



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC.,  
Petitioner,

v.

MONUMENT PEAK VENTURES, LLC,  
Patent Owner.

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Case IPR2021-00330  
Patent 7,583,294 B2

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Before ANDREW HIRSHFELD, *Commissioner for Patents performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*, SCOTT R. BOALICK, *Chief Administrative Patent Judge*, and JACQUELINE WRIGHT BONILLA, *Deputy Chief Administrative Patent Judge*.

BOALICK, *Chief Administrative Patent Judge*.

DECISION

Granting Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*  
Denying Institution of *Inter Partes* Review  
*35 U.S.C. § 314(a)*

## I. INTRODUCTION

Toshiba America Electronic Components, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 5, 10, 11, and 19 (“the challenged claims”) of U.S. Patent No. 7,583,294 B2 (Ex. 1001, “the ’294 patent”). Paper 1 (“Pet.”). The Petition was accorded the filing date of December 21, 2020. Paper 4, 1. After receiving authorization, Petitioner filed a Motion to Correct Filing Date, requesting to change the filing date to December 16, 2020, in order to avoid a 35 U.S.C. § 315(b) time bar.<sup>1</sup> Paper 5 (“Mot.”), 1, 15. According to Petitioner, the Petition complied with all statutory and regulatory requirements in 35 U.S.C. § 312(a)(1) and 37 C.F.R. § 42.106(a) on December 16, 2020, in part because Petitioner paid the Petition filing fee via a wire transfer on December 16, 2020. Mot. 4–9.

Monument Peak Ventures, LLC (“Patent Owner”) filed an Opposition to Petitioner’s Motion to Correct Filing Date, arguing that Petitioner failed to show that the U.S. Patent and Trademark Office (“USPTO”) received the fee payment before December 18, 2020, pursuant to 37 C.F.R. § 42.103(b). Paper 6 (“Opp.”). Petitioner filed a Reply to the Opposition. Paper 7 (“Reply”). Subsequently, Patent Owner filed a Preliminary Response to the Petition, arguing that the Petition was time-barred under § 315(b), based on the Petition’s accorded filing date of December 21, 2020. Paper 8 (“Prelim. Resp.”).

On June 25, 2021, the Board, in a split decision, denied Petitioner’s Motion to Correct Filing Date and denied institution of an *inter partes*

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<sup>1</sup> Patent Owner served Petitioner with a complaint alleging infringement of the ’294 patent on December 17, 2019. Ex. 2001.

review. Paper 9 (“Decision” or “Dec.”). In so doing, the Board panel majority (“majority”) rejected Petitioner’s argument that Petitioner complied with the pertinent statutory and regulatory provisions regarding the filing fee before its statutory deadline under § 315(b). Dec. 6–14. The dissent would have found that the pertinent provisions were satisfied or, alternatively, would have found good cause to waive the applicable regulations under 37 C.F.R. §§ 42.5(b), 42.5(c)(3). *Id.* at 22–27.

On July 23, 2021, Petitioner requested rehearing and Precedential Opinion Panel (“POP”) review of the Decision. Paper 10; Ex. 3003. The POP ordered review on September 24, 2021, to address the following issue (“the POP issue”):

Does Fedwire confirmation of payment constitute sufficient evidence of payment under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103(a)?

Paper 13, 2 (citing Standard Operating Procedure 2<sup>2</sup>, 2, 3–7).

Petitioner and Patent Owner each filed a brief addressing the POP issue. Paper 14 (“Pet Br.”); Paper 15 (“PO Br.”). Each party also filed a response. Paper 16 (“Pet. Resp.”); Paper 17 (“PO Resp.”).

## II. BACKGROUND

### A. *Relevant Facts*

On December 17, 2019, Patent Owner served Petitioner with a district court complaint alleging infringement of the ’294 patent.<sup>3</sup> Ex. 2001.

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<sup>2</sup> Available at <https://go.usa.gov/xPMqx>.

