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Filed on behalf of Sony Electronics Inc.
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY ELECTRONICS INC.,

Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01229
U.S. Patent No. 8,503,691

PETITIONER'S NOTICE REGARDING MULTIPLE PETITIONS[1]

[1] Petitioner is filing a substantively identical document in IPR2023-01228.

Petitioner Sony Electronics Inc., is concurrently filing two petitions (IPR2023-01228 and IPR2023-01229) against U.S. Patent No. 8,503,691. These petitions are necessary to address all forty-six claims of the '691 patent. Patent Owner has reserved its right to assert all forty-six claims against Petitioner in the co-pending litigation and has not narrowed its asserted claims. "[T]he board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation…." Consolidated Trial Practice Guide (Nov. 2019) at 59.

Of the '691 patent's forty-six claims, six are independent: claims 1, 23, 27, 28, 29, and 41. In IPR2023-01228, Petitioner challenges claims 1-22 and 29-40 of the '691 patent. In IPR2023-01229, Petitioner challenges claims 23-28 and 41-46. Both petitions assert a single ground of unpatentability based on the same prior art: U.S. Patent Publication No. 2004/0185804 ("Kanamori") and Iain A. McCowan et al., *Near-Field Adaptive Beamformer for Robust Speech Recognition*, 12 Digital Signal Processing 87-106 (2002) ("McCowan"). Pursuant to the Consolidated Trial Practice Guide (Nov. 2019), Petitioner provides the following ranking of petitions:

Rank	IPR	Prior Art	Claims
1	IPR2023-00559	Kanamori and McCowan	1-22 and 29-40
2	IPR2023-00561	Kanamori and McCowan	23-28 and 41-46

Challenging the '691 patent with two petitions is reasonable and necessary and does not unduly burden the Board or Patent Owner. Given the word limit for IPR

petitions, challenging forty-six claims makes two petitions reasonable. *Platform Sci., Inc. v. Omnitracs, LLC*, IPR2020-01518, Paper 14 at 17-18 (PTAB Apr. 15, 2021) ("The Board has found that about twenty claims constitutes the 'large number' that the CTPG suggests may justify multiple petitions.") (citations omitted); *Dolby Labs., Inc. v. Intertrust Techs. Corp.*, IPR2020-01105, Paper 14 at 19-21 (PTAB Jan. 5, 2021). While many claims overlap to a large degree, the six independent claims and their forty dependents are not identical, and the sheer volume of claims did not allow Petitioner to address all distinctions between the claims in a single petition. *Samsung Elecs. Am., Inc. v. Snik LLC*, IPR2020-01429, Paper 10 at 12-13 (PTAB Mar. 9, 2021) (noting the "word count constraints" of challenging 55 claims, and "the substantive differences between the groups of challenged claims").

Additional considerations weigh against a discretionary denial. First, Petitioner gains no unfair advantage by requesting institution on two petitions: (1) there is no overlap in claims between the two petitions—each petition challenges a different subset of claims; (2) the two petitions are Petitioner's first requests seeking review of the '691 patent; and (3) the petitions are substantively identical to petitions filed by Amazon (and by Google) in IPRs in which the Board has already instituted trial, and Petitioner requests joinder with the Amazon IPRs. There is thus no multiplicity of proceedings or a second bite at the apple.

Further, instituting both petitions does not impose any undue burdens on the Board or Patent Owner because the two petitions rely on identical prior art and are supported by declarations from the same technical expert. *Twitter, Inc. v. Palo Alto Research Ctr., Inc.*, IPR2021-01459, Paper 11, at 37 (PTAB Apr. 6, 2022) (quoting Consolidated Trial Practice Guide (Nov. 2019) at 59). The proceedings could thus be effectively consolidated, for depositions of Petitioner's declarant and any oral hearing. *Id*. at 38.

For these reasons, the Board should not exercise its discretion to deny institution.

Respectfully submitted,

LERNER DAVID LLP

Dated: July 24, 2023

/Gregory S. Gewirtz/
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITIONER'S NOTICE REGARDING MULTIPLE PETITIONS is** being served on July 24, 2023 via Federal Express overnight mail on counsel of record for U.S. Patent No. 8,503,691 as addressed below:

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