

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

SONRAI MEMORY LIMITED,

Patent Owner

IPR2023-00975

PETITIONER'S NOTICE OF MULTIPLE PETITIONS

Petitioner Apple Inc. has requested Inter Partes Review (“IPR”) of claims 1, 3, 5, 7, 11-13, and 15 (the “Challenged Claims”) of U.S. Patent No. 6,874,014 (the ’014 Patent”). In view of a potential priority dispute regarding the effective filing date of the Challenged Claims, Petitioner has presented two petitions with materially distinct, non-cumulative challenges to the Challenged Claims. *See* IPR2023-819 (the “819 Petition”) and IPR2023-00975 (the “975 Petition”). Petitioner respectfully requests institution of both petitions for the reasons detailed below.

I. Detailed Reasons for Multiple Petitions Against the ’014 Patent

The ’014 Patent issued from U.S. Patent Application Serial No. 09/865,605 (the ’605 application”), which was filed on May 29, 2001. Petitioner understands that Patent Owner is asserting a priority date no later than May 29, 2001 in the co-pending district court litigation. Because the ’014 Patent was filed prior to the enactment of the Leahy-Smith America Invents Act (“AIA”), the ’014 Patent is entitled to a first-to-invent priority standard. Patent Owner has not conceded that it cannot establish a priority date earlier than the filing date of the ’605 application, and discovery in the co-pending district court litigation is still in the early stages. Patent Owner’s failure to do so raises the possibility that the Patent Owner may attempt to defeat one or more of the challenges in the 819 Petition by antedating one or more references on which those challenges are based.

The 819 Petition and the 975 Petition rely on completely distinct prior art combinations to address the different effective filing dates for the Challenged Claims. The 819 Petition relies on three different prior art references having the following priority dates:

1. U.S. Patent Application Publication 2001/0044817 (“Asano”), filed as Application No. 09/756,282 on January 9, 2001, which is prior art under at least 35 U.S.C. § 102(e).
2. U.S. Patent No. 6,542,991 (“Joy”), filed as Application No. 09/309,734 on May 11, 1999, which is prior art under 35 U.S.C. § 102(e).
3. U.S. Patent No. 7,143,401 (“Babaian”), filed as Application No. 09/789,850 on February 20, 2001, which is prior art under 35 U.S.C. § 102(e).

There are two challenges in the 819 Petition, one based on the combination of Asano and Joy, and the other based on the combination of Asano and Babaian. Patent Owner therefore could possibly defeat both challenges in the 819 Petition by establishing a priority date earlier than Asano’s priority date of January 9, 2001, which is about four months prior to the May 29, 2001 filing date of the ’014 patent.

The 975 Petition includes two grounds, both of which rely on Applicant Admitted Prior Art (“AAPA”) and U.S. Patent No. 6,314,501 (“Gulick”). Gulick is prior art under 35 U.S.C. § 102(e) with a priority date of December 18, 1998.

Because AAPA is an admission that cannot be antedated, defeating the challenges in the 975 Petition would require Patent Owner to establish that the '014 patent is entitled to priority earlier than Gulick's December 18, 1998 date, which is more than two years earlier than the January 9, 2001 date necessary to defeat the 819 Petition challenges, which is a significantly higher burden. Thus, should Patent Owner establish that '014 patent is entitled to a priority date earlier than January 9, 2001, the 975 Petition's grounds will remain viable against the '014 Patent unless Patent Owner is able to carry that significantly higher burden.

The potential priority dispute between the two parties justifies institution of the two petitions. The Patent Trial and Appeal Board's Consolidated Trial Practice Guide, November 2019, ("TPG") expressly acknowledges that "a dispute about priority date requiring arguments under multiple prior art references" is a situation in which it is appropriate to file multiple petitions against the same patent. *See* TPG, 59. While the TPG notes that such circumstances may be rare, the facts in the present case here justify institution of two petitions challenging the '014 Patent. *See, e.g., 10X Genomics, Inc. v. Bio-Rad Laboratories, Inc.*, IPR2020-00088, Paper 8, 46-47 (PTAB April 27, 2020) (granting institution of two parallel petitions, explaining that a priority fight concerning swear-behind dates for prior art references justifies concurrent filings with no stipulation by Patent Owner).

II. Ranking of the Petitions

Petitioner ranks the 819 Petition higher than the 975 Petition. Petitioner believes, however, that instituting both petitions is the fairest outcome in view of the potential priority dispute regarding priority between the parties. Petitioner has also relied on Patent Owner's own admissions in the 975 Petition in conjunction with only a single prior art reference as forming both of the asserted grounds, thus limiting any burden imposed on the Patent Owner to analyze unfamiliar art.

Dated: May 26, 2023

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on May 26, 2023, a true and correct copy of the foregoing materials were served on Patent Owner electronically, by agreement, by emailing a copy to the following attorneys for the Patent Owner:

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