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Paper 13
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.

IPR2022-01330
Patent 9,779,418 B2

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

WORMMEESTER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. (collectively, "Samsung"), and Google LLC (collectively, "Petitioner") filed a Petition (Paper 4, "Pet.") requesting *inter partes* review of claims 1–10 of U.S. Patent No. 9,779,418 B2 (Ex. 1001, "the '418 patent"). Ryan Hardin and Andrew Hill (collectively, "Patent Owner") filed a Preliminary Response (Paper 9, "Prelim. Resp."). With our authorization, Petitioner filed a Preliminary Reply (Paper 11, "Prelim. Reply") to Patent Owner's Preliminary Response, and Patent Owner filed a Preliminary Sur-reply (Paper 12, "Prelim. Sur-reply") to Petitioner's Preliminary Reply.[1]

Petitioner also filed a Notice Ranking Petitions and Explaining Material Differences Between Petitions for U.S. Patent No. 9,779,418. Paper 5 ("Notice"). Patent Owner filed a Response to Petitioner's Notice. Paper 10 ("Notice Resp.").

We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we institute an *inter partes* review as to all the challenged claims of the '418 patent, namely, claims 1–10, based on the sole ground presented in the Petition.

[1] We authorized the parties to file these papers in an e-mail dated December 8, 2022.

II. BACKGROUND

A. Related Proceedings

The parties identify a related federal district court case, *Hardin v. Samsung Electronics Co.*, No. 2:21-cv-00290-JRG (E.D. Tex.). Pet. 73; Paper 8, 1 (Patent Owner's Mandatory Notices).

The parties additionally indicate that Petitioner concurrently filed several other, related petitions for *inter partes* review. Pet. 73–74; Paper 8, 1. Two related petitions also involve the '418 patent, one petition challenging claims 11–18 (not challenged in this proceeding) in IPR2022-01331, and the other petition challenging claims 19–25 (not challenged in this proceeding) in IPR2022-01332. Pet. 74; Notice 2; Paper 8, 1. In separate decisions, we institute review in those proceedings.

B. The '418 Patent

As background, the '418 patent explains that advertisements and other content can be "broadcast to any mobile device within a city, or a similar area," or can be delivered over the Internet "in response to a request, received from the receiving device." Ex. 1001, 1:40–47. According to the '418 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 1:60–64.

An exemplary content delivery system is depicted in Figure 1 of the '418 patent, reproduced below.

