

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,

Petitioner

v.

AX Wireless LLC,

Patent Owner.

IPR 2023–01145

U.S. Patent No. 11,212,146

**PETITIONER’S EXPLANATION FOR AND RANKING OF TWO
PETITIONS CHALLENGING U.S. PATENT NO. 11,212,146**

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

Petitioner, Intel Corporation, has requested Inter Partes Review (“IPR”) of claims 1-10 (the “Challenged Claims”) of U.S. Patent 11,212,146 (“the ’146 Patent”) in two separate petitions, IPR2023-01145 and IPR2023-01146. In these two petitions, Petitioner has presented two materially distinct, non-cumulative petitions, one of which addresses a priority dispute regarding the effective filing date of the Challenged Claims. Petitioner respectfully requests institution of both petitions for the reasons detailed below.

I. Detailed Reasons for Multiple Petitions Against the ’146 Patent.

The ’146 Patent claims priority through a series of continuations to application No. 13/376,856 (“the ’856 application”), filed August 20, 2010, now U.S. Patent No. 9,584,262 (“the ’262 Patent”). The ’856 application is a national stage application under 35 U.S.C. § 371 of PCT Application No. PCT/US2010/046088, which has an international filing date of August 20, 2010 and further claims priority to U.S. Provisional Application No. 61/235,909 (“the ’909 provisional”), filed August 21, 2009. In a co-pending district court litigation filed by Patent Owner (“PO”), PO contends that the challenged claims of the ’146 patent are entitled to a priority date of August 2009. (*See* EX-1007, 11.)

Although the burden is on PO to show priority benefit of its claims to the earlier provisional application (*i.e.*, the ’909 provisional), Petitioner establishes in IPR2023-01146 that the challenged claims of the ’146 patent are not entitled to

priority based on the '909 provisional because the '909 provisional lacks written description support for the challenged claims. IPR2023-01146 demonstrates that the earliest effective filing date for the challenged claims is no earlier than December 29, 2020.

The priority dispute between the parties justifies two petitions. The Patent Trial and Appeal Board's Consolidated Trial Practice Guide 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* Office Consolidated Trial Practice Guide, 84 Fed. Reg. 64280 (Nov. 20, 2019) ("TPG"). While the TPG notes that such circumstances may be rare, the facts in the present case justify institution of two petitions challenging the '146 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 dispute concerning swear-behind dates for prior art references justifies concurrent filings with no stipulation by Patent Owner).

The Petitions in IPR2023-01145 and IPR2023-01146 rely on completely distinct prior art and combinations that are asserted to address the different effective filing dates for the Challenged Claims. IPR2023-01145 relies on three different prior art references (two grounds), all of which were published before

August 21, 2009. The two grounds in IPR2023-01145 are therefore viable even if it is determined the challenged claims are entitled to priority benefit of the '909 provisional. IPR2023-01146, in contrast, presents two grounds based on two prior art references dated after August 21, 2009. Therefore, the two grounds in IPR2023-01146 are only viable if it is determined the challenged claims are not entitled to priority based on the '909 provisional.

II. Ranking of the Petitions

Petitioner believes that instituting both petitions is the fairest outcome because of the priority dispute created by the PO during the co-pending litigation. However, Petitioner provides the following table ranking the Petitions should the Board determine otherwise.

	Petition	Claims	Grounds
1	IPR2023-01145	1-10	103: (1) Yu and/or (2) Hansen in combination with WWiSE
2	IPR2023-01146	1-10	103: (1) Huang and/or (2) Sun

Date: July 7, 2023

Respectfully submitted,

/ Jon R. Carter /

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the PETITIONER'S EXPLANATION FOR AND RANKING OF FOR TWO PETITIONS CHALLENGING U.S. PATENT NO. 11,212,146 was served via overnight delivery on the Patent Owner at the correspondence address of record as listed in USPTO records:

Capitol IP Law Group, PLLC
1629 K Street NW Suite 300
Washington, DC

and via email to the attorneys of record for Plaintiff in the concurrent *AX Wireless LLC, v. Dell Inc., and Dell Technologies Inc.*, 2-22-cv-00277 (EDTX), *AX Wireless LLC, v. HP Inc.*, 2-22-cv-00279 (EDTX), and *AX Wireless LLC, v. Lenovo Group Ltd.*, 2-22-cv-00280 (EDTX) litigations:

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