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Filed on behalf of Meta Platforms, Inc.
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01128
U.S. Patent No. 8,326,611

PETITIONER'S NOTICE OF RANKING PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,326,611

Petitioner herewith files two parallel petitions for *inter partes* review of U.S. Patent No. 8,326,611 ("the '611 patent"), IPR2023-01128 (challenging Claims 1-2 and 5-28) and IPR2023-01129 (challenging Claims 29 and 31-44). Pursuant to the Consolidated Trial Practice Guide, Petitioner provides the following ranking of petitions:

Rank	IPR Number	Prior Art	Claims Addressed
1	IPR2023-01128	Avendano '880, Visser[1], Bisgaard[2], Hou, "Frequency Art" (Byrne[3], Burnett[4], and/or Berglund[5])	1-2 and 5-28
2	IPR2023-01129	Avendano '880, Hou, Avendano '252	29 and 31-44

Challenging the '611 patent with two petitions was reasonable and necessary, and does not unduly burden the Board or Patent Owner. First, the '611 patent includes 44 claims, 41 of which are challenged by Petitioner. The large number of challenged claims alone makes two petitions reasonable, given the limited word

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[1] U.S. Patent No. 7,464,029 B2 ("Visser")

[2] U.S. Publication No. US 2011/0103626 A1 ("Bisgaard")

[3] Byrne, D., *et al*, "An international comparison of long-term average speech spectra," 1994 Oct; *J. Acoust. Soc. Am.*; 96(4):2108-2120 ("Byrne")

[4] U.S. Publication No. US 2002/0198705 A1 ("Burnett")

[5] Berglund, B., *et al*, "Source and effects of low-frequency noise," 1996 May; *J. Acoust. Soc. Am*; 99(5):2985-3002 ("Berglund")

count available. *Platform Sci., Inc. v. Omnitracs, LLC*, IPR2020-01518, Paper 14 at 17-18 (Apr. 15, 2021) ("[T]wenty claims constitutes the 'large number'") (citations omitted); *Dolby Lab'ys., Inc., v. Intertrust Techs. Corp.*, IPR2020-01105, Paper 14 at 19-21 (PTAB Jan. 5, 2021).

Further, the challenged claims present features that require distinct treatment. *Samsung Elecs. Am., Inc. v. Snik LLC*, IPR2020-01429, Paper 10 at 12-13 (P.T.A.B. Mar. 9, 2021) (noting "word constraints" of challenging 55 claims, and "the substantive differences between the groups of challenged claims"). For example, the independent claim in IPR2023-01128 (*i.e.*, Claim 1) recites limitations that are not recited in any of the claims challenged in IPR2023-01129, namely "forming a filter that describes a relationship for speech between the first physical microphone and the second physical microphone." Further, each independent claim challenged in IPR2023-01129 (*i.e.*, Claims 29 and 44) recites limitations that are only recited in a dependent claim of the claims challenged in IPR2023-01128 (*i.e.*, claim 17), namely limitations directed to forming a filter by "generating a first quantity by applying a calibration to [] the second signal," "generating a second quantity by applying the delay to the first signal," and "forming the filter as a ratio of the first quantity to the second quantity." These two groups of independent claims recite substantively different combinations of features that require distinct treatment.

Patent Owner also asserts all of the challenged claims of the '611 patent in

concurrent litigation against Petitioner. *Dolby Lab'ys.*, IPR2020-01105, Paper 14 at 20. Should the Board deny institution of one of Petitioner's petitions, Patent Owner would gain an unfair advantage, as Patent Owner could adjust its ultimate assertion towards the claims that had been challenged in the denied petition.

Petitioner gains no unfair advantage by requesting institution on two petitions because (1) each petition challenges a different subset of claims (*see Dolby Lab'ys,* IPR2020-01105, Paper 14 at 20), (2) the two petitions are Petitioner's first requests seeking review of the '611 patent, and (3) the petitions do not consider, rely on, or otherwise take advantage of any prior Patent Owner response. There is thus no multiplicity of proceedings or a second bite at the apple.

Institution of both petitions would not impose any undue burdens on the Board or Patent Owner, as the petitions deploy overlapping prior art references, and both petitions are supported by declarations from the same technical expert. *Twitter, Inc. v. Palo Alto Rsch. Ctr., Inc.*, IPR2021-01459, Paper 11 at 37 (PTAB Apr. 6, 2022). The proceedings could thus be effectively consolidated, for depositions of Petitioner's declarant and for oral argument. *Id*. at 38.

In view of the differences described above, the Board should use its discretion to institute both petitions. The grounds set forth in the petitions are not redundant, duplicative, unduly burdensome on the Board, or unfair to Patent Owner.

Respectfully submitted,

ALLEN & OVERY, LLP

Dated: June 27, 2023

/Lisa Nguyen/
Lisa Nguyen (Reg. No. 58,018)

Counsel for Petitioner,
META PLATFORMS, INC.

CERTIFICATE OF SERVICE

I hereby certify that true and correct copies of the foregoing **PETITIONER'S NOTICE OF RANKING PETITIONS FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,326,611** is being served on June 27, 2023, via FedEx Priority Overnight on counsel of record for U.S. Pat. 8,326,611 patent owner Jawbone Innovations, LLC at the address below:

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A courtesy copy is also being served via electronic mail on counsel for the patent holder in the pending district court litigation, *Jawbone Innovations, LLC v. Meta Platforms, Inc.*, 6:23-cv-00158 (W.D. Tex., filed February 28, 2023), and all counsel for the patent owner in IPR2023-00286:

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