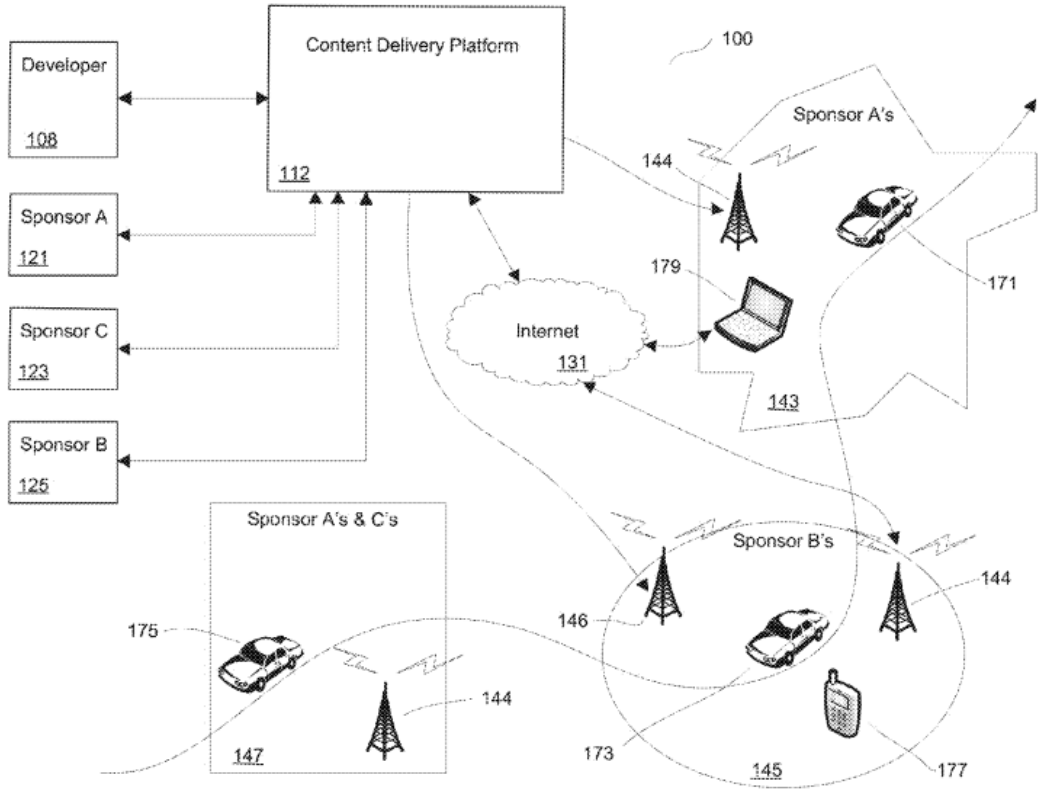

FIG. 1

Figure 1 is an "abstract representation of exclusive content delivery to particular reserved areas." Ex. 1001, 2:41–43. System 100, as shown in Figure 1, provides "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 3:9–13. 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 3:13–17.

For example, content delivery platform 112 receives a request from developer platform 108 to register a program or other application for use on mobile devices, and "can use the registered application program to provide selected content to mobile devices." Ex. 1001, 3:17–21. According to the '418 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 3:22–26. Additionally, "[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." *Id.* at 3:32–34. The '418 patent 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 3:34–39.

Figure 2 of the '418 patent is reproduced below.

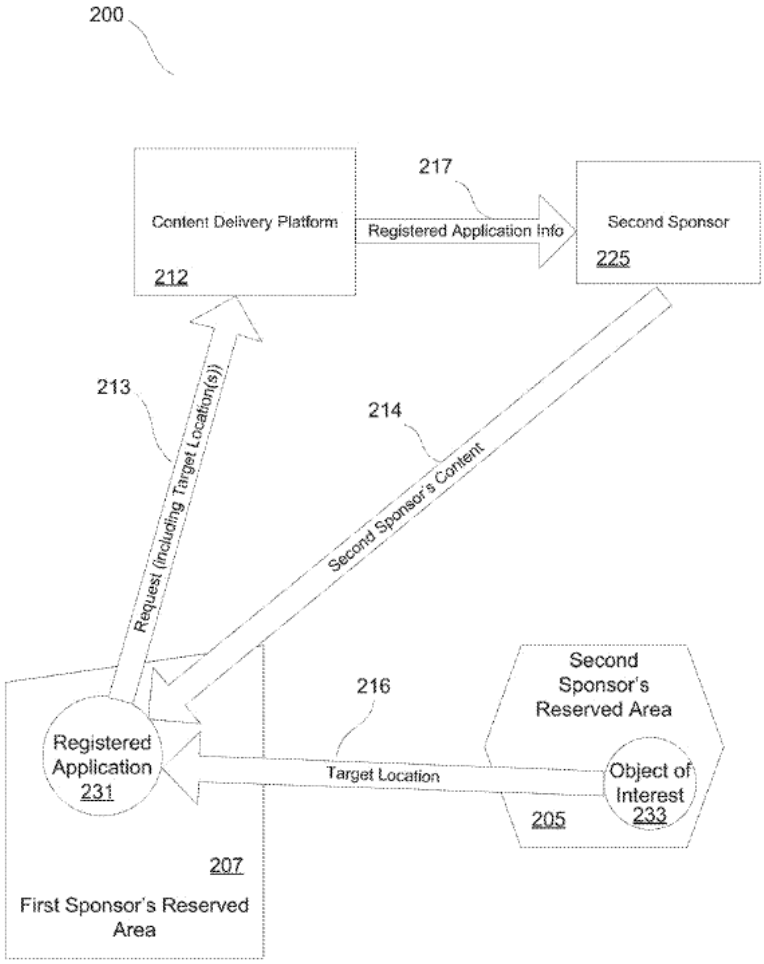

FIG. 2

Figure 2 "is a diagram illustrating a target location other than the location of the mobile device executing a registered application." Ex. 1001, 2:44–47. The '418 patent explains the following regarding Figure 2:

> [A] user of registered application 231 is located within the perimeter defining 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. . . . [O]bject of interest 233 could be a friend . . . employing . . . [a] device capable of sending location information 216 . . . to 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 . . . .

