

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DJI EUROPE B.V.,
Petitioner,

v.

TEXTRON INNOVATIONS INC.,
Patent Owner.

Case IPR2023-01106
Patent No. 10,275,950

**PATENT OWNER’S RESPONSE TO PETITIONER’S EXPLANATION
FOR AND RANKING OF TWO PETITIONS CHALLENGING
U.S. PATENT 10,275,950¹**

¹ Patent Owner is filing this Response in both IPR2023-01106 and IPR2023-01107 and refers to Petitioner’s Explanation for and Ranking of Two Petitions Challenging U.S. Patent 10,275,950, filed in both proceedings as Paper 2, as “IPR2023-01106/01107, Paper 2.”

No exceptional circumstances exist that warrant granting two petitions on the same patent. Claims 1-5, 7, and 8 of U.S. Patent No. 10,275,950 (the '950 patent) (challenged in IPR2023-01106) overlap significantly in content with claims 9-14 and 16 (challenged in IPR2023-01107). These fourteen claims could have been challenged in a single petition had Petitioner not presented multiple independent unpatentability grounds using Warner (EX1005) or Uzekaj (EX1010) as the primary references in each of its petitions.

I. LEGAL STANDARD

Absent exceptional circumstances, only one petition should be filed against a single patent. *SolarEdge Techs. Ltd., v. SMA Solar Tech., AG.*, IPR2020-00966, Paper 9 at 10 (PTAB Jan. 11, 2021). The Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) explains “one petition should be sufficient to challenge the claims of a patent in most situations” and “[t]wo or more petitions filed against the same patent at or about the same time [] may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” CTPG at 59 (citing 35 U.S.C. § 316(b)). Indeed, “multiple petitions by a petitioner are not necessary in the vast majority of cases.” *Id.* The CTPG recognizes (1) a large number of asserted claims or (2) a dispute about priority requiring arguments under multiple references may necessitate multiple petitions. *Id.* But even then, two petitions “should be rare.” *Id.* Multiple petitions were not

necessary against the '950 patent and neither example applies.

II. MORE THAN ONE PETITION WAS NOT WARRANTED

The '950 patent has sixteen claims, with claims 1, 9, and 13 independent. Patent Owner asserted claims 1-5, 8, 9, 12-14, and 16 against Petitioner in related litigation. IPR2023-01106/01107, EX1012. IPR2023-01106 challenges claims 1-5, 7, and 8 across five grounds that utilize either Warner or Uzekaj as the primary reference. IPR2023-01106, Paper 3 at 1-2. The parallel petition of IPR2023-01107 challenges claims 9-14 and 16 using four of the same grounds. IPR2023-01107, Paper 3 at 1-2. Petitioner ranked the IPR2023-01106 petition second and IPR2023-01107 petition first. IPR2023-01106/01107, Paper 2 at 3.

Petitioner states multiple petitions are necessary due to the “number of independent claims (3) and total claims (11)” asserted in related litigation, “the length of the independent claims, the depth of analysis presented in the petitions, and the petition word limit,” and because each petition challenges a “unique claim set” (including unasserted claims). IPR2023-01106/01107, Paper 2 at 1-2. These conclusory arguments have no merit. *Lifescan, Inc. v. Facet Technologies, LLC*, IPR2023-00713, Paper 13 at 15-18 (PTAB Sept. 1, 2023) (“conclusory assertions” found “insufficient to show a second petition is required”).

The fourteen challenged claims could have been challenged in a single petition and the Board “routinely receives petitions challenging more.” *Apple Inc.*

v. Koss Corp., IPR2021-00679, Paper 14 at 12 (PTAB Oct. 12, 2021); *Fitbit, Inc. v. Kononolijke Phillips N.V.*, IPR2020-00772, Paper 14 at 26 & n.8 (PTAB Oct. 19, 2020) (average of 16 challenged claims per challenged patent in fiscal year 2019). Indeed, the basic filing fee for an *inter partes* review contemplates challenging up to 20 claims. 37 C.F.R. § 42.15(a)(1), (3). Petitioner has not shown anything unusual in the complexity of the '950 Patent's claims, the number of asserted (or challenged) claims, or the technology at issue that would distinguish it from cases where one petition is sufficient. IPR2021-00679, Paper 14 at 12.