<sup>3</sup> On August 12, 2020, the U.S. District Court for the Central District of California issued a decision finding the ’294 patent invalid under 35 U.S.C.

Nearly one year later, on December 16, 2020, Petitioner filed its Petition for *inter partes* review of the '294 patent, and all associated documents, via the Board's End to End ("PTAB E2E") filing system, and served Patent Owner with a copy of the Petition via email and Federal Express. Pet., Certificate of Service; Ex. 1019 ¶ 5; Ex. 1020.

Also on December 16, 2020, Petitioner initiated a wire payment of \$41,500 to "Treas[ury] NYC," the USPTO's designated bank, using the Federal Reserve Fedwire System ("Fedwire"). Ex. 1023. Upon doing so, Petitioner obtained a receipt from Wells Fargo, its bank, identifying the payment as "Completed" and indicating that Petitioner's wire transfer to Treasury NYC was "Successful" as of 2:46 pm ET on December 16, 2020. *Id.* (hereinafter, "Fedwire confirmation," see Mot. 6; Dec. 5, 8 (referring to Ex. 1023 as the "Fedwire confirmation")). A "Fedwire Detail Report" for Petitioner's wire transfer shows that Treasury NYC accepted Petitioner's wire transfer at 2:56 pm ET on December 16, 2020. Ex. 3002<sup>4</sup> (identifying "RECEIVER" as "TREAS NYC" and stating "ACCEPTANCE-DATE 1216" and "ACCEPTANCE-TIME 1456").

Later on December 16, 2020, Mr. Douglas F. Stewart, counsel for Petitioner, sent an email to the USPTO Receipts Accounting Division ("RAD") Helpdesk, indicating that his firm "wired \$41,500 to the USPTO's

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§ 101, and granting a motion to dismiss. Ex. 1012, 6–7, 10. The district court issued a final judgment on September 11, 2020, which Patent Owner appealed. Ex. 1013, 1–2; Ex. 1014. On December 13, 2021, the Federal Circuit entered a Rule 36 judgment affirming the district court decision. *Monument Peak Ventures, LLC v. Toshiba America Business Solutions*, No. 21-1052 (Fed. Cir. Dec. 13, 2021).

<sup>4</sup> Ex. 3002 is an internal USPTO document the Board entered as an exhibit.

account at Treasury NYC as payment for the inter partes review request and post-institution fees for case IPR2021-00330.” Ex. 1024 (emphasis omitted). Mr. Stewart attached Petitioner’s Fedwire confirmation to the email. *Id.* The USPTO RAD Helpdesk responded on the same day, indicating that it “ha[d] not yet received the wire in the amount of \$41,500.00,” and that “[t]he wire will be processed when it’s received.” Ex. 1025. Mr. Stewart sent another email to the USPTO RAD Helpdesk on December 17, 2020, and the USPTO RAD Helpdesk responded that it had not yet received the funds. Ex. 1028.

On January 14, 2021, the Board issued the Notice of Filing Date Accorded to the Petition, according a filing date of December 21, 2020. Paper 4. On that date, Mr. Stewart contacted the Board Trial Division, which informed Mr. Stewart “that the PTAB’s internal records indicated that the filing fee was received on December 18, 2020,” and December 21, 2020, the next business day, “was the date the Petition and associated documents first appeared in the Trial Division’s internal docketing system.” Ex. 1018 ¶ 13. As a result, the Petition was accorded a filing date of December 21, 2020. Paper 4.

*B. The Board’s Decision Denying Petitioner’s Motion to Correct Filing Date and Denying Institution of an Inter Partes Review*

In its Decision, the majority determined that the Board’s trial practice rules required that USPTO receive the filing fee in order for that fee to “accompany” a petition, as required under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103. Dec. 3. Citing the email correspondence between Mr. Stewart and the USPTO RAD Helpdesk, the majority determined that the USPTO had not received Petitioner’s filing fee as of December 16 or 17, 2020. *Id.* at

7–8 (citing Ex. 1025; Ex. 1028). Instead, the majority determined that the USPTO received Petitioner’s filing fee on December 18, 2020, the “settlement date” shown on the Fedwire Detail Report. *Id.* at 7 (referring to the settlement date as “when the USPTO received the payment”) (citing Ex. 1018 ¶¶ 7, 8, 11; Ex. 1025; Ex. 3002, 1).