Id. at 5:43–6:27.

Figure 4 of the ’418 patent is reproduced below.

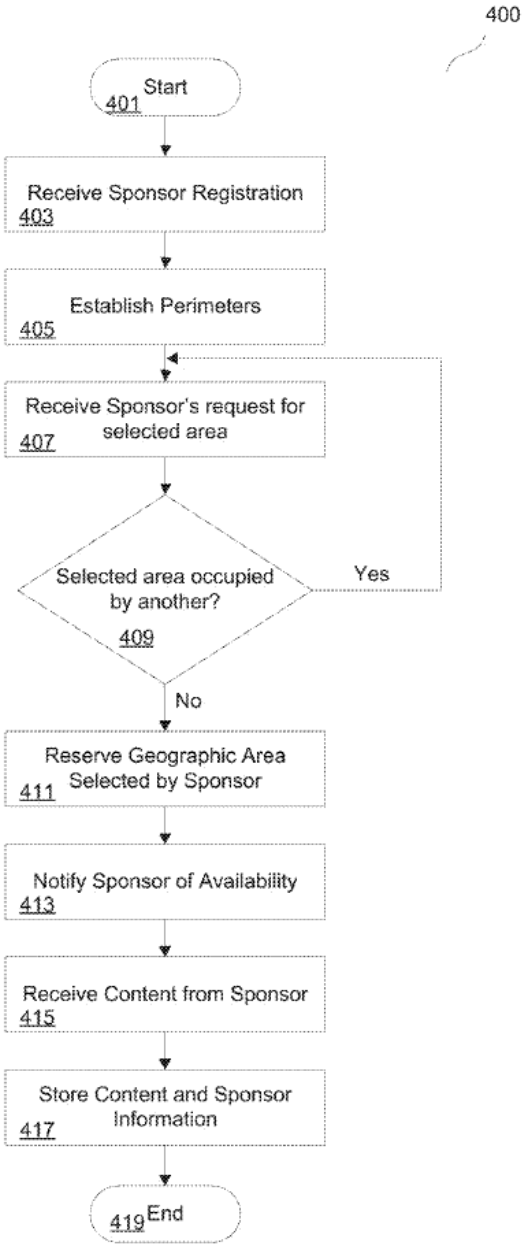

FIG. 4

Figure 4 “is a flowchart illustrating a method of reserving a geographic area.” Ex. 1001, 2:51–53. In particular, the ’418 patent states that method 400 “allow[s] sponsors to reserve particular geographic areas.” *Id.* at 8:62–65. The ’418 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 8:65–9:46.

C. Illustrative Claim

As noted above, Petitioner challenges claims 1–10 of the '418 patent. Claim 1, reproduced below, is independent and illustrative of the claims under challenge.

> 1. A method comprising:
>
> implementing, on a mobile device, at least one computer readable program instruction, made available for use by one or more distinct application programs operating on the mobile device, for receiving, from a particular one application program of the one or more distinct application programs during the particular one application program's execution on the mobile device, a request to reserve, for the particular one application program, at least one designated geographic area of interest for having a

particular associated identifier exclusively provided for use by the particular one application program after it is determined, by at least use of at least one processor tangibly embodied by the mobile device and of location information representing a physical geographic location of the mobile device as determined by a location-determination component tangibly embodied in the mobile device for determining the mobile device's physical geographic location, that the mobile device has at least entered the at least one designated geographic area of interest, wherein the at least one computer readable program instruction comprises at least one input parameter for receiving, from the particular one application program, data representing a) the particular associated identifier as provided content associated with the at least one designated geographic area of interest and exclusively related to the particular one application program, and b) a perimeter definition defining, with at least reference to longitude and latitude, the at least one designated geographic area of interest, and wherein the one or more distinct application programs each comprises a system of executable coded instructions as programmed by at least one developer for execution on the mobile device;

