UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
GOOGLE LLC,

Petitioners

v.

RYAN HARDIN and ANDREW HILL,

Patent Owners.

Case IPR2022-01329

U.S. Patent No. 10,049,387

Petitioners' Notice Ranking Petitions And Explaining Material Differences Between Petitions For U.S. Patent No. 10,049,387

Petitioners are filing three concurrent petitions challenging the patentability of claims of U.S. Patent No. 10,049,387 (the "'387 patent"). Pursuant to the Board's November 2019 Consolidated Trial Practice Guide ("TPG"), Petitioners submit this paper to "identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits …, and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions."

I. ORDERING OF PETITIONS

Petitioners believe that each petition is meritorious and justified, especially because (as explained further below), each petition is necessary to address all of the claims that Petitioner seeks to challenge. Nonetheless, to the extent required by the Trial Practice Guide, Petitioners request that the Board consider the petitions in the following order:

Rank	PTAB Case No.	Primary References	Challenged Claims
A	IPR2022-01327 ("Petition 1")	*Hardin '665* in view of *Salmre*	1-9, 29-30
B	IPR2022-01328 ("Petition 2")	*Hardin '665* in view of *Salmre*	10-18, 31-32
C	IPR2022-01329 ("Petition 3")	*Hardin '665* in view of *Salmre*	19-28, 33-34

II. THREE PETITIONS ARE NEEDED TO PREVENT PREJUDICE

Each of Petitions 1-3 rely on the same prior art grounds but challenge different, non-overlapping sets of claims. Petitioners submit that three petitions challenging the '387 patent are necessary because there was no practicable way to fit the challenges in a single petition containing less than 14,000 words. Petitioners submit this is because:

- The claims are very long, with claims 1-34 themselves comprising 4,332 words;
- Patent Owners have every claim in the co-pending district court litigation, meaning all three challenged independent claims and all challenged dependent claims are at issue in the district court, for a total of thirty-four asserted claims;
- Demonstrating the '387 patent's broken priority chain requires an extensive discussion of the prosecution history and requires analysis not normally needed in petitions for *inter partes* review;
- While three petitions are needed, each petition relies on the same prior art combination (*Hardin '665*/*Salmre*), thus easing any burden on the Board;
- Petitioners have drafted the challenges as efficiently as possible, providing a claim chart to satisfy 37 C.F.R. § 42.104(b)(4). Petitioners

respectfully submit that claim charts are appropriate here given that *Hardin '665* has the same specification as the challenged patent and Petitioners would expect Patent Owners to take the position that all claim limitations in the challenged patent are found in *Hardin '665*; and

- Petitioners have filed all three petitions concurrently, meaning that Petitioners neither have serially challenged the same claims under different prior art references nor had the benefit of any of Patent Owners' preliminary responses that it might file.

III. THE DIFFERENCES BETWEEN THE PETITIONS

The main difference between each petition is that different claims are challenged. Petitioners note that the analysis in each petition is substantially similar due to the repetitive nature of the challenged claims. For example, independent claim 1 recites a mobile device, independent claim 10 is a *Beauregard* claim, and independent claim 19 is a method claim, similar to claim 1. Petitioners were unable to fit analysis of these three similar independent claims (and similar corresponding dependent claims) into a single 14,000 word petition.

Petitioners submit that the situation here is unlike *General Plastics Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017). Petitioners have not previously challenged the '387 patent, all of the petitions were filed the same day, and while they each challenge different claims, they are all based

on the same prior art. Indeed, given the similarity between the independent claims, the Board's analysis of one petition will in all likelihood be similar to the analysis required by the other two.

IV. DENIAL OF TRIAL INSTITUTION WOULD BE UNFAIR

Petitioners neither drafted the lengthy claims of the '387 patent nor had any say in how many claims would be included in the patent. Nor did Petitioners have any say in what claims to assert in district court litigation. Petitioners respectfully submit that Patent Owners, and not Petitioners, should bear any burden caused by an unreasonable multiplicity of lengthy claims. Petitioners further submit that Patent Owners' decision to assert almost every claim in the co-pending litigation has necessitated the need to file these three petitions. Indeed, denial of any of these three petitions would deprive Petitioners of the forum Congress created to hear patentability challenges.

V. CONCLUSION

Petitioners request that the Board not exercise its discretion to deny any of these three petitions. Petitioners have neither filed multiple serial petitions nor asserted multiple different prior art challenges. Instead, Petitioners challenge a patent with a significant number of lengthy claims, and Patent Owners have asserted almost all of them.

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