

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

World Programming Limited

Petitioners

v.

SAS Institute Inc.

Patent Owner

Case No. Unassigned
Patent 7,170,519

**PETITIONER'S EXPLANATION OF PARALLEL PETITIONS AND
RANKING OF PETITIONS
FOR U.S. PATENT NO. 7,170,519**

Petition for *IPR* of U.S. Patent 7,170,519

Petitioners provide this Explanation of Parallel Petitions and Notice of Ranking of Petitions pursuant to the July 2019 Update of the Trial Practice Guide. The '519 Patent is subject to a pending lawsuit entitled SAS Institute Inc., v. World Programming Limited, et. al., Case No. 2-18-cv-00295 (E.D. Tex.) (the “Litigation”) in which Petitioner World Programming Limited is a defendant. The '519 Patent has 59 claims. Ex. 1001, 10:17-16:10. In the Litigation, Patent Owner asserted at least 42 of the 59 claims in the '519 Patent. Given the number of claims being asserted, it is impossible for Petitioner to address all of the claims in just one petition. Petitioner therefore has concurrently filed two Petitions (“Petition 1” and “Petition 2”) relating to the '519 Patent, which in combination address the aforementioned 42 claims. Thus, the present circumstance is consistent with the example in the July 2019 Update of the Trial Practice Guide, which states that “the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation.”

Although Petitioner believes that its two petitions are both meritorious and justified in light of the number of claims being asserted by Patent Owner in the Litigation, Petitioner requests that the Board consider the petitions in the following order:

Petition for *IPR* of U.S. Patent 7,170,519

Rank	Petition	Grounds and References
1	Petition 1	Ground 1: Davis and Harold
2	Petition 2	Ground 1: Davis and Harold Ground 2: Davis, Harold, and Excel Ground 3: Davis, Harold, Rousseeuw, and Krause

Below are some of the material differences between the two petitions:¹

1. **Petition 1:**

- a. Ground 1 – Claims Challenged: **1-4, 14-18, 21, 27, 29-30, 34-36, 39, 42-47, 49, 51-53, and 56** (Davis and Harold)

2. **Petition 2:**

- a. Ground 1 – Claims Challenged: 5-6 and 37-38 (Davis and Harold),
- b. Ground 2 – Claims Challenged: 7-11 (Davis, Harold and Excel), and
- c. Ground 3 – Claims Challenged: 22-26 (Davis, Harold, Rousseeuw and Krause)

As shown above, the grounds set forth in the concurrently filed petitions are not redundant and are materially different because the claims being challenged in each petition differ, with dependent claims being challenged in Petition 2 that are not

¹ Independent claims are bolded.

Petition for *IPR* of U.S. Patent 7,170,519

challenged in Petition 1. Petition 2 also includes obviousness grounds as well as motivations to combine the references that are not in Petition 1. A summary of the similarities and material differences between Petitions 1 and 2 are identified in the table below.

Grounds	Petition 1	Petition 2
Independent Claims Being Challenged: 1 and 34	✓	
Dependent Claims Being Challenged: 2-4, 14-18, 21, 27, 29-30, 35-36, 39, 42-47, 49, 51-53, and 56	✓	
Dependent Claims Being Challenged: 5-11, 22-26, and 37-38		✓
Obviousness Combination and Motivation to Combine of Davis and Harold	✓	✓
Obviousness Combination and Motivation to Combine of Davis and Harold and Excel		✓
Obviousness Combination and Motivation to Combine of Davis and Harold and Rousseuw and Krause		✓

The Board should consider both petitions and not exercise its discretion to deny institution in either IPR given the number of claims being asserted by the Patent Owner in the Litigation. And as shown above, the two petitions are not redundant, and the differences between the two petitions are material given the

Petition for *IPR* of U.S. Patent 7,170,519

different dependent claims being challenged, obviousness grounds, and motivations to combine.

Respectfully submitted,

BAKER BOTTS L.L.P.

Date: August 5, 2019

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