

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner

v.

SURGETECH LLC,
Patent Owner

Case IPR2023-00735
Patent 11,334,598

PETITIONER'S EXPLANATION OF PARALLEL PETITIONS

I. EXPLANATION

Petitioner is requesting *inter partes* review challenging claims 1-20 of U.S. Patent No. 11,334,598 (the “’598 patent”) in two concurrently-filed *inter partes* review petitions (IPR2023-00735 and IPR2023-00736). Petitioner respectfully submits that its second Petition need only be considered in the event the Board denies Petitioner’s Motion to Waive Word Count in IPR2023-00735.

Pursuant to the July 2019 Update to the USPTO Trial Practice Guide, Petitioner submits this explanation of the differences between and ranking of the petitions for the Board’s consideration. The Guide recognizes that “there may be circumstances in which more than one petition may be necessary.” USPTO Trial Practice Guide (November 2019), p.59. And the Board has found challenges involving a “large number of claims” as an example of a situation justifying parallel petitions. *E.g., DJI Europe B.V. v. Daedalus Blue LLC*, IPR2020-01475, Pap.14 at 9-10 (Feb. 12, 2021). In the district court litigation related to this proceeding, Patent Owner has asserted *all* claims of the ’598 Patent, including claims 6-7, 14-15, and 19-20 challenged in the second (-00736) petition—precisely the claims that would *not* be covered by IPR2023-00735 in the event the Board denies Petitioners’ Motion to Waive Word Count in that case.

The short version of the first petition challenging the ’598 Patent (IPR2023-00735)—which will be the operable version if the Board denies the Motion to

Waive Word Count in that proceeding—challenges claims 1-5, 8-13, and 16-18, which include three independent claims, claims 1, 9, and 17.

The second petition (IPR2023-00736) challenges claims 6-7, 14-15, and 19-20, which are all dependent claims. Petitioner requests a second petition due to the number and length of the claims, and so that it may provide analysis under alternative constructions. Although Patent Owner chose to assert *all* 24 claims of the ‘598 patent in litigation, Petitioner has streamlined its PTAB filings by reducing the number of claims it is challenging by omitting the four means-plus-function limitations, which Petitioner asserts are indefinite in district court. However, 20 claims remain. These 20 claims, covered across the two Petitions, are lengthy: the independent claims each contain as many as seven (claims 1 and 9) to nine (claim 17) limitations, and claims 1-20 together stretch across almost 3 columns of the patent. *See* EX1001, 41:18-44:5. It has proven impractical to fit a sufficiently-explained six-way obviousness combination—with the appropriate explanation and level of necessary detail, including motivations to combine, for 20 claims of this length—into a single Petition. *Adobe Inc. v. SynKloud Technologies, LLC*, IPR2020-01392, Pap.8, 8-10 (Mar. 11, 2021) (granting two petitions against 20 “lengthy” claims totaling less than three total columns); *Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Pap.10, 28 (June 15, 2020) (declining to exercise dis-

cretion to deny multiple petitions challenging twenty claims asserted in related litigation based on the same grounds); *see also Assa Abloy AB v. CPC Patent Technologies Pty, Ltd.*, IPR2022-01045, Pap.21 (Jan. 3, 2023) (instituting parallel petitions challenging total of 13 claims about 2½ columns long, including certain means-plus-function limitations).

Indeed, Petitioner relies only on a single base reference (Jacob), and combines that reference with secondary reference Phillips for each ground. While Petitioner recognizes there are a large number of Grounds identified with this single base, this is a result of Petitioner’s effort to be clear that fewer than all of the four additional secondary references (Evangelist, Franklin, Kono and Tamura) may be necessary, depending on PO’s arguments. Evangelist is relied on in the event PO argues, or the Board determines, that Jacob does not disclose an initial “allocation” despite its teaching to “*reallocate* inventory to [a] better-selling channel” (EX1004, ¶[0180]) (*see, e.g.*, -00735 Short Pet.34, 40; -00736 Pet.34, 40); Franklin is relied on for “real time” (*see, e.g.*, -00735 Short Pet.41, 44-47; -00736 Pet.41, 44-47) in the event Jacob’s disclosures that “*confirmation information is sent to... the Property*” (EX1004, ¶[0086]) and of “real time” (EX1004, ¶[0005]) are deemed insufficient (-00735 Short Pet.44; -00736 Pet.44); and Kono and Tamura are relied on for a set of additional limitations in the event Jacob’s disclosures are deemed insufficient— with Kono and Tamura as alternatives presenting distinct systems

