UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC,
Petitioner,

v.

PIRANHA MEDIA DISTRIBUTION, LLC,
Patent Owner.

Case Nos. IPR2024-01252, IPR2024-01253
Patent 11,463,768

PATENT OWNER'S RESPONSE
TO PETITIONER'S STATEMENT REGARDING MULTIPLE PETITIONS

Patent Owner hereby responds to Petitioner's Statement Regarding Multiple Petitions filed with its two petitions challenging the same claims of a single patent. Paper 3. Petitioner has not shown that this is the rare situation in which multiple petitions should be instituted against one patent. Indeed, given that Petitioner also is requesting *ex parte* reexamination of the same independent claims of the same patent as here based on the same primary references as in ***both*** its IPR petitions, ***both*** its IPR petitions should be denied as unnecessarily burdening the Office.

I. These Cases Are Among The "Vast Majority Of Cases" In Which Two Petitions Are Unjustified, And Not The "Rare" Exceptions To The Rule.

As set forth in the Consolidated Trial Practice Guide (emphases added):

> Based on the Board's experience, ***one petition should be sufficient to challenge the claims of a patent in most situations.*** Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C. § 316(b). In addition, ***multiple petitions by a petitioner are not necessary in the vast majority of cases.*** To date, a substantial majority of patents have been challenged with a single petition.

CTPG, 59. This clear guidance is routinely followed to deny parallel petitions by a petitioner against the same claims of one patent. *See, e.g.*, *Apple Inc. v. SEVEN Networks, LLC*, IPR2020-00254, Paper 13 (July 28, 2020) (denying one of two petitions each challenging 50 claims); *Nalox-1 Pharms., LLC, v. Opiant Pharms.*,

IPR2019-00689, Paper 11, 6-12 (Sep. 9, 2019) (denying two of three petitions challenging 45 claims). The two petitions here, IPR2024-01252 & IPR2024-01253, fall easily into this commonly-encountered category. Petitioner has shown no reason why its petitions fall within any "rare" exceptions to the general rule.

II. Neither Of The Practice Guide's Exceptions To The Usual Rule Applies.

The CTPG mentions two "rare" exceptions to the rule against parallel petitions: "when patent owner has asserted a large number of claims in litigation," or "there is a dispute about priority date requiring arguments under multiple prior art references." CTPG, 59. Neither of these "rare" exceptions applies here.

As to the first exception ("a large number of claims [asserted] in litigation"), both Petitions independently challenge ***all*** then-asserted claims of the '768 patent. Should the Board institute either petition, no asserted claim will go unchallenged. There is thus no showing that Petitioner could not challenge all asserted claims in one petition. Instead, there is proof to the contrary, since Petitioner has done just that. *See, e.g.*, *SEVEN*, *supra*, 9-10 (denying parallel petition where petitioner "was able to address all 50 claims … in each of its Petitions," so even though only one parallel petition was instituted, "none of the claims... goes unchallenged"); *Comcast Cable Commc'ns, LLC, v. Rovi Guides, Inc.*, IPR2019-01377, Paper 9, 9 (Feb. 10, 2020) (denying 2 of 3 petitions on 30 claims, where instituted petition "includes at least one ground challenging each of the claims challenged in this

Petition, so no claim … goes unchallenged."); *Comcast Cable Commc'ns, LLC, v. Rovi Guides, Inc.*, IPR2019-01376, Paper 9, 8 (Feb. 10, 2020) (same).

Petitioner fails to substantiate its contention (at 1) that "two petitions are necessary because of the large number of challenged claims." The Petitions both challenge the ***same*** 28 claims of the patent (1-3, 5-12, 14-21, 23-25, 27-29, and 31-33). No Petition is necessary to address any claims unchallenged in the other.

Petitioner asserts that "[t]he Board has repeatedly found 'that about twenty claims constitutes the large number that the CTPG suggests may justify multiple petitions'" (*id.*), but fails to substantiate this assertion too. Petitioner misrepresents the reasoning in the decisions it cites. Each case instituted multiple petitions that challenged ***different*** claims of the patent at issue with the ***same references***. In contrast to those cases, here Petitioner is using ***different references*** in each Petition to challenge the ***same*** claims. Indeed, the references raised are apparently the only difference between these two Petitions. Petitioner's cases are inapposite.

