UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
HP INC., DELL INC., DELL TECHNOLOGIES INC.,
ASUSTEK COMPUTER INC., ASUS GLOBAL PTE. LTD.,
Petitioners

v.

LITL LLC,
Patent Owner.

IPR2024-00455

U.S. Patent No. 9,003,315

PETITIONER'S EXPLANATION FOR AND RANKING OF TWO PETITIONS CHALLENGING U.S. PATENT NO. 9,003,315

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I. INTRODUCTION

Pursuant to the November 2019 Consolidated Trial Practice Guide ("Guide"), Microsoft Corporation, HP Inc., Dell Inc., Dell Technologies Inc., ASUSTeK Computer Inc., and ASUS Global Pte. Ltd. (collectively, "Petitioners") provide this explanation of multiple petitions challenging U.S. Patent No. 9,003,315 (the "'315 patent"). The '315 patent contains 57 total claims, and in the co-pending litigation, LiTL LLC ("PO") has not yet provided infringement contentions.[1] Petitioners have attempted to narrow the '315 claims that could be at issue in the parties' dispute, but still determined the need to challenge 35 total claims. These claims include numerous dependent claims with different scope that required different prior art to address.

Accordingly, Petitioners present two petitions to address the large number of challenged claims, including lengthy independent claims and numerous claims of materially different scope. In the second-ranked petition (IPR2024-00455), Petitioners challenge non-overlapping dependent claims 26, 29-33, 36-42, and 52, with overlap between the two petitions only to address dependency of those non-overlapping claims (presenting the same ground as the first-ranked petition (IPR2024-00454)).

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[1] *See* EX-1016, 1017, 1018, 1020.

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

Each of the petitions is materially distinguishable from the other by virtue of challenging a unique claim set. The petition in IPR2024-00454 challenges claims 1–5, 7–13, 16, 18, 23, 24, 27, 28, 53–57 (23 total). The petition in IPR2024-00455 challenges claims 1, 23, 24, 26, 28–33, 36–42, 52 (18 total). The only overlapping claims in these petitions are claims 1, 23, 24, and 28 by virtue of the need to address these claims to challenge their dependents. The petition in IPR2024-00454 relies on a prior art reference, Preppernau (EX-1008), to challenge the 19 dependent claims in that petition. Preppernau is not relied upon in the petition in IPR2024-00455, and instead that petition relies on two additional references, Pröll (EX-1006) and Lane (EX-1014), to challenge the 14 non-overlapping dependent claims in that petition.

As noted above, PO has not yet identified asserted claims in the co-pending litigation, making it difficult for Petitioners to further narrow the challenged claims, so that they could be challenged in a single petition. Despite Petitioners' efforts, Petitioners require two petitions because of the length of the claims and varying scope requiring different combinations of references to address.

In addition, both petitions provide explanations why the Board should not exercise its discretion to deny institution under *Fintiv*, *General Plastic*, and Section 325(d), as well as prior history involving other patents assigned to LiTL

and "component" limitations requiring means-plus function analysis, 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. Consolidated Trial Practice Guide ("CTPG"), 59 ("[T]here 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."). Petitioners have filed the second-ranked petition due to the word count limit for petitions, the number of asserted claims, and the need to address each challenged claim in sufficient detail. The second-ranked petition is not submitted to present additional grounds of challenge or invalidity theories for the same claims addressed in first petition.

Beyond the CTPG, additional factors support institution of Petitioners' 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. Additionally, Petitioners' use the same expert witness (Dr. Henry Houh) to support both petitions, meaning a single deposition should be sufficient.

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 because

they challenge unique claim sets (other than overlap necessary to address the independent claims that provide the basis for non-overlapping dependent claims challenged in the second-ranked petition). In view of the guidance in the CTPG (CTPG, 60), Petitioners request that the Board consider the petitions in the following order.

Order	IPR Case No.	Challenged Claims
1	IPR2024-00454	1–5, 7–13, 16, 18, 23, 24, 27, 28, 53–57
2	IPR2024-00455	1, 23, 24, 26, 28–33, 36–42, 52

II. CONCLUSION

Petitioners request that the Board grant institution for both petitions.

Respectfully submitted,

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