

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner

v.

THL HOLDING COMPANY, LLC,  
Patent Owner

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Case Nos. IPR2024-00399 and IPR2024-00400  
Patent No. 11,350,246

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

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Petitioner submits this paper with its two parallel petitions (IPR2024-00399(a) and IPR2024-00400(b)) challenging the patentability of claims 1-27 of U.S. Patent No. 11,350,246 (“the ’246 Patent”). *Trial Practice Guide* (TPG) (July 2019), 60.

## **I. EXPLANATION OF MATERIALS DIFFERENCES BETWEEN THE PETITIONS**

There are several material differences between the two Petitions. First, each petition covers different claims, with 27 claims in total. Petition One covers claims 1-19, and Petition Two covers claims 20-27. Petitioner challenged this number of claims because the Challenged Claims largely correspond to Patent Owner’s asserted claims in the District Court litigation. Ex. 1013, *THL’s Disclosure of Asserted Claims and Infringement Contentions*, at 1. Second, independent claims 1 and 11 include different limitations than independent claim 20, warranting different primary prior art references in the two Petitions, namely Kalliola in Petition One and Sweeney in Petition Two. Notably, this is not a situation where Petitioner is seeking multiple bites at the apple. To the contrary, each claim is covered by only one ground of invalidity, except for claim 26 for which a priority challenge is made (discussed below). Third, the claims are unusually long requiring two Petitions. Fourth, there are no overlapping claims between the two Petitions. Fifth, as noted Petitioner is raising a priority challenge to dependent claim 26, and consequently, must submit two grounds for claim 26 relying on art pre-dating the claimed priority versus the actual priority and must further establish the lack of priority.

### **A. Petitioner Is Challenging a Large Number of Claims**

Per the Consolidated Trial Practice Guide “more than one petition may be necessary, including for example, when the patent owner has asserted a large number of claims in litigation...” TPG, 60; *Micron Tech., Inc., et al. v. Netlist, Inc.*, IPR2022-00744, Paper 15 at 9 (PTAB Nov. 1, 2022) (holding that the Board “agreed with Petitioner that a large number of claims have been asserted against it in district court and that addressing those 29 claims may necessitate filing two separate petitions”); *Hanwha Solutions Corp., et al. v. Rec Solar Pte., Ltd.*, IPR2021-00989, Paper 12 at 9-12 and IPR2021-00988, Paper 12 at 9-11 (PTAB Dec. 13, 2021) (granting two petitions each challenging the same 8 claims, where the petitions included different grounds). Here, challenging 27 claims in total is sufficient to necessitate filing two Petitions.

### **B. The Challenged Claims Vary in Scope**

Claim 20 of Petition Two includes the following limitations different from claims 1 and 11 of Petition One: (1) determining distance based on Bluetooth signals (EX1001, 41:1-4); (2) displaying an estimated position on a map (*id.*, 41:7-9); (3) “unique device identifier” (*id.*, 40:41-44); (4) displaying “a name” of the remote device and receive selection of remote device that visually indicates the remote device (*id.*, 40:45-52); and (5) determining the remote device is within Bluetooth

range (*id.*, 40:53-58). Additionally, claim 11 recites an orientation sensor and detecting rotation of the mobile device, which is not recited in either claims 1 or 20.

Given the additional limitations in claim 20 and differing methods of determining distance and position in claim 20 versus claim 1, Petitioner is required to use different primary references. Due to (1) the difference in claimed subject matter between claims 1 and 20; and (2) the different primary references required between the two petitions, filing two petitions is warranted. *Google LLC v. Jenam Tech, LLC*, IPR2021-00869, Paper 11 at 13 (PTAB Nov. 9, 2021) (granting two petitions with 14 claims total given the length of the claims and the differences in subject matter recited in the claims); *Samsung Elecs. Co. v. Staton Techiya, LLC*, IPR2022-00243, Paper 15 at 21 (PTAB Jun. 21, 2022) (holding “it 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”).

