UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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JPMORGAN CHASE BANK, N.A.,
Petitioner,

v.

DYNAPASS IP HOLDINGS LLC,
Patent Owner.

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IPR2023-01331
Patent 6,993,658 B2

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Before KEVIN F. TURNER, KRISTEN L. DROESCH, and
LYNNE H. BROWNE, *Administrative Patent Judges.*

BROWNE, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. 42.122

I.   INTRODUCTION

A.   Background

On August 16, 2023, JPMorgan Chase Bank, N.A. ("Petitioner") filed a Petition (Paper 1, "Pet." or "Petition") requesting an *inter partes* review of claims 1 and 3–6 of U.S. Patent No. 6,993,658 (Ex. 1001, "the '658 patent"). Concurrently, Petitioner filed a Motion for Joinder seeking to be joined as a party to *Unified Patents, LLC v. Dynapass IP Holdings LLC*, IPR2023-00425 ("the Unified Patents IPR"). Paper 2 ("Mot."). Dynapass IP Holdings, LLC ("Patent Owner") has not filed a Preliminary Response to the Petition. We have authority and jurisdiction under 35 U.S.C. §§ 6, 314 and 37 C.F.R. § 42.4.

For the reasons discussed below, we determine institution of *inter partes* review is warranted on the same grounds instituted in the Unified Patents IPR, and grant Petitioner's Motion for Joinder.

B.   Real Parties in Interest

Petitioner identifies itself as the real party-in-interest in this proceeding. Pet. 76. Patent Owner identifies itself as the real party-in-interest. Paper 5, 1.

C.   Related Matters

The parties identify *Dynapass IP Holdings LLC v. JPMorgan Chase & Co., JPMorgan Chase Bank, National Association, and Chase Bank USA National Association*, 2:22-cv-00212 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Bank of America Corporation*, 2:22-cv-00210 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. BOKF, National Association*, 2:22-cv-00211 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. PlainsCapital Bank*, 2:22-cv-00213 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. PNC Financial Services*, 2:22-cv-00214 (EDTX 6-17-2022), *Dynapass IP*

Holdings LLC v. Regions Financial Corporation, 2:22-cv-00215 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Truist Financial Corporation*, 2:22-cv-00216 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Wells Fargo & Company*, 2:22-cv-00217 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Woodforest National Bank*, 2:22-cv-00218 (EDTX 6-17-2022), *Dynapass Inc. v. Mobile Authentication Corporation*, 8:18-cv-01173 (CDCA 7-3-2018), *Dynapass IP Holdings LLC v. Amazon.com, Inc.*, 2:23-cv-00063 (EDTX 2-20-2023), *Dynapass IP Holdings LLC v. The Charles Schwab Corporation et al.*, 2:23-cv-00064 (EDTX 2-20-2023), *Dynapass IP Holdings LLC v. East West Bancorp, Inc. et al.*, 2:23- cv-00065 (EDTX 2-20-2023) (voluntarily dismissed), *Dynapass IP Holdings LLC v. Experian Information Services, Inc.*, 2:23-cv-00066 (EDTX 2-20-2023), *Dynapass IP Holdings LLC v. First Citizens Bancshares, Inc. et al.*, 2:23-cv-00067 (EDTX 2-20-2023) (voluntarily dismissed), and *Dynapass IP Holdings LLC v. Simmons First National Corporation et al.*, 2:23-cv-00068 (EDTX 2-20-2023) as civil litigations involving the '658 patent. Pet. 76–77; Paper 5, 1–3.

The parties also identify *Unified Patents, LLC v. Dynapass IP Holdings LLC*, IPR2023-00425 (PTAB) as a proceeding involving the '658 patent. Pet. 78; Paper 5, 3. Petitioner also identifies *Bank of America, N.A. et al. v. Dynapass IP Holdings*, IPR2023-00367 (PTAB) (denied) as a proceeding involving the '658 patent. Pet. 78.

D.   *The '658 patent*

The '658 patent is titled "Use of Personal Communication Devices For User Authentication." Ex. 1001, code (54). The invention "relates generally to the authentication of users of secure systems and, more particularly, the invention relates to a system through which user tokens

required for user authentication are supplied through personal communication devices such as mobile telephones and pagers." *Id.* at 1:7–11.

