UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

ADOBE INC.
Petitioner

v.

SYNKLOUD TECHNOLOGIES, LLC
Patent Owner

_____

Case IPR2020-01393
Patent No. 9,239,686

_____

PETITIONER'S EXPLANATION FOR MULTIPLE PETITIONS

Petitioner is concurrently filing two petitions challenging U.S. Patent No. 9,239,686 (the "'686 Patent"), both of which are based on the same primary prior art references combined with the same secondary prior art references and including substantially the same analysis of the patent claims. The petition filed in IPR2020-01392 addresses claims 1-11 of the '686 Patent, and the petition in IPR2020-01393 addresses claims 12-20. Two petitions were required because the analysis of all 20 claims of the '686 Patent could not reasonably fit within the word limit for a single petition.

Petitioner is challenging claims 1-20 of the '686 Patent because Patent Owner has asserted all 20 of those claims against Petitioner in the related district court litigation. There is no overlap in claims between the two petitions and together the two petitions address all of the claims asserted by the Patent Owner against Petitioner. Therefore, Petitioner cannot rank the two petitions because they are equally important. If the Board were to choose one petition and summarily deny the other, the parties would be forced to address the same basic grounds for unpatentability before the Board (for some claims) and in the district court (for the

other claims), which would be an extremely inefficient result.[1]

By presenting its grounds for unpatentability on all of the claims asserted in the district court action, Petition has attempted to reduce the overall burden and avoid any inefficient use of the Board's and the district court's resources. The Board's November 2019 Consolidated Trial Practice Guide (at page 59) recognized that petitioners would be justified in bringing multiple petitions against a single patent "when the patent owner has asserted a large number of claims in litigation," which is precisely the scenario confronting Petitioner here. *See, e.g.*, *Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 28 (PTAB June 15, 2020) (declining to exercise discretion to deny multiple petitions filed to challenge 20 claims asserted in related litigation).

Both petitions are necessary because they challenge different claims with each petition addressing one independent claim and its dependent claims—an approach that was driven by word limits.[2] *See Intel Corp. v. VLSI Technology*

---

[1] If forced to rank, however Petitioner would rank IPR 2020-1392, addressing claims 1-11, higher, simply because it addresses a larger number of asserted claims.

[2] As the Board has noted, a request for additional words would not have made any material difference, as it merely "would result in shifting the same issues

LLC, IPR2019-01199, Paper 19 at 10 (Feb. 6, 2020) (declining to exercise discretion to deny petitions where "Petitioner contends each petition is necessary…because each petition is directed to a different independent claim."); *Microsoft Corp. v. IPA Techs. Inc.*, IPR2019-00810, Paper 12 at 14 ("Faced with word count limitations and a large number of challenged claims, Petitioner's decision to divide its analysis of those claims among a number of petitions appears reasonable.").

The Board has found multiple petitions against a single patent appropriate where, as here, the petitions rely on the same prior art. *See, e.g., IPA Technologies, Inc.*, IPR2019-00810 Paper 12 at 11-16 (Oct. 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; *see also Seven Networks, LLC*, IPR2020-00156, Paper 10 at 26 ("By asserting overlapping prior art under the present circumstances, Petitioner challenges the claims across the two petitions in a manner that does not present an undue burden on the Board or parties."). Because the same grounds of

---

presently raised in two petitions into one large petition." *Seven Networks, LLC*, IPR2020-00156, Paper 10 at 27.

unpatentability are raised in both of Petitioner's two petitions, any potential duplication of effort can be addressed by consolidating the proceedings (e.g., setting a single oral hearing for both).[3]

In sum, this is not the kind of case for which discretionary denial of one petition would be appropriate or equitable. Both of the petitions were filed on the same day, challenging different/non-overlapping claims based on the same basic prior art combinations, and they were not preceded by a preliminary response in any other IPR challenging the same patent. This is simply a case challenging a patent with a large number of claims—and a case where the Patent Owner chose to assert every one of those claims in the related litigation. Petitioner respectfully

---

[3] Petitioner also notes that it has filed two prior petitions challenging patents related to the '686 Patent based on the same primary prior art references raised here: IPR2020-01235 and IPR2020-01301. Petitioner was able to file one petition in each of those other proceedings because Patent Owner asserted only 5 claims from those related patents against Petitioner rather than the 20 asserted claims in the '686 Patent. In any event, these multiple proceedings filed within a few weeks of each other present further opportunity for efficiency as the parties and the Board will be addressing similar challenged patents based on the same primary prior art references on a similar (or the same) schedule.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.