UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

YECHEZKAL EVAN SPERO,
Patent Owner.

U.S. Patent No. 9,955,551

Case IPR2023-00318

PATENT OWNER'S SUR-REPLY

I. Petitioner fails to explain why it did not provide a "ranking of the petitions" in accordance with Board Guidance

The PTAB requires Petitioners to justify filing multiple parallel petitions. CTPG at 60, FN 4 ("[I]t will be **expected** that petitioners will justify multiple petitions in the first instance in their petitions or in a separate paper [of no more than 5 pages] with the petitions, and patent owners will respond in their preliminary responses or in a separate paper with their preliminary responses.") The CTPG explains that a Petitioner "**should** . . . identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, . . . and (2) a succinct explanation of the differences between the petitions. . . ." CTPG at 59-60. Nonetheless, Petitioner asserts that the "implication that Petitioner was required to provide any further justification beyond its 'succinct explanation' of differences between the petitions . . . is unsubstantiated and mischaracterizes the Trial Practice Guide." Reply at 1 - 2.

In accordance with the CTPG, Petitioners routinely provide a succinct explanation of the differences in addition to providing a ranking of parallel petitions. *See, e.g., Volkswagen Grp. Am., Inc. v. Carucel Investments, LP*, IPR2019-01106, Paper 8, 7-11 (PTAB Dec. 2, 2019); *Medtronic Vascular, Inc. v. TMT Systems, Inc.*, IPR2021-01533, Paper 20, 10-14; *Solaredge Tech. LTD., v. Koolbridge Solar, Inc.*, IPR2022-00008, Paper 10, 9-14; *Home Depot U.S.A., Inc., v. Lynk Labs, Inc.*, IPR 2022-00143, Paper 17, 5-13.

Indeed, VW and its counsel of record are aware of the ranking requirement and how to satisfy it. In *Volkswagen v. Carucel Investments*, the Board reiterated that the CTPG requires a ranking of parallel petitions: "Finally, as required by the Trial Practice Guide Update, Petitioner provides a 'ranking of the petitions,' ranking the petition in IPR2019-01105 first and this Petition second, stating the 'petitions should be considered in [that] order.'" *Volkswagen v. Carucel Investments*, IPR2019-01106, Paper 8 at 9. Now, Petitioner fails to explain why it chose to ignore the ranking requirement contrary to Board Guidance and jurisprudence that expressly involves VW.

II. Petitioner's parallel petition strategy exemplifies gamesmanship

As explained in the POPR, Petitioner filed three parallel petitions with redundant grounds, and could have readily consolidated the three petitions to one or two petitions by removing redundant grounds. (POPR at 36-38.) In *VW v. Carucel*, the PTAB denied institution of VW's second petition challenging U.S. 8,718,543 for failing to provide sufficient justification for filing a second petition. *VW v. Carucel Investments*, IPR2019-01106, Paper 8 at 11. Carucel argued that "Petitioner's strategy of filing multiple petitions against the '543 Patent—without any ranking and without any requisite explanation to justify the added burden of two IPR proceedings—also places an enormous burden on the Board and the Patent Owner." *Id.*, Paper 6 at 11. Carucel also noted the '106 Petition was duplicative of VW's

petition in IPR2019-01105, and "presents two stand-in references, Mears and Forssen for the same disclosures as Ito and Paneth in the co-pending petition." *Id*.,10. VW filed a reply to the POPR and ranked the '105 Petition over the '106 Petition; and the Board denied the lower ranked parallel petition. *Id.*, Paper 8 at 9, 11.

Here, Petitioner repeats its redundant parallel petition practice, but challenges different claims in each Petition, in an effort to justify the number of petitions it advances. However, Petitioner's own case law exemplifies the Board's disapproval of such gamesmanship. In *Lab. Corp*., similar to this case, Petitioner failed to rank its parallel petitions and challenged different claims in each petition. *Lab. Corp. v. Ravgen*, IPR2021-01054, Paper 11. The Board cautioned against such gamesmanship, stating "Petitioner should have better heeded the Board's guidance about what should be done when filing parallel petitions on the same patent." *Id*., Paper 11 at 31-32. Further, "[c]learly, Petitioner is not challenging the same claims in its two petitions . . . [b]ut all of those challenged claims likely could have been challenged in a single petition." *Id*., 31-32. (

Despite requesting a reply on this issue, Petitioner has failed to rank its parallel petitions and explain its redundant grounds. Therefore the Board should deny all three parallel petitions.

Respectfully submitted,

Dated: May 16, 2023 / Andrew B. Turner /

Andrew B. Turner (Reg. No. 63,121)

Sangeeta G. Shah (Reg. No. 38,614)
Bernard P. Tomsa (Reg. No. 60,121)
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Certificate of Service

The undersigned hereby certifies that on May 16, 2023, a complete and entire copy of **PATENT OWNER'S SUR-REPLY** , was served via electronic mail by serving the correspondence email address of record as follows:

Michael D. Specht (Reg. No. 54,463) Sterne, Kessler, Goldstein & Fox P.L.L.C. 1100 New York Avenue, N.W. Washington D.C., 20005 Telephone: (202) 371-2600 Facsimile: (202) 371-2540 mspecht-PTAB@sternekessler.com	Jason A. Fitzsimmons (Reg. No. 65,367) Daniel E. Yonan (Reg. No. 53,812) Trevor M. O'Neill (Reg. No. 72,981) Ian Soule (Reg. No. 74,290) Sterne, Kessler, Goldstein & Fox P.L.L.C. 1100 New York Avenue, N.W. Washington D.C., 20005 Telephone: (202) 371-2600 Facsimile: (202) 371-2540 jfitzsimmons-PTAB@sternekessler.com dyonan-PTAB@sternekessler.com toneill-PTAB@sternekessler.com isoule-PTAB@sternekessler.com PTAB@sternekessler.com

Respectfully submitted,

/ Andrew B. Turner /

Andrew B. Turner (Reg. No. 63,121)
Sangeeta G. Shah (Reg. No. 38,614)
Bernard P. Tomsa (Reg. No. 60,121)
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner

Certificate of Compliance Pursuant to 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24. The paper contains 3 pages as authorized by the Board on May 2, 2023, excluding the parts of the paper exempted by §42.24(a).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

Respectfully submitted,

Dated: May 16, 2023 / Andrew B. Turner /

Andrew B. Turner (Reg. No. 63,121)
Sangeeta G. Shah (Reg. No. 38,614)
Bernard P. Tomsa (Reg. No. 60,121)
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
(248) 358-4400

Attorneys for Patent Owner