UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

INTERDIGITAL PATENT HOLDINGS, INC.,
Patent Owner.

IPR2024-00538
U.S. Patent No. 9,173,054
Issued: October 27, 2015
Application No. 14/251,383
Filed: April 11, 2014

Title: DATA TRANSFER BETWEEN WIRELESS DEVICES

PETITIONER'S NOTICE OF RANKING PETITIONS

Petitioner Microsoft Corporation has filed two petitions for *inter partes* review of claims 1, 3-10, 12, 14-15, 21, 23, 25-32, 34, 36-37, 43, 46-47, 49-50 (the "challenged claims") of U.S. Patent No. 9,173,054 (the "'054 patent"). These two materially distinct, non-cumulative petitions address a priority dispute regarding the effective filing date of the challenged claims. **Petition 1 (IPR2024-00306)** shows that the challenged claims were obvious even if entitled to Patent Owner's earliest alleged effective filing date of December 23, 2008. **Petition 2 (IPR2024-00538)** shows why the challenged claims lack written description support in any ancestor applications and thus the earliest possible effective filing date is June 28, 2013. Petition 2 further shows how, under that proper effective filing date, a single prior art reference (Forutanpour, EX1204) either anticipates or renders obvious each challenged claim.

Pursuant to the November 2019 Consolidated Trial Practice Guide ("TPG"), Petitioner submits this explanation of why the Board should institute on both petitions. *See* TPG, 59-60. While Petitioner submits that both petitions should be instituted, it **ranks Petition 1 first and Petition 2 second**.

I. DIFFERENCES BETWEEN THE TWO PETITIONS

While each petition challenges the same claims of the '054 patent, they do so under materially different grounds of unpatentability—one relying on obviousness assuming Patent Owner's earliest alleged effective filing date and the other

presenting a reference that anticipates most claims and is prior art because Patent Owner will be unable to show entitlement to an earlier priority date.

The following table compares the grounds presented in the two petitions:

Petition	Ground	Claims	Prior Art
Petition 1 (IPR2024-00306)	1 (§ 103)	1, 3-10, 12, 14-15, 21, 23, 25-32, 34, 36-37, 43, 46-47, 49-50	Ahya and McKillop
	2 (§ 103)	"	Ahya, McKillop, and Turner
	3 (§ 103)	"	Hoddie and Hinckley
Petition 2 (IPR2024-00538)	1 (§ 102)	1, 4-9, 12, 14-15, 21, 23, 26-31, 34, 36-37, 43, 46-47, 49-50	Forutanpour
	2 (§ 103)	1, 3-10, 12, 14-15, 21, 23, 25-32, 34, 36-37, 43, 46-47, 49-50	Forutanpour
	3 (§ 103)	3, 25	Forutanpour and Hinckley
	4 (§ 103)	12, 34	Forutanpour and Hoddie
	5 (§ 103)	10, 32	Forutanpour and Heinonen

Petition 1 presents two sets of obviousness grounds, one with primary reference Ahya (EX1004) and another with primary reference Hoddie (EX1006), and assumes the claims are entitled to Patent Owner's alleged effective filing date of December 23, 2008. Petition 1 does not challenge the written description support of the ancestor applications.

Petition 2 presents an anticipation ground that shows how a single prior art reference, Forutanpour (EX1204), either anticipates or renders obvious all challenged claims. It further shows why Patent Owner cannot backdate its claims

prior to June 28, 2013, because the claimed method combining Bluetooth detection and WiFi transfer lacks Section 112 support in the ancestor applications, as required by Section 120 in order to establish priority. While Petition 2 presents fallback grounds that rely on two secondary references also presented in Petition 1, there is otherwise no overlap in grounds or repetition of argument between the two petitions.

