IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HULU, LLC,
Petitioner,

v.

PIRANHA MEDIA DISTRIBUTION, LLC,
Patent Owner.

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Case Nos. IPR2024-01252, IPR2024-01253

U.S. Patent No. 11,463,768

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STATEMENT REGARDING MULTIPLE PETITIONS

Pursuant to the Nov. 2019 Consolidated Trial Practice Guide, Petitioner provides this Paper to rank its petitions for Inter Partes Review of U.S. Patent No. 11,463,768, and identify the differences and reasons justifying multiple petitions.

I. Petitioner requests consideration of the Petitions in the following order:

Rank	Petition	Prior Art	Claims Challenged
1	IPR2024-01252	U.S. Patent No. 7,877,766 ("Wu") U.S. Patent App. Pub. No. 2003/0200128 ("Doherty")	1–3, 5–12, 14–21, 23–25, 27–29, 31–33
2	IPR2024-01253	U.S. Patent App. Pub. No. 2002/0083439 ("Eldering-I") U.S. Patent App. Pub. No. 2003/0149975 ("Eldering-II")	

II. Material Differences and Additional Factors that Support Permitting Multiple Petitions

A. Two Petitions Are Necessary Given the Large Number of Claims

The Consolidated Trial Practice Guide (Nov. 20, 2019) (page 59) recognizes petitioners may be justified in bringing multiple petitions against a single patent "when the patent owner has asserted a large number of claims." Here, two petitions are necessary because of the large number of challenged claims (28). Because the Patent Owner asserts all 28 challenged claims in its Infringement Contentions, these claims are material to the parties' dispute.

The Board has repeatedly found "that about twenty claims constitutes the 'large number' that the CTPG suggests may justify multiple petitions." *Platform Sci., Inc. v. Omnitracs, LLC*, IPR2020-01518, Paper 14 at 17-18 (Apr. 15, 2021). Multiple petitions have been considered reasonable when claims were numerous, lengthy, and complex in subject matter. *Samsung Elecs. Co. v. Hardin*, IPR2022-

01335, Paper 13 at 22 (Feb. 8, 2023) (finding three petitions reasonable given the large number of claims); *ASSA ABLOY AB v. CPC Patent Technologies Pty Ltd.*, IPR2022-01089, Paper 21 at 3-5 (Jan. 3, 2023) (finding two petitions reasonable for voluminous claims). Besides volume of the claims, the Board also considers factors such as "[the claims'] detail and specificity and the nature of the subject matter[.]" *3Shape A/S and 3Shape Inc. v. Align Technology, Inc.*, IPR 2020-01644, Paper 9 at 3-4 (May 11, 2021) (noting that "[w]e agree with Petitioner that the number of claims, their detail and specificity and the nature of the subject matter support multiple [(2)] petitions in this case."); *see also Dolby Labs., Inc., v. Intertrust Techs. Corp.*, IPR2020-01105, Paper 14 at 21 (Jan. 5, 2021) (finding two petitions reasonable "[g]iven the length of the remaining eighteen claims in the [challenged] patent, [and] the complexity of the involved subject matter[.]").

Similar considerations apply here. Multiple petitions are warranted because the challenged claims recite granular details of obtaining, scheduling/rescheduling, and playing advertisements in response to user input and based on rules, with dependent claims directed at a range of scenarios. The claims span about three columns of patent text. Petitions 1 and 2 rely on distinct grounds to each challenge 28 claims, as explained below. Addressing the two grounds in one petition would materially reduce the petition's thoroughness and unduly burden the Board with overly terse analysis that would be more difficult to analyze. Filing two petitions

allows for clearer and more detailed analysis for this volume of claims. This would not be overly burdensome because the petitions each presents only one ground.

