

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Terence W. O'Brien
U.S. Patent No.: 7,765,399 Attorney Docket No.: 50095-0112IP1/0112IP2
Issue Date: July 27, 2010
Appl. Serial No.: 11/359,224
Filing Date: February 22, 2006
Title: COMPUTER ARCHITECTURE FOR A HANDHELD
ELECTRONIC DEVICE

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PETITIONER'S NOTICE RANKING PETITIONS
AND EXPLAINING MATERIAL DIFFERENCES BETWEEN
PETITIONS AGAINST U.S. PATENT NO. 7,765,399

Petitioner is concurrently filing two petitions challenging claims of U.S. Patent No. 7,765,399 (“the ’399 Patent”): As explained below, each petition challenges a different set of the claims of the ’399 Patent. APPLE-1014. Pursuant to the Board’s Consolidated Trial Practice Guide, Petitioner submits this paper to “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, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.”

I. Ordering of Petitions

Petitioner believes that both petitions are meritorious and justified, as explained below. Nonetheless, to the extent required by the Trial Practice Guide, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims
1	IPR2023-00542	1-7, 9-10
2	IPR2023-00543	12, 13, 15-18

II. Material Differences that Compel Permitting Multiple Petitions

Petitioner submits that institution of both petitions against the ’399 Patent is warranted due to the different, and mutually exclusive, sets of claims challenged in the petitions. Specifically, the first petition challenges claims 1-7 and 9-10, which are directed to a “computer system.” By contrast, the claims challenged by the

second petition—claims 12, 13, and 15-18—are directed to a “method for managing classified and unclassified data on a portable mobile computing device of a computer system.” Because the challenged claims of the two petitions do not overlap, consideration of the merits of both petitions will allow the Board to address properly each challenged claim in an efficient manner.

The grounds presented in the two petitions are similar: the Marek-Skarine prior art combination, which is the sole combination relied upon in the second petition, also forms the basis for the prior art challenges in the first petition. Despite the overlap in grounds, however, word count constraints prevented Petitioner from presenting challenges against both sets of claims in a single petition. For instance, the different requirements of the system claims (addressed in the first petition) and the method claims (addressed in the second petition) necessitated distinct treatment of these two sets of claims, obviating many of the normal efficiencies of consolidating arguments. These distinctions are illustrated in the table below, which shows selected examples of generally corresponding claim features between claim 1 (a system claim) and claim 12 (a method claim), with italics indicating features that are unique to their respective claims. The length and complexity of the claims presented further challenges to addressing all challenged claims in a single petition.

Example element of system claim 1	Generally corresponding element of method claim 12
[1b] said secure user processor comprising a trusted microprocessor, a trusted operating system executing on said trusted microprocessor, and <i>a trusted application software executing on said trusted microprocessor;</i>	[12a] <i>processing said classified data exclusively</i> using a secure processor of said portable mobile computing device, [12b] said secure processor comprising a trusted microprocessor and a trusted operating system executing on said trusted microprocessor;
[1e] a first data communication link communicating data between said secure processor and said cryptographic engine;	[12e] <i>communicating encrypted and decrypted classified data</i> between said secure processor and a cryptographic engine ... using a first data communication link;

Indeed, the Board has previously recognized that “there may be appropriate reasons for Petitioner to divide the claims and grounds into multiple petitions, such as to logically separate different claim sets for purposes of analysis.” *Intel Corp. v. Qualcomm Inc.*, IPR2018-01240, Paper 9 at 15 (PTAB Feb. 6, 2019). In *Intel Corp. v. Qualcomm Inc.*, the petitioner filed four petitions challenging non-

overlapping subsets of claims. The Board did not exercise its discretion to deny any of the petitions, noting that “the asserted grounds across the four petitions are similar and address distinct sets of claims that will allow the Board to efficiently evaluate the four petitions and potentially consolidate them if warranted.” *Id.* at 17. Here, too, the asserted grounds are similar between the two petitions, and distinct sets of claims are addressed.

Petitioner respectfully submits that given the similarity in the asserted grounds, and the non-overlapping sets of claims addressed in the two petitions, any additional burden on the Board and the parties that would be imposed by institution of both petitions would not be extraordinary. Indeed, the two petitions here are filed concurrently, providing the Board an opportunity to gain efficiencies by issuing a single scheduling order that sets the same due dates for both proceedings, ultimately culminating in a consolidated oral hearing. *See Dolby Laboratories, Inc. v. Intertrust Technologies Corp.*, IPR2020-01106, Paper 12 at 19-21 (PTAB Jan 5, 2021) (noting scheduling efficiencies in granting two parallel petitions).

Moreover, the Trial Practice Guide explains that “there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation.” Consolidated TPG at 59 (Nov. 2019). Here, claims 1-7 and 9 are currently asserted in the co-pending district court case. However, Patent Owner

has provided no assurance that it will not assert additional claims of the '399 Patent, either in the current co-pending district court case or in another case or venue. Accordingly, Petitioner challenges certain of the currently non-asserted claims in its second petition. *See Apple v. UUSI d/b/a Nartron*, IPR2019-00358, Paper 12 at 19-20 (PTAB Aug. 5, 2019) (instituting two petitions when nonoverlapping claims were challenged and subject to assertion); *Dolby Laboratories, Inc. v. Intertrust Technologies Corp.*, IPR2020-01106, Paper 12 at 19-21 (PTAB Jan 5, 2021) (granting two petitions filed against 18 claims); *Adobe Inc. v. Syncloud Technologies, LLC*, IPR2020-01393, Paper 8 at 8-10 (PTAB Mar. 11, 2021) (granting two petitions filed against 20 “lengthy” and “complex” asserted claims).

For each of these reasons, Petitioner respectfully requests institution of both of its concurrently filed IPR petitions against the '399 Patent.

Respectfully submitted,

Dated: February 1, 2023

/David L. Holt/
W. Karl Renner, Reg. No. 41,265
David Holt, Reg. No. 65,161
Gretchen A. DeVries, Reg. No. 72,505
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on February 1, 2023, 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:

L3Harris Technologies, Inc.
C/O FOX ROTHSCHILD, LLP
997 Lenox Drive, Building 3
Lawrenceville, NJ 08543-5231

/Crena Pacheco/
Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(617) 956-5938