

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

In Re: U.S. Patent No. 7,475,246 : Attorney Docket No. 081841.0119  
Inventor: Moskowitz, Scott A.; :  
Berry, Mike W. :  
Filed: Aug. 4, 2000 :  
Issued: Jan. 6, 2009 : IPR Nos.: IPR2019-01357, -01358  
Assignee: Wistaria Trading Ltd.  
Title: Secure personal content server

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*Submitted Electronically via the Patent Trial and Appeal Board End to End System*

**NOTICE RANKING AND EXPLAINING DIFFERENCES  
BETWEEN PETITIONS FOR *INTER PARTES* REVIEW OF  
U.S. PATENT NO. 7,475,246**

## Notice Ranking and Explaining Differences Between Petitions

Pursuant to the July 2019 Update to the USPTO Trial Practice Guide, DISH Network Corporation, DISH Network L.L.C., and DISH Network Service L.L.C. (collectively, “Petitioner” or “DISH”) hereby submits this notice ranking and explaining the differences between two concurrently filed petitions for *inter partes* review of U.S. Patent No. 7,475,246 (“’246 Patent”), IPR2019-01357 and IPR2019-01358, filed herewith (the “Petitions”).

The Petitions challenge non-overlapping claims of the ‘246 Patent based on non-overlapping grounds. To the extent Petitioner’s burden under 35 U.S.C. § 314(a) is met for the Petitions, institution of both of the Petitions is critical to allow Petitioner to challenge all of the asserted claims in pending litigation.

U.S. Patent No. 7,475,246 is currently involved in a pending lawsuit involving Petitioner entitled *Blue Spike LLC et al. v. DISH Network Corporation et al.*, United States District Court for the District of Delaware, Case No. 1:19-CV-00160-LPS-CJB (the “District Court Litigation”). In that case, Blue Spike has asserted claims 1, 17, 20, 21, 24, 25, and 31 of the ‘246 Patent, of which claims 1, 17, 20, 24, and 31 are independent. As shown in detail below, challenging all of the asserted claims requires five different obviousness grounds and five prior art references. Due to the word limit of 37 C.F.R. § 42.24(a)(1)(i), two petitions are necessary for Petitioner to meet its burden for all of these claims and grounds under 35 U.S.C. § 314(a). Accordingly, Petitioner has filed two non-overlapping petitions:

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one challenging claims 1, 20, 21, 24, and 25 of the '246 Patent (“Petition 1”) and another challenging claims 17 and 31 (“Petition 2”).

### **1. Ordering of Petitions**

Although both petitions are non-overlapping, meritorious, and necessary to address Blue Spike’s asserted claims, Petitioner requests that the Board consider the petitions in the following order:

1. Petition for *Inter Partes* Review of Claims 1, 20, 21, 24, and 25 of U.S. Patent No. 7,475,246.
2. Petition for *Inter Partes* Review of Claims 17 and 31 of U.S. Patent No. 7,475,246.

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

As shown in the table below, each Petition challenges non-overlapping asserted claims of the '246 Patent. Petition 1 challenges independent claims 1, 20, and 24 and dependent claims 21 and 25, and Petition 2 challenges independent claims 17 and 31.

Additionally, each Petition asserts non-overlapping obviousness grounds against the asserted claims. Petition 1 asserts two obviousness grounds: Yeung in view of Lee and Yeung in view of Lee and Downs. Petition 2 asserts three different obviousness grounds: Yeung, Yeung in view of Levine, and Yeung in view of Lee, Levine, and Rhoads.

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Finally, the Petitions assert non-overlapping prior art references. The Downs reference is relied upon only in Petition 1, whereas the Levine and Rhoads references are relied upon only in Petition 2.

	<b>Petition 1</b>	<b>Petition 2</b>
Challenged Claims of the '246 Patent (independent claims in bold)	<b>1, 20, 21, 24, and 25</b>	<b>17 and 31</b>
Asserted References	Yeung, Lee, and Downs	Yeung, Lee, Levine, and Rhoads
Grounds	<ol style="list-style-type: none"><li>1. Claims 1, 20, 21, 24, and 25 are obvious over Yeung in view of Lee</li><li>2. Claims 1, 20, 21, 24, and 25 are obvious over Yeung in view of Lee and Downs.</li></ol>	<ol style="list-style-type: none"><li>1. Claim 17 is obvious over Yeung.</li><li>2. Claim 17 is obvious over Yeung in view of Levine.</li><li>3. Claim 31 is obvious over Yeung, Lee, Levine, and Rhoads</li></ol>

For these reasons, neither Petition is redundant of the other, and both Petitions are necessary for Petitioner to challenge all of the claims asserted in the District Court Litigation in light of the word limits of 37 C.F.R. § 42.24(a)(1)(i). Accordingly, the Board should exercise its discretion to institute both of the Petitions filed herewith.

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Respectfully Submitted,

July 19, 2019

/Eliot D. Williams/

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