using the at least one computer readable program instruction to receive, from a first particular application program during its execution on the mobile device, a first request for a reservation for a first particular designated geographic area of interest for having a first particular associated identifier exclusively provided for use by the first particular application program after it is determined that the mobile device has at least entered the first particular designated geographic area of interest, wherein the first request comprises data representing a) the first particular associated identifier, represented by a data string, as provided content by the first particular application program to be associated with the first particular designated geographic area of interest and exclusively related to the first particular application program, and b) a first perimeter definition provided by

the first particular application program, wherein the first perimeter definition comprises at least data representing a first latitude and longitude coordinate and a first radius value for defining the first particular designated geographic area of interest;

determining availability for the first particular designated geographic area of interest to be reserved for the first particular application program;

using the first perimeter definition in conjunction with the first particular associated identifier to establish the first particular designated geographic area of interest in the first request as an area reserved for first content related to the first particular application program and not an area reserved for first content related to other application programs, wherein the first content related to the first particular application program comprises the first particular associated identifier;

in response to receiving the first request, after availability for the first particular designated geographic area of interest to be reserved for the first particular application program has been positively determined, storing, in a memory tangibly embodied by the mobile device, an at least first record, for the first particular application program, associated with the first particular associated identifier and the first particular designated geographic area of interest, thereby designating the first particular application program as a first one of one or more registered application programs on the mobile device, wherein the one or more registered application programs on the mobile device each consists of an application program designated for having a particular identifier, being associated with a particular reserved geographic area of interest, to be exclusively provided for use by said application program after it is determined, by at least use of the at least one processor and of the location information, that the mobile device has at least entered said particular reserved geographic area of interest;

using the at least one computer readable program instruction to receive, from a second particular application program during its execution on the mobile device, a second request for a reservation for a second particular designated geographic area of interest for having a second particular associated identifier exclusively provided for use by the second particular application program after it is determined that the mobile device has at least entered the second particular designated geographic area of interest, wherein the second request comprises data representing a) the second particular associated identifier, represented by a data string, as provided content by the second particular application program to be associated with the second particular designated geographic area of interest and exclusively related to the second particular application program, and b) a second perimeter definition provided by the second particular application program, wherein the second perimeter definition comprises at least data representing a second latitude and longitude coordinate and a second radius value for defining the second particular designated geographic area of interest;

determining availability for the second particular designated geographic area of interest to be reserved for the second particular application program;

using the second perimeter definition in conjunction with the second particular associated identifier to establish the second particular designated geographic area of interest in the second request as an area reserved for second content related to the second particular application program and not an area reserved for second content related to other application programs, wherein the second content related to the second particular application program comprises the second particular associated identifier;

in response to receiving the second request, after availability for the second particular designated geographic area of interest to be reserved for the second particular application program has been positively determined, storing, in the memory, an at least second record, for the second

particular application program, associated with the second particular associated identifier and the second particular designated geographic area of interest, thereby designating the second particular application program as a second one of the one or more registered application programs on the mobile device;

after it is determined, by at least use of the at least one processor, of the location information, and of the first particular designated geographic area of interest associated with the at least first record stored in the memory for the first one of the one or more registered application programs on the mobile device, that the mobile device has at least entered the first particular designated geographic area of interest associated with the at least first record stored in the memory and has remained therein for at least a first designated length of time, selecting the first particular associated identifier associated with the at least first record stored in the memory to be provided for use by the first one of the one or more registered application programs on the mobile device;

after it is determined, by at least use of the at least one processor, of the location information, and of the second particular designated geographic area of interest associated with the at least second record stored in the memory for the second one of the one or more registered application programs on the mobile device, that the mobile device has at least entered the second particular designated geographic area of interest associated with the at least second record stored in the memory and has remained therein for at least a second designated length of time, selecting the second particular associated identifier associated with the at least second record stored in the memory to be provided for use by the second one of the one or more registered application programs on the mobile device;

in response to receiving, from the first one of the one or more registered application programs on the mobile device, a request to receive content, providing, to the first one of the

> one or more registered application programs on the mobile device, at least the first particular associated identifier from its selecting; and
>
> in response to receiving, from the second one of the one or more registered application programs on the mobile device, a request to receive content, providing, to the second one of the one or more registered application programs on the mobile device, at least the second particular associated identifier from its selecting.

