

Petitioner's Explanation of Multiple Petitions
Challenging U.S. Patent No. 7,155,451 B1

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and YOUTUBE, LLC,
Petitioner

v.

ROBOCAST, INC.,
Patent Owner

U.S. Patent No. 7,155,451 B1
Issue Date: December 26, 2006

Title: AUTOMATED BROWSING SYSTEM FOR PUBLISHERS AND USERS
ON NETWORKS SERVING INTERNET AND REMOTE DEVICES

**PETITIONER'S EXPLANATION OF MULTIPLE PETITIONS
CHALLENGING U.S. PATENT NO. 7,155,451 B1
(IPR2023-00590 & IPR2023-00591)**

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Petitioners Google LLC and YouTube, LLC (collectively "Petitioner") respectfully submit this Paper in support of its Petitions for *Inter Partes* Review ("IPR") of claims 1-21 and 37-38 (IPR2023-00590) and claims 22-36 and 39-45 (IPR2023-00591) of U.S. Patent No. 7,155,451 B1 (the "'451 patent").

Pursuant to Board guidance in its November 2019 Consolidated Trial Practice Guide ("Guidance"), Petitioner provides this separate paper to (1) rank the concurrently filed Petitions for the Board's consideration; and (2) identify differences between the two petitions and the reasons that filing two separate petitions is necessary to challenge the claims in the '451 patent. Petitioner respectfully requests that the Board institute IPR with respect to both petitions.

I. RANKING OF PETITIONS

Petitioner requests the Board consider the merits of each petition beginning with the petition in IPR2023-00590 (claims 1-21 and 37-38) followed by the petition in IPR2023-00591 (claims 22-36 and 39-45). Although Petitioner has provided the above ranking pursuant to the Guidance, Petitioner respectfully submits that ranking is unwarranted because the Board should institute both non-overlapping petitions in order to address all challenged claims, as explained below.

II. DIFFERENCES BETWEEN THE TWO PETITIONS

As explained in the petitions, the pending litigation against Petitioner commenced in March 2022 but remains in early stages with no substantive discovery

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having occurred. Patent Owner has not provided infringement contentions or otherwise identified the claims of the '451 patent it intends to assert, and in fact, refused to agree to a deadline by which it would provide such an identification in advance of providing its infringement contentions. The Court subsequently ordered Patent Owner to provide a narrowed identification of asserted claims, but that identification is not due until May 2023. Accordingly, Petitioner does not expect to receive any such identification prior to expiration of the statute of limitations under 35 U.S.C. § 315(b). Petitioner is therefore challenging forty-five (45) claims in the '451 patent across the two petitions. Petitioner is not challenging claims 46-64 of the '451 patent.

The two petitions do not overlap with respect to any challenged claims. As noted, the first petition in IPR2023-00590 challenges claims 1-21 and 37-38, and the second petition in IPR2023-00591 challenges claims 22-36 and 39-45.

Petitioner considered filing a single IPR petition with respect to all challenged claims, but given the number and length of the limitations and the applicable word limits, enumerating the grounds in a single petition would have reduced the thoroughness of the analysis. Petitioner respectfully submits that filing a single IPR petition against the challenged claims would have resulted in a petition more difficult to fully evaluate, placing unnecessary burdens on the Board.

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This is further demonstrated by the limitations in the challenged independent claims. Although each independent claim recites certain limitations that overlap with other independent claims, many claims nevertheless present distinct features and limitations. For example, in IPR2023-00591, Petitioner challenged claims 22-45, which revolve around independent claims 22 and 39. These claims recite features relating to using an “**online search**” that do not appear in claims challenged in the -00590 petition, which are addressed via prior art references extensively discussed in the -00591 petition (*i.e.* Guinan (EX1108) and Miller (EX1110)). But these features are not recited in the challenged claims in the -00590 petition. And with respect to the -00590 petition, independent claims 10 and 37 recite distinct features including the use of “**dragging and dropping**” to record a sequence of resources (claim 10) and a “**multidimensional**” show structure of nodes (claim 37). These features are not recited in the claims challenged in the -00591 Petition, and thus required a distinct prior art analysis. Petitioner accordingly submits that, in light of the diversity of features recited across the five challenged independent claims, it was infeasible to cover all challenged claims within a single petition.

