UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

DYNAPASS IP HOLDINGS LLC,
Patent Owner.

IPR2023-00425[1]
Patent 6,993,658

PETITIONER'S SUPPLEMENTAL BRIEFING PURSUANT TO PAPER 27

[1] JPMorgan Chase Bank N.A. was joined as a party to this proceeding via Motion for Joinder in IPR2023-01331.

Pursuant to the Board's Order (Paper 27) for additional briefing, Unified submits (1) the Board may consider a party's inconsistent positions from a different venue at the oral argument state of this proceeding; and (2) PO's contradictory statements should be given significant weight.

1. It is not too late for the Board to consider PO's contradictory position

The Board has broad discretion as to the conduct of the proceeding, including for issues not specifically addressed by the rules, and may waive or suspend a requirement and place conditions on the waiver or suspension. 37 C.F.R. §§ 42.5(a) and (b). Here, PO's noncompliance with mandatory discovery (Rule 42.51(b)(1)(iii)) and duty of candor to the PTAB led to Unified identifying PO's inconsistent position during the oral hearing. Thus, the Board should exercise its discretion and/or waive the prohibition of new evidence in order to serve the interests of justice.

Unified is not a party to the district court litigations (16 filed, Paper 11), and was not immediately aware of PO's inconsistent position. PO did not serve the amended infringement contentions (Ex. 1026) containing the contradictory position when it filed its sur-reply (Paper 18) or inform the Board of the inconsistency. That an opposing party filed Ex. 1026 in district court did not relieve PO of its mandatory disclosure and duty of candor to the PTAB. Unified's reference to PO's "nose of wax" infringement position at the hearing was the result of PO's failure to comply with the Board's rules, which should not be rewarded by exclusion of Ex. 1026.

While there is a general prohibition of the introduction of "new evidence" at the hearing, it is intended to prevent prejudice to an opposing party having to confront actual new evidence without a chance to respond, and not to insulate a party from its own contrary positions and obligations. The Board can and should waive this rule under the present circumstances. *See Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364, 1369-70 (Fed. Cir. 2018) (confirming that the Board can exercise its waiver authority under 37 C.F.R. § 42.5(b) for new arguments at oral hearing.) A strict time-based prohibition on the consideration of inconsistent positions would invite gamesmanship, and would be contrary to the interests of justice especially when PO failed to serve Unified or inform the Board of the inconsistency. PO cannot claim prejudice by the Board's consideration of Ex. 1026, or feign surprise or ignorance of its own positions. Further, PO has the opportunity to address its own position through the additional briefing. Thus, the Board can and should consider Ex. 1026.

2. Exhibit 1026 should be given significant weight

Ex. 1026 should be afforded significant weight because it refutes PO's arguments and discredits its expert's verbatim assertions, while supporting Kew's disclosure of the claimed "passcode" of limitation [5.3]. In this proceeding, PO argues that the claimed "passcode" is (1) not a username ("The "actual name or PIN" are used to identify the user's "identity code," **like a username**, not as part of a password.") PO Response at 46, Ex. 2003, ¶113; and (2) not information that

references or is an alias to the username ("Kew's 'user identification code' is used to lookup, within a database, the appropriate 'identity code.'") Sur-reply, at 18. However, after the response and prior to the sur-reply, PO stated in the district court proceeding that the "passcode" is met by "the passcode (e.g., the password that the user uses for login or other information that is known to the user, such as **the username or information that references or is an alias to the username**)." Ex. 1026, 12, 18. PO also asserted that a session ID met the claimed passcode because "the … session ID **corresponds to the username**, which is known to the user, and the session ID is used for the **same purpose of authenticating the user**." *Id.*, 24. When filing the sur-reply, PO had the chance to either retract the previous arguments or distinguish its position in Ex. 1026. PO did neither, violating its duty of candor and tarnishing its expert's credibility.

Ex. 1026 supports Unified's position that a "POSITA would have understood that the "corresponding identity code" is linked with the user ID such that the user ID (known to the user) is necessary to identify the identity code in instances when they are not the same." Reply, 13. That is, the user ID and identity code are "the username or information that references or is an alias to the username," and/or the identity code "corresponds to the username" and "authenticat[es] the user."

Given this non-disclosure and violation of duty of candor, appropriate sanctions should also be considered. 87 Fed. Reg. 45,764, 45,765 (July 29, 2022).

Dated: April 24, 2024

Respectfully Submitted,

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