Ex. 1001, 14:6–16:46.

D. Asserted Ground of Unpatentability

Petitioner challenges claims 1–10 of the '418 patent on the following sole ground of obviousness. Pet. 3, 21–70.

Claims Challenged	35 U.S.C. §[2]	Reference(s)/Basis
1–10	103	Hardin '665,[3] Salmre[4]

In support of its arguments, Petitioner relies on a Declaration of David H. Williams (Ex. 1003).

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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 application for the '418 patent was filed on January 29, 2016 (Ex. 1001, code (22)), and claims priority to an application filed on May 1, 2009 (*id.* at code (63)). Petitioner contests the '418 patent's priority claim, asserting that the earliest priority date of the challenged claims is January 29, 2015. Pet. 22. 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] Hardin et al., U.S. Publ'n No. 2010/0279665 A1, Nov. 4, 2010 (Ex. 1005).

[4] Salmre et al., U.S. Publ'n No. 2006/0116817 A1, June 1, 2006 (Ex. 1006).

Patent Owner submits a Declaration of Scott Andrew Denning (Ex. 2001) to support its Preliminary Response.

III. DISCUSSION

A. Level of Ordinary Skill in the Art

We consider the asserted ground of unpatentability in view of the understanding of a person of ordinary skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Relying on the declaration testimony of Mr. Williams, Petitioner proposes that a person of ordinary skill in the art at the time of the invention "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. 20 (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 Petitioner's proposed level of ordinary skill in the art in his declaration supporting Patent Owner's Preliminary Response. Ex. 2001 ¶ 26.

On this record, at this stage of the proceeding, we find that Petitioner's uncontested proposed level of ordinary skill in the art is consistent with the level of ordinary skill in the art reflected by the '418 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 proposed level of ordinary skill in the art in our consideration of the issues presently before us.

B. Claim Construction

In an *inter partes* review proceeding, we construe a claim of a patent "using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b)." *See* 37 C.F.R. § 42.100(b) (2019). That standard involves construing claims in accordance with the ordinary and customary meaning of such claims as would have been 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).

Petitioner asserts that it "believe[s] that no express claim constructions are necessary, and the claims should be given their plain and ordinary meaning in this proceeding." Pet. 21. Similarly, Patent Owner asserts that it "do[es] not believe the Board needs to construe any terms." Prelim. Resp. 33. For purposes of this Decision, we conclude that no claim term requires express interpretation at this time to resolve any controversy in this proceeding. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

C. Obviousness over Hardin '665 and Salmre

As noted above, Petitioner filed three petitions challenging claims of the '418 patent. Recently, we instituted *inter partes* review in IPR2022-01331, one of the cases in which Petitioner challenges claims of the '418 patent. *See Samsung Elecs. Co. v. Hardin*, IPR2022-01331, Paper 14 (PTAB Feb. 7, 2023) (institution decision). The parties acknowledge that the issues raised in this proceeding are substantially identical to those raised in IPR2022-01331. Notice 4 ("Petitioner[] 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 in IPR2022-01331 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 IPR2022-01331:

(1) Petitioner asserts that substantially the same two claim limitations lack written description support in U.S. Application No. 12/434,094 ("the '094 application") and U.S. Patent Application No. 13/856,392 ("the '392 application") (*compare* Pet. 22–26, *with* IPR2022-01331, Paper 4 at 22–26 (petition));

(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, 26–27, *with* IPR2022-01331, Paper 4 at 1, 2, 26–27);

(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. 27–70, *with* IPR2022-01331, Paper 4 at 27–69);

(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. 64–70, *with* IPR2022-01331, Paper 4 at 64–69);

(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 ’418 patent are entitled to the priority date of the ’094 application (*see generally* Prelim. Resp.; IPR2022-01331, Paper 10 (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* IPR2022-01331, Paper 10 at 61–66);

(7) Patent Owner’s Response to Petitioner’s Notice Ranking Petitions 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 the claims of the ’418 patent in a single petition (*compare* Notice Resp., *with* IPR2022-01331, Paper 11 (Patent Owner’s response to Petitioner’s notice ranking petitions)); 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. 33–44, *with* IPR2022-01331, Paper 10 at 33–44).

