

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MPL BRANDS NV, INC.

Petitioner,

v.

BUZZBALLZ, LLC

Patent Owner.

PTAB Case No. IPR2024-01000

U.S. Patent No. 11,932,441

PETITIONER'S STATEMENT REGARDING MULTIPLE PETITIONS

I. INTRODUCTION

Petitioner MPL Brands NV, Inc. (“Petitioner”) has filed two petitions for review of claims 1-20 of U.S. Patent No. 11,932,441 (“’441 patent”): (1) a petition for post-grant review (PGR2024-00035, the “PGR Petition”), and (2) a petition for *inter partes* review (IPR2024-01000, the “IPR Petition”) should the Board find the ’441 patent is not an AIA patent. Petitioner respectfully submits this paper to identify (A) a “ranking of the petitions in the order in which [the petitioner] wishes the Board to consider the merits” and (B) “a succinct explanation of the differences between the petitions” and why they are “material.” *See* Consolidated Trial Practice Guide (Nov. 2019) at 59-61, available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

II. BACKGROUND

The ’441 patent issued on March 19, 2024, less than 9 months before these petitions are filed. As a result, whether Petitioner may respectively challenge the patentability of the ’441 patent in post-grant review or *inter partes* review depends on whether the ’441 patent is an AIA patent. *See* 35 U.S.C. §§ 311(c), 321(c) (AIA); Pub. L. 112–274, § 1(d)(2).

As discussed in Section IV of the PGR petition, Petitioner believes the ’441 patent is an AIA patent because (1) it claims priority to an AIA patent

application and (2) at least one original claim that was at issue during prosecution is an AIA claim.

As discussed in the Section IV of the IPR petition, Patent Owner did not identify the '441 patent as an AIA patent at the time of its filing, and the examiner indicated that the '441 patent was examined under the pre-AIA provisions. In view of the possibility that Patent Owner disputes that the '441 patent is an AIA patent, and the Board concludes that the '441 patent is a pre-AIA patent, Petitioner has filed concurrent PGR and IPR Petitions. The two petitions challenge the same claims based on the same two obviousness grounds. The PGR Petition advances additional obviousness arguments based on a prior art product. As explained below, Petitioner submits that the Board should grant one of the two petitions depending on its determination of whether the '441 patent is an AIA patent or not.

III. NECESSITY OF MULTIPLE PETITIONS

Two petitions are necessary to ensure that Petitioner's patentability challenges are heard by the Board in a timely manner regardless of whether the '441 patent is or is not an AIA patent. Because the two petitions have substantial overlap in their invalidity arguments, and only one would need to be instituted

depending upon the Board’s AIA-status determination,¹ they create no “substantial and unnecessary burden on the Board and the patent owner” or create any “fairness, timing, and efficiency concerns.” *See Consolidated Trial Practice Guide* (Nov. 2019) at 59. Indeed, the Practice Guide expressly contemplates the need for multiple petitions “when there is a dispute about priority date.” *Id.* That is precisely the case here.

A. Ranking

(1) The Board should institute trial in PGR2024-00035 if it determines that the ’441 patent is an AIA patent. Because Petitioner believes the ’441 patent is an AIA patent, Petitioner requests that the Board institute post-grant review in PGR2024-00035, and accordingly moot *inter partes* review in IPR2024-01000.

(2) Alternatively, if the Board determines that the ’441 patent is not an AIA patent and thus denies the petition in PGR2024-00035 on the

¹ Because the ’441 patent would not be eligible for simultaneous post-grant review and *inter partes* review proceedings, the Board need not institute review in both proceedings. *See Philip Morris Products, S.A. v. Rai Strategic Holdings, Inc.*, IPR2020-01188, Paper 12 at 10-12 (PTAB Jan. 13, 2021) (denying an IPR when a corresponding PGR was instituted).

ground that the '441 patent is ineligible for post-grant review,
Petitioner requests that the Board institute *inter partes* review in
IPR2024-01000.

B. Differences Between Petitions

The two petitions advance the same 35 U.S.C. § 103 invalidity grounds
against the same challenged claims of the '441 patent based on prior art patents.

The PGR Petition additionally challenges the patentability of all claims as
obvious over a prior art product.

IV. CONCLUSION

For these reasons, the Board should institute post-grant review in
PGR2024-00035 if it determines the '441 patent is an AIA patent. Otherwise, the
Board should institute *inter partes* review in IPR2024-01000.

Dated: June 7, 2024

Respectfully submitted,

/Babak Tehranchi/

PERKINS COIE LLP
11452 El Camino Real, Suite 300
San Diego, CA 92130
Telephone: (858) 720-5700
Fax: (858) 720-5834

Lead Counsel
Babak Tehranchi, Reg. No. 55,937

Back-up Counsel
M. Craig Tyler, Reg. No. 41,519
Daniel T. Shvodian, Reg. No. 42,148
Kristen Schunter, Reg. No. 76,519
R. Tyler Kendrick, Reg. No. 73,930
Andrew Kalamarides, *pro hac vice* to be
submitted

Attorneys for Petitioner
MPL Brands NV, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing **PETITIONER'S STATEMENT REGARDING MULTIPLE PETITIONS** have been served this 7th day of June, 2024, by FedEx® mail delivery service on Patent Owner at the correspondence address for the attorney of record for the '441 patent shown in USPTO Patent Center:

Haynes and Boone, LLP
IP Section
2801 N. Harwood St., Suite 2300
Dallas, TX 75201

A courtesy electronic service copy is also being sent to the following counsel in the related litigation:

Jason Whitney - Jason.Whitney@haynesboone.com
Jason Bloom - Jason.Bloom@haynesboone.com

Dated: June 7, 2024

/ Anita Chou /
Anita Chou
Paralegal