

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EPIC GAMES, INC.,  
Petitioner,

v.

INGENIOSHARE, LLC,  
Patent Owner.

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Case No. IPR2022-00291  
U.S. Patent No. 10,708,727

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**PATENT OWNER'S PRELIMINARY RESPONSE  
UNDER 37 C.F.R. § 42.107**

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Mail Stop PATENT BOARD, PTAB  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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## PATENT OWNER'S EXHIBIT LIST

Exhibit 2001	Complaint
Exhibit 2002	Epic Games Inc.'s Preliminary Invalidation Contentions
Exhibit 2003	Order Setting Markman Hearing
Exhibit 2004	Epic Games Inc.'s Opening Claim Construction Brief

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## **I. INTRODUCTION**

Pursuant to 37 C.F.R. § 42.107, the Patent Owner, IngenioShare, LLC hereby submits the following Preliminary Response to the Petition for *inter partes* review of U.S. Patent No. 10,708,727, Case No. IPR2022-00291. For the reasons explained herein, the Petition should be denied.

## **II. SUMMARY OF WHY THE PETITION SHOULD BE DENIED**

### **A. The Board Should Deny Institution Based On The *Fintiv* Factors**

The Petition should be denied because Petitioner has raised the same invalidity arguments (and substantially more) in a parallel district court proceeding and the district court's trial date precedes the Board's deadline for a final written decision. Moreover, Petitioner is taking inconsistent positions before the district court and the Board that the district court is better suited to address and resolve. As a result, efficiency, fairness, and merits dictate the Board's discretionary denial of institution in view of the district court's earlier comprehensive trial date.

### **B. The Board Should Deny Institution Based On The Merits**

All proposed grounds of unpatentability rest on a fundamental flaw. Each challenged claim requires a "network-based portal." Each ground of unpatentability presented in the Petition relies on the assertion that this limitation is satisfied in the cited art by limitations in client-side. This is contrary to the use of the term "network-based portal" in the specification, which universally indicates that the network-based portal is at server-side. Nothing in the '727 Patent suggests

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