

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASSA ABLOY AB, ASSA ABLOY Inc.,
ASSA ABLOY Residential Group, Inc., August Home, Inc., HID Global
Corporation,
Petitioners,

v.

CPC Patent Technologies PTY LTD.,
Patent Owner.

Case No. IPR2022-01045
Patent No. 9,269,208

**PETITIONERS' RANKING AND EXPLANATION FOR
TWO PETITIONS CHALLENGING U.S. PATENT NO. 9,269,208**

Pursuant to the Consolidated Trial Practice Guide, ASSA ABLOY AB, ASSA ABLOY Inc., ASSA ABLOY Residential Group, Inc., August Home, Inc., and HID Global Corporation (collectively, “Petitioners”) rank, and explain the need to file, two Petitions challenging the claims in U.S. Patent No. 9,269,208 (“the ’208 Patent”).

II. RANKING OF PETITIONS

Rank	Petition	Grounds
1	IPR2022-01045 (“-045 Petition”)	Ground 1: Obviousness of Claims 1, 3-5, and 9 based on Bianco as modified by Mathiassen Ground 2: Obviousness of Claims 2 and 6-7 based on Bianco , Mathiassen, and Houvener Ground 3: Obviousness of Claim 8 based on Bianco , Mathiassen, Houvener, and Richmond
2	IPR2022-01089 (“-089 Petition”)	Ground 1: Obviousness of Claims 10-13 based on Bianco as modified by Mathiassen

III. MATERIAL DIFFERENCES BETWEEN THE PETITIONS

Petitioners are concurrently filing two petitions that together challenge *all claims* (claims 1-13) of the ’208 patent. There is *no overlap* in claims between the two petitions. The same claims are included in a declaratory judgment action between Petitioners and CPC Patent Technologies Pty Ltd. (“Patent Owner”). *ASSA ABLOY AB, et al. v. CPC Patent Technologies Pty Ltd., et al.*, No. 3-22-cv-

00694 (D. Ct.); *see also* EX-1020.¹ If the Board were to institute one petition and discretionarily deny the other, the parties would likely be forced to address the same grounds for unpatentability in District Court, which would be highly inefficient. Petitioners submit that *two petitions are necessary* to address each of the claims and their *lengthy claim recitations*, including *numerous means-plus-function limitations*, some of which were construed in district court proceedings between Patent Owner and third parties. This complexity required splitting the challenged claims into two groups, each addressed in one of the instant petitions.

A. The Petitions Together Address Thirteen Lengthy Claims with Multiple Means-Plus-Function Limitations

The challenged claims recite nearly twenty means-plus-function limitations related to biometric authentication and secure access. For example, the means-plus-function limitations *in independent claim 1 alone* include: (1) **means for matching** biometric signals against a database, (2) **means for emitting** a secure access signal, (3) **means for receiving** the transmitted secure access signal, (4)

¹ The '208 Patent was also asserted against Apple, Inc. in *CPC Patent Technologies Pty Ltd v. Apple Inc.*, No. 5:22-cv-02553-NC (N.D. Cal.), and against *HMD Global in CPC Patent Technologies Pty Ltd v. HMD Global Oy*, WDTX-6-21-cv-00166-ADA. Petitioners understand that Patent Owner dropped its assertions of the '208 Patent against both Apple and HMD Global, but did so without prejudice.

means for providing conditional access, (5) **means for populating** the data base of biometric signatures, (6) **means for mapping** said series into an instruction, and (7) **means for populating** the data base according to the instruction. EX-1007, Cl. 1. There are also other lengthy limitations in claim 1, which spans nearly 30 lines.

All other **independent claims** also include permutations of long means-plus-function limitations (*see* EX-1007, Cls. 1, 9, 10) that needed to be construed.

Further complicating the analysis, in two separate district court cases, Judge Albright (WDTX) construed seven means-plus-function limitations from the challenged claims. These constructions have been addressed in the petitions.

Petitioners have done their best to streamline the analysis, but are unable to address all of the lengthy claims and constructions in conjunction with the asserted grounds of unpatentability within the allotted 14,000 words per petition.

B. The Petitions are Non-Cumulative and Consistent with Board Guidance and Precedent.

By challenging all claims in the ‘208 Patent, Petitioners have attempted to reduce the overall burden and avoid inefficient use of the Board’s and the district court resources. The Board’s Consolidated Trial Practice Guide (at page 59) recognizes that petitioners may be justified in bringing multiple petitions against a single patent “when the patent owner has asserted a large number of claims”.

Patent Owner has previously asserted many of the challenged claims against Apple and HMD Global, and is expected to do the same against Petitioners. *See* Ex-1020.

Both petitions are necessary because each challenges distinct independent claims and their dependent claims—an approach that was driven by word limits. *See Intel Corp. v. VLSI Technology LLC*, IPR2019-01199, Paper 19 at 10 (Feb. 6, 2020) (declining to exercise discretion to deny petitions where “Petitioner contends each petition is necessary...because each petition is directed to a different independent claim.”); *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 14 (“Faced with word count limitations and a large number of challenged claims, Petitioner’s decision to divide its analysis of those claims among a number of petitions appears reasonable.”). The Board has also found multiple petitions against a single patent appropriate where, as here, the petitions rely on the same prior art. *See, e.g., IPA Technologies, Inc.*, IPR2019-00810 Paper 12 at 11-16 (Oct. 16, 2019). The Board has observed that “any duplication of effort that may place unnecessary burdens on the parties and the Board may be avoided or reduced by consolidating the instituted IPRs (if institution of review is granted in more than one proceeding), including consolidating the parties’ briefing, motion practice, and the oral hearings. *Id.* at 15; *see also Seven Networks, LLC*, IPR2020-00156, Paper 10 at 26 (“By asserting overlapping prior art under the present circumstances, Petitioner challenges the claims across the two petitions in a manner that does not present an undue burden on the Board or parties.”). Because the same grounds of unpatentability are raised in both of Petitioners’ two petitions (although against

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