Petitioner also notes that although the two Petitions collectively challenge 45 claims, the burden on the Board is nonetheless reduced by a number of factors. For example, *across* the two petitions, there is overlap with respect to the subject matter recited in the independent and dependent claims, as identified in the table below.

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For example, each independent claim recites similar limitations relating to the creation, access, and presentation of “**a show structure of nodes.**” Overlapping subject matter in the second petition therefore should not require significant additional effort by the Board beyond the effort expended in analyzing that subject matter in the first petition, and such similarities also exist *within* each petition.

For the convenience of the Board, Petitioner has provided the following table identifying sections of the -00590 and -00591 petitions that have substantially similar and/or overlapping subject matter (identified based on headings used in the petitions and in the Table of Contents):

Sections of Petition in IPR2023-00590	Corresponding Similar Sections in IPR2023-00591
Part I (Mandatory Notices)	Part I (Mandatory Notices)
Part III.A (Standing), Part III.C (§314 and §325(d) analysis)	Part III.A (Standing), Part III.C (§314 and §325(d) analysis)
Part IV (Overview of the Challenged Patent)	Part IV (Overview of the Challenged Patent)
Part V (Claim Construction)	Part V (Claim Construction)
Part VI.B.1 (Claim 1, Preamble, 1[a], 1[c]-[d])	Part VI.B.1 (Claim 22, Preamble, 22[b], 22[c]-[e])
Part VI.C.1 (Claim 10, Preamble, 10[c]-[e])	Part VI.D.1 (Claim 39, Preamble, 39[c]-[e])
Part VI.B.2 (Claim 2)	Part VI.B.2 (Claim 23)
Part VI.B.5 (Claim 5)	Part VI.C.5 (Claim 30)

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Sections of Petition in IPR2023-00590	Corresponding Similar Sections in IPR2023-00591
Part VI.B.7 (Claim 7)	Part VI.C.6 (Claim 31)
Part VI.B.5 (Claim 8)	Part VI.C.7 (Claim 32)
Part VI.D.1 (Claim 13)	Part VI.B.4 (Claim 25)
Part VI.D.3 (Claim 15)	Part VI.C.2 (Claim 27)
Part VI.D.4 (Claim 16)	Part VI.C.3 (Claim 28)
Part VI.D.5 (Claim 17)	Part VI.D.4 (Claim 29)
Part VI.F (Claims 9/21)	Part VI.E (Claims 33-34)

Petitioner has thus endeavored to group similar independent and dependent claims within each petition in order to present the analysis in the most efficient manner possible. Moreover, each petition also identifies when claimed subject matter overlaps with subject matter covered earlier within the same petition, to streamline and expedite the Board's consideration of the challenged claims.

Because each Petition challenges a distinct and non-overlapping set of claims and presents no more than one ground for any independent claim, both should be afforded full and fair consideration by the Board on their merits. For these reasons, Petitioner respectfully requests that the Board exercise its discretion to institute both the Petition in IPR2023-00590 (claims 1-21 and 37-38) and the Petition in IPR2023-00591 (claims 22-36 and 39-45).

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Dated: February 21, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Sections 42.6 and 42.105, that a complete copy of the attached **PETITIONER'S EXPLANATION OF MULTIPLE PETITIONS CHALLENGING U.S. PATENT NO. 7,155,451 B1**, and related documents, are being served via Federal Express on the 21st day of February, 2023, the same day as the filing of the above-identified document in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon Patent Owner by serving the correspondence address of record with the USPTO as follows:

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And, via Federal Express upon counsel of record for Patent Owner in the litigation pending before the U.S. District Court for the District of Delaware entitled *Robocast, Inc. v. YouTube, LLC*, Case No. 1-22-cv-00304 (D. Del.) as follows:

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DATED: February 21, 2023

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