UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

KOVE IO, INC.,
Patent Owner

Patent No. 7,814,170

PETITIONER'S NOTICE
REGARDING MULTIPLE PETITIONS

I. INTRODUCTION

Petitioner is concurrently filing two petitions challenging U.S. Patent No. 7,814,170 ("the '170 patent"). "To aid the Board in determining" why "more than one petition is necessary," Petitioner provides the information below. *See* PTAB Consolidated Trial Practice Guide ("TPG") (November 2019) at 59-60. As explained below, the Board should not deny either petition on the basis of the filing of multiple petitions, and instead institute both petitions.

II. RANKING

While both petitions are meritorious and justified as explained below, Petitioner requests that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	Skagerwall-based Petition (IPR2024-01020)	1-17	Grounds based on Skagerwall and Skagerwall in combination with Vingralek
2	Kahn-based Petition (IPR2024-01019)	1-17	Ground based on Kahn in combination with Vingralek

III. DIFFERENCES, MATERIALITY, AND REASONS FOR INSTITUTION

Circumstances may arise "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 or when there is a dispute about priority date requiring arguments under multiple prior art references." PTAB Consolidated TPG at 59-60. These are the exact circumstances here.

First, Patent Owner asserts an excessive number of claims in litigation. The Northern District of Illinois's Local Patent Rules require that in the final infringement contentions "no Accused Instrumentality may be accused of infringing more than ten (10) claims per patent and twenty (20) claims overall" (Ex. 1053, 10). Patent Owner previously asserted only 4 claims, but on April 25, 2024 it asserted 46 claims across the '640, '170, and '978 patents, with 13, 15, and 18 claims asserted respectively from each of these patents. By asserting this many claims at this point (Ex. 1055, 1), notwithstanding that it is more than double what Patent Owner will be allowed to proceed with for trial, Patent Owner precludes Petitioner from fully presenting its unpatentability grounds in a single petition complying with the Board's word-count limit.[1]

In addition, each petition is based on only a single primary reference, Kahn or

---

[1] Patent Owner's assertion of excessive number of claims is burdensome (Ex. 1055, 1) and the NDIL court has granted Petitioner's opposed motion to stay discovery pending the court's finding on Petitioner's motion to dismiss (Ex. 1052).

Skagerwall. As such, Petitioner is not proposing an excessive number of grounds between both petitions. Petitioner's filing of multiple petitions here simply ensures an adequate record for the Board in deciding whether to institute review. Given the number of asserted claims, Petitioner could not have adequately briefed the two sets of grounds within a single petition. Because it is Petitioner's burden to establish unpatentability of the challenged claims, the level of detail included in the petitions is appropriate. The Board should not penalize Petitioner for doing so by exercising its discretion to deny either petition. Further, the Board should reject any objection from Kove alleging that defending multiple petitions is burdensome because the vast majority of the challenged claims were asserted by Kove.

Second, there is a priority date issue involved here. As discussed in the petition, none of the claims of the '170 patent are entitled to the filing date of one of the applications to which the '170 patent claims priority. (Kahn-based Pet., 3-4; Skagerwall-based Pet., 4-6.) Against the backdrop of this priority date issue, Petitioner addresses the claims based on two primary references, each in a separate petition, where Kahn qualifies as prior art for all claims regardless of the outcome of the priority challenge, and Skagerwall qualifies as prior art only if Petitioner is correct regarding the priority date. Thus, the Kahn-based petition and the Skagerwall-based petition are materially different at least with respect to the priority date issue.

Third, the Kahn-based petition and the Skagerwall-based petition are materially different with respect to the mapping of the claimed "redirect message." Petitioner presents grounds based on a combination of Skagerwall and Vingralek (Skagerwall-based Pet., 50-59), and on a combination of Kahn and Vingralek (Kahn-based Pet., 45-52), to address the claimed "redirect message." The combinations are materially different. For example, distinguished from the Skagerwall-Vingralek combination, the Kahn-Vingralek combination relies on Kahn's own transmission of a message in combination with Vingralek's teaching to address the claimed "redirect message." (Kahn-based Pet., 45-52.) The combinations are also materially different with respect to the claimed "redirect message" because Kahn involves a three-component arrangement (including a client and two servers) (Kahn-based Pet., 22-25, 45-52), whereas the Skagerwall-Vingralek combination involves a two-component arrangement (including a client and a server) (Skagerwall-based Pet., 50-59).

Lastly, in the IPR2024-01017 and IPR2024-01018 proceedings, where Petitioner challenges claims of the '640 patent, Petitioner ranks the Kahn-based petition before the Skagerwall-based petition. Given the material differences in the prior art described above, Petitioner ranks the petitions differently for the different patents. Thus, if both primary references are at issue in instituted proceedings (e.g., the current proceeding and the '640 patent IPR proceeding), it would not

significantly increase the burden on the Board or Patent Owner to analyze both references for all three patents.

IV. CONCLUSION

For the reasons given above, the Board should institute both petitions.

Respectfully submitted,

Dated: June 28, 2024

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on June 28, 2024, I caused a true and correct copy of the foregoing Petitioner's Notice Regarding Multiple Petitions to be served via express mail on the Patent Owner at the following correspondence address of record as listed on Patent Center:

Reichman Jorgensen Lehman & Feldberg LLP
100 Marine Parkway
Suite 300
Redwood City, CA 94065

A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel at the following addresses:

Christine E Lehman (clehman@reichmanjorgensen.com)
Jaime Francisco Cardenas-Navia (jcardenas-navia@reichmanjorgensen.com)
Gina H Cremon (gcremona@reichmanjorgensen.com)
Khue Hoang (khoang@reichmanjorgensen.com)

Reichman Jorgensen Lehman & Feldberg LLP

Respectfully submitted,

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner