

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent of: Scott MacDonald Ward  
U.S. Patent No.: 10,992,480  
Issue Date: April 27, 2021  
Appl. Serial No.: 16/597,773  
Filing Date: October 9, 2019  
Title: METHOD AND SYSTEM FOR PERFORMING A  
TRANSACTION AND FOR PERFORMING A  
VERIFICATION OF LEGITIMATE ACCESS TO, OR USE OF  
DIGITAL DATA

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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL  
DIFFERENCES BETWEEN PETITIONS FOR POST-GRANT REVIEW  
AND *INTER PARTES* REVIEW OF U.S. PATENT NO. 10,992,480**

Petitioner is filing two petitions (PGR2022-00007 and IPR2022-00113) challenging U.S. Patent No. 10,992,480 (the “**’480 Patent**”).

## **I. Ranking of Petitions**

Both petitions are meritorious and justified, particularly in view of their complementary nature, with each presenting the same prior art grounds. Petitioner has pursued both types of petitions to ensure consideration of the merits of these grounds, regardless of whether Patent Owner’s unwarranted priority claim is deemed valid. Indeed, Petitioner seeks institution of both petitions for reasons discussed below, including the benefit of proceeding without fully resolving this issue based on an undeveloped pre-institution record, given the highly factual nature of priority and the benefits of a full factual record yielded through trial. Still, to comply with the rules, Petitioner provides the following ranking:

| <b>Rank</b> | <b>Petition</b> | <b>Asserted Grounds</b> |
|-------------|-----------------|-------------------------|
| <b>1</b>    | PGR2022-00007   | §§ 112 and 103          |
| <b>2</b>    | IPR2022-00113   | § 103                   |

## **II. Material Differences Between the Petitions**

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” TPG, 59. One of the examples provided by the Board for justifying the institution of multiple petitions is a “dispute about priority date.” *Id.* In these proceedings, the priority date accorded to the ’480 Patent will be disputed, as it is directly related to whether the ’480 Patent claims

are invalid under 35 U.S.C. § 112. Although the dispute about priority date does not require assertion of different sets of prior art references, the dispute impacts whether PGR or IPR is the appropriate tool for challenging the '480 Patent. Due to the priority dispute, which will continue past institution should the Board preliminarily agree with the written description arguments set forth in PGR2022-00007, institution and consolidation of PGR and IPR proceedings is justified to ensure that Petitioner has a fair and reasonable opportunity to challenge the validity of the '480 Patent through the Board's final written decision.

Petitioner's two petitions are materially different because (1) they assert a different set of grounds (Petition 1 asserting 112 and 103 grounds; Petition 2 asserting 103 grounds only), and (2) they are different types of petitions subject to different statutory requirements (Petition 1 is a PGR petition subject to 35 U.S.C. §§321-329 requirements; Petition 2 is an IPR petition subject to 35 U.S.C. §§311-319 requirements). As explained in Petition 1, although the '480 Patent was filed as a continuation application, the '480 Patent should not be eligible to claim priority to earlier-filed applications in its family because the claims that ultimately issued in the '480 Patent do not have written description support in the '480 Patent or any of the earlier filed applications. *See* PGR2022-00007, 10-34.

Petitioner recognizes that the Board will make an initial assessment of the written description arguments and the related priority dispute at the time of

institution. The Board's preliminary assessment and decision at the time of institution has a direct impact on whether PGR or IPR is appropriate. While the '480 patent clearly lacks written description support for its claims thus warranting PGR institution and a final finding of invalidity on that basis, at the time of institution, the Board's assessment is *preliminary* and may *change* post-institution. Because the decision on whether the '480 Patent is eligible for PGR or IPR will necessarily continue through final written decision should the Board preliminarily agree with the written description arguments set forth in PGR2022-00007, institution of both petitions is necessary to ensure Petitioner's prior art grounds are properly considered through final written decision. Otherwise, Petitioner's prior art grounds may be unfairly dismissed for procedural reasons should the Board change its mind on PGR eligibility in a final written decision.

For example, consider a situation where, at the time of institution, the Board finds (1) it more likely than not that at least 1 of the claims challenged in the PGR is unpatentable under 35 U.S.C. § 112 (and thus is eligible for PGR review) and (2) that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged under 35 U.S.C. § 103. In this example, the Board could institute the PGR, but not the IPR, and consideration of Petitioner's written description arguments under 35 U.S.C. § 112 and Petitioner's prior art arguments under 35 U.S.C. § 103 would extend beyond institution through

the PGR final written decision. At the time of the final written decision, however, the Board could determine that the claims are unpatentable based on the prior art arguments under 35 U.S.C. § 103, but change its mind on the written description and priority issues (erroneously we respectfully submit) based on the record developed through trial. In this circumstance, the '480 Patent would not be eligible for PGR and Petitioner's otherwise valid prior art grounds may be dismissed for procedural reasons. This result would be unfair and against public interest.

To avoid such a result and to ensure Petitioner gets a fair and complete opportunity to challenge the '480 Patent's validity, Petitioner requests institution of both IPR and PGR petitions if the Board finds that the threshold requirements for institution of both IPR and PGR are met. Because the 35 U.S.C. § 103 grounds advanced in both petitions are identical, instituting both petitions will not impose any further burden on the Board or Patent Owner. In addition, Petitioner requests consolidation of the two proceedings, as permitted by 35 U.S.C. §§ 315(d) and 325(d), and a briefing schedule that matches the briefing schedule of a PGR alone. With these aspects, institution of both IPR and PGR would not increase the complexity of the proceedings beyond institution of a PGR alone and would prevent the unjust result of otherwise valid prior art grounds being dismissed for procedural reasons should the Board change its mind on PGR eligibility.

Further, nothing in the PGR and IPR statutes prevents institution of both types of proceedings against the same patent. Whereas other statutes prohibit the Board from instituting review (*see, e.g.*, 35 U.S.C. § 315(b)(“[a]n *inter partes* review **may not be instituted**”); 35 U.S.C. § 325(a)(“[a] post-grant review **may not be instituted** under this chapter”), the statutes related to PGR and IPR filing deadlines do not prohibit institution, but, instead, simply place requirements of petition filing dates that can be held in abeyance and evaluated post-institution.

Finally, the Board’s rules related to discretionary denial prevent Petitioner from taking a wait-and-see approach and dictate the need to file both PGR and IPR petitions concurrently. Specifically, Petitioner could wait the six months to gain the Board’s insight on its PGR petition before deciding whether to pursue an IPR petition since Petitioner would still be within its one year bar date. The *Fintiv* discretionary denial law, however, would likely prohibit such a strategy because a six-month advancement in the co-pending litigation would likely push an IPR filed six months from now beyond trial. Also, a subsequent IPR petition filed after denial of a PGR petition for lack of PGR eligibility would likely have issues under the Board’s *General Plastic* precedent, which discourages serial petition filings.

For at least these reasons, the Board’s discretionary denial case law has dictated the need to pursue simultaneous PGR and IPR petitions and Petitioner requests that the Board institute trial on both Petitions.

Respectfully submitted,

Dated: October 29, 2021

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## **CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on October 29, 2021, a complete and entire copy of this Notice Ranking Petitions was provided via Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

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