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Paper 13
Entered: February 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RYAN HARDIN and ANDREW HILL,
Patent Owner.

IPR2022-01328
Patent 10,049,387 B2

Before BART A. GERSTENBLITH, MICHELLE N. WORMMEESTER, and ARTHUR M. PESLAK, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. (collectively, "Samsung") and Google LLC ("Google"; collectively, "Petitioner") filed a Petition (Paper 4, "Pet.") requesting institution of *inter partes* review of claims 10–18, 31, and 32 ("the Challenged Claims") of U.S. Patent No. 10,049,387 B2 (Ex. 1001, "the '387 patent"). Petitioner also filed a Notice Ranking Petitions and Explaining Material Differences Between Petitions for U.S. Patent No. 10,049,387 (Paper 5, "Notice") because Petitioner filed two additional petitions challenging claims of the '387 patent in IPR2022-01327 and IPR2022-01329. Ryan Hardin and Andrew Hill (collectively, "Patent Owner") filed a Preliminary Response (Paper 9, "Prelim. Resp.") and a Response to Petitioner's Notice (Paper 10, "Notice Resp."). With our prior authorization, Petitioner filed a limited[1] Preliminary Reply (Paper 11, "Prelim. Reply"), and Patent Owner filed a Sur-reply (Paper 12, "Prelim. Sur-reply").

An *inter partes* review may be instituted only if "the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a) (2018). For the reasons below, Petitioner has established a reasonable

[1] Petitioner's Preliminary Reply is limited to the issue of discretionary denial pursuant to *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), and, particularly, the effect of Samsung's stipulation in related litigation, in accordance with *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A).

likelihood that it would prevail in showing the unpatentability of at least one of the Challenged Claims. Accordingly, we institute an *inter partes* review of the Challenged Claims on all grounds raised in the Petition.

B. Related Proceedings

The parties identify *Hardin et al. v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.*, No. 2:21-CV-00290-JRG (E.D. Tex.), as a related matter. Pet. 68; Paper 8 (Patent Owner's Mandatory Notices), 1. Petitioner also challenges claims of the '387 patent in IPR2022-01327 and IPR2022-01329, and challenges claims of two related patents in the following proceedings: U.S. Patent No. 9,779,418 B2 (IPR2022-01330, IPR2022-01331, and IPR2022-01332); and U.S. Patent No. 10,984,447 B2 (IPR2022-01333, IPR2022-01334, and IPR2022-01335). Pet. 68; Paper 8, 1. Additionally, Petitioner identifies U.S. Patent Application No. 17/182,809, as a pending continuation application of U.S. Patent Application No. 16/019,285. Pet. 68.

C. Real Parties in Interest

Petitioner and Patent Owner each identifies itself as the real party in interest. Pet. 67; Paper 8, 1.

D. The Asserted Ground of Unpatentability and Declaration Evidence

Petitioner challenges the patentability of claims 10–18, 31, and 32 of the ’387 patent on the following ground:

Claim(s) Challenged	35 U.S.C. §[2]	Reference(s)/Basis
10–18, 31, 32	103	Hardin ’665,[3] Salmre[4]

Pet. 3. Petitioner supports its challenge with a Declaration of David H. Williams (Ex. 1003). Patent Owner supports its Preliminary Response with a Declaration of Scott A. Denning (Ex. 2001).

E. The ’387 Patent

The ’387 patent is titled “Exclusive Delivery of Content Within Geographic Areas.” Ex. 1001, code (54). The ’387 patent issued on August 14, 2018, and claims priority through a series of continuation applications to U.S. Patent Application No. 12/434,094 (“the ’094 application”), filed May 1, 2009. *Id.* at code (63).

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[2] The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective on March 16, 2013. One of the central issues in this proceeding is the priority date of the Challenged Claims. The ’387 patent was filed on September 2, 2017 (Ex. 1001, code (22)), and claims priority to an application filed May 1, 2009 (*id.* at code (63)). Petitioner contests the ’387 patent’s priority claim, asserting that the earliest priority date of the Challenged Claims is January 29, 2015. Pet. 27–28. Because we find that Petitioner has established a reasonable likelihood of prevailing on the present record, we apply the current version of § 103 here. Our analysis, however, would be the same regardless of which version of the statute is applied because the critical issues before us are not impacted by the differences in the two versions of the statute.

[3] U.S. Patent Application Publication No. 2010/0279665 A1, published Nov. 4, 2010 (Ex. 1005, “Hardin ’665”).

[4] U.S. Patent Application Publication No. 2006/0116817 A1, published June 1, 2006 (Ex. 1006, “Salmre”).

