

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATFIX INC.
Petitioner,

v.

WALKME LTD.
Patent Owner.

Patent No. 10,819,664

Inter Partes Review Nos. IPR2023-01368 and IPR2023-01443

**PETITIONER'S PETITION RANKING AND EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS**

Petitioner Whatfix Inc. seeks *inter partes* review of U.S. Patent No. 10,819,664 (“the ‘664 patent” (EX1001)) in two filed Petitions. (*See* IPR2023-01368, Paper 2; IPR2023-01443, Paper 2.) Pursuant to the November 2019 Patent Trial and Appeal Board Consolidated Trial Practice Guide published by the USPTO, Petitioner submits this paper to “identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).”¹ *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 at 59-61.

I. ORDERING OF PETITIONS

Although Petitioner believes that its two Petitions are meritorious and justified in light of the positions Patent Owner may take, at this stage, Petitioner requests that the Board consider the Petitions in the following order:

¹ Petitioner previously submitted a ranking document in IPR2023-01443 along with the filing of its petition in that proceeding. (*See* IPR2023-01443, Paper 3.)

Rank	Petition	Prior Art References	Claims Challenged
1	IPR2023-01368 (Petition 1 of 2)	Symons Williams Allen Dayanandan Krishnan Radhakrishnan	1-9, 12-16, 18-23, 25, 26, 28-31, 33
2	IPR2023-01443 (Petition 2 of 2)	Symons Williams Allen Ben-Itzhak	10, 24

II. MATERIAL DIFFERENCES

A. Public Availability Date

Petition 1 relies on two prior art references (Symons and Williams) that are not patent publications. The Symons Article and the Symons Video (collectively “Symons”) are a publicly available blog post and a Vimeo video, respectively. Williams is a white paper. Due to the need to establish the authenticity and printed publication status of the Symons Article, the Symons Video, and Williams, Petitioner was not able to fit all grounds against all challenged claims into a single petition, but rather needs two petitions to demonstrate unpatentability of the challenged claims.

B. Large Number of Claims

Further a large number of claims of the ’664 patent are potentially being asserted in the co-pending litigation. At the time the Petitions were filed, Patent

Owner had not yet served its infringement contentions, but the complaint leaves open the option to assert all 33 claims in the litigation. Accordingly, Petitioner is challenging a large number of claims, *i.e.*, 29 claims. Based on USPTO statistics, in fiscal year 2019, an average of about 12 claims were challenged per Petition—well below the 29 claims at issue here. (EX1035, pp. 7, 9 (*e.g.*, 20,247 total challenged claims / 1,641 total Petitions = 12.34 claims per Petition).) Thus, due to the large number of challenged claims, Petitioner needs two.

C. Prior Art Reference Teachings

The claims challenged and the corresponding prior art references of the Grounds of Petitions 1 and 2 differ. More specifically, Petition 2 relies on the prior art reference, Ben-Itzhak, to challenge dependent claims 10 and 24. Dependent claims 10 and 24 are not challenged in Petition 1, nor does Petition 1 rely on Ben-Itzhak in any of its Grounds.

III. TABLE SUMMARIZING MATERIAL FACTORS

Material Factors	Petition 1	Petition 2
Challenges Claims 1-9, 12-16, 18-23, 25, 26, 28-31, 33?	Yes	No
Challenges Dependent Claims 10 and 24?	No	Yes
Relies on Ben-Itzhak Prior Art Reference?	No	Yes

In view of the material factors shown above, the Board should exercise its discretion to institute both Petitions. Both Petitions are necessary to show the breadth of prior art that reads on the overly broad claims. Each Petition provides a strong showing of unpatentability, without being redundant or duplicative.

Dated: December 18, 2023

Respectfully submitted,

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Certificate of Service (37 C.F.R. § 42.6(e)(4) and 42.205(a))

I hereby certify that the attached PETITIONER’S PETITION RANKING
AND EXPLANATION OF MATERIAL DIFFERENCES BETWEEN
PETITIONS was served as of the below date via e-mail to the following counsel of
record for the Patent Owner:

Kim Kennedy
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Dated: December 18, 2023

Respectfully submitted,

By /s/ Alex S. Yap
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