UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,

Petitioner,

v.

NORTHSTAR SYSTEMS, LLC,

Patent Owner.

U.S. Patent No. 8,805,416
Filing Date: February 14, 2008
Issue Date: August 12, 2014

Case No. IPR2023-01191

PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS[1]

[1] Petitioner is filing a substantively identical document in IPR2023-01049.

I. Two Petitions Are Necessary to Address the Quantity and Scope of the Claims

While a single petition is generally sufficient to address all challenged claims of patent, the Board recognizes that there are "situations" that justify parallel petitions, including when "the petitioner is challenging a large number of claims… there are a large number of claimed embodiments challenged" or the "the case is technically complex. *See* Advanced Notice of Proposed Rulemaking, 88 FR 24503, 24513 (April 2023). The Board should grant each of the petitions filed against U.S. Patent No. 8,805,416 because the quantity and scope of the claims raises such a situation.

First, the '416 patent contains 35 technically complex claims—several of which have been asserted by patent owner in the parallel litigation. Ex. 1022. The number and complexity of claims cannot be sufficiently addressed in a single petition. Second, the claims are directed to different embodiments containing non-overlapping subject matter. For example, claims 1-16 and 24-29 (of which, 1, 11, 24, and 25 are independent) relate to systems, methods, and a memory device for using "signal interference" information, while claims 17-23 and 30-35 (of which 17, 20, and 30 are independent) relate to methods, systems, and an apparatus for using "environmental information." The lack of overlap warrants separate analyses that cannot be sufficiently addressed in a single petition. Lastly, five of

the thirty-five claims invoke means plus function language—a total of 10 means plus-function limitations, each requiring claim construction pursuant to 37 C.F.R. § 42.104(b)(3). The Board also recognizes that "the requirements in [the] rules for challenging means-plus-function claim limitations" present another case in which two petitions may be necessary. *DJI Europe BV v. Daedalus Blue, LLC*., IPR2020-01474, Paper 14 (PTAB Feb. 12, 2021).

Accordingly, Petitioner submits that the totally of the circumstances presents a case where two petitions are necessary.

II. The *General Plastics* Factors Favor Institution

The petitions are split to provide a thorough analysis of all claims—one petition addresses claims asserted in a parallel litigation, the other addresses non-asserted claims that patent owner-plaintiff reserves the right to assert[2] at a later date—including claims invoking means-plus function language, as demonstrated below:

IPR 2023-01049			
Ground	**Claim(s) Challenged**	**35 U.S.C. §**	**Reference(s)**
1	1, 3-5 and 9-13	103	Chern and Garceran

[2] Patent owner has already increased the number of allegedly infringed claims at least once. *Compare* Ex. 1021 at 24 *with* Ex. 1022.

2	6	103	Chern, Garceran, and Ihara
3	17-19	103	Yamakita
4	17-19	103	Yamakita and Chern

IPR 2023-01191			
Ground	**Claim(s) Challenged**	**35 U.S.C. §**	**Reference(s)**
1	1, 2, 7, 8, 11, 14, 16, 24 and 25-29	103	Chern and Garceran
2	11 and 15	103	Chern and Garin
3	20-23 and 30-35	103	Yamakita

The first five *General Plastics* factors favor institution because Petitioner filed both petitions for the first time and on the same day. *See Intex Recreation Corp. v. Team Worldwide Corp*., IPR2018-00873, Paper 14 at 8-12 (PTAB Oct. 29, 2018) (noting factors 1-5 "do not weigh in favor of exercising discretion to deny" where petitions were filed on the same day). No other petitions challenging the '416 patent have ever been filed by any petitioner.

Factors 6 and 7 also favor institution. Though the petitions present different combinations, they rely on overlapping references, lowering the burden associated

with consideration of the second petition. In total, the two petitions address five prior art references, so the Board's ability to render timely final decisions should not be impeded.

III. Ranking of Petitions

If the Board decides to institute only a single petition against the '416 patent, Petitioner requests that the Board institute IPR2023-01049.

Date: August 3, 2023

Respectfully Submitted,

/Lionel Lavenue/
Lionel M. Lavenue, Lead Counsel
Reg. No. 46,859

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS** was served on August 3, 2023, by FedEx Priority Overnight at the following address of record for the subject patent.

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Date: August 3, 2023

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