As background, the ’387 patent explains that advertisements and other content can be broadcast “to any mobile device within a city, or a similar area,” or can delivered over the Internet “in response to a request, received from the receiving device.” *See* Ex. 1001, 1:37–52. According to the ’387 patent, in order to provide more targeted advertising, a “content delivery platform can receive a request from a registered application program for content to be displayed on a mobile device, and the request can be used to determine a target location.” *Id.* at 1:65–2:2. An exemplary content delivery system is depicted in Figure 1, reproduced below.

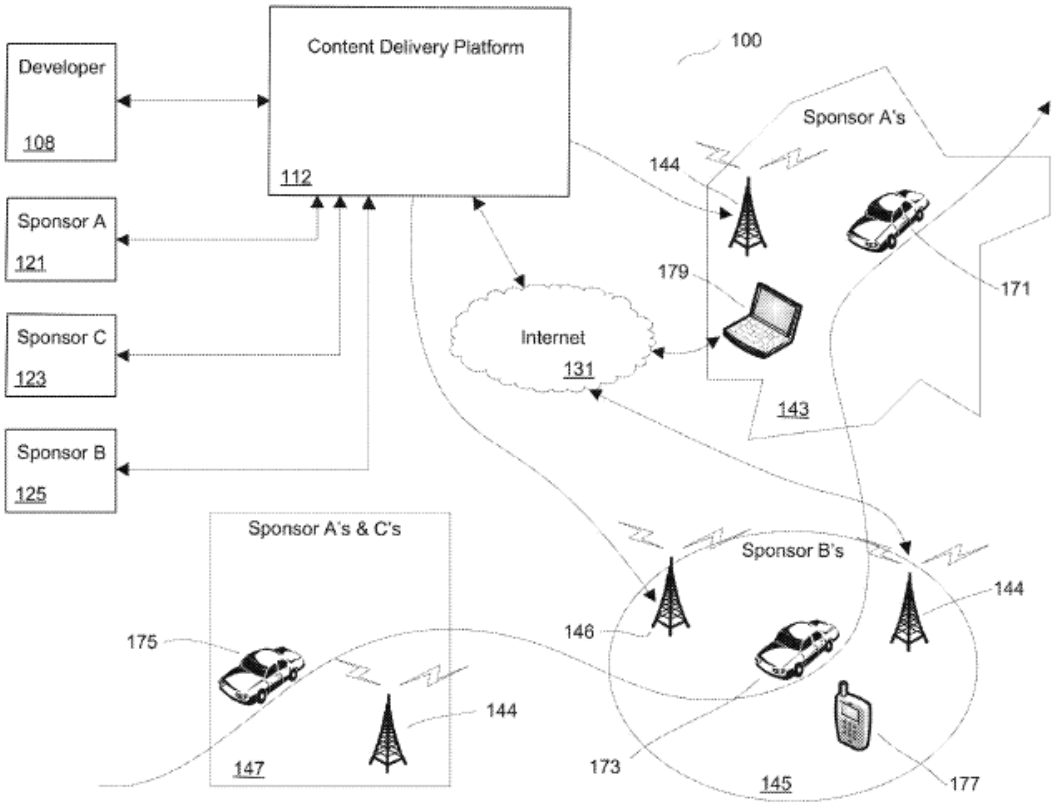

FIG. 1

Figure 1 “is an abstract representation of exclusive content delivery to particular reserved areas.” *Id.* at 2:48–50. System 100, depicted in Figure 1, “can provide exclusive delivery of advertising or other content to registered

applications running on mobile devices located within a particular proximity to a reserved geographic area." *Id.* at 3:17–21. System 100 "includes content delivery platform 112, which is in communication with developer platform 108, and systems or individuals operating under control of sponsor A 121, sponsor C 123, and sponsor B 125." *Id.* at 3:21–25. The '387 patent provides that content delivery platform 112 receives a request from developer platform 108 to register a program or other application for use on mobile devices, and uses "the registered application program to provide selected content to mobile devices." *Id.* at 3:25–29. According to the '387 patent, "a registered application program is provided to mobile devices by developer platform 108, content delivery platform 112, one of sponsor A 121, sponsor C 123, or sponsor B 125, or by another desired delivery mechanism." *Id.* at 3:30–34.

The '387 patent explains that "[s]ponsor A 121, sponsor C 123, or sponsor B 125 can reserve an exclusive interest in a particular geographic area by sending a request to content delivery platform 112." Ex. 1001, 3:40–42. The '387 patent further explains that "the request can be for exclusive delivery of content to mobile devices running any registered application within given geographic areas, or for content to be delivered to particular registered applications based on a target location." *Id.* at 3:43–47.

Figure 2 of the ’387 patent is reproduced below.