In reaching its Decision, the majority was not persuaded that Petitioner’s Fedwire confirmation established that the USPTO received payment of the Petition fee on December 16, 2020. *Id.* at 6–7. Petitioner had argued that its Fedwire confirmation establishes that the filing fee was withdrawn from its bank account and accepted by Treasury NYC on the USPTO’s behalf on December 16, 2020, and that the “Fedwire system is a ‘real-time’ system in which payments are ‘individually processed and settled in central bank money *in real time.*’” Mot. 6 (quoting Ex. 1030). The majority, however, determined that Petitioner’s argument improperly treated Treasury NYC and the USPTO as the same entity, and failed to account for the time that it takes Treasury NYC to transfer the payment and make the funds available to the USPTO. Dec. 8. As a result, the majority held “the Fedwire confirmation (Ex. 1023) does not constitute sufficient evidence to support Petitioner’s position that the USPTO received full payment for the Petition on December 16, 2020.” *Id.*

In its Motion to Correct Filing Date, Petitioner also argued that Fedwire transfers are governed by 12 C.F.R. Subpart B of Part 210, which incorporates Article 4A of the Uniform Commercial Code (“UCC”) in Appendix B (Ex. 3004, hereinafter “Appendix B”), and that “[u]nder Article 4A of the UCC, a wire transfer is deemed both *complete and accepted* when the beneficiary’s designated bank receives the full payment.” Mot. 7–9.

Although the majority agreed that Appendix B applies, the Board disagreed with Petitioner's conclusion. Dec. 11–12. In particular, the majority determined that, under these regulations, a “beneficiary” (here the USPTO) and a “beneficiary's bank” (here Treasury NYC) are two separate entities, and “the beneficiary receives the payment when the beneficiary's bank actually pays the beneficiary or credits the beneficiary's account and makes the funds available to the beneficiary, not when the beneficiary's bank accepts the wire transfer from the sender's bank as alleged by Petitioner.” *Id.* at 12 (citing Appendix B §§ 4A-103(a)(2), 4A-103(a)(3), 4A-405(a)). Accordingly, Petitioner's arguments did not persuade the majority that the USPTO received the Fedwire payment when Treasury NYC—the USPTO's bank—accepted the payment on its behalf.

As a result, the Decision denied Petitioner's Motion to Correct Filing Date, and determined that the filing date of the Petition was December 21, 2020. Dec. 20. Because the Petition was filed more than one year after service of a complaint alleging infringement of the '294 patent, the majority determined that the Petition was time-barred under 35 U.S.C. § 315(b). *Id.* at 20–21.

The dissent observed that the Decision “penalizes Petitioner for the *government's* delay” in transferring the fee from Treasury NYC to the USPTO, and that the record revealed no errors or deficiencies in Petitioner's actions to pay the filing fee on December 16, 2020. Dec. 22–23. The dissent would have determined that the Petition was accompanied by the requisite fee on December 16, 2020, thereby satisfying the requirements of 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103, because “both the Petition and the payment were sent (and received) pursuant [to] the USPTO's explicit



instructions.” *Id.* at 24. In the alternative, the dissent would have found good cause to waive the applicable regulations. *Id.* at 26. Accordingly, the dissent would not have found the Petition to be barred under 35 U.S.C. § 315(b).

