UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

LITL LLC
Patent Owner

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Case IPR2024-00481
Patent No. 9,563,229

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PETITIONERS' NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS

Petitioners are filing two concurrent petitions challenging the patentability of claims of U.S. Patent No. 9,563,229 (the "'229 Patent"):

- Petition 1 challenges independent claim 1 and most of the dependent claims that depend directly or indirectly from claim 1 (i.e., claims 2-11, 19-21, and 23-25); and
- Petition 2 challenges independent claims 12, 16, and 18 and certain dependent claims that depend from those claims (i.e., claims 14 and 17).

There is no overlap in challenged claims between the two petitions (i.e., each challenged claim is addressed in one petition or the other; none are addressed in both). Petitioners submit two petitions here solely because they are unable to adequately address all challenged claims in a single petition within the applicable word limit.

Petitioners submit this paper, pursuant to the Board's November 2019 Consolidated Trial Practice Guide ("TPG"), in order 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 if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)." TPG, 60.

I. RANKING OF PETITIONS

Petitioners believe that both petitions are meritorious and justified, especially because (as explained further below) both petitions are necessary to address all the claims that Patent Owner may assert in related district court litigation. Nonetheless, as required by the TPG, Petitioners provide the following ranking:

Rank	Petition/PTAB Case No.	Challenged Claims
1	Petition 1/IPR2024-00480	1-11, 19-21, 23-25
2	Petition 2/IPR2024-00481	12, 14, 16-18

II. MATERIAL DIFFERENCES REQUIRING MULTIPLE PETITIONS

The key difference between the two petitions is that Petition 1 addresses most of the challenged claims, and Petition 2 addresses the rest of the challenged claims. No claims are addressed in both petitions. Petitioners submit that institution of both petitions against the ’229 Patent is warranted due to word limit constraints caused by the arguments necessary to address all the challenged claims.

Patent Owner has not yet been required in the related district court litigation to identify the claims of the ’229 Patent that it contends are infringed by each of the Petitioners. Therefore, Petitioners had no reasonable option but to challenge all the claims that could potentially be asserted in the related litigation. The

alternative would be to inefficiently challenge some claims in an IPR proceeding while the same and additional claims are asserted in the district court.

Petition 1 addresses independent claim 1 and most of its dependent claims. As the petition explains, claim 1 is unpatentable as obvious based on Lane (EX1005) combined with Fujinawa (EX1007). Most of the dependent claims are unpatentable based on the same combination, but several dependent claims require a third reference (i.e., Pröll (EX1010) or Santoro (EX1011)). The petition also includes alternative grounds of unpatentability based on adding one or both of two additional prior art references (i.e., MIT (EX1048) or Wehrenberg (EX1023)) to each combination depending on how the challenged claims are construed.

Petition 2 addresses different claims that are not addressed in Petition 1. While Petition 1 addresses independent claim 1, Petition 2 addresses the other three independent claims (i.e., claims 12, 16, and 18). Claim 18 is similar to claim 1, but both claims 12 and 16 include substantially different limitations. As explained in Petition 2, claim 12 is unpatentable based on the combination of Lane and Fujinawa. Many of claim 12's limitations require detailed explanation; most cannot be addressed by simply citing to the same limitation in claim 18 (or claim 1). Claim 16 is even more different from the other independent claims—it is unpatentable based on the combination of Lane with a different prior art reference (i.e., Tonouchi (EX1008)). Claims 12 and 16 require an element-by-element

analysis with limited opportunity to streamline by simply referring back to prior discussion regarding another claim. Even limiting the focus to just those two independent claims (and their two challenged dependent claims), the analysis in Petition 2 requires nearly 4,500 words. Petitioners could not have included that analysis in Petition 1, which is near the word limit as is (i.e., 13,997 words).

Petitioners made every reasonable effort to shorten Petition 1 to include additional claims. For example, Petitioners deleted the language of the dependent claims from the headers of each section addressing them. (The language of every claim is provided in an appendix attached to each petition.) Petitioners did not delete the language of the independent claims, however, as they make the analysis of those claims easier for the Board to follow. In any event, omitting the 360 words of claim 1 from the headings in Petition 1 would not have enabled combining the petitions within the word limit.

For these reasons, Petitioners respectfully request institution of both their concurrently filed IPR petitions against the ’229 patent.

Respectfully submitted,

/James L. Day/
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Lead Counsel for Petitioners

CERTIFICATE OF SERVICE

I hereby certify that on January 29, 2024, the foregoing document entitled Petitioners' Notice Ranking Petitions and Explaining Material Differences Between Petitions was served on Patent Owner's counsel via email, as agreed to by Patent Owner, at the following addresses:

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