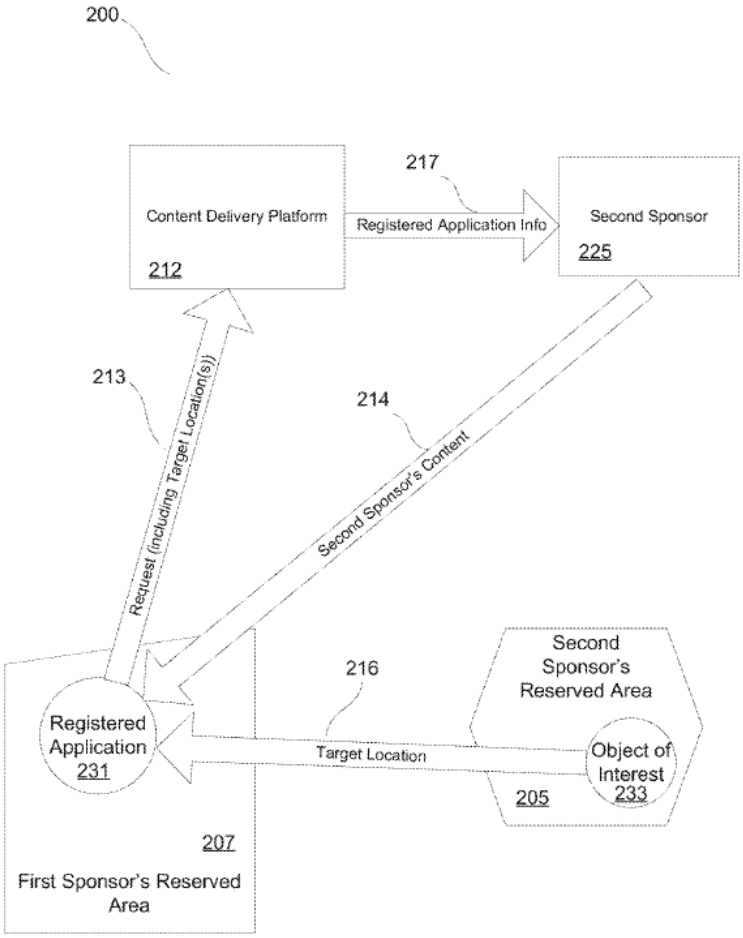

FIG. 2

Figure 2 “is a diagram illustrating a target location other than the location of the mobile device executing a registered application.” Ex. 1001, 2:51–54. The ’387 patent explains the following regarding Figure 2:

> [A] user of registered application 231 is located within the perimeter defining a first sponsor’s reserved area 207. Object of interest 233 is located in second sponsor’s reserved area 205. In some embodiments, object of interest 233 can be any type of object of interest to the user of registered application 231. . . . In some embodiments, target location information 216 can be any type of information that can be used to determine the location of the object of interest 233. . . .

> In response to receiving the target location information 216 from object of interest 233, registered application 231 can send a request 213 to content delivery platform 212. The request can include, but is not limited to, information indicating the location of object of interest 233, a request for content, information indicating the location of registered application 231, information indicating the identity of the registered application 231, and a previously received request identifier.
>
> Content delivery platform 212 can receive and process request 213 to identify the location of registered application 231 and the location of object of interest 233. . . .
>
> Content delivery platform 212 can provide registered application information 217 to second sponsor 225 to allow second sponsor 225 to deliver second sponsor's content 214 to registered application 231. . . . In some embodiments, application information 217 need not be provided to second sponsor 225, but instead can be processed internally by content delivery platform 212, and a determination can be made for second sponsor's content 214 to be delivered directly to application 231 from content delivery platform 212, or a third party (not illustrated).

Id. at 5:53–6:35.

Figure 4 of the ’387 patent is reproduced below.