### III. ANALYSIS

For the reasons discussed below, we conclude that Fedwire confirmation of payment constitutes sufficient evidence to demonstrate that the required fee accompanies a petition under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103(a), and constitutes sufficient evidence to demonstrate that “payment is received” under 37 C.F.R. § 42.103(b).<sup>5</sup> Accordingly, we *grant* Petitioner’s Request for Rehearing and accord the Petition a filing date of December 16, 2020. Additionally, we vacate the Board’s decision denying institution of an *inter partes* review based on the originally-accorded December 21, 2020 filing date, and associated 35 U.S.C. § 315(b) time bar. Nevertheless, we deny institution of an *inter partes* review because the U.S. Court of Appeals for the Federal Circuit recently affirmed a district court’s decision finding all challenged claims at issue in this proceeding invalid under 35 U.S.C. § 101. *Monument Peak Ventures, LLC v. Toshiba America Business Solutions*, No. 21-1052 (Fed. Cir. Dec. 13, 2021).

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<sup>5</sup> Patent Owner argues that in referring only to 37 C.F.R. § 42.103(a), the POP “is reviewing the wrong issue,” and that the “relevant rule” here is 37 C.F.R. § 42.103(b). PO Br. 4–5 (emphasis omitted). Although we disagree with Patent Owner’s characterization, we address both subparts of section 42.103 in our analysis.



A. *Because the USPTO Permits Fee Payment by Fedwire Transfer, Fedwire Confirmation of Payment is Sufficient Evidence of Compliance with 35 U.S.C. § 312(a)(1) and 37 C.F.R. §§ 42.103(a)–(b)*

We begin with the relevant federal statute and Board rules governing payment of an *inter partes* review fee. 35 U.S.C. § 312(a)(1) states that “[a] petition filed under section 311 may be considered only if—[]the petition is accompanied by payment of the fee established by the Director under section 311.” Moreover, 37 C.F.R. § 42.103 provides that “(a) An inter partes review fee set forth in § 42.15(a) must accompany the petition,” and “(b) No filing date will be accorded to the petition until full payment is received.”

The USPTO permits fees to be paid by wire transfer through Fedwire, and provides instructions for sending a wire payment to the USPTO. Ex. 1022. The USPTO instructions include a list of required Fedwire fields and the corresponding “Required Information.” Ex. 1022, 1–2. For example, the USPTO instructs that a wire payment must include “Treas NYC” as the “Receiver ABA Short Name,” “021030004” as the “Receiver ABA Routing Number,” “13100001” for the “Beneficiary Identifier (account number),” and “USPTO” for the “Beneficiary Name.” *Id.* The USPTO instructions also require the name of the party sending the payment (the “Originator”), the payment amount, and “Originator to Beneficiary Information” that includes “the brief purpose of payment and information that helps identify the transaction (e.g., maintenance fee, patent#, application#), and a phone number.” *Id.*

Petitioner’s Fedwire confirmation demonstrates that, on December 16, 2020, Petitioner complied with the USPTO’s published instructions.

Specifically, Petitioner's Fedwire confirmation shows that on December 16, 2020, Petitioner initiated a wire transfer to the USPTO for the full amount of the *inter partes* review Petition filing fee, and that wire transfer included all required information identified in the USPTO's instructions for wire payments. Ex. 1023. For example, as shown in Exhibit 1023, Petitioner listed the "USPTO" as Beneficiary, "Treas NYC" as Beneficiary's Bank, "13100001" as the account number, "021030004" as ABA routing number, "BRACEWELL LLP" as originator name, and "[\\$]41,500.00 USD" as the payment amount, and included other "originator to beneficiary information." *Id.*

Petitioner's Fedwire confirmation also identifies the transfer as a "Completed Payment[]" and indicates the wire transfer was "Successful" as of 2:46 pm ET on December 16, 2020. Ex. 1023. Thus, the Fedwire confirmation is consistent with the Fedwire Detail Report that the Board entered, which indicates a Fedwire acceptance date and time of December 16, 2020, at 2:56 pm ET. Ex. 3002 ("ACCEPTANCE-TIMESTAMP").