### **C. The Challenged Claims Are Unusually Lengthy**

Challenged Claims 1-27 are unusually long, totaling 1,919 words. Claim 20 is 419 words, while claim 1 is 254 words and claim 11 is 281 words. The length of the claims alone warrants two Petitions. *Meta Platforms, Inc. v. Thales Visionix, Inc.*, IPR2022-01303, Paper 11 at 19 (PTAB Mar. 13, 2023) (noting Patent Owner asserted a “large number of claims” in the parallel litigation “that are distinct from

one another, that collectively comprise several thousand words of claim language”); *Google*, Paper 11 at 13 (granting two petitions with a total of 14 claims given the length of the claims and the differences in subject matter recited in the claims).

**D. Petition One and Petition Two Have Different Challenged Claims**

There is no overlap in claims between Petition One (claims 1-19) and Petition Two (claims 20-27), which justifies two Petitions. *Micron*, Paper 15 at 9 (“The lack of overlapping claims between the petitions weighs in favor of instituting two Petitions”); *Exactech, Inc. v. ORTHOsoft ULC*, IPR2022-00837, Paper 6 at 4 (PTAB Nov. 8, 2022) (“[B]ecause the petitions challenged two different sets of claims...we decide both cases on the merits.”).

**E. Petitioner Raised a Priority Argument Regarding Claim 26**

Claim 26 lacks written description. Petitioner raises two grounds of unpatentability in Petition Two, with a first ground applying art predating the Feb. 26, 2010 priority date that Patent Owner alleges for the ’246 Patent, and a second ground applying art predating the actual priority date (Jan. 19, 2022) for claim 26. Once the lack of written description detailed by Petitioner is considered, the actual priority date becomes clear. This necessitates two Petitions. *Google LLC, et al. v. Carolyn W. Hafeman*, IPR2022-01189, Paper 16 at 8 (PTAB Jan. 31, 2023) (“We find that two petitions are justified here due to the priority date issue”). Claims 5 and 11 (challenged in Petition One) include a similar limitation to claim 26, but given

the sizable length of claims 1-19, Petitioner does not have the word count for also including the priority argument and additional ground for Petition One. Because a claim's priority entails important notice and consistency considerations for evaluation by the PTAB to ensure patentees are fairly protecting their innovation and not overreaching, the Board should evaluate the priority issue for claim 26.

Conducting two Petitions will not stress the Board's resources or unduly burden the Board or Patent Owner. Institution of both petitions is warranted.

## II. RANKING OF PETITIONS AND DISCLOSURE OF GROUNDS

| Rank                  | Grounds/Reference                                                                                                                                                                                                                                                                                                            |
|-----------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2<br>IPR2024-00399(a) | Ground 1 (§ 103): Claims 1, 11-14 ( <b>Kalliola</b> /Turunen/Oswald/Vauclair/Kalayjian)<br>Ground 2 (§ 103): Claims 2-5, 15-18 ( <b>Kalliola</b> /Turunen/Oswald, Vauclair/Kalayjian/Thorn)<br>Ground 3 (§ 103): Claims 6-10, 19 ( <b>Kalliola</b> /Turunen/Oswald/Vauclair/Kalayjian/Thorn/Sharp)                           |
| 1<br>IPR2024-00400(b) | Ground 1 (§ 103): Claims 20, 27 ( <b>Sweeney</b> /Kalliola/Turunen/Mohammadian/Kalayjian/Vauclair)<br>Ground 2 (§ 103): Claims 21-26 ( <b>Sweeney</b> /Kalliola/Turunen/Mohammadian/Kalayjian/Vauclair/Thorn)<br>Ground 3 (§ 103): Claim 26 ( <b>Sweeney</b> /Kalliola/Turunen/Mohammadian/Kalayjian/Vauclair/Thorn/Lopatin) |

Dated: January 19, 2024

Respectfully submitted,

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**CERTIFICATE OF SERVICE ON PATENT OWNER**  
**UNDER 37 C.F.R. § 42.105(a)**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on January 19, 2024, a complete and entire copy of this Petitioner's Ranking and Explanation of Material Differences Between Petitions, and Exhibits, to be served via Federal Express to the following:

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