UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and YOUTUBE LLC,
Petitioner,

v.

ROBOCAST, INC.
Patent Owner.

Case IPR2023-00590
U.S. Patent No. 7,155,451 B1

PATENT OWNER'S OBJECTION TO MULTIPLE PETITIONS CHALLENGING U.S. PATENT NO. 7,155,451

I. THE BOARD SHOULD DENY INSTITUTION PURSUANT TO THE PTAB TRIAL PRACTICE GUIDE

The Board should exercise its discretion under § 325(d) and deny institution of either the instant Petition or the co-pending IPR2023-00591 Petition.[1] Multiple petitions against the same patent are strongly disfavored by the Trial Practice Guide. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide ("TPG") at 59. As stated in the TPG, multiple petitions "may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns." *Id*. Accordingly, multiple petitions "are not necessary in the **vast majority** of cases." *Id.* (emphasis added).

A. Petitioner Should Have Submitted A Single Petition Given The Substantial Overlap Between The Two Petitions

The concerns expressed by the Board in the Trial Practice Guide are particularly applicable here. Petitioner admits that "*across* the two petitions, there is overlap with respect to the subject matter recited in the independent and dependent claims." Paper 3 at 3 (emphasis in original). Petitioner further admits that "each independent claim recites similar limitations relating to the creation, access, and presentation of '**a show structure of nodes.**'" *Id*. at 4 (emphasis in original). Indeed,

[1] Concurrent with this objection, Patent Owner is filing a similar objection in IPR2023-00591.

Petitioner provides an extensive table "identifying sections of the -00590 and -00591 petitions that have substantially similar and/or overlapping subject matter." *Id*. at 4-5. Petitioner appears to contend this is a reason to institute IPR on both petitions, but it instead indicates that Petitioner should have been able to make all arguments against the challenged claims in a single petition. *See, e.g., Netskope, Inc. v. Bitglass, Inc.*, PGR2021-00092, Paper 11 at 22 (PTAB December 14, 2021) ("[W]e we do not discern, based on our own review of the petitions, any reason why one petition would not have been sufficient to challenge the claims of the '671 patent, given the substantial overlap in the subject matter of the claims.").

In addition, the substantial overlap of subject matter between the two petitions is reflected by the fact that Petitioner's expert, Mr. Christopher Schmandt, submitted a *single* declaration for both IPRs (IPR2023-00590, EX1002; IPR2023-00591, EX1102), and a large portion of his analysis for later claims refers back to his analysis of earlier claims. *See Netskope, Inc.*, Paper 11 at 23 (denying institution on second petition where the expert's "testimony is repetitive, often referencing analysis directed to claim 1 and its challenged dependent claims in analyzing claim 17 and its challenged dependent claims."). The same rationale for denying instution of two petitions exists here. For example, Mr. Schmandt's analysis of independent claim 22 (challenged in IPR2023-00591) incorporates a substantial amount of the analysis for claim 1 (challenged in IPR2023-00590). *See, e.g.*, EX1002, ¶221

("**Many of the limitations of claim 22 are substantially similar to limitations recited in claim 1 that were covered above**. In the interests of brevity and consistency, therefore, I will refer back to my analysis of claim 1 where appropriate.") (emphasis added).

Thus, Petitioner could have easily submitted a single Petition given the substantial overlap of its expert's analysis for the challenged claims. "Multiple grounds, which are presented [across multiple petitions] in a redundant manner by a petitioner who makes no meaningful distinction between them, are contrary to the regulatory and statutory mandates, and therefore are not all entitled to consideration." *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00003, Paper 7, 2 (PTAB Oct. 25, 2012) (representative opinion). Accordingly, this is precisely the type of case in which multiple petitions create "a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns" and the Board should exercise its discretion and deny institution. *See* TPG at 19.

B. Petitioner Has Failed To Show That This Is One Of The "Rare" Cases That Requires Two Petitions

Petitioner repeatedly points out that the two petitions challenge "non-overlapping" sets of claims. Paper 3 at 1, 5. However, the Board has previously held that this reasoning falls far short of justifying two petitions. *See Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01470, Paper 7, 11-13 (PTAB Feb. 11, 2020) ("we do

not find persuasive Petitioner's argument that 'no claim is being challenged in both petitions,' and we 'should give consideration to all challenged claims.' … Such reasoning would justify as many petitions as there are claims in a patent, which is untenable.").

Petitioner also alleges that the "diversity of features recited across the five challenged independent claims" rendered it "infeasible to cover all challenged claims within a single petition." Paper 3 at 3. This argument does not withstand scrutiny. Petitioner only points to three "distinct features" among the claims that purportedly justify the need for two petitions, namely the "on-line search" features of independent claims 22 and 39 (challenged in the -00591 petition), the "dragging and dropping" features of independent claim 10 (challenged in the -00590 petition), and the "multidimensional" feature of the claimed show structure in independent claim 37 (challenged in the -00590 petition). Paper 3 at 3.

Petitioner's discussion of the "on-line search" feature takes up no more than five (5) pages of the entire -00591 petition. See Pet (-00591) at 11-15. Nonetheless, Petitioner argues that it could not sufficiently address all the Challenged Claims in a single Petition. Paper 3 at 3. This contention strains credulity. With efficient drafting, Petitioner could easily have addressed all elements of the Challenged Claims in a single petition. More than one Petition was not "necessary" here (*see* TPG at 59); instead, it was a strategic choice by Petitioner. The rules limit the word

count of a single IPR petition to 14,000 words. 37 CFR §42.24. The combined word count of the two IPR petitions filed on the ’451 Patent is over 27,900 words. The Petitioner has circumvented the word count by splitting the claims of the ’451 Patent into two separate petitions, each petition having the substantially overlapping Grounds. The Board should not tolerate this obvious attempt to evade the word count limit, which placed a substantial and unnecessary burden on the Board as well as the Patent Owner.

Finally, Patent Owner has served its infringement contentions in the parallel district court litigation, asserting only **16 claims** of the ’451 Patent. EX2008 (asserting infringement of claims 1-3, 22-29, 37-39, 41 and 42). This is hardly a large number of claims that would justify two petitions. *See Netskope, Inc.*, Paper 11 at 21-22 (agreeing with patent owner that 21 asserted claims is “hardly a large number that would justify two petitions.”). Accordingly, Patent Owner respectfully requests that the Board exercise its discretion and deny institution of this Petition or the Petition filed in IPR2023-00591 under 35 U.S.C. §§ 314(a) and 325(d) given the Petitioner’s unnecessary and unjustified filing of multiple petitions on the ’451 Patent.

II. CONCLUSION

Petitioner’s duplicative petitions on the same patent are unnecessary, and only serve to place a substantial and unnecessary burden on both the Board and the

Patent Owner. For the reasons outlined above, in the event that the Board is inclined to institute IPR in either IPR2023-00590 or IPR2022-00591, institution should be limited to only one of the petitions, not both.

Respectfully submitted,

Dated: June 20, 2023

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on this 2Oth day of June 2023, service of the foregoing PATENT OWNER'S OBJECTION TO MULTIPLE PETITIONS CHALLENGING U.S., PATENT NO. 7,155,451 was made on the counsel of record for the Petitioner by filing this document through the Patent Trial and Appeal Board's P-TACTS System as well as delivering a copy via electronic mail to the following address:

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Dated: June 20, 2023

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