(from slightly different perspectives) as to some of these (*see, e.g.*, -00735 Short Pet.47-49, 56-57; -00736 Pet.§VI, 47-48, 56-57), Tamura without Kono as an alternative for certain other limitations and as a requirement for certain dependent claims (*see e.g.*, -00735 Short Pet.§VI, 64 & 69-72 (cl.9[f]), 84-87 (cl.11 with Tamura as a required part of the combination), 87-90 (cl.13 with Tamura as a required part of the combination); -00736 Pet.§VI, 64-65 & 69-72 (cl.9[f])), and Kono (without Tamura) as an alternative for certain other limitations (*see e.g.*, -00735 Short Pet.§VI, 80-84 (cl.10)).

In addition, Petitioner has identified several claim construction disputes, and has provided obviousness analysis under both the correct constructions, and under alternative constructions, in the event Patent Owner argues them. Short Pet. §VI.A, 44-47, 68-72, 77-80; -00736 Pet.§VI.A, 44-47, 68-72, 77-80; *see also* EX1022, 2; EX1021, 2.

Further, while (as set forth in its Motion) Petitioner has urged that waiver of the word limit would be more efficient and appropriate here, a second petition is not unduly burdensome to the Board or Patent Owner. The parties and Board can obtain significant efficiencies by consolidating the proceedings or, at minimum, conducting a single oral argument and consolidating depositions. Indeed, the two Petitions rely on the same grounds, with the second Petition overlapping substantially with the first, and contains less than about 2000 words of argument, which

are necessary to cover claims 6-7, 14-15, and 19-20 in view of their dependencies.

Instituting both petitions also does not increase the number of challenges against the same claims, since each petition covers a *different set of claims* (despite the second petition having to repeat some independent claims to show that the dependent claims challenged therein are unpatentable). Indeed, as explained above, two petitions are necessary here to cover claims 1-20 unless the Motion to Waive Word Count is granted.

Petitioner's comparison and ranking per claim of the two petitions, which address different claims, is provided in the following table:

	IPR2023-00735	IPR2023-00736
Claims Challenged	Short Version: 1-5, 8-13, and 16-18	6-7, 14-15, and 19-20
Prior Art	Jacob, Phillips, Evangelist, Franklin, Kono and Tamura	Jacob, Phillips, Evangelist, Franklin, Kono and Tamura
Ranking	#1	#2

These petitions—which address non-overlapping sets of claims—are not cumulative challenges in the event Petitioner's Motion to Waive Word Count is denied. The rankings above reflect Petitioner's request that the first Petition be given priority. To the extent both are instituted, Petitioner is amenable to consolidating the two proceedings to eliminate duplicative efforts for Patent Owner and the

Board from having two petitions. (And as stated in Petitioner's Motion to Waive Word Count, Petitioner submits the Board may deny institution of the second petition (IPR2023-00736) as moot (e.g., under §314) in the event the Motion is granted.)

Respectfully submitted:

/s/ Megan Raymond
Megan F. Raymond

March 28, 2023

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the following document has been served in its entirety on the patent owner as provided in 37 CFR §42.105:

PETITIONER’S EXPLANATION OF PARALLEL PETITIONS

The copy has been served on March 28, 2023 by causing the aforementioned document to be mailed by Priority Mail Express to the following attorneys of record for patent owner listed below:

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Dated: March 28, 2023

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