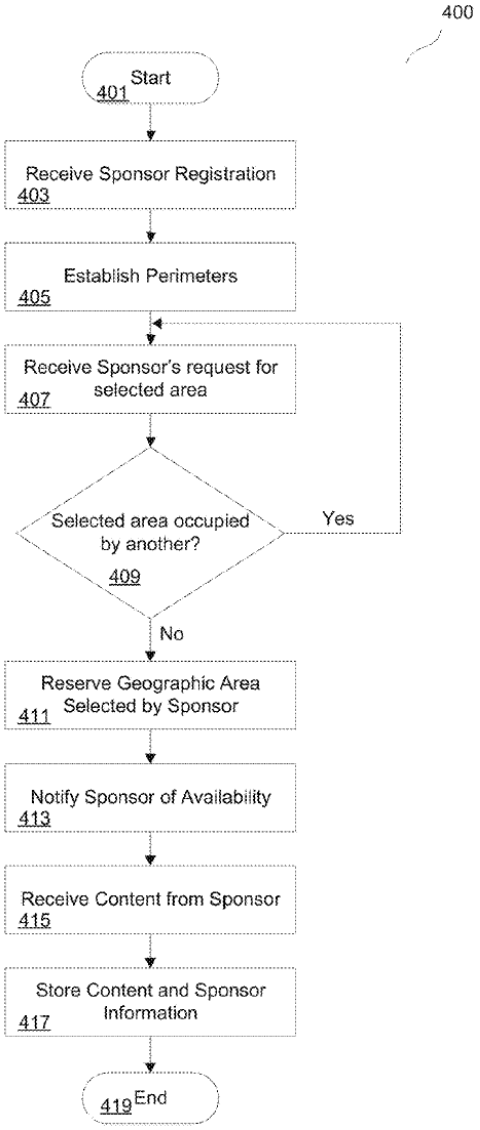

Figure 4 “is a flowchart illustrating a method of reserving a geographic area.” Ex. 1001, 2:59–61. In particular, the ’387 patent states that method 400 “allow[s] sponsors to reserve particular geographic areas.” *Id.* at 9:3–6. The ’387 patent explains the following regarding the disclosed method of reserving a geographic area:

> Method 400 begins, as illustrated by block 401. As illustrated by block 403, a content delivery platform, for example content delivery platform 112 as illustrated in FIG. 1, can receive a

> request for sponsor registration . . . . As illustrated by block 405, the sponsor can establish perimeters defining geographic areas of exclusive or semi-exclusive control. These geographic areas are areas the sponsor wishes to reserve for delivery of his own advertisements or other content controlled by the sponsor.
>
> . . . .
>
> As illustrated by block 407, a sponsor's request for a selected area is received. . . .
>
> As illustrated by block 411, if an area selected for exclusive or semi-exclusive content delivery is available, the selected geographic area can be reserved for the sponsor. . . .
>
> A sponsor can provide content for delivery to mobile devices having target locations contained within its reserved area, as illustrated by block 415.

Id. at 9:6–54.

F. Illustrative Claim

Claim 10, the sole independent claim challenged in this proceeding, is illustrative of the claimed subject matter and is reproduced below with Petitioner's bracketing added for reference (*see* Pet. v–vi (Listing of Challenged Claims)):

> [10.pre] A non-transitory computer readable medium tangibly embodying at least one program of computer executable instructions, wherein the at least one program of computer executable instructions comprises at least one instruction for:
>
> [10.a] receiving, on a mobile device, from an application program during its execution in the mobile device, one or more requests to reserve at least one selected geographic area of interest, wherein the at least one selected geographic area of interest in each of the one or more requests is being requested via said application program to be reserved for having a particular identifier associated with the at least one selected geographic area of interest provided to said application program

[10.b] after it has been determined, by at least use of at least one processor tangibly embodied by the mobile device and of location information representing at least one physical geographic location of the mobile device as determined by a location-determination component tangibly embodied by the mobile device, that the mobile device has at least entered the at least one selected geographic area of interest, and
[10.c] wherein each of the one or more requests comprises data representing a) said particular identifier, represented by a data string, as content provided via said application program to be associated with the at least one selected geographic area of interest, [10.d] b) at least one latitude value, at least one longitude value, and at least one radius value, each being provided via said application program, to be used for establishing a perimeter boundary for the at least one selected geographic area of interest, and c) information specifying at least one area bound by the perimeter boundary as the at least one selected geographic area of interest;

[10.e] registering said application program, in a memory tangibly embodied by the mobile device, for having said particular identifier provided to said application program after it has been determined, by at least use of the at least one processor and of the location information, that the mobile device has at least entered the at least one selected geographic area of interest;

[10.f] storing, in the memory, at least one record, for said application program, associated with said particular identifier and the at least one selected geographic area of interest;

[10.g] obtaining the location information representing at least one physical geographic location of the mobile device as determined by the location-determination component; and

[10.h] after it has been determined, by at least use of the at least one processor, of the location information, and of the at least one selected geographic area of interest associated with the at least one record stored in the memory for said application program, that the mobile device has at least entered the at least one selected geographic area of interest associated with the at

> least one record stored in the memory and has remained therein for at least a designated length of time, [10.i] providing at least said particular identifier associated with the at least one record stored in the memory to said application program.

Ex. 1001, 16:17–17:9.

G. Level of Ordinary Skill in the Art

Petitioner, supported by Mr. Williams' testimony, proposes that a person of ordinary skill in the art at the time of the invention ("either 5/1/2009 or 1/29/2015") would have had "at least a bachelor's degree in computer science or a comparable field of study and at least five years of professional experience in mobile or location-based computing or other relevant academic experience." Pet. 21 (citing Ex. 1003 ¶¶ 38–41).

