

Filed: June 28, 2024

Filed on behalf of: Aylo Freesites Ltd

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AYLO FREESITES LTD,
Petitioner

v.

WELLCOMEMAT, LLC,
Patent Owner

IPR2024-01101
U.S. Patent No. 8,307,286

**PETITIONER'S NOTICE RANKING PETITIONS FOR *INTER PARTES*
REVIEW OF U.S. PATENT NO. 8,307,286**

I. INTRODUCTION

Aylo Freesites Ltd (“Petitioner”) has filed two petitions for *inter partes* review of U.S. Patent No. 8,307,286 (“the ’286 patent”) (EX1001)—(i) IPR2024-00710 (“-710 Petition”) and (i) the Petition filed herewith, assigned IPR2024-01101 (“-101 Petition”). Petitioner hereby ranks the petitions and explains why two petitions were necessary and why both petitions should be instituted.

II. RANKING OF THE PETITIONS

Petitioner requests the Board consider the petitions in the following order:

Rank	Petition	Primary References	Secondary References	Claims
1	IPR2024-00710	Gupta, Fegan, Kim, Vasilevsky	Gupta, Logan	13-15, 18-20
2	IPR2024-01101	Gupta, Fegan, Kim, Vasilevsky	Gupta, Logan, Sull	17

III. MATERIAL DIFFERENCES BETWEEN PETITIONS

The -710 Petition challenges claims 13-15 and 18-20 of the ’286 patent, while the -101 Petition challenges solely claim 17 (which depends from claim 13). Beyond that, only minimal differences exist.

A comparison of the grounds advanced in each petition is as follows:

Ground #	-710 Petition		-101 Petition	
	Challenged Claims	Basis	Challenged Claim	Basis
1	13-15, 18-20	Anticipation by Gupta	17	Anticipation by Gupta
2	13-15, 18-20	Anticipation by Fegan	17	Obviousness over Fegan and Sull

3	13-15, 18-20	Obviousness over Kim (which incorporates by reference Sull)	17	Obviousness over Kim (which incorporates by reference Sull)
4	13-15, 18-20	Obviousness over Kim and Gupta	17	Obviousness over Kim and Gupta
5	13-15, 18-20	Obviousness over Vasilevsky and Logan	17	Obviousness over Vasilevsky and Logan

Significantly, the -710 Petition and the -101 Petition both rely on the same prior art, including the same primary references. And in establishing unpatentability of claim 17 (which depends on claim 13), the -101 Petition reproduces the same substantive analysis from the -710 Petition for claim 13 for all five grounds. The -101 Petition deviates from the -710 Petition in that it addresses unpatentability of claim 17, but based on the same prior art and, in the case of Grounds 1 and 3-5, based on the same ground. While Ground 2 differs only in its reliance on Sull, Sull is already relied upon in Ground 3 of both petitions as a reference incorporated into Kim.

IV. THE BOARD SHOULD INSTITUTE BOTH PETITIONS

The Board should exercise its discretion to institute both petitions for at least four reasons.

First, Petitioner’s filing of the -101 Petition was only necessitated only by Patent Owner’s (“WellcomeMat”) own belated assertions of ’286 patent claim 17. As background, WellcomeMat sued Petitioner in the Eastern District of Texas

(“EDTX”) asserting the ’286 patent, and served its infringement contentions on March 11, 2024. EX1019. As EDTX Local Patent Rule 3-1(a) requires infringement contentions to identify “[e]ach claim of each patent in suit that is allegedly infringed by each opposing party,” WellcomeMat’s infringement contentions identified claims 13-15 and 18-20. EX1019, EX1020. Relying on WellcomeMat’s identification of asserted claims, Petitioner proceeded to prepare and, just over two weeks later, file the -710 Petition on March 29, 2024.

However on June 10, 2024, WellcomeMat served proposed amendments to its infringement contentions in the EDTX litigation which added—for the first time—an assertion of dependent claim 17. EX1020. While Petitioner believes that the EDTX Court should reject these proposed amendments due to lack of good cause¹ and intends to so challenge the proposed amendments, Petitioner is filing the -101 Petition to ensure the PTAB’s review of claim 17.

Second, the two petitions share no commonality in challenged claims, thus readily distinguishing this situation from the typical circumstance where petition

¹ EDTX Local Patent Rule 3-6(b) permits such amendments to infringement contentions “only by order of the Court, which shall be entered only upon a showing of good cause.”

ranking arises—multiple concurrent petitions presenting multiple challenges on the same claims. The -710 Petition challenges only claims 13-15 and 18-20 while the -101 Petition challenges only claim 17. Claim 17 of the '286 Patent has not been challenged in any prior proceeding at the USPTO.

Third, instituting both petitions will not impose an undue burden on the Board or the parties. The prior art relied on is the same for both petitions. The analysis of independent claim 13 (as presented in the -101 Petition due to claim 17's dependency on claim 13) is substantively identical, and the -101 Petition simply adds an unpatentability analysis for dependent claim 17 using the same prior art as in the -710 Petition. Thus, institution of both petitions incurs at most minimal additional resources for the Board and for the parties.

Fourth, the -101 Petition is being filed (i) less than three months after the filing of the -710 Petition, (ii) on the same day as Patent Owner's Preliminary Response ("POPR") in the -710 IPR² (which Patent Owner filed 12 days early),

² Patent Owner's early-filed -710 POPR had no effect on the -101 Petition. Petitioner had already otherwise finalized the -101 Petition and was preparing for filing. Indeed, the common sections between the -710 Petition and the -101 Petition remain unchanged in substance.

and (iii) less than three weeks after receiving Patent Owner’s notice of its intent to assert claim 17 in the EDTX litigation. Thus, Petitioner has been diligent in reacting to WellcomeMat’s new attempt to assert claim 17, and is not, for example, relying on any developments from the -101 Petition as a “road map” to correct any weaknesses. Moreover, the timing between the two petition filings allows for any necessary alignment of schedules and/or consolidation of the two IPRs upon institution.

For the foregoing reasons, the Board should institute both petitions.

DATED: June 28, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on June 28, 2024 I caused a true and correct copy of this
Petitioner's Notice Ranking Petitions to be served via Federal Express Overnight
to the following address:

Correspondence Address of Record for U.S. Patent No. 8,307,286

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