

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, and ASSA ABLOY Global Solutions, Inc.,
Petitioners,

v.

CPC Patent Technologies PTY LTD.,
Patent Owner.

Case No. IPR2022-01094
Patent No. 8,620,039

**PETITIONERS' RANKING AND EXPLANATION FOR
TWO PETITIONS CHALLENGING U.S. PATENT NO. 8,620,039**

Pursuant to the Consolidated Trial Practice Guide, ASSA ABLOY AB, ASSA ABLOY Inc., ASSA ABLOY Residential Group, Inc., August Home, Inc., HID Global Corporation, and ASSA ABLOY Global Solutions, Inc., (collectively, “Petitioners”) rank, and explain the need to file, two Petitions challenging the claims in U.S. Patent No. 8,620,039 (“the ’039 Patent”).

II. RANKING OF PETITIONS

Rank #1: IPR2022-01093	Rank #2: IPR2022-01094
<p>Ground 1: Obviousness of Claims 1, 2, 13, 14, 19, and 20 based on Hsu and Sanford</p> <p>Ground 2: Obviousness of Claims 1, 2, 13, 14, 19, and 20 based on Hsu, Sanford, and Tsukamura</p>	<p>Ground 1: Obviousness of Claims 3, 4, 6-11, 15, 16, and 18 based on Sanford and Hsu</p> <p>Ground 2: Obviousness of Claims 3, 4, 6-11, 15, 16, and 18 based on Sanford, Hsu, and Tsukamura</p> <p>Ground 3: Obviousness of Claim 5 based on Sanford, Hsu, and Leu</p> <p>Ground 4: Obviousness of Claim 5 based on Sanford, Hsu, Tsukamura, and Leu</p> <p>Ground 5: Obviousness of Claim 12 based on Sanford, Hsu, and Houvener</p> <p>Ground 6: Obviousness of Claim 12 based on Sanford, Hsu, Tsukamura, and Houvener</p> <p>Ground 7: Obviousness of Claim 17 based on Sanford, Hsu, and McCalley</p> <p>Ground 8: Obviousness of Claim 17 based on Sanford, Hsu, Tsukamura, and McCalley</p>

III. MATERIAL DIFFERENCES BETWEEN THE PETITIONS

Petitioners are concurrently filing two petitions that together challenge *all claims* (claims 1-20) of the ’039 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.).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 Twenty Lengthy Claims with Multiple Means-Plus-Function Limitations

The challenged claims recite twenty means-plus-function limitations related to biometric authentication and card devices. For example, *independent claim 15 alone* requires: “[1] means for determining if the provided card information has been previously provided...; [2] means... for: storing the inputted biometric signature in a memory...; [3] means... for: performing the process dependent upon

¹ The ’039 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.).

the received card information; [4] means... for: comparing the inputted biometric signature...; [5] means... for...performing the process dependent upon the received card information; and [6] means... for...not performing the process dependent upon the received card information.” EX-1001, Cl. 15.

Four out of the **six independent claims** include permutations of long means-plus-function limitations (*see* EX-1001, Cls. 13, 15, 18, and 19) that needed to be construed. Further, the remaining claims are lengthy and include numerous discrete subparts. *See id.* at Cl. 3 (nearly 30 lines long). Further complicating the analysis, Judge Albright (WDTX) construed two means-plus-function limitations from the challenged claims. These constructions have been addressed in the petitions. Petitioners are unable to address all of the lengthy claims, numerous constructions, and present the asserted grounds within the allotted word limit.

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

By challenging all claims in the ‘039 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 is expected to do the same against Petitioners. *See* Ex-1016.

Both petitions are necessary because each challenges distinct independent claims and their dependent claims²—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

² Although the petitions include overlapping prior art, they use different primary references based on differences between the independent claims in each petition.

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