

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Maged F. Barsoum et al.
U.S. Patent No.: 11,019,509 Attorney Docket No.: 19688-0197IP2
Issue Date: May 25, 2021
Appl. Serial No.: 16/728,384
Filing Date: December 27, 2019
Title: RECEIVERS INCORPORATING NON-UNIFORM
CONSTELLATIONS WITH OVERLAPPING CONSTELLATION
POINT LOCATIONS

Mail Stop Patent Board

Patent Trial and Appeal Board
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PETITIONER'S NOTICE RANKING PETITIONS FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 11,019,509

Petitioner has filed two petitions (IPR2023-00229 and IPR2023-00320) challenging U.S. Patent No. 11,019,509 (the “’509 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	IPR2023-00229	Eroz	1, 2, 8-12, 18-23, and 29-30
2	IPR2023-00320	’777 patent	3-7, 13-17, and 24-28

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 ’509 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 IPR2023-00320 petition, at least claims 3-7, 13-17, and 24-28 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. 27, 2019) of the ’509 Patent. *See* IPR2023-00320 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 Erozi primary reference, whereas 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 (IPR2023-00320) qualify as prior art based on the Dec. 27, 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 ’509 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 IPR2023-00229 petition challenges claims 1, 2, 8-12, 18-23, and 29-30, and the IPR2023-00320 petition challenges claims 3-7, 13-17, and 24-28. 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 claims 3-5 to any claim challenged in the IPR2023-00229). These differences require individualized attention, and significant consumption of word count to address each of the respective claim sets. For example, claim 5 is almost one column long and recites several substantively narrow claim features that were not at issue in the claims challenged in the IPR2023-00229 petition. Other differences between the claims challenged in IPR2023-00229 and the claims challenged in IPR2023-00320 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 IPR2023-00320 that required particular attention, two petitions were needed to sufficiently demonstrate a reasonable likelihood that the claims of the '509 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 '509 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 '509 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.

Respectfully submitted,

Dated: December 9, 2022

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on December 9, 2022, a complete and entire copy of this Notice Ranking Petitions was provided via Federal Express, to the Patent Owner by serving the correspondence address of record as follows:

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