

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC, and JPMORGAN CHASE BANK, N.A.  
Petitioner,

v.

DYNAPASS IP HOLDINGS LLC,  
Patent Owner.

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IPR2023-00425<sup>1</sup>  
Patent 6,993,658 B1

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Before KEVIN F. TURNER, LYNNE H. BROWNE, and  
JASON M. REPKO, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

ORDER  
Conduct of Proceeding  
37 C.F.R. § 42.5

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<sup>1</sup> JPMorgan Chase Bank N.A. was joined as a party to this proceeding via Motion for Joinder in IPR2023-01331.

## I. INTRODUCTION

Oral argument for the above-referenced proceeding was heard on April 16, 2024. During the presentation of its case in chief, counsel for Petitioner referred to a position taken by Patent Owner in its infringement contentions in district court litigation.

## II. DISCUSSION

The infringement contentions referred to by Petitioner are not of record in this proceeding. The Board questioned whether this issue was properly raised and what, if any weight, the Board should give to the referenced infringement contentions. Petitioner asserted that the issue was properly raised because it had only recently learned about the infringement contentions and was not able to raise the issue prior to oral argument. Patent Owner responded that the infringement contentions were publicly available and had been available since December, 2023.

The Board queried the parties as to whether they would like additional briefing on this issue. Petitioner did not oppose additional briefing, but indicated that it did not think it was necessary. Patent Owner opposed additional briefing. We, however, cannot ignore the fact that new evidence was introduced during oral argument. For that reason, we require additional briefing on two questions: 1) is it too late for Petitioner to file a copy of the infringement contentions argued at oral argument; and 2) if the infringement contentions are allowed to be entered, what, if any, weight should we give to a position taken by Patent Owner in a different, albeit related, proceeding (i.e., district court litigation). A copy of the infringement contentions should accompany Petitioner's brief, as an exhibit and for purposes of discussion, but will be expunged from the record if the panel deems that no

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consideration will be given the infringement contentions. No additional evidence or exhibits should accompany the briefs.

### III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that by April 24, 2024, Petitioner shall file its brief addressing the questions outlined above, not to exceed 3 pages; and

FURTHER ORDERED that by May 1, 2024, Patent Owner shall file its brief in response to Petitioner's brief, not to exceed 3 pages.

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