By virtue of its status as a "Successful" and "Completed" payment, Petitioner's Fedwire confirmation demonstrates that Petitioner had adequate funds in its account at Wells Fargo, and successfully transferred the full amount of the fee to Treasury NYC, the USPTO's designated bank, on December 16, 2020. Ex. 1023; *see also* Ex. 3002 (indicating acceptance of the wire transfer on December 16, 2020); Ex. 1018 ¶ 6 (stating that Mr. Stewart "independently verified that the \$41,500 payment was debited from Bracewell's bank account at Wells Fargo" on December 16, 2020).

Although Patent Owner asserts that there is "nothing from Treasury NYC in the wire confirmation attesting to 'acceptance' of these funds,"

Patent Owner does not specifically dispute that Treasury NYC *received* the funds via a successful wire transfer on December 16, 2020. PO Br. 12 (“At best, Petitioner’s wire confirmation, Ex. 1023, shows that the sending bank . . . successfully transferred funds to ‘Treasury NYC.’”); *see also id.* at 13 (“[E]ven if the ‘wire confirmation’ (Ex. 1023) showed successful receipt of funds by Treasury NYC (the USPTO’s bank), . . . it does not equate to payment by Treasury NYC to the USPTO”). Furthermore, Patent Owner does not direct us to, nor do we discern, any evidence in the record that Treasury NYC did not receive the full amount of the fee from Petitioner on December 16, 2020. Nor does Patent Owner dispute the Fedwire Detail Report, which indicates an acceptance date and time of December 16, 2020, at 2:56 pm ET. Ex. 3002 (“ACCEPTANCE-TIMESTAMP”).

The evidence of record thus establishes that, on December 16, 2020, Petitioner complied with the published USPTO instructions for sending a payment through Fedwire, and successfully transferred the full amount of the fee to Treasury NYC, the bank the USPTO specifically instructs to designate as its “Receiver” for such payments. Ex. 1022, 1. Based on the Fedwire confirmation, we understand that Petitioner did everything in its power to pay the fee as instructed, and that the fee transfer was successful (i.e., payment was received through Fedwire) on December 16, 2020. Accordingly, we accept Petitioner’s Fedwire confirmation as evidence that the wire transferred fee “accompanied” the Petition filed on December 16, 2020, as required by 35 U.S.C. § 312(a) and 37 C.F.R § 42.103(a). Further, because the evidence shows that the bank designated by USPTO as its “Receiver” for Fedwire payments timely received the payment, we accept Petitioner’s Fedwire confirmation as evidence that the wire transferred fee

was “received” on December 16, 2020, as required by 37 C.F.R. § 42.103(b).

*B. Reliance on Fedwire Confirmation is Consistent with UCC Article 4A and Constitutes Sufficient Evidence of Compliance with 35 U.S.C. § 312(a)(1) and 37 C.F.R. §§ 42.103(a)–(b)*

The federal regulations that govern fund transfers using Fedwire, codified in Appendix B, also mandate the same result. *See* 12 C.F.R. Subpart B of Part 210, Appendix B (incorporating Article 4A of the Uniform Commercial Code) (Ex. 3004); 12 C.F.R. § 210.25.

It is undisputed that the federal regulations incorporating Article 4A of the Uniform Commercial Code are applicable here. *See, e.g.*, 12 C.F.R. § 210.25(a) (“This subpart provides rules to govern funds transfers through the Fedwire Funds Service.”); *id.* § 210.25(b)(1) (“This subpart incorporates the provisions of Article 4A set forth in appendix B to this subpart.”); Pet. Br. 9–11; PO Br. 6–7. It is also undisputed that these regulations expressly address when the originator of a wire transfer (Petitioner) is considered to have paid the beneficiary (USPTO). PO Br. 14; Pet. Reply 3, 4, 11. Specifically, Section 4A-406, is titled “Payment by Originator to Beneficiary; Discharge of Underlying Obligation,” and states, in relevant part, that the “originator of a funds transfer [Petitioner] pays the beneficiary [USPTO] . . . (i) at the time a payment order for the benefit of the beneficiary [USPTO] *is accepted* by the beneficiary’s bank [Treasury NYC] in the funds transfer and (ii) in an amount equal to the amount of the order accepted by the beneficiary’s bank.” Ex. 3004, 421 (emphasis added). Thus, even though the regulations governing Fedwire transactions consider the USPTO (the beneficiary) and Treasury NYC (the beneficiary’s bank) to

be separate entities, section 4A-406 dictates that a petitioner *pays the USPTO* when Treasury NYC *accepts* the petitioner's funds transfer.