B. Two Petitions Are Necessary to Address the Material Differences Between the Petitions and the Complex Subject Matter Involved

The two petitions here present substantively distinct challenges based on a limited number of grounds and references—the kind of circumstances the Board has recognized to warrant more than one petition. *Trend Micro Inc. v. CUPP Computing AS*, IPR2021-01237, Paper 16 at 11-12 (finding the petitioner's approach of "using two different petitions to present substantively distinct challenges" against six claims reasonable); *see also Hanhwa Solutions Corp. and Hanhwa Q Cells USA, Inc., v. Rec Solar PTE. LTD.*, IPR2021-00989, Paper 12 at 9-12 (declining to exercise discretion to deny two petitions presenting different grounds for the same eight claims); *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, IPR2020-00136, Paper 20 at 40 (instituting two petitions presenting different grounds against the same claims).

The material differences between the two petitions warrant granting both. First, Petition 1 presents a ground based on the combination of Wu and Doherty; Petition 2 presents a ground based on the combination of Eldering-I and Eldering-II. The prior art for the petitions do not overlap.

Second, the petitions rely on different prior art disclosures to show obviousness of the challenged claims. As an example, for limitation [1e], Petition 1

relies on Wu's teaching of displaying a sub-advertisement in response to a user input skipping over or fast forwarding through an advertisement and Doherty's teaching of rescheduling advertisements and other items of information in response to a user interrupt. In contrast, Petition 2 relies on Eldering-I's teaching of rescheduling advertisements in a queue for insertion in avails in response to changes to viewing parameters and Eldering-II's teaching of user inputs that change viewing parameters. As another example, for limitation [1f], Petition 1 presents Doherty's teachings about scheduling items of information based on their priority profiles; Petition 2 presents Eldering-I's teachings about scheduling advertisement based on sponsorship models and parameters. The prior art references disclose challenged claim limitations in materially different ways. *See Trend Micro*, Paper 16 at 11.

Third, the two petitions combine prior-art references in different manners. For Petition 1, Wu and Doherty are directed to different media display systems, where Wu focuses on media streaming and Doherty focuses on public media display. The combination applies Doherty's teachings regarding the functionalities of its output compiler and scheduler as well as its priority-based advertisement selection and scheduling with Wu's digital media system. For Petition 2, on the other hand, Eldering-I and Eldering-II have the same first-named inventor and Eldering-II incorporates Eldering-I by reference. The combination applies well-

known user control functionalities such as skipping and fast forwarding taught by Eldering-II to Eldering-I. The different combinations likely give rise to different issues regarding obviousness for the Board's consideration.

This is not a situation where multiple petitions are used to assert an inordinate number of prior art references or permutations thereof. Rather, the two petitions present materially distinct challenges, each presenting one ground based on two references that are "not excessive or duplicative" as explained above. *Medtronic*, Paper 20 at 40. The two petitions are not overly burdensome given that they each present one ground and share introductory sections regarding the '768 patent and technical background. The Board has repeatedly found petitions with two to three groupings of grounds "not unreasonable." *Trend Micro*, Paper 16 at 12 ("[T]wo petitions is enough for Petitioner to clearly lay out three substantively distinct challenges based on three different primary prior-art references, while not overly burdening the Board."); *Hanhwa Solutions*, Paper 12 at 11-12 (finding that "the two parallel petitions are not overly burdensome because the petitions present only five total grounds" and noting overlap between the petitions). Moreover, the Board may further reduce any burden of the two petitions by exercising its authority under 37 C.F.R. §§ 42.1(b), 42.122(a) to consolidate the trials. *See Medtronic*, Paper 20 at 40.

Respectfully submitted,

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Date: August 22, 2024

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 22, 2024, a true and correct copy of the Statement Regarding Multiple Petitions was served on the Patent Owner at the following addresses of record as listed on Patent Center, via Priority Mail Express®:

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The undersigned certifies that a true and correct copy of the Statement Regarding Multiple Petitions was also sent via electronic mail to the attorneys of record for Plaintiff in the concurrent litigation matter:

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