That the petitions each challenge a “unique claim set” is a red herring. IPR2023-01106/01107, Paper 2 at 1-2. The subject matter of claims 1-5, 7, and 8 overlaps significantly with claims 9-14 and 16. For example, independent claims 9 and 13 are simply “system” and “method” claims that are exceedingly similar in content to independent claim 1. Petitioner acknowledges the significant overlap because the same grounds, using almost identical analysis, are applied against the challenged claims in both proceedings. Petitioner also filed the same expert declaration in both proceedings that addresses all challenged claims, where most of the analysis for independent claims 9 and 13 solely refers to analysis of independent claim 1 as the “limitations are substantially overlapping.” *See, e.g.*, IPR2023-01106, EX1003, ¶¶122-134, 136-148; *id.*, ¶¶149, 155-156 (regarding overlap of dependent claims 3 and 7 in relation to dependent claims 12 and 10);

IPR2023-01107, EX1003. Due to this overlapping subject matter, a single petition presenting grounds only using *one* of either Warner or Uczekaj as the primary reference, rather than Petitioner’s chosen course of multiple petitions each presenting multiple independent grounds using each as primary references, could have addressed all fourteen claims. Board panels have found that such a similarity between the content of claims challenged in parallel petitions is grounds for denial. *Apple Inc. v. Speir Technologies Ltd.*, IPR2023-00543, Paper 8 at 6, 9-10 (PTAB August 8, 2023) (denying lower ranked petition challenging different claims compared to parallel petition because the “claims are more similar than Petitioner suggests” and petitions were based on overlapping grounds); *Netskope, Inc. v. Bitglass, Inc.*, IPR2021-01046, Paper 11 at 11, 13-14 (PTAB December 14, 2021) (multiple petitions using same grounds against different claims unnecessary “given the substantial overlap in the subject matter of the claims”). Such an overlap also undercuts Petitioner’s argument that “[t]he second petition is not submitted to present additional grounds of challenge or invalidity theories for the same claims addressed in first petition” (IPR2023-01106/01107, Paper 2 at 2) as Petitioner’s chosen strategy improperly allows for presenting multiple independent unpatentability theories. That “there remains a possibility that Patent Owner will attempt to assert additional claims” (*Id.*) doesn’t change the calculus. Two petitions were not necessary to challenge fourteen claims of the ‘950 patent.

Petitioner argues that 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,” (IPR2023-01106/01107, Paper 2 at 2), but that is a problem of Petitioner’s own making. As noted, Petitioner could have included all fourteen challenged claims (including the eleven asserted claims) in a single petition. Petitioner intentionally chose not to, admitting that “[t]he second petition has been filed due to the word count limit for petitions.” *Id.* The failure to prioritize arguments is not an adequate reason to file two petitions; instead, it amounts to an improper attempt to present multiple grounds by circumventing word limit rules. IPR2023-00543, Paper 8 at 6, 9-10 (denying lower ranked petition in view of petitioner’s word count constraint argument).

Petitioner’s other arguments are unavailing and conclusory. Each petition expends under two pages to address 325(d) and *Fintiv*, which is hardly reason to permit multiple petitions, and Petitioner did not show the claims are unduly lengthy. IPR2023-01106, Paper 2 at 1-2; Paper 3 at 79-81; IPR2023-01107, Paper 3 at 78-80. That the petitions were filed simultaneously with the same declarant and may proceed with the same schedules does not support instituting both petitions. IPR2023-01106/01107, Paper 2 at 2-3. Instead, it would be the result of Petitioner circumventing the rules to present multiple independent grounds.

Respectfully submitted,

/s/ Brian W. Oaks
Brian W. Oaks
Reg. No. 44,981
Lead Attorney for Patent Owner

Date: November 15, 2023

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§ 42.6(e), the undersigned certifies that on November 15, 2023, a complete and entire copy of **PATENT OWNER'S RESPONSE TO PETITIONER'S EXPLANATION FOR AND RANKING OF TWO PETITIONS CHALLENGING U.S. PATENT 10,275,950** was served on Petitioner via electronic mail at the below addresses:

gordon-ptab@perkinscoie.com

bi-ptab@perkinscoie.com

November 15, 2023
Date

/s/ Brian W. Oaks
Brian W. Oaks
Reg. No. 44,981
Lead Attorney for Patent Owner