

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DJI EUROPE B.V.,
Petitioner

v.

TEXTRON INNOVATIONS INC.,
Patent Owner.

IPR2023-01106

U.S. Patent No. 10,275,950

**PETITIONER'S EXPLANATION FOR AND RANKING OF TWO
PETITIONS CHALLENGING U.S. PATENT 10,275,950**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. Introduction

Pursuant to the November 2019 Consolidated Trial Practice Guide (“Guide”), DJI Europe B.V. (“Petitioner”) provides this explanation of multiple petitions challenging U.S. Patent No. 10,275,950 (the “’950 patent”). Petitioner presents two petitions, each of which applies the same grounds based on same prior art references. The petitions differ in respect to the particular claims challenged in each. The multiple petitions are justified by the number of independent claims (3) and total claims (11) Patent Owner has asserted in the related district court litigation¹, the length of the independent claims, the depth of analysis presented in the petitions, and the petition word limit.

II. Detailed Reasons for Multiple Petitions Against the ’950 Patent.

Each of the petitions is materially distinguishable from the other by virtue of challenging a unique claim set. The petition in IPR2023-01106 challenges claims 1-5, 7, and 8. The petition in IPR2023-01107 challenges claims 9-14 and 16.

There are no overlapping claims in these petitions. Therefore, the petitions present materially different challenges, each to a unique subset of ’950 patent claims. Patent Owner’s current list of asserted claims is not final, as there

¹ Petitioner has asserted claims 1-5, 8, 9, 12-14, and 16.

remains a possibility that Patent Owner will attempt to assert additional claims at some future date. Moreover, even the currently asserted claims would be difficult if not impossible to challenge in a single petition without significantly reducing the amount of analysis provided, prejudicing Petitioner's ability to explain the basis of invalidity in view of the complex subject matter at issue.

In addition, both petitions provide explanations why the Board should not exercise its discretion to deny institution under 35 U.S.C. §325(d) and *Fintiv*, limiting the space available to address the merits of invalidity.

Accordingly, two petitions are necessary to address each of the challenged claims in sufficient detail. (Guide, 59 (“[T]here 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.”).) The second petition has been filed due to the word count limit for petitions, the number of asserted independent and total claims, and the need to address each challenged claim in sufficient detail. The second petition is not submitted to present additional grounds of challenge or invalidity theories for the same claims addressed in first petition.

Beyond the Guide, additional factors support institution of Petitioner's multiple petitions. Because the petitions are filed simultaneously, they will be able to track the same schedule post-institution, maximizing the efficiency of

depositions, briefing, and oral argument. In addition, Petitioner uses the same expert witness to support both petitions, meaning a single deposition should be sufficient.

III. Ordering of Petitions

For the reasons discussed above, the Board should grant institution for both petitions. Under the circumstances, a ranking of petitions is not appropriate given that they challenge unique claim sets with no overlap. However, in view of the guidance in the consolidated trial practice guide (Guide, 60), Petitioner requests that the Board consider the petitions in the following order.

	Petition	Claims	Grounds
1	IPR2023-01107	9-14, 16	Warner, Wakutsu, Shavit and/or Greubel (claims 9-14, 16) Uczekaj and Jiang and/or Greubel (claims 9-14, 16)
2	IPR2023-01106	1-5, 7, 8	Warner, Wakutsu, Shavit and/or Greubel (claims 1-5, 7, 8) Warner, Wakutsu, Shavit and Uczekaj (claims 4, 5) Uczekaj and Jiang and/or Greubel (claims 1-5, 7, 8)

IV. Conclusion

Petitioner requests that the Board grant institution for both petitions.

Respectfully submitted,

/Lori A. Gordon/

Lori A. Gordon
Reg. No. 50,633

PERKINS COIE LLP
700 Thirteenth Street, NW, Suite 800
Washington, DC 2005

Lead Counsel for Petitioner

Date: July 27, 2023

CERTIFICATE OF SERVICE

The undersigned hereby certifies that true copies of the PETITIONER'S EXPLANATION FOR AND RANKING OF TWO PETITIONS CHALLENGING U.S. PATENT 10,275,950 were served via overnight delivery on the Patent Owner at the correspondence address of record as listed on PAIR:

James Walton
LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON, TX 76028

and via email to the attorneys of record for Plaintiff in the concurrent litigation:

Kevin James Meek
kmeek@mwe.com
Boyang Zhang
boyang.zhang@bakerbotts.com
Caroline Duncan
caroline.duncan@bakerbotts.com
Emily F. Deer
emily.deer@bakerbotts.com
Harrison Gheens Rich
harrison.rich@bakerbotts.com
James Travis Underwood
travis@gillamsmithlaw.com
Jeffery Scott Becker
jeff.becker@bakerbotts.com
Kurt Max Pankratz
kurt.pankratz@bakerbotts.com
Mark Speegle
mark.speegle@bakerbotts.com
Morgan Grissum Mayne
morgan.mayne@bakerbotts.com
Melissa Richards Smith
melissa@gillamsmithlaw.com

Respectfully submitted,

/Lori A. Gordon/

Lori A. Gordon
Reg. No. 50,633

Lead Counsel for Petitioner

Date: July 27, 2023