

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MARVELL SEMICONDUCTOR, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case No. IPR2019-01350

U.S. Patent No. 7,016,676

STATEMENT REGARDING MULTIPLE PETITIONS

Petitioner Marvell Semiconductor, Inc., (“Marvell”) submits this paper pursuant to the July 2019 Update to the AIA Trial Practice Guide. Marvell filed two petitions against the ’676 patent and ranks them (1) IPR2019-01349 challenging claims 1, 2, 5, and (2) IPR2019-01350 challenging claims 3, 6-9. Two petitions were necessary to prevent potential prejudice to Marvell and to address potential priority date disputes by Patent Owner (“PO”). Institution of both petitions will be an efficient use of resources because it requires minimal additional work for the Board.

I. Two Petitions Were Needed to Prevent Prejudice

The petitions rely on the same prior art grounds but challenge different, non-overlapping sets of claims. The first petition (IPR2019-01349) challenges the same set of claims (1, 2, and 5) challenged by another party, Microsoft, who prepared and filed its petitions without any involvement from Marvell. Marvell is not an RPI or privy of the Microsoft petitions. Marvell never discussed its petitions with Microsoft, and Microsoft never discussed its petitions with Marvell. Marvell had no control, provided no funding, and had no knowledge that Microsoft was preparing petitions. Marvell learned of Microsoft’s petitions from their publication in PTAB dockets. Nonetheless, Microsoft’s petitions state their uncertainty as to what an RPI is under applicable law and name Marvell an RPI “out of an abundance of caution”.

Even though Marvell is not an RPI or privy of the Microsoft petitions, Marvell anticipates that PO may attempt to exploit Microsoft’s improper identification of

Marvell. To protect Marvell from prejudice in case PO engages in gamesmanship, Marvell split its challenge into two petitions, with one petition matching the claims challenged by Microsoft. This split facilitates consolidation and schedule alignment, as requested in Marvell's motion to consolidate.

There is no prejudice to the PO here. Neither the PO Preliminary Response nor an Institution Decision have issued in Microsoft's proceedings. And even if Marvell were a RPI or privy, which it is not, neither Microsoft nor Marvell are time-barred under §315(b). Both of Marvell's petitions should be allowed to go forward.

II. Two Petitions Were Needed to Address Potential Priority Disputes

Although the '676 patent does not claim priority to it, an earlier German patent application is referenced in the file history. The Examiner marked in the Notice of Allowance that no certified foreign documents had been received and the conditions of 35 § U.S.C. 119 had not been met. Thus far PO has not claimed an earlier priority date, nor are they entitled to one. However, because PO may attempt to argue that it can somehow rely upon the German application, Marvell included one set of grounds based on the priority date on the face of the '676 patent (the Sherman grounds) and another that pre-dates the filing date of the German patent application (the Shellhammer grounds).

III. The Second Petition Adds Minimal Additional Work

Should the Board institute the first petition (IPR2019-01349), the Board can efficiently resolve the grounds of the second petition (IPR2019-01350) with minimal additional work. Both petitions rely on the same exact prior art and combinations. The second petition addresses one additional limitation in claims 6 and 7. It also addresses claims 3 and 8, but the analysis for those claims substantially overlaps with claims 2 and 5 of the first petition, given the similarities of the elements.

As a result, despite the formality of two petitions, the aggregate amount of content is comparable to that of a single petition because the second petition effectively addresses the elements and issues of the first petition, plus the additional elements discussed above. Unlike other situations where multiple petitions increase content, here the division of claims provided minimal additional space. Table 1 illustrates some similarities and differences in the petitions:

Table 1: Table Comparing Petitions

IPR2019-01349	IPR2019-01350	Comments
1	(1)	IPR2019-01350 did not challenge claim 1 but addressed it as part of dependent claim 3.
2	3	These claims have related elements and analysis.
5	8	These claims have related elements and analysis.

	6	This claim adds one limitation beyond claim 1.
	7	This claim adds one limitation beyond claim 1.
	9	This claim is nearly identical to claim 1.

IV. The Differences in the Petitions Are Material

Despite their similarities, the differences between the petitions—the challenged claims—are material and denial of either petition would be highly prejudicial to Marvell. Here, the division of claims into two petitions was necessitated by the improper identification of Marvell in Microsoft’s petitions. Should one petition be denied, Marvell would be deprived of a fair opportunity to challenge one half of the claims of the ’676 patent, or the other.

This is not a situation where multiple petitions attack the same claims, leveraging the extra space to assert additional prior art references or permutations of references. Nor is this a situation where multiple petitions allow more grounds to be asserted in each petition. Here, two petitions were filed for procedural reasons to facilitate consolidation and schedule alignment, where the aggregate content of both petitions, if consolidated, would be comparable to a single petition in normal circumstances. Between the two petitions, there is effectively a total of two primary references and five grounds. Institution of both petitions would be efficient and economical.

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