With the exception of issue (7), which we address further below,[5] 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 14) in IPR2022-01331. Therefore, we adopt and incorporate our findings and determinations from that decision as though they were fully set forth herein.

Accordingly, for the reasons set forth in IPR2022-01331, Paper 14, we: (1) determine, based on the present record, that challenged claims 1–10 of the '418 patent are not entitled to the priority date of the '094 application, and, therefore, Hardin '665 is available as prior art to the '418 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 1–10 of the '418 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).

D. Discretion Under 35 U.S.C. § 314(a) – Multiple Petitions

As noted above, Petitioner filed three petitions on the same day in IPR2022-01330, IPR2022-01331, and IPR2022-01332, challenging different claim sets of the '418 patent. Pet. 73–74; Notice 2. Because our analysis of whether to exercise our discretion to deny institution of the instant Petition

[5] We discuss issue (7) further below because our consideration of that issue here is different than our consideration of that issue in IPR2022-01331.

(i.e., Petitioner's third-ranked petition) is different than our analysis of this issue in the context of Petitioner's first-ranked petition (in IPR2022-01331), 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 an explanation of the differences between the petitions. *See* PTAB Consolidated Trial Practice Guide, 59–60 (Nov. 2019) ("CTPG").[6] In IPR2022-01331, Petitioner challenges claims 11–18, and ranks the petition as "A." Notice 2. In IPR2022-01332, Petitioner challenges claims 19–25, and ranks the petition as "B." *Id.* In IPR2022-01330, which is this proceeding, Petitioner challenges claims 1–10, and ranks the instant 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 2. Petitioner asserts that claims 1, 11, 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 4. Petitioner specifies that claim 1 is directed to a method, claim 11 is directed to a mobile device, and claim 19 is a *Beauregard* claim.[7] *Id.* Petitioner further acknowledges that, "given the similarity between the independent

[6] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated.
[7] 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, the Board's analysis of one petition will in all likelihood be similar to the analysis required by the other two." *Id.*

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 '418 patent are "very long," comprising 7,637 words; (2) Patent Owner has asserted twenty-one of the twenty-five claims of the '418 patent in the co-pending district court case; and (3) "[d]emonstrating the '418 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.* at 2–3. 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.* at 3. 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.*

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 '418 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 '418 patent are very long is without merit. Notice Resp. 4. According to Patent Owner, "[e]ven if the claims total 7,637 words, that still leaves nearly 6,400 words for analysis (and nearly ***20,400*** 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 3–4).

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* unnecessary and unreasonable." *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 (for example, claim 1 is at least two and half columns in length) and that Patent Owner asserts twenty-one claims in district court, including all 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 ’418 patent, include a lengthy and detailed argument as to whether the challenged claims of the ’418 patent are entitled to claim priority to the ’094 application (which published as 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 ’418 patent, the prosecution history of the ’418 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.[8] Indeed, Patent Owner states

[8] 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.

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 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 "[did] 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 have "fit '*all of its grounds* against the asserted claims into a single petition,'" where it asserted alternative grounds across multiple petitions. *Id.* at 12–13. 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 '418 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).

E. Consolidation of Proceedings

As discussed above, the petitions in this proceeding as well as in IPR2022-01331 and IPR2022-01332 challenge claims of the '418 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 IPR2022-01331 and conduct the proceedings as one trial.[9]

[9] We contemporaneously issue an institution decision in IPR2022-01332 and, in that decision, we also consolidate IPR2022-01332 with IPR2022-01331 for the same reasons discussed above.

IV. CONCLUSION

For the foregoing reasons, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the ’418 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.

V. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is instituted as to claims 1–10 of the ’418 patent on the sole 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 ’418 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), IPR2022-01330 and IPR2022-01331 are consolidated, and all further filings in the consolidated proceeding shall be made in IPR2022-01331;

FURTHER ORDERED that the parties shall file in IPR2022-01331 any exhibits from IPR2022-01330 that are not of record in IPR2022-01331 within ten business days of this Order;

FURTHER ORDERED that the Scheduling Order entered in IPR2022-01331 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 IPR2022-01331 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 IPR2022-01331.

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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.

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[10] IPR2022-01330 and IPR2022-01332 have been consolidated with this proceeding.