

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

DYNAPASS IP HOLDINGS LLC,
Patent Owner.

IPR2023-00425
Patent 6,993,658 B1

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

BROWNE, *Administrative Patent Judge*.

DECISION
Final Written Decision
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 314

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner, Unified Patents, LLC has shown by a preponderance of the evidence that claim 5 of U.S. Patent No. 6,993,658 B1 (Ex. 1001, “the ’658 Patent”) is unpatentable and has not shown by a preponderance of the evidence that claims 1, 3, 4, and 6 are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

A. Procedural History

The Petition (Paper 1, “Pet.” or “Petition”) requested *inter partes* review of claims 1 and 3–6 of the ’658 Patent. Patent Owner, Dynapass IP Holdings, LLC, filed a Preliminary Response. Paper 8. Based upon the record at that time, we instituted *inter partes* review on all challenged claims on the grounds presented in the Petition. Paper 9.

After institution, Patent Owner filed a Response (Paper 13, “PO Resp.”), Petitioner filed a Reply (Paper 16, “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 19, “PO Sur-reply”).

On April 16, 2024, an oral hearing was held. The transcript of this hearing was entered in the record of this proceeding as Paper 31 (“Tr.”). During the oral hearing, Petitioner, for the first time, asserted that Patent Owner

filed amended infringement contentions in one of the corresponding District Court cases . . . which alleged that infringement of the claim passcode limitation is met by the password that the user uses for login or other information that is known to the user, such as the username or in termination that references or is an alias to the username.

Tr. 12.

On April 17, 2024, we ordered 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). Paper 27 (“Order”). Petitioner filed a Supplemental Brief (Paper 28, “Pet. Supp.”), and Patent Owner filed a Response (Paper 30, “PO Resp. to Supp.”).

B. Real Parties in Interest

Petitioner identifies itself, Unified Patents, LLC, as the only real party-in-interest. Pet. 79. Patent Owner identifies itself, Dynapass IP Holdings LLC and DynaPass Inc., as the only real parties-in-interest. Paper 3, 1.

C. Related Matters

The parties identify the following as related district court matters: *Dynapass IP Holdings LLC v. Regions Financial Corporation*, 2:22-cv-00215 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. JPMorgan Chase & Co.*, 2:22-cv-00212 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. PlainsCapital Bank*, 2:22-cv-00213 (EDTX 6-17-2022), *Dynapass IP Holdings LLC v. Woodforest National Bank*, 2:22-cv-00218 (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. Wells Fargo & Company*, 2:22-cv-00217 (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. PNC Financial Services*, 2:22-cv-00214

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(EDTX 6-17-2022), *Dynapass IP Holdings LLC v. BOKF, National Association*, 2:22-cv-00211 (EDTX 6-17-2022), *Dynapass Inc. v. Mobile Authentication Corporation*, 8:18-cv-01173 (C.D. Cal. 7-3-2018). Pet. 80–81; Paper 3, 1–2.

Patent Owner also identifies *Bank of America, N.A. v. Dynapass IP Holdings LLC*, IPR2023-00367 (filed January 3, 2022) as a related matter. Paper 3, 2.

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.

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