Even setting that point aside, Petitioner ignores the many decisions that have failed to find that 28 claims is a large enough number to justify a second petition. Many Board panels have rejected parallel petitions challenging 45-50 claims, as already illustrated above. *See, e.g.*, *SEVEN*, *supra*; *Nalox-1*, *supra*.

Petitioner argues that 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." Paper 3, 2. Even if that were so, Petitioner provides no support for asserting that such aspects can justify its multiple Petitions, especially where, as here, Petitioner was able to discuss the same claims in each Petition raising different references.

The CTPG's other "rare" exception, "a dispute about priority date," is also absent. No one has raised any dispute about whether any references are prior art.

III. Petitioner's Remaining Arguments For Two Petitions Are Unsupported.

Petitioner's remaining arguments also fail. Petitioner asserts that "[t]he 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." Paper 3, 3. These asserted "differences" merely are that "the petitions rely on different prior art disclosures" that "do not overlap" (Paper 3, 3-4) and that the "two petitions combine prior-art references in different manners" which "likely give rise to different issues regarding obviousness" (*id.*, 4-5). But the mere fact that parallel petitions challenge the same claims in different prior art combinations is not the "rare" instance sufficient to justify two petitions. *See, e.g.*, *Freewheel Media, Inc. v. Intent IQ, LLC*, IPR2024-00423, Paper 9, 9 (Oct. 3, 2024) (rejecting petitions challenging same claims on different grounds, finding that "the differences in how Petitioner applies the art to the challenged claims are not sufficient to justify filing two additional petitions"); *Apple Inc. v.*

Resonant Sys., Inc., Paper 11 (Oct. 15, 2024) (denying parallel petition challenging same claims by different references). "Simply saying that the petitions present alternative arguments contemplated by the Board and are not cumulative does not constitute a sufficiently meaningful explanation." *Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01630, Paper 13, 10 (Apr. 2, 2020). Nor are Petitioner's references —Doherty in the -01252 and Eldering-I in the -01253—as different as contended. Indeed, Eldering-I was denied allowance based on Doherty. Ex. 2008, 2.

IV. The Parallel Reexamination Request Is A Further Reason For Denial.

The fairness and efficiency concerns associated with instituting the parallel Petitions here is only heightened by yet ***another*** related parallel challenge: the parallel request for *ex parte* reexamination No. 90/019,699 of the same patent—filed by Unified Patents LLC, of which Petitioner is a known member. Exs. 2009; 2013, 10. The EPR claims and references strongly overlap with the Petitions: they challenge the same independent claims, and the primary references in both Petitions, Wu and Eldering-I, are also raised in the EPR. The parallel EPR by an entity related to Petitioner is justification to deny ***both*** these parallel Petitions.

V. Conclusion

For these reasons, both parallel Petitions should be denied in light of the parallel overlapping EPR Request, or, at least, one of the parallel Petitions should be denied as an unjustified burden on Patent Owner and the Office. CTPG, 59-60.

Respectfully submitted,

/ David Alberti /

David Alberti, Reg. No. 43,465
KRAMER ALBERTI LIM & TONKOVICH LLP
Kenneth J. Weatherwax, Reg. No. 54,528
LOWENSTEIN & WEATHERWAX LLP

Dated: December 11, 2024

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by agreement between the parties, on December 11, 2024:

PATENT OWNER'S RESPONSE TO PETITIONER'S STATEMENT REGARDING MULTIPLE PETITIONS

The names and address of the parties being served are as follows:

Harper Batts	HBatts@sheppardmullin.com
Chris Ponder	CPonder@sheppardmullin.com
Jeffrey Liang	JLiang@sheppardmullin.com
Fangzhou Qiu	FQiu@sheppardmullin.com
	LegalTM-Piranha-CDCA@sheppardmullin.com

Respectfully submitted,

/ Robert Pistone /

Date: December 11, 2024