

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Michael S. Smith
U.S. Patent No.: 10,656,754 Attorney Docket No. 50095-0166IP1
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Title: DEVICES AND METHODS FOR NAVIGATING
BETWEEN USER INTERFACES

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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF UNITED STATES PATENT NO. 10,656,754**

To address the significant number asserted claims in U.S. Patent No. 10,656,754 (the “’754 Patent”), Petitioner is filing herewith seven petitions (IPR2024-01086 and IPR2024-01114 to -01119) (“Petitions”).

I. Ranking of Petitions

The Petitions demonstrate unpatentability of **99 Challenged Claims** using only one single ground. As discussed in § II, multiple petitions are necessary to explain the various relevant aspects of the applied prior art that renders the 99 claims unpatentable. Still, given the juxtaposition of a 14,000 word limit for each petition and recitation by Patent Owner of overlapping subject matter between various Challenged Claims, seven petitions were needed to address the full complement of claims and claim limitations recited by them (and those they depend from). These petitions are meritorious and justified, and yet, Petitioner below abides the requirement for ranking:

Rank	Petition	Asserted Grounds
1	IPR2024-01119	Claim 2: Ahn, Chaudhri ’842 Claims 1, 80-82, 208-216: Ahn, Chaudhri ’842, Shiplacoff
2	IPR2024-01116	Claims 2, 27, 186, 187, 189, 191, 192, 197, 199-204, 225, 230: Ahn, Chaudhri ’842
3	IPR2024-01115	Claims 2, 27, 37, 58, 60-64, 67, 70-79, 223: Ahn, Chaudhri ’842
4	IPR2024-01114	Claims 2, 27-30, 32-36, 38, 40, 42-44, 46, 47, 52, 54, 57, 59: Ahn, Chaudhri ’842
5	IPR2024-01117	Claims 2, 27: Ahn, Chaudhri ’842 25, 65, 66, 83, 88, 90, 94, 95, 101, 104, 109, 110, 117, 122: Ahn, Chaudhri ’842, Hinkley
6	IPR2024-01118	Claims 2: Ahn, Chaudhri ’842

		83, 88, 90, 94, 95: Ahn, Chaudhri '842, Hinkley 80-82: Ahn, Chaudhri '842, Shiplacoff 97-100: Ahn, Chaudhri '842, Hinkley, Shiplacoff
7	IPR2024-01086	Claims 2, 8, 10, 16, 24, 26, 224: Ahn, Chaudhri '842

II. Material Differences Compelling Permitting Multiple Petitions

The Board has routinely recognized that multiple petitions are justified and “necessary” “when the patent owner has asserted a large number of claims in litigation.” Consolidated Trial Practice Guide (November 2019), 59. That is squarely the case here. Patent Owner is asserting 166 of the '754 Patent's 365 claims, and elected to draft claims that are long and that mix and match terms to create different combinations that vary only slightly in substance. APPLE-1001, claims 1, 8, 10, 16, 24-30, 32-38, 43-44, 46-47, 52, 54, 57-83, 85-86, 88, 90, 94-95, 97, 99-101, 104, 108-115, 117-120, 122-127, 130-132, 134, 136-137, 142-148, 150-189, 191-193, 195-221, 223-224, and 232.

The need for multiple petitions is a direct result of Patent Owner's decision to draft 365 verbose claims, with multiple dependencies, and to assert 166 claims of those claims in parallel litigation. Put simply, the nature and relationship of the Challenged Claims demand significant overlap across the petitions. This is borne out by a simple comparison between (1) the 14,000 word limit/petition (imposed by 37 C.F.R. §42.24(a)(1)(i)) and (2) the number of words spent in each petition repeating arguments advanced in other petitions against claims directed to

combinations involving similar features.

To illustrate the point, the '754 Patent includes only three independent claims (1, 2, 225), but the dependencies on at least one of the independent claims necessitate a substantial amount of repeated text across the petitions. Indeed, while Patent Owner does not assert claim 2, nearly all asserted claims depend from at least claim 2, thus requiring Petitioner to repeat arguments advanced for claim 2 across every petition as a prerequisite in presenting any argument for a Challenged Claim that depends from claim 2 (of which there are 96).

To this point, each petition presents an invalidity ground based at least on a combination of Ahn and Chaudhri and challenges independent claim 2 from which nearly all asserted claims depend. As a result, each petition includes identical text for §§ I-V (Conventions of the Petition, Requirements for IPR, The '754 Patent, Level of Ordinary Skill, Claim Construction) and § VII (Analysis on Discretion) and further includes identical text in § VI as it relates to Ahn, Chaudhri '842, the combination of Ahn and Chaudhri '842, and the application of the combination of Ahn and Chaudhri '842 to claim 2. This text alone requires approximately **8,350** words. Indeed, these approximately 8,350 words only lay the foundation for Petitioner's challenge for a petition and cover no actual Challenged Claim. And, as a result, Petitioner is left with only about 5,650 words per petition with which to present any invalidity arguments specifically directed to any Challenged Claims.

In addition to the need to address unasserted claim 2 because of the claims' dependency on that claim, the asserted claims also include multiple dependencies, further increasing the amount of overlap and repeated text across the petitions. Indeed, of the Challenged Claims, 80 dependent claims include multiple dependencies.

For example, Petitioner's analysis of claim 27 is repeated across five petitions. This repeated text (approximately 150 words) is necessitated by 44 Challenged Claims that each depend on claim 27 (recall, itself a dependent of claim 2). Even where multiple dependencies are not explicit in a claim's preamble, Patent Owner's practice of mixing and matching claim elements across the claims of the '754 Patent further necessitate repeated language across the petitions. For example, 10 asserted claims depend on claim 186, but its individual features are recited in numerous other claims. As a consequence of this claiming practice, Petitioner's analysis of element [186.a] is shared in three petitions (approximately 240 words), Petitioner's analysis of element [186.b] is shared in four petitions (approximately 160 words), Petitioner's analysis of element [186.c] is shared in three petitions (approximately 140 words), Petitioner's analysis of element [186.d] is shared in two petitions (approximately 360 words), Petitioner's analysis of element [186.e] is shared in two petitions (approximately 520 words), Petitioner's analysis of element [186.f] is shared in five petitions (approximately 590 words), Petitioner's analysis of element [186.g] is

shared in at least three petitions (approximately 240 words)

Moreover, the merits of the petitions justify institution of all petitions. The prior art combinations presented in the petitions are strong and straightforward. As laid out above, the petitions present substantially overlapping material, as necessitated by Patent Owner's claiming practice and assertion of 166 claims. Efficiencies and public policy concerns warrant PTAB consideration of all petitions.

Finally, Petitioner's filings are not abusive. Rather, Petitioner merely requests an opportunity to present its invalidity arguments. Given the number of claims Patent Owner is asserting in the co-pending litigation, instituting multiple petitions is warranted. To ensure Petitioner is afforded a fair and complete opportunity to challenge Patent Owner's asserted claims, Petitioner respectfully requests institution of all seven petitions to prevent the unjust result of otherwise strong invalidity grounds being dismissed for procedural reasons. In addition, Petitioner requests consolidation of the proceedings, as permitted by 35 U.S.C. §§ 315(d) and 325(d), given the substantial overlap across the proceedings and to simplify the complexity of the proceedings. The goals of discretionary denial are not served by denial here.

For at least these reasons, Petitioner requests that the Board institute trial on all petitions.

Respectfully submitted,

Dated: June 28, 2024

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