

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Maged F. Barsoum et al.
U.S. Patent No.: 10,693,700 Attorney Docket No.: 19688-0196IP2
Issue Date: June 23, 2020
Appl. Serial No.: 16/726,037
Filing Date: December 23, 2019
Title: RECEIVERS INCORPORATING NON-UNIFORM
MULTIDIMENSIONAL CONSTELLATIONS AND CODE RATE
PAIRS

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**PETITIONER'S NOTICE RANKING PETITIONS FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 10,693,700**

Petitioner has filed two petitions (IPR2023-00228 and IPR2023-00319) challenging U.S. Patent No. 10,693,700 (the “’700 patent”). This paper provides “(1) a ranking of the petitions in the order in which [Petitioner] 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....” Trial Practice Guide, 59-61.

I. Ranking of Petitions

Although both petitions are meritorious and justified, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Primary Reference	Claims
1	IPR2023-00228	Eroz	1, 4, 6-11, 14, 16-21, 24, and 26-30
2	IPR2023-00319	’777 patent	2-3, 5, 12-13, 15, 22-23, and 25

II. Factors Supporting Institution, Including Material Differences

A. Two Petitions are Merited due to a Priority issue

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” TPG, 59. One of the examples provided by the Board for justifying the institution of multiple petitions is a “dispute about priority date.” *Id.* The priority date accorded to the ’700 Patent is in dispute because

Patent Owner has alleged priority to June 5, 2007, the filing date of U.S. Provisional Application No. 60/933,319 (“**’319 Provisional**” or LGE1007). However, as explained in Section II of the IPR2023-00319 petition, at least claims 2-3, 5, 12-13, 15, 22-23, and 25 should not be accorded an earlier priority date of June 5, 2007. The subject matter claimed by these claims lacks written description support in the ’319 Provisional and any intervening application in the family, and was introduced into the record as of the filing date (Dec. 23, 2019) of the ’700 Patent. *See* IPR2023-00319 petition, Section II.

The two petitions also assert different prior art references, which are eligible, in part, due to the twelve year gap in the two priority dates. As noted in the table above, the grounds included in the first petition are based on the Eroz primary reference, whereas as the grounds included in the second petition are based on the ’777 Patent (U.S. Patent No. 7,978,777) primary reference. The ’777 Patent and secondary references, such as the ATSC standard references, asserted in the second petition (IPR2023-00319) qualify as prior art based on the Dec. 23, 2019 priority date. Thus, the priority date at issue has also given rise to different prior art challenges based on entirely different combinations in both petitions. Institution of both petitions is therefore warranted to ensure that Petitioner is afforded a fair and reasonable opportunity for the PTAB to consider IPR challenges on the claims of the ’700 Patent based on their respective priority dates and eligible prior art.

B. The Two Petitions Challenge Different Claims

As noted in the table above, the IPR2023-00228 petition challenges claims 1, 4, 6-11, 14, 16-21, 24, and 26-30, and the IPR2023-00319 petition challenges claims 2-3, 5, 12-13, 15, 22-23, and 25. Thus, the two petitions challenge entirely different claims with no overlap.

The scope of the two sets of claims are also substantively different (e.g., compare claim 3 to any claim challenged in the IPR2023-00228). These differences require individualized attention, and significant consumption of word count to address each of the respective claim sets. For example, claim 3 is almost half a column long and recites several substantively narrow claim features that were not at issue in the claims challenged in the IPR2023-00228 petition. Other differences between the claims challenged in IPR2023-00228 and the claims challenged in IPR2023-00319 are facially apparent. Due to the difference in claim scope between the two sets of challenged claims, the different prior art mapped against the claims in each petition, and the significantly narrow scope of the claims challenged in IPR2023-00319 that required particular attention, two petitions were needed to sufficiently demonstrate a reasonable likelihood that the claims of the '700 Patent were obvious and invalid.

Institution of both petitions is respectfully requested to ensure that Petitioner is afforded a fair and reasonable opportunity for the PTAB to consider IPR challenges on each of claims 1-30 of the '700 Patent.

Finally, the Board's institution of IPRs based on both petitions, which compellingly demonstrate invalidity of the Challenged Claims based on materially different grounds, would serve to efficiently address issues of invalidity for all parties, including Patent Owner. Indeed, the Board's institution of both petitions and subsequent resolution of the validity issues presented therein has the potential to play a significant role in bringing the dispute between the parties to a close sooner than if the Board exercised discretion not to institute on one or more of the petitions. The compelling merits of the grounds set forth in both petitions also warrants instituting both petitions, both to serve the public's interest in weeding out bad patent claims and to ensure that Petitioner has a fair and reasonable opportunity for its invalidity challenges against all the claims that Patent Owner currently asserts in its litigation campaign to be considered by the PTAB. Moreover, because Petitioner has offered a *Sotera* stipulation, the Board should address the invalidity of all the '700 Patent claims as a matter of judicial efficiency as the same invalidity issues will not be addressed in the District Court.

For at least these reasons, Petitioner respectfully requests that the Board institute trial on both petitions.

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