In the Preliminary Response, Patent Owner acknowledges Petitioner's proposed level of ordinary skill in the art, but does not take a position on the issue. Prelim. Resp. 46. Mr. Denning, however, applies Mr. Williams' level of ordinary skill in the art in Mr. Denning's Declaration in support in Patent Owner's Preliminary Response. Ex. 2001 ¶ 26.

At this stage of the proceeding and on the present record, we find that Petitioner's uncontested level of ordinary skill in the art is consistent with the level of ordinary skill in the art reflected by the '387 patent and the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978). Therefore, we adopt Petitioner's level of ordinary skill in the art in our consideration of the issues presently before us.

II. CLAIM CONSTRUCTION

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil

action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b) (2021). The claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art at the time of the invention. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Phillips*, 415 F.3d at 1315–17.

Additionally, only terms that are in controversy need to be construed, and these need be construed only to the extent necessary to resolve the controversy. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) ("The Board is required to construe 'only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.'") (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

Petitioner explains that it has "taken the position in [district court] that several claim terms are indefinite," but "solely for purposes of this proceeding[,] Petitioner[] adopt[s] [Patent Owner's] position that each such term should receive its plain and ordinary meaning." Pet. 21. Petitioner contends that "because Hardin '665[5] contains the identical disclosure as the specification of the challenged '387 patent, Petitioner[] believe[s] that no express claim constructions are necessary, and the claims should be given

[5] Throughout the Petition, Petitioner italicizes the names of the references (i.e., *Hardin '665* and *Salmre*). *See, e.g.*, Pet. 20 (indicating both). In this Decision, we have removed the italics from these terms in any quoted material and do not further indicate such removal.

their plain and ordinary meaning in this proceeding." *Id.* at 21–22 (footnote added) (citing *Phillips*, 415 F.3d at 1303).

In the Preliminary Response, Patent Owner acknowledges that Petitioner proposes that the claim terms should be given their plain and ordinary meaning, but does not affirmatively agree with Petitioner's statement. Prelim. Resp. 33. Patent Owner, however, contends that "[f]or purposes of this response, Patent Owner[] do[es] not believe the Board needs to construe any terms." *Id.*

At this stage of the proceeding, we need not construe any claim terms expressly because none are in dispute. *Realtime Data*, 912 F.3d at 1375 (quoting *Vivid Techs.*, 200 F.3d at 803).

III. ANALYSIS

As noted above, Petitioner filed three petitions challenging claims of the '387 patent. Recently, we instituted *inter partes* review in IPR2022-01327, one of the cases in which Petitioner challenges claims of the '387 patent. *See Samsung Elecs. Co. v. Hardin*, IPR2022-01327, Paper 13 (PTAB Feb. 7, 2023) (institution decision). The parties acknowledge that the issues raised in this proceeding are substantially identical to those raised in IPR2022-01327. Notice 3 ("Petitioner[s] note[s] that the analysis in each petition is substantially similar due to the repetitive nature of the challenged claims."); Prelim. Resp. 1 n.1 ("Because the petitions each raise the same written description argument, the inventors' Patent Owner Preliminary Responses are substantively identical."). Based on our review of the briefing filed in this proceeding, we agree with the parties that the briefs in this proceeding and IPR2022-01327 raise substantially the same issues, arguments, and evidence. In particular, we note at least the following

substantial similarities between the issues in this proceeding and those raised in IPR2022-01327:

(1) Petitioner asserts that substantially the same two claim limitations lack written description support in the ’094 application and U.S. Patent Application No. 13/856,392 (“the ’392 application”) (*compare* Pet. 23–27, *with* IPR2022-01327, Paper 4 (petition) at 23–27);

(2) Petitioner asserts that because these limitations lack written description support in the ’094 and ’392 applications, the Challenged Claims are not entitled to the priority date of either of these applications and, therefore, Hardin ’665 (the pre-issuance publication of the ’094 application) is available as prior art to the Challenged Claims (*compare* Pet. 1, 2, 27–28, *with* IPR2022-01327, Paper 4 at 1, 2, 27–28);

(3) Petitioner asserts that the same combination of references—Hardin ’665 and Salmre—would have rendered the subject matter of the claims challenged in each petition obvious to one of ordinary skill in the art at the time of the invention (*compare* Pet. 28–59, *with* IPR2022-01327, Paper 4 at 28–63);

(4) Petitioner asserts the same reasons with rational underpinning as to why one of ordinary skill in the art would have been motivated to combine the teachings of Hardin ’665 and Salmre as proposed with a reasonable expectation of success (*compare* Pet. 59–65, *with* IPR2022-01327, Paper 4 at 63–69);

