

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TWITTER, INC.,  
Petitioner

v.

PALO ALTO RESEARCH CENTER INC.,  
Patent Owner

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Case IPR2021-01459  
Patent 8,489,599

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**PETITIONER'S EXPLANATION OF PARALLEL PETITIONS**

## I. EXPLANATION

Petitioner is requesting *inter partes* review challenging claims 1, 4, 6, 7, 9-12, 15, 17-19, 22, 24, and 25 of U.S Patent No. 8,489,599 in two concurrently-filed *inter partes* review petitions (IPR2021-01458 and IPR2021-01459). Pursuant to the July 2019 Update to the USPTO Trial Practice Guide, Petitioner submits this explanation of the differences between the petitions and ranking of the petitions for the Board's consideration.

The Trial Practice Guide recognizes that “there may be circumstances in which more than one petition may be necessary.” (USPTO Trial Practice Guide (November 2019) p. 59.) And the Board has found challenges involving a “large number of claims” as well as “limitations using means-plus-function claim language” among the situations justifying parallel petitions. *DJI Europe B.V. v. Daedalus Blue LLC*, IPR2020-01475, Pap.14 at 9-10 (Feb. 12, 2021). In the district court litigation related to this proceeding, Patent Owner has asserted claims 1, 4, 6, 7, 9-12, 15, 17-19, 22, 24 and 25—precisely the claims covered across Twitter's two '599 petitions.

The first petition (IPR2021-01458) challenges claims 1, 4, 6, 7, 9-12, 15, 17-18, which are all method or computer readable storage medium claims, and the claims challenged in that petition include two independent claims, claims 1 and 12.

The claims in the first Petition are lengthy: independent claims 1 and 12 each contain nine limitations, and some dependent claims add multiple limitations, such as claims 2 and 13, which each contain an additional six limitations.

The second petition (IPR2021-01459) challenges claims 19, 22, 24, and 25, which are apparatus claims. Claim 19 may be argued to contain up to three means-plus-function (“mechanism configured to”) limitations, and the other three claims depend from claim 19. To the extent it is determined that any of these “mechanism configured to” limitations are means-plus-function, they are indefinite because the specification does not disclose the corresponding structure, *and the IPR on those claims* (the second petition, IPR2021-1459) *should not be instituted*. Patent Owner has not yet asserted that these claims are written in means-plus-function form, and Petitioner has thus addressed these claims accordingly. However, if the Board were to determine that these claims are, in fact, means-plus-function claims, they would be indefinite, and this could deprive Petitioner of the opportunity to challenge the remaining litigated claims before the Board. Accordingly, Petitioner has separated these claims into a stand-alone petition, and respectfully requests that the Board accept Petitioner’s filing here of two petitions to address the risk it may be determined that a petition including Claim 19 and its dependents cannot be instituted for this reason. Petitioner also requests a second petition due to the number

and length of the independent claims, especially claim 19. Comparison and ranking per claim of the two petitions, which address different claims, is provided in the following table:

	<b>IPR2021-01458</b>	<b>IPR2021-01459</b>
<b>Claims Challenged</b>	1, 4, 6, 7, 9-12, 15, 17-18	19, 22, 24, 25
<b>Potential Means-Plus-Function Limitations</b>	N/A	“an input mechanism configured to”; “a receiving mechanism configured to”; “a content delivery mechanism configured to”
<b>Prior Art</b>	PALLAS, Yau, and Kim	PALLAS, Yau, and Kim
<b>Ranking</b>	#1	#2

These petitions are not cumulative challenges. Not only do they address different types of claims—namely method claims and computer-readable storage medium claims in the first petition, and apparatus claims in the second petition—but the second petition also includes claims that may be asserted to be means-plus-function limitation, which (as discussed above) presents separate and distinct issues pertaining to, among other things, claim construction. The rankings above reflect Petitioner’s request that the first Petition be given priority. To the extent both are instituted, Petitioner is amenable to joining the two petitions to eliminate any duplicative work that might be caused by having two petitions.

Respectfully submitted:

/J. Steven Baughman/  
J. Steven Baughman

August 31, 2021

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