

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, MICROSOFT CORPORATION

Petitioners

v.

CAROLYN W. HAFEMAN

Patent Owner.

IPR2022-01193

U.S. Patent No. 9,892,287

PETITIONERS' NOTICE OF MULTIPLE PETITIONS

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Petitioners, Google LLC and Microsoft Corporation, have requested *Inter Partes* Review (“IPR”) of claims 1-7 (the “Challenged Claims”) of U.S. Patent No. 9,892,287 (“the ’287 Patent”). Petitioners have presented two materially distinct, non-cumulative petitions addressing a priority dispute regarding the effective filing date of the Challenged Claims. *See* IPR2022-01192 (the “November 2002 Priority Petition”) and IPR2022-01193 (the “November 2013 Priority Petition”). Petitioners respectfully request institution of both petitions for the reasons detailed below.

I. Detailed Reasons for Multiple Petitions Against the ’287 Patent.

The ’287 patent claims priority through a series of continuations to U.S. Patent No. 8,601,606 (“the ’606 patent”), filed September 20, 2004, which is a continuation-in-part of Application No. 10/304,827 (“the ’827 application”), filed on November 25, 2002. Petitioners understand that Patent Owner (“PO”) is asserting a priority date no later than August 30, 2002 (prior to the filing date of the ’827 application) in the co-pending district court litigation. (*See* EX-1019, 9.) However, the November 2013 Priority Petition (IPR2022-01193) details that Patent Owner (“PO”) introduced new matter into ’606 patent which severed any potential for priority benefit to the ’827 application. Specifically, the ’606 patent introduced a Retriever program which enabled remote communications solely for the purpose of **changing** the return/recovery information stored in a device. Additionally, even though designated as a continuation, U.S. Patent No. 9,021,610,

filed November 22, 2013, introduced more new matter through its originally filed claims, namely, **initiating** of return/recovery information by remote communications. The four corners of the '606 patent specification, as filed, do not provide any disclosure of the claimed remote initiating. The November 2013 Priority Petition demonstrates that the earliest effective filing date for the Challenged Claims is no earlier than November 22, 2013.

The priority dispute between the parties justifies two petitions. The Patent Trial and Appeal Board's Consolidated Trial Practice Guide expressly acknowledges that "a dispute about priority date requiring arguments under multiple prior art references" is a situation in which it is appropriate to file multiple petitions against the same patent. *See* Office Consolidated Trial Practice Guide, 84 Fed. Reg. 64280 (Nov. 20, 2019) ("TPG"). While the TPG notes that such circumstances may be rare, the facts in the present case here justify institution of two petitions challenging the '287 Patent. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Laboratories, Inc.*, IPR2020-00088, Paper 8, 46-47 (PTAB April 27, 2020) (granting institution of two parallel petitions, explaining that a priority fight concerning swear-behind dates for prior art references justifies concurrent filings with no stipulation by Patent Owner).

The November 2002 Priority and November 2013 Priority Petitions rely on completely distinct prior art combinations asserted to address the different

effective filing dates for the Challenged Claims. The November 2002 Priority Petition relies on four different prior art references (two grounds) all of which pre-date the filing date of the '827 application. The two November 2002 Priority grounds are viable regardless of whether the Challenged Claims are entitled to a pre-November 2013 filing date. The November 2013 Priority Petition, in contrast, presents a ground of anticipation based on the publication of the application for the '606 parent patent and a ground of obviousness based on the publication of the '827 application in combination with Chiu which describes the well-known process of remote management of a mobile device. The November 2013 Priority Petition relies almost exclusively on PO's own prior art, removing the burden that might otherwise be imposed to analyze unfamiliar prior art.

II. Ranking of the Petitions

As set forth in the following table, Petitioners rank the November 2013 Priority Petition higher than the November 2002 Priority Petition. Petitioners believe, however, that instituting both petitions is the fairest outcome because of the dispute regarding priority benefit between the parties. Petitioners have intentionally streamlined the November 2013 Priority Petition which is significantly below the permitted word count to limit the additional effort required by the parties and the Board to resolve the priority issue. Petitioners have also

relied on PO's own prior art in the November 2013 Priority Petition, limiting the burden imposed on PO to analyze unfamiliar art.

	Petition	Claims	Grounds
1	November 2013 IPR2022-01193	1-7	Obviousness over Hafeman '298 and Chiu Anticipation by Hafeman '670
2	November 2002 IPR2002-01192	1-7	Obviousness over Jenne and Cohen Obviousness over Angelo and Helle

Respectfully submitted,

/LORI A. GORDON/

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