(5) Patent Owner does not raise an argument responding to Petitioner’s challenge based on Hardin ’665 and Salmre aside from whether the Challenged Claims of the ’387 patent are entitled to the priority date of

the ’094 application (*see generally* Prelim. Resp.; IPR2022-01327, Paper 9 (preliminary response));

(6) Patent Owner relies on the same argument and evidence to assert that we should exercise our discretion to deny institution pursuant to 35 U.S.C. § 314(a) and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (*compare* Prelim. Resp. 61–66, *with* IPR2022-01327, Paper 9 at 61–66);

(7) Patent Owner’s Response to Petitioner’s Notice relies on the same argument and evidence to assert that we should exercise our discretion to deny institution of the instant Petition pursuant to 35 U.S.C. § 314(a) because Petitioner should have challenged all of the claims of the ’387 patent in a single petition (*compare* Notice Resp., *with* IPR2022-01327, Paper 10 (Patent Owner’s notice response)); and

(8) Patent Owner relies on the same argument and evidence to assert that we should exercise our discretion to deny institution pursuant to 35 U.S.C. § 325(d) (*compare* Prelim. Resp. 34–44, *with* IPR2022-01327, Paper 9 at 34–44).

With the exception of issue (7), which we address further below,[6] our analysis of the parties’ arguments and evidence, at this stage of the proceeding, is identical to the detailed analysis we undertook and fully set forth in the institution decision (Paper 13) in IPR2022-01327. Therefore, we adopt and incorporate our findings and determinations from that decision as though they were fully set forth herein.

[6] We discuss issue (7) further below because our consideration of that issue here is different than our consideration of that issue in IPR2022-01327.

Accordingly, for the reasons set forth in IPR2022-01327, Paper 13, we: (1) determine, based on the present record, that the Challenged Claims of the ’387 patent are not entitled to the priority date of the ’094 application, and, therefore, Hardin ’665 is available as prior art to the ’387 patent; (2) determine that, on balance, considering the record presently before us, Petitioner has established a reasonable likelihood that it would prevail in showing that the combination of Hardin ’665 and Salmre would have rendered the subject matter of claims 10–18, 31, and 32 of the ’387 patent obvious to one of ordinary skill in the art at the time of the invention; (3) decline to exercise our discretion to deny institution pursuant to 35 U.S.C. § 314(a) and *Fintiv*; and (4) decline to exercise our discretion to deny institution pursuant to 35 U.S.C. § 325(d).

IV. DISCRETION UNDER 35 U.S.C. § 314(a) – MULTIPLE PETITIONS

As noted above, Petitioner filed three petitions on the same day in IPR2022-01327, IPR2022-01328, and IPR2022-01329, challenging different claim sets of the ’387 patent. Pet. 68; Notice 1. Because our analysis of whether to exercise our discretion to deny institution of the instant Petition (i.e., Petitioner’s second-ranked petition) is different than our analysis of this issue in the context of Petitioner’s first-ranked petition (in IPR2022-01327), we address this issue here fully. We begin with Petitioner’s Notice which, pursuant to the Board’s Consolidated Trial Practice Guide (“Trial Practice Guide”), provides a ranking of the three petitions in the order in which Petitioner wishes the Board to consider the merits and a succinct explanation of the differences between the Petitions. *See* PTAB Consolidated Trial

Practice Guide, 59–60 (Nov. 2019) ("CTPG").[7] In IPR2022-01327, Petitioner challenges claims 1–9, 29, and 30, and ranks the petition as "A." Notice 1. In this proceeding, Petitioner challenges claims 10–18, 31, and 32, and ranks the instant Petition as "B." *Id.* And, in IPR2022-01329, Petitioner challenges claims 19–28, 33, and 34, and ranks the petition as "C." *Id.*

As noted above, in each of the three petitions, Petitioner raises only one ground and that ground relies on the same combination of references, Hardin '665 and Salmre. Notice 1. Petitioner asserts that claims 1, 10, and 19 are independent and that the analyses of "these three similar independent claims (and similar corresponding dependent claims)" are "substantially similar due to the repetitive nature of the challenged claims." *Id.* at 3. Petitioner specifies that claim 1 recites a mobile device, claim 10 is a *Beauregard* claim,[8] and claim 19 is a method claim. *Id.* Petitioner further acknowledges that, "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." *Id.* at 4.

