

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

JENAM TECH, LLC,
Patent Owner

Patent No. 11,050,855

**PETITIONER'S NOTICE
REGARDING MULTIPLE PETITIONS**

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I. INTRODUCTION

Petitioner is filing two petitions challenging different claims of U.S. Patent No. 11,050,855 (“the ’855 patent”). “To aid the Board in determining” why “more than one petition is necessary,” Petitioner provides the information below. *See* PTAB Consolidated Trial Practice Guide (“TPG”) (November 2019) at 59–60.

II. RANKING

While both petitions are meritorious and justified as explained below, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	Petition 1	1 and 16	<u>Ground 1</u> : Claims 1 and 16 are obvious over Morris and SIP
2	Petition 2	17, 89, 122-124, 148, 174-178, 180, 192, and 194	<u>Ground 1</u> : Claims 17, 89, 122-124, 148, 174-178, 180, 192, and 194 are obvious over Morris and SIP

III. DIFFERENCES BETWEEN THE PETITIONS, WHY THEY ARE MATERIAL, AND WHY BOTH SHOULD BE INSTITUTED

While Petitioner provides the above ranking per the PTAB’s guidance, Petitioner believes ranking in this instance is inappropriate and/or unnecessary and the Board should institute both petitions because as explained further below, each petition addresses lengthy claims including varying dependent claims and includes priority challenges to the effective filing dates of the claims. Thus, the submission

of two petitions is warranted here as explained below.

Patent Owner asserts claims 16, 124, 180, and 194 of the '855 patent against Petitioner in the related litigation, *Jenam Tech, LLC v. Google, LLC*, Case No. 4:22-cv-02838-JST (N.D. Cal.). (*See e.g.*, Petition 1, Section II.)

Claim 16 depends from independent claim 1. Claims 89 and 122-124 depend from independent claim 17. Claims 174-178, 180, 192, and 194 depend from independent claim 148. Thus, a total of sixteen claims are addressed and challenged across the two petitions. The challenged claims include more than 1,850 words that need to be analyzed and addressed in the petitions (and consideration of 231 total issued claims spanning almost thirty columns).

While independent claims 1, 17, and 148 include some overlap, claim 1 is drafted from the perspective of an apparatus or node that initiates a connection with another node while claims 17 and 148 are drafted from the perspective of the apparatus or node that receives a packet from another node that initiates the connection. (*See, e.g.*, Petition 1, Section IX.A.1; Petition 2, Sections IX.A.1, IX.A.6.) There are several features that do not overlap between claim 1 compared to claims 17 and 148. (*See, e.g.*, Petition 1, Section IX.A.1.g-h, Petition 2, Section IX.A.1.f.) Moreover, the dependent claims are directed to various different features requiring separate lengthy explanations. (*See, e.g.*, Petition 1, Section IX.A.2, Petition 2, Sections IX.A.3-5, IX.A.14.)

In Petition 1 alone, the independent claim 1 analysis spans thirty-plus pages and the claim 16 analysis spans fifteen pages. (Petition 1, Section IX.A.) Given the different features recited in the challenged claims, as well as the numerous claims and claim elements, challenging all claims of the '855 patent in a single petition is not feasible or administratively efficient. *Samsung Electronics Co., Ltd. et al v. Hardin et al.*, IPR2022-01335, Paper 13 at 22-3 (Feb. 8, 2023) (granting institution of parallel petitions in similar scenario); *Microsoft Corp. v. Syncloud Tech., LLC*, IPR2020-01269, Paper 9 at 7–9 (April 7, 2021) (instituting two petitions for IPR where “the length of the claims, and the difference in scope of [the independent claims], warranted the filing of two petitions,” and noting that the analysis for the independent claims occupied forty-plus pages and some of the “lengthy or complex” dependent claims also “necessitate[ed] several pages of explanation”). ; *Google LLC v. Jenam Tech, LLC*, IPR2021-00869, Paper 11 at 13-14 (Nov. 9, 2011) (similar).

Moreover, both petitions rely on the same prior art combination of Morris and SIP. This should avoid any inefficient use of the Board’s resources. *Microsoft Corp. v. IPA Tech. Inc.*, IPR2019-00810, Paper 12 at 11–15 (October 16, 2019) (instituting multiple petitions where Petitioner challenged dependent claims of an independent claim across multiple petitions, including based on the same prior art, and repeated the independent claim analysis in each petition). And “any duplication of effort that may place unnecessary burdens on the parties and the Board may be avoided or

reduced by consolidating the instituted IPRs ... including consolidating the parties' briefing, motion practice, and the oral hearings." IPR2019-00810, Paper 12 at 15; *Samsung Electronics Co., Ltd.*, IPR2022-01335, Paper 13 at 23.

Furthermore, Petitions 1 and 2 include challenges to the effective filing date of the '855 patent claims. The analysis showing that two separate features in the challenged claims are not supported by the chain of eight (or more) priority applications and material incorporated by reference in the '855 patent spans more than twenty pages. (*See, e.g.*, Petition 1, Section X, Petition 2, Section X.) IPR2022-01335, Paper 13 at 22 (noting that petitioner's priority challenge required use of additional space, weighing in favor of instituting multiple petitions).

Accordingly, both petitions warrant institution so the Board may consider Petitioner's positions regarding all the challenged claims directed to various different features, along with the different issues (including priority) associated with the prior art references. The Board's decision concerning the patentability of the challenged claims in each petition would thus be materially different. Exercising discretion to deny one petition over the other would leave an asserted claim in the related litigation unaddressed. The current circumstances are consistent with the Consolidated TPG guidance, which states that "the Board recognizes 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

or when there is a dispute about priority date requiring arguments under multiple prior art references.” PTAB Consolidated TPG at 59–60. Petitioner strives for efficiency here by relying on the same prior art, but the analysis supporting the priority issues required usage of a substantial amount of space as noted above.

Institution of both petitions is also warranted because Petitioner had to address the different claims in two petitions to ensure the grounds associated with each challenged claim contained the required specificity as to how the prior art meets each claim limitation within the applicable word limit. The level of detail included in the petitions is appropriate, given it is Petitioner’s burden to establish unpatentability of the challenged claims. The Board should not penalize Petitioner by exercising its discretion to deny either petition on account of the grounds being presented across two petitions. Moreover, both the Administrative Procedures Act and due process weigh against denying the institution of either petition under 35 U.S.C. § 314(a). Indeed, the two petitions here do not constitute an abuse of the process because no petitioner has previously filed any petition challenging the ’855 patent.

IV. CONCLUSION

For the reasons given above, the Board should institute both petitions.

Respectfully submitted,

Dated: May 18, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on May 18, 2023, I caused a true and correct copy of the foregoing Petitioner's Notice Regarding Multiple Petitions to be served via express mail on the Patent Owner at the following correspondence address of record as listed on PAIR:

Patrick Caldwell (Reg. No. 44580)
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A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel at the following addresses:

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Respectfully submitted,

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