

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HARTMANN US INC. and THE HAPPY GROUP INC.
Petitioners

v.

MAURICE J.P. TABONE
Patent Owner

IPR2024-01215
IPR2024-01216
U.S. Patent No. 11,225,365

**PETITIONERS' RANKING OF PETITIONS AND
EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS**

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Hartmann US, Inc. and The Happy Group Inc. (“Petitioners”) filed two petitions challenging different, non-overlapping claims of U.S. 11,225,365 (“the ’365 patent”). Petitioners provide the information below “[t]o aid the Board in determining” why “more than one petition is necessary.” Consolidated Trial Practice Guide (“CTPG”) (Nov. 2019) at 59-60. The Board should institute both petitions.

I. RANKING OF PETITIONS

The ’365 patent includes four independent claims—claims 1, 11, 14, and 28—and numerous claims depending from each independent claim. Each petition groups the claims and addresses different, non-overlapping claim sets. As demonstrated by each petition, the grounds are meritorious and justified. In accordance with the CTPG, Petitioners request that the Board consider the petitions in the following order:

Rank	Petition	Challenged Claims	Grounds
1	IPR2024-01215 First Petition	1-10 & 28-30	Ground 1: Claims 1-6 & 8-10 are obvious over Post, Beese, and Mangla Ground 2: Claim 7 is obvious over Post, Beese, Mangla, and Buckley Ground 3: Claims 28-30 are obvious over Post and Beese
2	IPR2024-01216 Second Petition	11-27	Ground 1: Claims 11-21 & 23-27 are obvious over Post, Beese, and Mangla Ground 2: Claim 22 is obvious over Post, Beese, Mangla, and Buckley

II. EXPLANATION OF MATERIAL DIFFERENCES AND REASONS FOR INSTITUTION OF MULTIPLE PETITIONS

The Board recognized that “there may be circumstances in which more than one petition may be necessary.” CTPG at 59-60. That circumstance is present here:

- The First Petition challenges independent claims 1 and 28 and all associated dependent claims. Claim 1 is more than one column long (’365 patent, 8:8-9:15), and claim 28 is nearly one column long (’365 patent, 16:1-56).
- The Second Petition challenges independent claims 11 and 14 and all associated dependent claims. Claim 11 is nearly two columns long (’365 patent, 9:63-11:52), and claim 14 is more than two-and-a-half columns long (’365 patent, 12:4-14:42).

First, while the challenged claims have some similar limitations, the bulk of the claim groups in the First and Second Petitions recite unique elements, each of which must be addressed in full to show unpatentability. Indeed, just the language of claims 1-10 and 18-20 challenged in the First Petition alone is 1,491 words and claims 11-27 challenged in the Second Petition alone is 3,211 words. The considerable length of the challenged claims makes presenting the asserted obviousness grounds in a single petition impractical. Thus, institution of both the First and Second Petitions is warranted and consistent with the Board’s decisions in other cases. *See, e.g., Flex Logix Techs., Inc. v. Venkat Konda*, IPR2020-00261,

Paper 22 at 24 (PTAB Aug. 3, 2020) (independent claim more than one column long did not weigh in favor of discretionary denial); *Peloton Interactive, Inc. v. Ifit, Inc.*, IPR2022-00030, Paper 12 at 33-34 (PTAB Apr. 22, 2022) (finding “Petitioner’s filing of three petitions to challenge different claims of the ’062 patent...promotes efficiency” where the patent “include[s] five independent claims” that “differ[]...in various, potentially significant ways.”); *Novartis Gene Therapies v. Genzyme Corporation*, IPR2023-01045, Paper 10 at 3 (PTAB Jan. 17, 2024) (instituting multiple petitions where patent included seven independent claims with differing features and scope).

Second, the First Petition uses 13,597 words and the Second Petition uses 13,888 words. While Patent Owner asserted claims 1-23 and 28-30 in a co-pending litigation, the analysis of unasserted claims 24-27 in the Second Petition takes only 364 words. Removing the analysis of the unasserted claims would not permit Petitioners to challenge all the asserted claims in a single petition.

Third, Petitioner filed the First and Second Petitions concurrently and has not sought “a timing advantage that might otherwise occur were the petitions filed serially,” which further supports institution. *Samsung Electronics Col., Ltd. v. Ryan Hardin*, IPR2022-01335, Paper 13, 22-23 (PTAB Feb. 8, 2023) (Institution Decision).

Institution of both petitions would permit Petitioners to challenge all asserted claims, it would not raise concerns of duplicative time and resources, and Petitioners would not oppose consolidation of the two proceedings upon institution.

III. CONCLUSION

The Board should institute trial on both the First and Second Petitions.

Respectfully submitted,

Dated: August 1, 2024
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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. §42.6(e) and 37 C.F.R. §42.105, service was made on Patent Owner as detailed below.

Date of service August 1, 2024

Manner of service FEDERAL EXPRESS

Documents served Petition for *Inter Partes* Review Under 35 U.S.C. §312 and 37 C.F.R. §42.104 of U.S. 11,225,365;

Petitioner's Exhibit List;

Exhibits Ex.1001-Ex.1021; Ex.1024-Ex.1025; and
Ex.1029-Ex.1039, and

Petitioner's Ranking of Petitions and Explanation of
Material Differences Between Petitions.

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