

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YITA LLC,
Petitioner,

v.

MACNEIL IP LLC,
Patent Owner.

Case IPR2020-01139
Patent 8,382,186

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Submitted Electronically via the Patent Review Processing System

**PATENT OWNER'S RESPONSE TO
PETITIONER'S NOTICE RANKING PETITIONS FOR *INTER PARTES*
REVIEW OF U.S. PATENT NO. 8,382,186**

I. INTRODUCTION

The Board has recognized that multiple petitions “filed against the same patent owner at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (“CTPG”) at 59 (November 2019). Yita LLC’s (“Petitioner’s”) filing of two meritless petitions for *inter partes* review on the *same* day challenging the *same* claims of U.S. Patent No. 8,382,186 (the “’186 Patent”) is precisely the kind of tactic that imposes an unnecessary burden on the Board and MacNeil IP LLC (“Patent Owner”). Patent Owner must now defend against not one, but two meritless challenges at the pre-institution stage and potentially through trial should the Board institute. Petitioner’s superficial explanation alleging two petitions are necessary omits key facts that demonstrate institution of both petitions (let alone any single petition) is unwarranted. Patent Owner requests the Board, if it decides to institute review on any of the petitions, to restrict Petitioner to only one petition.

II. PETITIONER’S EXPLANATION DOES NOT JUSTIFY FILING MULTIPLE PETITIONS

As an initial matter, although both petitions lack merit, Patent Owner agrees with Petitioner’s ranking of its petitions challenging the ’186 Patent – specifically ranking IPR2020-01138 (the “MacNeil Petition”) first. There is no justification,

however, for filing two petitions. Patent Owner has not asserted a large number of claims in litigation: the '186 Patent has only seven claims. *See* CTPG at 59. To justify filing multiple petitions, Petitioner instead relies on a priority dispute and different references in the petitions. *See* Paper 2 at 2-3.

Apparently recognizing the deficiencies of its prior-art based challenge (IPR2020-01139), Petitioner hedges its bets by filing the MacNeil Petition, which Petitioner ranks first and which relies on a fabricated priority dispute and a single reference, U.S. Patent No. 7,444,748. But Petitioner's explanation for filing multiple petitions focuses on the priority dispute, which does not offer the Board sufficient reason under the standards in the Consolidated Trial Practice Guide to permit both petitions.

First, the Consolidated Trial Practice Guide states that multiple petitions *may* be necessary when there is a priority dispute "requiring arguments under multiple prior art references." CTPG at 59. But Petitioner only raises a single reference in the MacNeil Petition and nowhere explains why this single reference could not have been combined with its other petition, particularly given that the MacNeil Petition focuses only on a single claim limitation (the "substantially uniform thickness" limitation). Petitioner's ranking position omits any explanation as to why this narrow ground merits an additional petition.

Petitioner does not explain why this single reference, focusing on a single claim limitation, could not be included in its other petition. The Board should deny institution of multiple petitions for these reasons alone.

III. CONCLUSION

The Board should exercise its discretion and deny multiple petitions to avoid an unjustified burden on the Board. “[M]ultiple petitions by a petitioner are not necessary in the vast majority of cases,” and Petitioner has not shown this case to be the “rare” exception. CTPG at 59. Accordingly, if the Board decides to institute review on any of the petitions—a decision unjustified on the merits—it should restrict Petitioner to only one petition.

Respectfully submitted,
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Date: October 15, 2020

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on the 15th day of October, 2020, a complete and entire copy of this **PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE RANKING PETITIONS FOR INTER PARTES REVIEW OF U.S. PATENT NO. 8,833,186** was served on Petitioner via email to counsel for the Petitioner at the following addresses:

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October 15, 2020

Date

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