Despite the similarities across the petitions, Petitioner contends that three petitions "are necessary because there was no practicable way to fit the challenges in a single petition containing less than 14,000 words." Notice 2. As support, Petitioner asserts that (1) the claims of the '387 patent are "very long," comprising 4,332 words; (2) Patent Owner has asserted all thirty-four

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[7] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.
[8] A *Beauregard* claim is a computer-readable medium claim, named after the decision by the U.S. Court of Appeals for the Federal Circuit in *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995).

claims of the ’387 patent in the co-pending district court case; and (3) “demonstrating the ’387 patent’s broken priority chain” entails an “extensive discussion of the prosecution history” as well as “requires analysis not normally needed in petitions for *inter partes* review.” *Id.* Petitioner further asserts that it has “drafted the challenges as efficiently as possible,” and that “each petition relies on the same prior art combination,” thereby “easing any burden on the Board.” *Id.* Petitioner adds that it neither serially challenged the same claims based on different references nor had the benefit of any preliminary response, given that it filed all three petitions concurrently. *Id.* at 3.

According to Petitioner, denying institution of any of the petitions would be unfair. Notice 4. Petitioner asserts that it “neither drafted the lengthy claims of the ’387 patent nor had any say in how many claims would be included in the patent.” *Id.* Petitioner further asserts that it had no “say in what claims to assert in district court litigation” and that Patent Owner “should bear any burden caused by an unreasonable multiplicity of lengthy claims.” *Id.*

Patent Owner counters that “at most only one petition should be instituted . . . and the rest denied.” Notice Resp. 1. Patent Owner contends that our Trial Practice Guide “confirms[] [that] filing three petitions against a single patent is *prima facie* unnecessary and unreasonable.” *Id.* at 3 (citing CTPG 59). Patent Owner also points out that Petitioner fails to acknowledge or attempt to rebut the statement in the Trial Practice Guide concerning the filing of three or more petitions. *Id.*

Patent Owner further contends that Petitioner’s argument that the claims in the ’387 patent are very long is without merit. Notice Resp. 4.

According to Patent Owner, "[e]ven if the claims total 4,332 words, that still leaves over 9,500 words for analysis (and ***over 23,500*** words in two petitions)." *Id.* Additionally, Patent Owner contends that the fact that the petitions are based on the same broken priority chain arguments and the same prior art combination "weigh[s] against, not for, instituting multiple petitions." *Id.* According to Patent Owner, "other than different claims, Petitioner[] concede[s] that the petitions are materially the same." *Id.* (citing Notice 3).

Pursuant to 35 U.S.C. § 314(a), the Board "is permitted, but never compelled, to institute an IPR proceeding." *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016); *see also* 37 C.F.R. § 42.4(a) ("The Board institutes the trial on behalf of the Director."). That is, institution of an *inter partes* review is discretionary. In evaluating whether to exercise that discretion here, we turn to the Trial Practice Guide, which provides guidance on whether institution of more than one concurrently filed petition challenging the same patent is appropriate. *See* CTPG 59.

The Trial Practice Guide states that "one petition should be sufficient to challenge the claims of a patent in most situations." CTPG 59. "Two or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns." *Id.* (citing 35 U.S.C. § 316(b)). Although rare circumstances may necessitate two petitions, "the Board finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate." *Id.* We do not agree with Patent Owner, however, that this statement in the Trial Practice Guide means that the filing of three petitions

challenging the same patent "is *prima facie* unreasonable and unnecessary." *See* Notice Resp. 3. Rather, our determination is based on the specific facts of each case, starting with Petitioner's explanation of why multiple petitions may be necessary.

To help the Board determine whether multiple petitions are necessary, the Trial Practice Guide further instructs a petitioner filing multiple petitions challenging the same patent to explain "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 if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)." CTPG 59–60. Additionally, the Trial Practice Guide instructs the patent owner to "clearly proffer any necessary stipulations," where the patent owner asserts that "the differences identified by the petitioner are directed to an issue that is not material or not in dispute." *Id.* at 61. The patent owner may, for example, "seek to avoid additional petitions by proffering a stipulation that certain claim limitations are not disputed or that certain references qualify as prior art." *Id.*

In light of the particular facts before us, we decline to exercise our discretion to deny the Petition pursuant to 35 U.S.C. § 314(a). In particular, we recognize that the claims are very long (e.g., claim 1 is nearly a column in length) and that Patent Owner asserts thirty-four claims in district court, including the three independent claims. Unlike many cases involving only a single petition, the instant Petition, as well as the other two petitions challenging claims of the '387 patent, include a lengthy and detailed argument as to whether the claims are entitled to the priority date of Hardin '665. Pet. 22–28. As to this priority challenge, Petitioner incurred

the use of additional space to repeat substantially the same arguments concerning the specification of the ’387 patent, the prosecution history of the ’387 patent and related patents, and Petitioner’s priority arguments in each petition.