One embodiment of the invention provides a password setting system that includes a user token server and a communication module wherein a user token server generates a random token in response to a request for a new password from a user. Ex. 1001, 1:63–2:2. "The server creates a new password by concatenating a secret passcode that is known to the user with the token" and "sets the password associated with the user's user ID to be the new password." *Id.* at 2:2–6. A "communication module transmits the token to a personal communication device, such as a mobile phone or a pager carried by the user." *Id.* at 2:6–8. Then, the user concatenates the secret passcode with the received token in order to form a valid password, which the user submits to gain access to the secure system. *Id.* at 2:8–11.

Figure, reproduced below, "illustrates an overview, including system components, of a user authentication system 100 according to a preferred embodiment of the present invention." Ex. 1001, 4:2–4.

FIG. 1
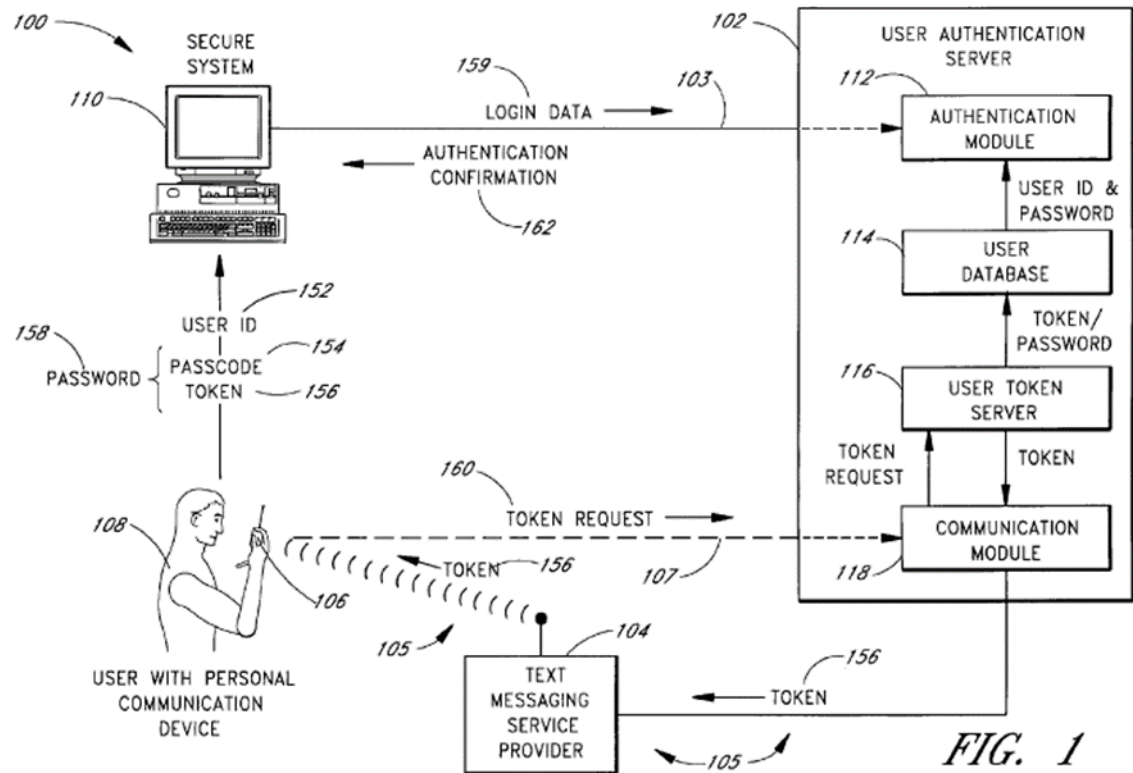
User authentication system 100 includes authentication Server 102, text messaging Service provider 104, personal communication device 106 carried by user 108, and secure system 110 to which the authentication system 100 regulates access. *Id.* at 4:9–13. "[P]ersonal communication device 106 is preferably a pager or a mobile phone having SMS (short message Service) receive capability." *Id.* at 4:13–15. Secure system 110 can be "any system, device, account, or area to which it is desired to limit access to authenticated users." *Id.* at 4:18–20.

User authentication server 102 is configured to require that user 108 supply authentication information through secure system 110 in order to gain access to secure system 110. Ex. 1001, 4:32–35. Authentication information provided by the user includes user ID 152, passcode 154 and user token 156. *Id.* at 4:36–37. User ID 152 may be publicly known and used to identify the user and passcode 154 is secret and only known to the

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