The regulations governing Fedwire transfers also dictate when Treasury NYC *accepts* a petitioner's fund transfer. Section 4A-209(b)(2) provides that "a beneficiary's bank [Treasury NYC] accepts a payment order at the earliest of" several times, including, "[w]hen the bank *receives payment of the entire amount* of the sender's order pursuant to section 4A-403(a)(1) or 4A-403(a)(2)." Ex. 3004, 415 (emphasis added).<sup>6</sup> Thus, under section 4A-209(b)(2), Treasury NYC accepts a payment order when it receives payment in the entire amount of the order. Considered together, sections 4A-406 and 4A-209 dictate that, by operation of law, Petitioner paid the USPTO when Treasury NYC *received the full amount* of the payment order.

Other sections of UCC Article 4A confirm the interconnectivity between when Treasury NYC receives the full amount of a payment order, when Treasury NYC accepts a payment order, and the timing of Petitioner's payment to the USPTO. For example, section 4A-104(a) provides that "[a] funds transfer is completed by acceptance by the beneficiary's bank of a payment order for the benefit of the beneficiary of the originator's payment order." Ex. 3004, 411. Additionally, section 4A-401 provides that the

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<sup>6</sup> Patent Owner focuses on other sub-sections of 4A-209 that identify other times when a beneficiary's bank "accepts" a payment order. *See, e.g.*, PO Br. 14 (addressing section 4A-209(b)(1)(i) and (ii), which refer to when the beneficiary's bank pays the beneficiary); PO Reply 2 (same). Patent Owner, however, does not address section 4A-209(b)(2), which is applicable here because section 4A-209 states that acceptance occurs "at the earliest of" the times set forth in section 4A-209(b).

“*Payment date* of a payment order . . . , unless otherwise determined, is the day the order is received by the beneficiary’s bank.” *Id.* at 419.

Furthermore, although not codified, Official Comment 1 to section 4A-107 states that “in a Fedwire transfer, payment to the beneficiary’s bank, acceptance by the beneficiary’s bank and payment by the originator to the beneficiary all occur simultaneously by operation of law.” Ex. 3005, 1.

As discussed above, Petitioner’s Fedwire confirmation indicates that the wire transfer of the full filing fee (\$41,500.00 USD) to Treasury NYC was “Completed” and “Successful” on December 16, 2020. Ex. 1023. We consider this evidence sufficient to establish that Treasury NYC *received the full payment* amount on December 16, 2020. Therefore, according to section 4A-209(b)(2) of the UCC, Treasury NYC *accepted* Petitioner’s payment on December 16, 2020,<sup>7</sup> meaning that pursuant to section 4A-406, Petitioner *paid the USPTO* on December 16, 2020, which is the date Petitioner filed its Petition.

Additionally, we consider Petitioner’s Fedwire confirmation to constitute sufficient evidence of compliance with 37 C.F.R. § 42.103(b). As discussed above, by operation of law pursuant to the federal regulations governing Fedwire transfers, Petitioner satisfied its obligation to pay the USPTO on the date Treasury NYC received the payment. Ex. 1023; Appendix B §§ 4A-209(b)(2), 4A-406. Therefore, receipt of Fedwire-transferred funds by Treasury NYC—the bank that USPTO identified for

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<sup>7</sup> This is consistent with the Fedwire Detail Report, which indicates that Treasury NYC accepted payment of the full amount of Petitioner’s order on December 16, 2020, as it shows an “ACCEPTANCE-DATE” of “1216” and “ACCEPTANCE-TIME” of “1456” (2:56 pm). Ex. 3002.

this express purpose—constitutes receipt as required by 37 C.F.R. § 42.103(b).