Additionally, the usual considerations of fairness, timing, and efficiency do not weigh in favor of exercising our discretion to deny institution. In particular, the petitions were filed concurrently, which means that Petitioner did not gain a timing advantage that might otherwise occur were the petitions filed serially. Additionally, the three proceedings can be coordinated or consolidated, and a common schedule adopted. Further, given that the same, single ground is raised in each petition and the petitions have overlapping arguments and evidence, institution on the second and third petitions will create at most a relatively small amount of additional effort by the parties and the Board as compared to instituting an *inter partes* review based on just one of the three petitions.[9] Indeed, Patent Owner states that, “[b]ecause the petitions each raise the same written description argument, the inventors’ Patent Owner Preliminary Responses are substantively identical.” Prelim. Resp. 1 n.1; *see also* Notice 4 (Petitioner arguing that, “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”). Therefore, we disagree with Patent Owner’s argument that instituting on all three petitions “places ‘a substantial and unnecessary burden on the Board and the patent owner and could raise

[9] The burden on Patent Owner and the Board here also is substantially less than if the multiple petitions raised multiple grounds or different grounds across each of the petitions.

fairness, timing, and efficiency concerns.'" Notice Resp. 2 (quoting CTPG 59).

We note Patent Owner's reliance on the prior Board decision *Fantasia Trading LLC v. CogniPower LLC*, IPR2021-00073, Paper 21 (PTAB May 12, 2021). Notice Resp. 4–5. We find *Fantasia* distinguishable from the facts before us for at least the following reasons. In *Fantasia*, the Board exercised its discretion to deny additional petitions because the petitioner "[d]id not argue that it could not have asserted at least one ground against each claim being challenged in a single petition." *Fantasia*, Paper 21 at 12. Instead, the petitioner in *Fantasia* asserted "that it could not fit '*all of its grounds* against the asserted claims into a single petition'" (*id.* at 12), where the petitioner asserted alternative grounds across multiple petitions (*id.* at 13). In contrast, Petitioner here raises only *one* ground *and* argues that "there was no practicable way to fit the challenges in a single petition containing less than 14,000 words." Notice 2. And, for the reasons discussed above, on the particular facts before us, we do not find that the additional petitions asserted against the '387 patent raise fairness, timing, and efficiency concerns.

Accordingly, based on the particular facts and circumstances before us, we decline to exercise our discretion to deny the instant Petition under § 314(a).

V. CONSOLIDATION OF PROCEEDINGS

As discussed above, this proceeding, IPR2022-01327, and IPR2022-01329 challenge claims of the '387 patent and have a substantial overlap of arguments and evidence. Consolidation is appropriate where, as here, the Board can more efficiently handle the common issues and

evidence, and can maintain consistency across proceedings. Pursuant to 35 U.S.C. § 315(d), "during the pendency of an inter partes review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for . . . consolidation . . . of any such matter or proceeding." *See* 37 C.F.R. § 42.122(a) ("Where another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the . . . consolidation . . . of any such matter."). Therefore, for the foregoing reasons, we consolidate this proceeding with IPR2022-01327 and conduct the proceedings as one trial.[10]

VI. CONCLUSION

For the foregoing reasons, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the '387 patent is unpatentable. Our analysis is based on the preliminary record developed thus far and may change after the record is developed fully, during trial.

[10] We contemporaneously issue an institution decision in IPR2022-01329 and, in that decision, we also consolidate IPR2022-01329 with IPR2022-01327 for the same reasons discussed above.

VII. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is instituted as to claims 10–18, 31, and 32 of the ’387 patent on the ground set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the ’387 patent shall commence on the entry date of this Decision, and notice is hereby given of the institution of a trial;

FURTHER ORDERED that, pursuant to 35 U.S.C.§ 315(d), IPR2022-01327 and IPR2022-01328 are consolidated, and all further filings in the consolidated proceeding shall be made in IPR2022-01327;

FURTHER ORDERED that the parties shall file in IPR2022-01327 any exhibits from IPR2022-01328 that are not of record in IPR2022-01327 within ten business days of this Order;

FURTHER ORDERED that the Scheduling Order entered in IPR2022-01327 shall govern the schedule of the consolidated proceeding;

FURTHER ORDERED that, throughout the consolidated proceeding, the parties shall file their papers as a single, consolidated filing and will conduct coordinated discovery in the consolidated proceeding so as to avoid multiple depositions of declarants;

FURTHER ORDERED that a conference call will be conducted with the parties during which the word counts for certain yet-to-be-filed papers in the consolidated proceeding will be discussed and determined;

FURTHER ORDERED that the case caption in IPR2022-01327 shall be changed to reflect the consolidation in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered in the record of IPR2022-01327.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RYAN HARDIN and ANDREW HILL,
Patent Owner.

IPR2022-01327[11]
Patent 10,049,387 B2

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[11] IPR2022-01328 and IPR2022-01329 have been consolidated with this proceeding.