

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. IPR2021-00175
U.S. Patent No. 7,870,225

**PETITIONERS' EXPLANATION REGARDING THE NECESSITY FOR
MULTIPLE PETITIONS**

I. INTRODUCTION

Petitioners have filed two petitions challenging U.S. Patent No. 7,870,225 to Kim (“the 225 Patent”), both of which are principally based on the same prior art and largely include substantively identical analysis. Two petitions were required because the analysis of all 22 claims of the 225 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 claim 1 (the only independent claim) and dependent claims 5-12 in one petition, and claim 1, and dependent claims 2-4 and 13-22 in a separate petition, was the most efficient path forward. Petitioners observe, however, that the analysis of claim 1 in each petition is the same, such that the Board need only address that analysis once. That claim 1 analysis is included in both petitions solely to support the analysis of different dependent claims addressed in the different petitions.

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 Corp. v. IPA Techs. 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.

Petitioners made this decision to file two petitions given the length of the claims and its assessment it could not reasonably fit its analysis in fewer petitions, and based on certain distinctions between the scope of claims challenged. For example, claims 18-22 disclose a "filter program" and functions performed by such a program while claims 6-12 primarily disclose device driver functions and disk characteristics. 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 22 claims of the 225 Patent because they do not know, at this time, which claims would be asserted against Petitioner HP Inc. ("HP") in district court. For example, HP was served with a complaint alleging infringement of the 225 Patent on November 12, 2019. The complaint asserts that HP infringes at least claim 1, and that it reserves the right to assert additional claims. Thus, HP does not know which claims, other than claim 1, Patent Owner will assert against it in district court litigation, thus supporting the need to challenge all the claims of the 225 patent. *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, and again note that claim 1 is the only independent claim of the 225 Patent:

IPR2021-00174	IPR2021-00175
Introduction	Introduction
Compliance with the Requirements for a Petition for <i>Inter Partes</i> Review	Compliance with the Requirements for a Petition for <i>Inter Partes</i> Review
The 225 Patent	The 225 Patent
Principal Prior Art	Principal Prior Art
Patentability Analysis A. 1. Claim 1	Patentability Analysis A. 1. Claim 1

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* pgs. 59-60. 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 in these unique circumstances.

Accordingly, given the structure of the claims of the 225 Patent, and the differences in claims addressed in IPR2021-00174 and IPR2021-00175, Petitioners respectfully requests 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 IPR2021-00174 ahead of IPR2021-00175.

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Respectfully submitted,

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