We recognize that the email correspondence from the USPTO RAD Helpdesk indicates that it “ha[d] not yet received the wire[d]” funds, as of December 17, 2020. Ex. 1028. We do not consider this email correspondence to reflect a legal determination of compliance with 37 C.F.R. § 42.103(b). Nor does this email somehow override federal regulations governing transfers using the Fedwire system. Rather, the information in the RAD Helpdesk correspondence simply reflects the processing status of the funds, as confirmed by the fact that the wire transfer was “Settled” the very next day without further action from Petitioner. Ex. 3002; PO Br. 3–4 (stating that Petitioner “elected to take no further action to pay the filing fee” after receiving the RAD Helpdesk email messages).

*C. Summary*

We conclude that Petitioner’s Fedwire confirmation constitutes sufficient evidence that Petitioner’s *inter partes* review fee accompanied the Petition under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103(a), and that payment was “received” under 37 C.F.R. § 42.103(b), on December 16, 2020.

Accordingly, we *grant* Petitioner’s Request for Rehearing and accord the Petition a filing date of December 16, 2020. We also vacate the Board’s decision denying institution of an *inter partes* review based on the originally-accorded December 21, 2020, filing date, and associated 35 U.S.C. § 315(b) time bar.



#### IV. CONCLUSION

As previously stated regarding the POP issue before us, we conclude that a Fedwire confirmation of payment constitutes sufficient evidence of payment under 35 U.S.C. § 312(a) and 37 C.F.R. § 42.103(a). Thus, Petitioner's Fedwire confirmation constitutes sufficient evidence that its fee payment accompanied its Petition filed on December 16, 2020, and a § 315(b) time bar does not apply here.

However, intervening events lead us to deny this timely-filed petition. As noted above, the U.S. Court of Appeals for the Federal Circuit recently issued a Rule 36 judgment affirming a district court decision finding all challenged claims at issue in this proceeding invalid under 35 U.S.C. § 101. *See supra* n.3; *Monument Peak Ventures, LLC v. Toshiba America Business Solutions*, No. 21-1052 (Fed. Cir. Dec. 13, 2021). Given the low probability that the Federal Circuit's judgment of unpatentability will be overturned, we do not believe that PTAB resources should be devoted to addressing additional potential grounds of unpatentability. *Cf. Asghari-Kamrani v. United Servs. Auto. Ass'n*, 737 F. App'x 539 (Fed. Cir. 2018) (non-precedential) (dismissing the appeal of a final written decision as moot because the parties agreed "affirmance of the district court's in-eligibility decision has the effect of invalidating all claims" of the patent at issue). Accordingly, based on the unique circumstances of this proceeding, we deny institution of an *inter partes* review.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is *granted* to address the POP issue;

FURTHER ORDERED that the Decision Denying Petitioner's Motion to Correct Filing Date and Denying Institution of *Inter Partes* Review (Paper 9) is *vacated*;

FURTHER ORDERED that Petitioner's Motion to Correct Filing Date is *granted* and the filing date accorded to the Petition in this proceeding is December 16, 2020; and

FURTHER ORDERED that the Petition is *denied* and no trial is instituted.

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For PETITIONER:

Douglas F. Stewart  
Jared D. Schuettenhelm  
Patrick Connolly  
BRACEWELL, LLP  
doug.stewart@bracewell.com  
jared.schuettenhelm@bracewell.com  
patrick.connolly@bracewell.com

For PATENT OWNER:

Tarek Fahmi  
Holly Atkinson  
Jonathan Tsao  
ASCENDA LAW GROUP, PC  
tarek.fahmi@ascendalaw.com  
holly.atkinson@ascendalaw.com  
jonathan.tsao@ascendalaw.com