

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SRAM, LLC,

Petitioner,

v.

FOX Factory, Inc.,

Patent Owner.

U.S. Patent No. 9,739,331 B2

Filing Date: August 10, 2015

Issue Date: August 22, 2017

Title: METHOD AND APPARATUS FOR AN ADJUSTABLE DAMPER

Case No. IPR2023-01301

**PETITIONER'S EXPLANATION OF TWO PETITIONS
CHALLENGING U.S. PATENT NO. 9,739,331**

I. INTRODUCTION

In accordance with the November 2019 Consolidated Trial Practice Guide, Petitioner SRAM, LLC (“SRAM”) provides this explanation of two petitions challenging U.S. Patent No. 9,739,331 (“the ‘331 patent”). SRAM presents two petitions with different primary references to account for all eight claims of the ‘331 patent. Two petitions are justified based on the glut of prior art not previously presented to the Patent Office during prosecution of the ‘331 patent, Patent Owner FOX Factory, Inc.’s (“Fox”) broad claim construction positions, the limited disclosure in individual prior art references of well-known elements in the art, the length and breadth of the claims asserted by Fox in the District Court, and the petition word limit.

A. Explanation of Material Differences and Reasons Why More Than One Petition Should Be Instituted

The two petitions are materially distinguishable from the other by virtue of presenting unique prior art that addresses the limitations of the ‘331 patent claims in materially different ways.

Independent claim 1 of the ‘331 patent includes over 370 words across multiple different limitations. Different primary references are required to address each in unique ways. The only overlap in references between the petitions applies to secondary references *Bruckbauer*, *Huang*, and *Danter*, which are required to cover dependent claims adding specifics of well-known elements in the art. The

Petition in IPR2023-01301 applies *Kojima* and *Becker* as primary references. The Petition in IPR2023-01302 applies *Kashima*, *Hoose*, and *Ceriani* as primary references. Each of these primary references addresses the multiple limitations of independent claim 1 in different ways.

Kojima provides a clear disclosure on the recited distance between the air bleed assembly and oil bath. *Kojima* also includes a screw-type air bleed assembly that penetrates into the related fork tube at or around the lower end of the tube. On the other hand, *Kashima* provides a screw-type air bleed assembly at the top end of the related fork tube. Although the '331 patent claims say nothing about intended use, *Kashima* differs from *Kojima* in that *Kashima* is intended to use the air bleed assembly to bleed all of the air therein after full construction of the fork, whereas *Kojima* is intended to be used with air surrounding the oil bath. *Ceriani* presents a screw-type air bleed assembly that is placed in the middle of its related tube and used to remove residual air. *Ceriani* also presents an alternate air bleed assembly that equalizes air pressure in a region that is isolated from the oil bath, like *Hoose*. *Hoose*, unlike the other primary references, includes a generic air bleed assembly (defined only by function) and multiple air and oil chambers. Finally, *Becker* does not include an air bleed assembly, but is the same fork disclosed in the '331 patent.

Fox has also argued in the district court proceedings that each of these primary references purportedly fail to include at least one claim element of independent claim

1, based on Fox's proposed claim constructions. As a result of this, and given the asserted breadth of the claims, each of the above prior art references is required to fully address Fox's broad constructions.

Additional word count is required due to the need to combine the primary references with the three secondary references: *Bruckbauer*, *Huang*, and *Danter*. Each is required to cover limitations related to the specifics of the air bleed assembly, as *Bruckbauer* discloses an air bleed assembly like that disclosed in the '331 patent, and *Huang's* air bleed assembly allows both air ingress and egress. *Danter* covers the '331 patent's die casting product-by-process set forth in claim 5. The dependent claims nearly double the claim word count, necessitating additional references and words.

In addition, both petitions provide explanations why the Board should not exercise its discretion to deny institution under *Fintiv* or § 325(d), limiting the space available to address the merits of invalidity.

Accordingly, two petitions are necessary to address each of the challenged claims in sufficient detail. See Guide at 59 (discussing circumstances in which burdens to address the claims-at-issue may necessitate multiple petitions). The second petition has been filed to address the above necessities and not to present redundant or duplicative grounds.

Additional factors support institution of SRAM's multiple petitions. Because the petitions are filed simultaneously, they will be able to track the same schedule post-institution, maximizing the efficiency of depositions, briefing, and oral argument. In addition, SRAM uses the same two expert witnesses to support both petitions, meaning a single deposition of each expert should suffice. Both petitions also apply the same references for the dependent claims, streamlining much of that analysis.

B. Ordering of Petitions

For the reasons discussed above, the Board should grant institution for both petitions. Under the circumstances, a ranking of petitions is not appropriate given the issues discussed above. In view of the guidance in the consolidated trial practice guide, see Guide at 60, SRAM requests that the Board consider the petitions in the following order:

Order	IPR Case No.	Challenged Claims
1	IPR2023-01301	1-8
2	IPR2023-01302	1-8

II. CONCLUSION

SRAM respectfully requests that the Board grant institution for both petitions.

Dated: August 10, 2023

Respectfully submitted,

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