Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
Petitioner,

v.

SINGULAR COMPUTING LLC,
Patent Owner.

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Case No. IPR2023-00395
Patent No. 10,754,616

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PETITIONER GOOGLE LLC'S NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES

Petitioner is filing two parallel petitions for *inter partes* review against U.S. Patent No. 10,754,616 ("the '616 patent"). Pursuant to the Board's Consolidated Trial Practice Guide (November 2019) ("TPG") at 59-60, Petitioner submits this notice to (1) identify a ranking of the petitions and (2) provide a succinct explanation of the differences between the petitions, why issues addressed by the differences are material, and why the Board should use its discretion to institute both petitions.

I. RANKING OF PETITIONS

Rank	Petition	Grounds
1	IPR2023-00394	**Ground 1**: Schmidt-2000 renders obvious claims 1, 4-5, 7, 9, and 14 **Ground 2**: Schmidt-2000 in view of Schmidt-1999 renders obvious claims 2-3 **Ground 3**: Schmidt-2000 in view of Schmidt-1999 and Kan renders obvious claims 8 and 10-13 **Ground 4**: Schmidt-2000 in view of Schimmler-1996 renders obvious claims 16-17 **Ground 5**: Schmidt-2000 in view of Schimmler-1996, Schmidt-1999, and Kan renders obvious claims 18-22 and 24
2	IPR2023-00395	**Ground 1**: Stuttard in view of Shirazi renders obvious claims 1-5, 7-14, 16-22, and 24

II. MATERIAL DIFFERENCES BETWEEN PETITIONS

The Schmidt-based grounds presented in Petition 1 are materially different from the Stuttard-based grounds presented in Petition 2. For example, Petition 1 relies on Schmidt-2000 alone, in combination with background knowledge in the

art, to meet some challenged claims; while relying on combinations with one or more other references to meet other claims. Petition 2 does not rely on Stuttard alone to meet any challenged claim, but relies on Stuttard in combination with Shirazi and background knowledge in the art to meet all challenged claims. The limitations met by the secondary references in Petition 1 (Schmidt-1999, Kan, and/or Schimmler-1996) are different from the limitations met by the secondary reference (Shirazi) in Petition 2.

As another example, Petition 1 relies primarily on a printed publication article (Schmidt-2000), whereas Petition 2 relies primarily on a published patent application (Stuttard); thus the public accessibility evidence is materially different between the two Petitions.

Given the Petitions' material differences, Patent Owner is likely to raise materially different issues in attempting to defend against the grounds in each Petition.

III. WHY THE BOARD SHOULD INSTITUTE BOTH PETITIONS

The TPG (at 59) recognizes that more than one petition "may be necessary…when the patent owner has asserted a large number of claims in litigation." Here, Patent Owner filed a district court complaint alleging that Petitioner infringes "at least claim 10 of the '616 patent" (EX1139, 33), but has not yet served infringement contentions identifying what other claims it will assert.

Patent Owner has further represented to Petitioner that Patent Owner will soon be voluntarily dismissing its district court complaint without prejudice, leaving Patent Owner free to later sue Petitioner again on any number of the ’616 patent’s claims.

The ’616 patent’s claims are long, spanning five columns of the patent’s text, and encompassing approximately 2,500 words. They recite a multiplicity of computer architecture limitations that require significant numbers of words to address. The independent claims have differing limitations—for example, claim 7 recites “no less than 5000” processing elements, which is not recited in claims 1 and 16; claim 16 recites an “external edge processing element” that is not recited in claims 1 and 7. Addressing all of these limitations consumes significant word count in the Petitions. The Board has concluded in prior cases that such circumstances warrant institution of more than one petition. *See, e.g., Adobe Inc. v. SynKloud Techs., LLC*, IPR2020-01392, Paper 8 at 9 (Mar. 11, 2021) (“[I]t is reasonable to conclude that the length of the claims, and the difference in scope of independent claims 1 and 12, warranted the filing of two petitions.”); *Flex Logix Techs., Inc. v. Venkat Konda*, IPR2020-00261, Paper 22 at 24 (Aug. 3, 2020) (“[T]he length of the claims in the ’523 patent, the complexity of the subject matter of the claims, and their relative detail, further persuade us that Petitioner’s filing of multiple petitions challenging the ’523 patent does not weigh in favor of exercising discretion to deny institution in this proceeding.”).

The combined number of grounds presented in Petition 1 and Petition 2 is reasonable, with only two grounds per challenged claim. *See Adobe*, IPR2020-01392, Paper 8 (instituting two petitions collectively presenting more than two grounds per challenged claim, based on two different primary references); *Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 27 (Jun. 15, 2020) (instituting two petitions collectively presenting three grounds against each independent claim, based on two different primary references; noting that had petitioner presented a "Spacey-based petition" and a "Boyle-based petition," "the two petitions would have introduced materially different issues, with different strengths and weaknesses," weighing against discretionary denial).

Given the lack of any contentions or briefing in the district court proceeding regarding the '616 patent, and that proceeding's impending voluntary dismissal without prejudice, Petitioner does not know what arguments Patent Owner may attempt to raise against the Schmidt-based grounds or against the Stuttard-based grounds in the future. Petitioner respectfully requests that the Board institute both petitions to fulsomely weigh the unpatentability of the challenged claims.

Respectfully submitted,
Google LLC

Date: December 22, 2022

/Elisabeth Hunt/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on December 22, 2022, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via Priority Express Mail at the following correspondence address of record for the patent:

Blueshift IP LLC
1 Broadway, 14th Floor
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Date: December 22, 2022

/MacAulay Rush/
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