

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIC GAMES, INC.,
Petitioner

v.

INGENIOSHARE, LLC,
Patent Owner

U.S. PATENT NO. 10,492,038

Case IPR2022-00294

**PETITIONER'S EXPLANATION OF MATERIAL
DIFFERENCES BETWEEN PETITIONS AND RANKING**

Case IPR2022-00294
U.S. Patent No. 10,492,038

Pursuant to the Trial Practice Guide, Petitioner Epic Games, Inc. (“Petitioner” or “Epic Games”) submits this notice of its ranking of its petitions for inter partes review of U.S. Patent No. 10,492,038 (the ’038 Patent) filed in IPR2022-00294 (“Petition 1”) and IPR2022-00295 (“Petition 2”), and an explanation of the material differences between the Petitions. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 (“TPG”) at 59–60.

Petition 1 challenges claims of the ’038 Patent based on U.S. Publ. Appl. No. 2002/0116461 (“Diacakis”) as a primary reference. Petition 2 challenges claims of the ’038 Patent based on U.S. Publ. Appl. No. 2004/0001480 (“Tanigawa”) in combination with U.S. Pat. No. 7,428,580 (“Hullfish”) as primary references. The Board should institute on both Petitions for the following reasons: (i) the length and large number (44) of challenged claims; (ii) given common issues across the Petitions, the burden to consider all Petitions is not substantially greater than considering just one; and (iii) Petitioner has filed (or will file) petitions for inter partes review of two patents in the same family as the ’038 Patent (U.S. Patent Nos. 10,142,810 and 10,708,727), and those petitions similarly present grounds based on Diacakis and on Tanigawa in combination with Hullfish.

Patent Owner IngenioShare, LLC (“PO” or “IngenioShare”) sued Petitioner on June 25, 2021 for infringement of four patents, including the ’038 patent. On

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September 16, 2021, PO asserted 42 claims of the '038 patent, claims 7–12, 22–24, 33–62, 64, 65, and 67. *See* Ex. 1012.

The claims of the '038 patent are directed to a non-transitory computer readable medium (and methods implementing the same) for a communications system, where a first user and a second user use a network-based portal based on the Internet protocol to send and receive messages using electronic devices. *See, e.g.,* Ex. 1001 ('038 Patent), cl. 7. The '038 patent claims various features related to this communications system, including using various modes of communication (*e.g.*, text and audio), using “identifiers” associated with the users, detecting the availability of users, allowing users to block one another, and not providing contact information of users to one another. *See, e.g., id.*

This claimed communications system and the claimed features are taught by Diacakis. Two additional prior art references, U.S. Pat. No. 7,287,056 (“Loveland”) and U.S. Publ. Appl. 2002/0183114 (“Takahashi”), are added to Diacakis to address certain arrangement limitations that may not be expressly disclosed in Diacakis and/or to address arguments PO may raise in its response. Similarly, the claimed communications system and the claimed features are taught by the combination of Tanigawa and Hullfish, which specifically teaches the claimed blocking features. Loveland and Takahashi are added to Tanigawa (as modified by Hullfish) to address

certain arrangement limitations that may not be expressly disclosed in Tanigawa and Hullfish and/or to address arguments PO may raise in its response.

The combination of Tanigawa and Hullfish is not cumulative over Diacakis. Diacakis is directed to a communications system with a “presence and availability management system,” used to detect when a user is available to communicate and to notify another of the user’s availability information. *See, e.g.*, Ex. 1007, Abstract, [0028]–[0029]. Diacakis teaches that users can block others (thereby preventing them from communicating with them) across specific modes of communication by defining “access levels” to give different people different levels of access at different times. *See, e.g., id.*, [0031]–[0036]. Tanigawa (as modified by Hullfish) teaches a server directed towards a communications system specifically facilitating transitions between text chat and voice chat in both a group setting and a one-on-one setting. *See, e.g.*, Ex. 1010, Abstract, [0006]–[0009]. In this combination, users can block others—not through defined access levels, as in Diacakis—by identifying a user to be blocked by a “pre-determined telephone number,” a process that prevents the blocked user from further communicating with the blocking user. *See, e.g.*, Ex. 1011, 8:66–9:18, Fig. 5.

In view of the foregoing, it is necessary and appropriate to file two Petitions against the 44 challenged claims of the ’038 patent. The Trial Practice Guide expressly acknowledges that multiple petitions against the same patent may be

appropriate “when the patent owner has asserted a large number of claims in litigation.” TPG at 59. The ’038 patent includes 4 independent claims and 66 dependent claims. Petitioner challenges 3 independent claims and 41 dependent claims. The claims are lengthy, comprising more than 11 columns in the ’038 patent. The word count for the challenged claims is 3,995—29% of the 14,000 words permitted for a single petition.

Ranking. Although Petitioner respectfully requests institution on both Petitions and believes that each Petition is meritorious and justified, the following table sets out the order in which Petitioner wishes the Board to consider the merits.

Rank	Petition	Primary Reference/Combination
1	Petition 1	Diacakis
2	Petition 2	Tanigawa/Huillfish

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Respectfully submitted,

/s/ W. Todd Baker

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