UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
Petitioner

v.

KOVE IO, INC.,
Patent Owner

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Cases IPR2024-01018
U.S. Patent No. 7,103,640

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PATENT OWNER'S RESPONSE TO PETITIONER'S NOTICE REGARDING MULTIPLE PETITIONS

Patent Owner Kove IO, Inc. submits this response to Petitioner Google LLC's Notice Regarding Multiple Petitions ("Notice") in IPR2024-01017 and -01018. For the reasons discussed below, the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution of one of the two parallel petitions.

The Patent Trial and Appeal Board Consolidated Trial Practice Guide states that "based on prior experience, the Board finds it unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate." CTPG at 59. This principle is grounded in concerns about efficiency and fairness in proceedings before the Board. The Guide further explains that "[t]wo or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns." *Id.* at 59-60. Such circumstances warranting multiple petitions "should be rare." *Id.* at 59. Contrary to Petitioner's assertions, the present situation is not one of those rare circumstances.

First, the substantial overlap in both petitions underscores the lack of justification for filing two petitions. The petitions challenge the exact same claims (claims 10-24) of the '640 patent. Notice, 1. The number of alternative challenges is also limited. IPR2024-01017 has two grounds (Kahn anticipating and obviousness by Kahn in view of Vingralek), and IPR2024-01018 contains only one ground (Skagerwall in view of Vingralek). Taken together, there are only three alternative

challenges involving the same secondary reference (Vingralek) to each claim. Therefore, this is not an example of the kind of "rare" circumstance that could justify multiple petitions.

The Board has denied institution under similar circumstances. In *Whatfix Inc. v. Walkme Ltd.*, for example, the Board denied institution of a second petition that challenged substantially the same claims as the first petition, finding no justification for the second petition:

> Petitioner does not persuasively explain in its Ranking why these arguments could not have been provided in a single petition. It is difficult to reconcile Petitioner's arguments that two petitions were necessary when Petitioner has asserted *three* alternative challenges against *nineteen* of the challenged claims in the -01368 petition.

IPR2023-01443, Paper 11 at 13-14 (P.T.A.B. March 20, 2024). Similarly, here, Petitioner has failed to adequately explain why the Kahn and Skagerwall grounds could not have been raised in a single petition, especially given the complete overlap in challenged claims and the small number of alternative challenges.

Second, Petitioner's arguments regarding the number of asserted claims and alleged priority date dispute do not justify multiple petitions. Petitioner argues that Patent Owner asserted 46 claims across multiple patents in litigation, but only 13 claims were asserted from the '640 patent. *See* Notice, 2. Challenging 13 asserted

claims (and two more that were not asserted) does not warrant two petitions, particularly when the claims themselves contain overlapping limitations. *See, e.g.*, *Affordable Wire Mgmt., LLC v. Cambria Cty. Ass'n for the Blind & Handicapped, Inc.*, IPR2024-00182, Paper 18 at 25 (PTAB Apr. 24, 2024) (finding no justification for the second petition denying institution where two petitions challenged substantially the same claims). Here, the challenged independent claims 10, 17, and 18 all recite the same concepts of a data location server network/servers that handle location queries/requests and provide redirect messages, employing similar claim language. *See* '640 pat. (Ex. 1001), cl. 10, 17, 18.

Third, Petitioner's alleged priority date dispute regarding Skagerwall's status as prior art introduces an issue that is not genuinely contested and does not justify splitting the petitions. Petitioner spends fewer than 3 pages in the Skagerwall-based Petition on its argument that the '640 patent claims are not supported by one of its priority applications. *See* IPR2024-01018 Pet., 4-6.[1] That limited discussion does

[1] Petitioner notes that Kove does not contend that the claims at issue are supported by the earlier provisional application in other proceedings, including the Google litigation. -01018 Pet., 5, n.3. The Petition also does not present any expert evidence on this issue—despite its factual and technical nature. All further suggesting that Petitioner has split its petitions for tactical rather than substantive reasons.

not warrant Petitioner doubling its effective word count to raise two alternative challenges to each patent claim.

Furthermore, allowing these duplicative petitions would waste the Board's finite resources. Petitioner's attempt to justify the petitions based on the "material differences in the prior art" (Notice, 4-5) is undermined by the substantial overlap in the challenged claims and Petitioner's reliance on the same secondary reference (Vingralek) in both petitions. As an initial matter, the Notice provides examples of "material differences" that only relate to the "redirect message" aspect of only one limitation of three claims (cl. 10, 17, and 18), each occurring in the same context and with nearly identical language. Notice, 4. Petitioner's explanation of why it needed to raise different theories against "redirect message" also seems to be based on weaknesses in its validity case. *Id.* (stating differences between Kahn's and Skagerwall's architectures). Petitioner should be able to identify its best grounds rather than throw all it can at the Board with the hope that something sticks.

Petitioner also complains about having to make its case within the Board's word limit (Notice, 2), but, besides prioritizing its best case for invalidity, Petitioner could have saved space by, for example, not duplicating its contentions regarding the technology of the '640 patent, claim construction, and the priority date; or its argument that Vingralek is prior art to the '640 patent. Splitting the petitions forces Kove to duplicate parts of its responses, further compounding the inefficiency.

Finally, Petitioner's inconsistent ranking of the Skagerwall and Kahn references across the '640 and '170 patents appears to be a tactical ploy to game the system. For the '640 patent, Petitioner ranks Kahn first and Skagerwall second; for the '170 patent, Petitioner flips the order. *See* Notice, 1, 4-5. Then, Petitioner argues that both petitions should be instituted, because each primary reference appears in at least one first-ranked challenge. This raises fairness concerns that the Trial Practice Guide warns against, for example, splitting its petitions allows the Petitioner to exceed word limits. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (P.T.A.B. Sept. 6, 2017) (precedential) (cautioning against allowing "petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions").

In sum, Petitioner has not justified the need for two petitions. The complete overlap in challenged claims, the reliance on Vingralek in both petitions, and lack of compelling reason for separate petitions all weigh against institution. As explained in the Preliminary Responses to the petitions, the Petitioner has failed to demonstrate a reasonable likelihood of success on any claim of the '640 patent, and both petitions should be denied. However, even if the Board finds grounds to institute on either petition, it should still exercise its discretion under § 314(a) to deny institution of at least one of them.

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that a copy of the foregoing document was served on, via electronic mail, as agreed to by counsel, upon the following counsel for Petitioner:

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