

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Mercedes-Benz USA, LLC,
Petitioner,

v.

Yechezkal Evan Spero,
Patent Owner.

Case [To be assigned]
Patent 11,208,029

**PETITIONER'S PETITION RANKING AND EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

On June 8, 2023, Petitioner Mercedes-Benz USA, LLC (“**Mercedes**” or “**Petitioner**”) filed a petition for *inter partes* review of US11,208,029 (the “**’029 Patent**”) in IPR2023-01034 (the “Mercedes Petition”). Petitioner now submits herewith a petition for *inter partes* review of the ’029 Patent (the “Joinder Petition”) along with a contingent motion to join IPR 2022-01586. Petitioner submits this notice of ranking of its petitions for *inter partes* review of the ’029 Patent, along with an explanation of the material differences between the petitions. *See* “TRIAL PRACTICE GUIDE UPDATE (July 2019)” at 26-28. The Mercedes Petition and this Joinder Petition each demonstrate that the ’029 Patent’s claims are unpatentable in materially different ways.

Material Differences. The Mercedes Petition presents a different case on patentability of the ’029 Patent from the Joinder Petition. Specifically, the Mercedes Petition raises a distinct ground based on an entirely different primary reference—Alden (US 2003/0137849), while the Joinder Petition relies on Beam (US 6,144,158) and Gotou (US 5,588,733) as primary references. Alden is not related to Beam or Gotou in any aspect. Thus, the Mercedes Petition and the Joinder Petition offer non-redundant, non-duplicative, and substantially dissimilar challenges to the ’029 Patent. Additionally, the Mercedes Petition is substantially different from the Joinder Petition in terms of Mercedes’ involvement. Mercedes independently uncovered the primary reference and the different grounds in the

Mercedes Petition, and independently prepared and filed that petition. Mercedes had no involvement in the preparation and filing of IPR 2022-01586, which the Joinder Petition seeks to join.

Ordering of Petitions. Petitioner ranks its Mercedes Petition ahead of the Joinder Petition. That is, Petitioner prefers and requests initial consideration of the Mercedes Petition before the Board considers the Joinder Petition and its accompanying contingent motion for joinder.

Rank	Petition	Primary Reference(s)
A	IPR2023-01034 (the “Mercedes Petition”)	Alden
B	Present petition seeking to join IPR2022-01586 (the “Joinder Petition”)	Beam and Gotou

As discussed, the Mercedes Petition includes a distinct ground against all 33 claims of the '029 patent, which provides a compelling case of obviousness based on prior art and arguments that the Board has not yet considered. Mercedes has a strong interest in prosecuting a case of unpatentability at the PTAB on its preferred ground. Further, institution could preclude or abridge a jury trial on validity by encouraging a stay and/or leading to a final written decision that estops Petitioner under 35 U.S.C. § 315(e)(2) from asserting printed publication grounds in the district court cases. The scope of the estoppel would be broader if the Mercedes Petition is instituted and proceeds to a final decision than if Mercedes is merely

joined to IPR2022-01586. *See Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1026-28 (Fed. Cir. 2020) (finding the scope of estoppel narrowed when a petitioner was limited to joining an instituted proceeding). The district court cases is still in its infancy and has been indefinitely stayed pending resolution of whether the complaints should be dismissed due to lack of standing and failure to join necessary parties. Thus, it is very likely that the Board's statutory deadline for issuing a final written decision in the Mercedes Petition will precede any jury trial.

In view of the material differences shown above, and for the reasons set forth in the Mercedes Petition, the Board should institute the Mercedes Petition. If the Board were to decline to institute review on the Mercedes Petition, the next best course of action would be to institute review on this Joinder Petition and grant Petitioner's contingent motion for joinder. As with the Mercedes Petition (albeit to a lesser extent), institution and joinder would promote efficiency in the district court cases, at least with respect to the grounds of this Joinder Petition, and would do so at no expense or prejudice to Patent Owner.

Dated: June 23, 2023

Respectfully submitted,

/s/ Celine J. Crowson

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