UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION and HP INC.
Petitioners,

v.

SYNKLOUD TECHNOLOGIES, LLC,
Patent Owner.

Inter Partes Review No. IPR2020-01269 and IPR2020-01270

U.S. Patent No. 9,219,780

PETITIONERS' EXPLANATION REGARDING THE NECESSITY FOR MULTIPLE PETITIONS

I. INTRODUCTION

Petitioners have filed two petitions challenging U.S. Patent No. 9,219,780 to Tsao ("the 780 Patent"), both of which are based on the same prior art and include substantive identical analysis. Two petitions were required because the analysis of all 20 claims of the 780 Patent could not reasonably fit within the word limit for a single petition. In considering how best to divide the analysis between the petitions, Petitioners determined that addressing claims 1 and 16 and their dependents in one petition, and claim 9 and its dependent claims in a separate petition, was the most efficient path forward.

The Board has found that a Petitioner may file multiple petitions against a single patent when, for example, the asserted claims in the litigation are uncertain and where petitions rely on the same prior art. *See, e.g.*, *Microsoft Corporation v. IPA Technologies Inc.*, IPR2019-00810, Paper 12 at 11-16 (October 16, 2019). The Board further observed that "any duplication of effort that may place unnecessary burdens on the parties and the Board may be avoided or reduced by consolidating the instituted IPRs (if institution of review is granted in more than one proceeding), including consolidating the parties' briefing, motion practice, and the oral hearings. *Id*. at 15.

Petitioners made this decision to file two petitions given the length of the claims and its assessment it could not reasonably fits its analysis in fewer petitions, and based on certain distinctions between the scope of claim 9 and the scope of claims 1 and 16. For example, claim 9 is generally directed to "*a server*," while claims 1 and 16 are directed to "*a wireless device*" and "*a system*," respectively. By analyzing the most similar independent and dependent claims in separate petitions, Petitioners have presented the analysis in the most efficient manner while maintaining appropriate word count limits.

In addition, Petitioners have challenged all 20 claims of the 780 Patent because they do not know which claims (if any) might be asserted against Petitioner Microsoft Inc. ("Microsoft") in district court. For example, Microsoft filed for a declaratory judgment of noninfringement of the 780 Patent in district court on January 3, 2020 and at present, only an exemplary claim has been identified. *See, e.g.*, *id.* at 14 (finding that Petitioner had provided "a reasoned explanation" for filing multiple petitions where Petitioner was "in the position of not knowing which claims…Patent Owner would assert against Petitioner in district court litigation.")

Further, pursuant to the Trial Practice Guide recommendations, Petitioners identify the following sections as the sections that are substantively identical across

the two petitions, noting that claims 1, 9 and 16 are the independent claims of the 254 Patent:

IPR2020-01269	IPR2020-01270
Introduction	Introduction
Compliance with the Requirements for a Petition for *Inter Partes* Review	Compliance with the Requirements for a Petition for *Inter Partes* Review
The 780 Patent	The 780 Patent
Principal Prior Art	Principal Prior Art
Patentability Analysis A. Claim 2 B. Claims 5 and 6 C. Claims 3 and 17 D. Claim 4	Patentability Analysis A. Claim 15 B. Claim 14 C. Claim 10 D. Claim 11

Finally, Petitioners recognize that the recent amendments to the Trial Practice Guide state that a petitioner filing multiple petitions against the same patent "should" identify "a ranking of the petitions in order in which [the petitioner] wishes the Board to consider the merits. *See* pg. 27. Petitioners respectfully suggest that doing so here would be somewhat anomalous. This is not a situation where the petitions challenge the same claims on different prior art bases. The basic prior art analysis of the independent claims is identical in both petitions. Thus, a comparison of the strengths and weaknesses between the two

petitions, which would be necessary to determine a preference, would seem to be a nonsensical exercise.

Accordingly, given the structure of the claims of the 780 Patent, and the differences in claims addressed in IPR2020-01269 and IPR2020-01270, Petitioners respectfully request that the Board consider and institute *Inter Partes* reviews on both petitions. Nevertheless, to the extent the Board deems it necessary to only consider a single petition, Petitioners rank IPR2020-01269 ahead of IPR2020-01270.

Dated: July 20, 2020

Respectfully submitted,

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