG-1105, 4; SAMSUNG-1001, claims 1-27.

Furthermore, as addressed in both Petitions, the '286 Patent is an AIA patent that issued less than nine months prior to the filing dates of the Petitions.

Therefore, *Inter Partes* Review (IPR) is unavailable with respect to the '286 Patent and Post Grant Review (PGR) is the only available avenue for challenging the claims of the '286 Patent before the PTAB. Unlike IPR, which allows claims to be challenged based only on printed publication prior art, PGR allows claims to be challenged under §§ 101 and 112 in addition to prior art based challenges under §§ 102 and 103. 35 U.S.C. §§ 321(b), 282(b). As mentioned above, 35 U.S.C. § 325(e)(2) bars Petitioner from challenging any of the Challenged Claims in another proceeding based “on any ground that the petitioner raised or reasonably could have raised during that post-grant review” if one of the PGR Petitions reaches a Final Written Decision. Therefore, Petitioner is compelled to pursue all available arguments under §§ 101, 102, 103, and 112 before the PTAB due to the estoppel that would prevent pursuing such grounds in another forum should at least one of the current PGR Petitions reach Final Written Decision. If Petitioner did not file the two present Petitions to advance challenges to the asserted claims under §§

101, 103, and 112 at this time, Petitioner would be foreclosed from making the additional arguments that would not fit into a single petition (due to the number and length of asserted claims) in any forum should the PTAB reach a Final Written Decision on just one Petition of the Petitions. Petitioner should have the right to justly and efficiently pursue all available defenses against CardWare's assertion of the '286 patent.

Petitioner's two petitions are materially different because they assert different sets of grounds under different statutory provisions (Petition 1 asserting §103 grounds; Petition 2 asserting §§ 101 and 112 grounds). As mentioned above, Patent Owner has asserted all 27 claims of the '286 Patent. SAMSUNG-1105, 4. The large number of asserted claims along with the estoppel provisions of PGR require the filing of two Petitions to allow Petitioner to raise all available invalidity arguments. The current Petitions are far from the "abuse" or "repeated attacks" feared in the *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha* decision. IPR2016-01357, Paper 19 at 16–17 (PTAB Sept. 6, 2017) (precedential). Rather than presenting duplicative or redundant arguments, the two petitions pursue separate grounds under distinct statutory provisions. The two Petitions here are thus highly similar to those filed in *Samsung Elec. Co. LTD. v. Nucurrent, Inc.* in which the Board instituted both petitions in a situation in which a large number of claims were asserted and one petition challenged the claims on prior art grounds

under § 103 while the other petition presented challenges under § 112. PGR2019-00049, Paper 7 (PTAB Dec. 4, 2019); PGR2019-00050, Paper 8 (PTAB Dec. 4, 2019). Indeed, just as in *Samsung v. Nucurrent*, here the PGR2023-00012 Petition relies on a single primary reference (Smith, SAMSUNG-1004) for all of the presented § 103 obviousness grounds. The present situation is therefore substantially dissimilar to situations in which a Petitioner attempts to take multiple bites at the apple by presenting duplicative prior art based grounds relying on myriad different primary references.

Additionally, the strong merits justify institution of both PGR Petitions. The prior art combination presented in Petition 1 are strong, and notably, as outlined in Petition 2, the § 101 ground aligns closely with Federal Circuit cases that addressed substantially similar technology and found that technology unpatentable under § 101. Efficiencies and public policy concerns warrant PTAB consideration of both Petitions.

To ensure Petitioner gets a fair and complete opportunity to challenge the '286 Patent's validity under all available statutory grounds (§§ 101, 103, and 112), Petitioner requests institution of both PGR petitions. Institution of both PGR petitions would prevent the unjust result of otherwise strong invalidity grounds being dismissed for procedural reasons. In addition, Petitioner requests

consolidation of the two proceedings, as permitted by 35 U.S.C. §§ 315(d) and 325(d) to simplify the complexity of the proceedings.

This is not a situation where Petitioner has filed many IPR petitions against one patent or is asserting dozens of independent grounds. Rather, Petitioner has filed only two petitions, each under different statutory provisions, and has advanced prior art grounds based on a single primary reference. Given the number of claims asserted in litigation by Patent Owner, instituting two petitions is reasonable.

For at least these reasons, Petitioner requests that the Board institute trial on both Petitions.

Respectfully submitted,

Dated: January 20, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on January 20, 2023, a complete and entire copy of this Notice Ranking Petitions was provided by Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

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