II. THE ISSUES ADDRESSED BY THE DIFFERENCES ARE MATERIAL AND WARRANT INSTITUTION OF BOTH PETITIONS

The priority dispute addressed by the differences is material because nothing suggests that the named inventors possessed the alleged invention prior to claim amendments filed in November 2013. The challenged claims should thus face the anticipatory Forutanpour-based grounds and should not be allowed to benefit from Patent Owner's belated and hindsight-driven amendments. Institution of the second Petition is warranted because it would allow the Board to address the proper effective filing date for the challenged claims and to apply materially different prior art.

The Board has found that a "potential priority dispute between the two parties justifies institution of [] two petitions." *Apple Inc. v. Sonrai Mem. Ltd.*, IPR2023-00975, Paper 9 at 14 (PTAB Dec. 14, 2023) (noting that the TPG "provides that a 'patent owner may seek to avoid additional petitions by proffering a stipulation'") (citing TPG, 61); *see also* TPG, 59 ("a dispute about priority date" may warrant institution on multiple petitions). When such disputes exist, "it is not unreasonable

for Petitioner to present separate challenges, one of which relies on references that are prior art only if the challenged claims are not entitled to Patent Owner's claimed priority date, which has yet to be finally determined." *BJ'S Whlsle. Club Holdings, Inc., v. Walmart Apollo, LLC*, IPR2022-01564, Paper 9 at 46 (PTAB April 11, 2023); *Medtronic*, *Inc. v. Teleflex Innovations S.A.R.L.*, IPR2020-00136, Paper 20 at 39 (PTAB June 26, 2020) (a priority dispute is "precisely one of the circumstances … in which more than one petition may be necessary"). While such circumstances may be infrequent, the facts in the present case warrant granting both petitions challenging the '054 patent. *See, e.g., 10X Genomics*, *Inc. v. Bio-Rad Labs.*, *Inc.*, IPR2020-00088, Paper 8 at 47 (PTAB Apr. 27, 2020) (granting institution of two parallel petitions where one petition presented a priority date dispute).

The Board should institute both petitions even if the Board identifies one petition that satisfies the requirements of 35 U.S.C. § 314(a). While Petition 1 presents strong obviousness arguments, Petition 2's Forutanpour reference is indisputably stronger than any of the Petition 1 references because it anticipates most challenged claims. But Patent Owner will surely attempt to antedate that stronger prior art and if only Petition 2 were instituted and Patent Owner unexpectedly prevailed on the priority issue, then Petitioner would be left without grounds based on the earlier priority date.

Similarly, if only Petition 1 were instituted and Patent Owner prevailed on some unforeseen issue that impacted the obviousness grounds, then Petitioner would be left without the stronger grounds presented in Petition 2 and Patent Owner would unfairly escape review of its claims under the proper, later priority date.

Here, Petition 2 presents a simple, compelling, and focused priority date argument. The merits of that argument further warrant a proceeding on the Petition 2 grounds in addition to the Petition 1 grounds. This will allow the Board to fulfill its mission "to improve patent quality and restore confidence in the presumption of validity that comes with issued patents." *Code200, UAB v. Bright Data Ltd.*, IPR2022-00861, Paper 18 at 6 (PTAB Aug. 23, 2022). Public interest and efficiency concerns call for resolution of these unpatentability issues all in one forum.

Given the large number of asserted claims (30), which alone total more than 850 words, it was not practicable to present all of these grounds in a single petition. To present the priority dispute and associated grounds, without any other portions of Petition 2, required over 8,000 words. Even if presented alongside just one of the sets of obviousness grounds from Petition 1, there would have been inadequate words in a single petition, especially given the need for other sections such as an introduction, summary of grounds, and explanation of the state of the art and a POSITA. Thus, two petitions were required, and institution of both petitions is warranted.

Respectfully submitted,

Dated: February 9, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that **PETITIONER'S NOTICE OF RANKING PETITIONS** was served on February 9, 2024, via **Express Mail** on the Patent Owner at the following address of record as listed on the USPTO Patent Center:

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