

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

HANSHOW AMERICA INC.,
HANSHOW TECHNOLOGY CO., LTD.,

Petitioners

v.

SES-IMAGOTAG INC.

Patent Owner

Cases: IPR2024-00189 and IPR2024-00190

Patent No. 10,674,340

**PETITIONERS' RANKING AND EXPLANATION OF MATERIAL
DIFFERENCES BETWEEN PETITIONS**

Petitioners are filing two concurrent Petitions (IPR2024-00189 and IPR2024-00190) challenging the validity of claims 1-9 of U.S. Patent No. 10,674,340 (“the ’340 patent”). Pursuant to the Board’s November 2019 Consolidated Trial Practice Guide (“TPG”), Petitioners submit this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits . . . , 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” TPG, 60.

I. RANKING OF THE PETITIONS

Although Petitioners believe that both Petitions are meritorious and justified, Petitioners request that the Board consider the Petitions in the following order:

Rank	Petition	Grounds/References
1	IPR2024-00189	Ground 1 (§ 103): Cl. 1-9 (Fujiwara) Ground 2 (§ 103): Cl. 1-9 (Fujiwara/Arntzen) Ground 3 (§ 103): Cl. 1-5, 8-9 (Bandy/Fowler) Ground 4 (§ 103): Cl. 1-5, 8-9 (Bandy/Fowler/Arntzen)
2	IPR2024-00190	Ground 1 (§ 103): Cl. 1-5, 8 (Siotia/Sakata) Ground 2 (§ 103): Cl. 6-7, 9 (Siotia/Sakata/Akao) Ground 3 (§ 103): Cl. 8-9 (Siotia/Sakata/Akao/Chen) Ground 4 (§ 103): Cl. 1-3, 5, 8 (Ghosh/Sakata) Ground 5 (§ 103): Cl. 6-7, 9 (Ghosh/Sakata/Akao) Ground 6 (§ 103): Cl. 8-9 (Ghosh/Sakata/Akao/Chen)

II. MATERIAL DIFFERENCES BETWEEN THE PETITIONS

The two Petitions are materially different. For example, because the ’340 Patent is pre-AIA, there may be a dispute about the priority date of the ’340 Patent

for pre-AIA § 102(a) and § 102(e) purposes that can affect the prior art status of certain references. The Petition IPR2024-00189 uses exclusively pre-AIA § 102(b) prior art references and is thus materially different from the Petition IPR2024-00190.

Additionally, each petition presents a different, non-cumulative challenge premised on a different primary reference, which illustrates the overly-broad nature of the '340 patent claims. As such, the petitions overlap only in their shared conclusion that the Challenged Claims are invalid.

Specifically, the obviousness grounds also contain material differences. Although the Fujiwara-based grounds, the Bandy-based grounds, the Siotia-based grounds and the Ghosh-based grounds all cover every claim element, they do not present the same theories of obviousness or use identical language. In particular, Ground 1 in the Petition IPR2024-00189 presents a single reference obviousness ground, while the other grounds rely on combinations of references. Accordingly, the Petitions have different starting points and different rationales as to why the challenged claims are obvious.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO INSTITUTE BOTH PETITIONS

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” TPG, 59. One of the examples provided by the Board for justifying the institution of multiple petitions is a “dispute about priority date.” *Id.* Here, Petitioners contend that Ghosh qualifies as a pre-AIA § 102(e) prior art due to its filing date. But in the event that Patent Owner attempts to challenge the

prior art status of Ghosh, Petitioners provide arguments based on other references that do not present potential priority date disputes. This fits into the Board’s example for justifying the institution of multiple petitions. *See also Xilinx, Inc. v. Analog Devices, Inc.*, IPR2020-01484, Paper 11 at 9 (PTAB Mar. 15, 2021) (finding justification of two petitions because of the potential by the Patent Owner to challenge the prior art status of certain reference and a lack of a clear disclaimer not to present such challenge).

Further, despite Petitioners’ best efforts, it is not possible to present all the grounds in one petition. The claims of the ’340 patent are verbose and altogether contain 777 words, with claim 1 by itself containing 229 words. Furthermore, as shown below, the claims of the ’340 patent recite different and unrelated features:

Independent Claims 1 and 5: Method and system for communicating spatially localized information to a mobile terminal

Claim 2: Activation of radio-frequency communication peripheral through energy of electromagnetic waves

Claim 3: Communication via the Internet

Claim 4: Association of the spatially localized information with account data specific to the user of the mobile terminal

Claim 6: Radio-frequency communication peripheral as an electronic shelf label with display capabilities

Claim 7: Transmission of data to the radio-frequency communication module by the mobile terminal

Claim 8: Placement and connection between antenna and chip

Claim 9: Connection between chip and microcontroller, and arrangement of antenna

This necessitated separate explanation of background and disclosure of such features within the prior art. *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00234, Paper 15 at 21 (PTAB June 21, 2022) (“[I]t was reasonable for Petitioner to conclude that the number of claims, the difference in scope of the dependent claims, and the different references needed to present its arguments of unpatentability for the various claims, warranted the filing of two petitions.”)

Petitioners streamlined each petition as much as possible, however, due to the above-described length and complexity of the claims, attempting to combine the Petitions into one within the word count limit would not be possible. Thus, this is a unique situation in which multiple petitions are necessary to adequately address the challenged claims, and discretionary denial would prejudice Petitioners.

In view of the material differences and of the unique situation 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 and disconnected claims. The Petitions are not redundant, duplicative, or substantially similar, and each Petition provides a strong showing of unpatentability.

Finally, this is not a situation where Petitioners have filed many IPR petitions against one patent or are asserting dozens of independent grounds. Rather, Petitioners have filed only two petitions, with only four non-overlapping grounds. These grounds will not unduly burden the Board or the parties.

IV. CONCLUSION

For the above reasons, Petitioners respectfully request the Board institute both Petitions.

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Respectfully submitted,

/ Hao Tan /

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