UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENIUS SPORTS LTD.,
Petitioner

v.

SPORTSCASTR INC.,
(D/B/A PANDA INTERACTIVE),
Patent Owner.

IPR2024-01310
U.S. Patent No. 11,039,218

PETITIONER'S REASONS FOR PARALLEL PETITIONS AND PETITION RANKING

Genius Sports LTD ("Petitioner") requests IPR of claims 1-30 of U.S. Patent No. 11,039,218 ("the '218"). Ex.1009. Petitioner is filing parallel petitions separately challenging claims 1-9, 19-25, and 27-30 of U.S. Patent No. 10,805,687 ("the '687") and claims 1-9, 19-25, and 27-30 of U.S. Patent No. 10,425,697 ("the '697").

1. REASONS WARRANTING TWO PETITIONS

PO is asserting 30 claims from the '218 in the Texas Litigation. *See* Ex.1019 at 3. The Board has recognized that in such circumstances more than one petition may be necessary. *See* Trial Practice Guide Update (July 2019). Petitioner has filed two petitions related to the '218's claims and respectfully requests that the Board institute both petitions. The Board should institute both petitions for three basic reasons. First, the claims cannot be addressed in one petition because of the number and length of the claims (which alone includes roughly 2,988 words) and because of the nature of the claims themselves. Second, each petition challenges different claims. Thus, the petitions are not duplicative and efficiently address the patentability of the '218 claims. Third, the petitions cite essentially the same art against all claims, thus minimizing the burden on the Board from instituting both petitions.

The first petition challenges 15 claims including two independent claims. The other petition also challenges 15 claims including two independent claims. The

Challenged Claims are directed to substantially overlapping subject matter and the multiple petitions are only needed due to the large number and length of the Challenged Claims. *See e.g., AliveCor, Inc. v. Apple Inc.*, IPR2023-00949, paper 8 (P.T.A.B., January 9, 2024) (acknowledging that "[j]ust reproducing the [almost 1000 word] claims and claim limitations alone, as a Petitioner generally must do for purposes of appropriate analysis, accounts for a significant portion of the required 14,000 word count").

2. RANKING OF THE PETITIONS

Petitioner requests that the Board consider the petitions in the following order, although, for the reasons explained above, the Board's analysis of the claims asserted in the Texas Litigation would not be complete without considering both petitions:

Rank	Petition	Challenged Claims	Prior Art Applied in Grounds
A	IPR2024-01310	1-15	1. U.S. Patent Publication No. 2014/0229992 to Ellis et al. ("Ellis") 2. U.S. Patent Publication No. 2016/0036910 to Spivey ("Spivey") 3. U.S. Patent Publication No. 2015/0163379 to Herzog ("Herzog")
B	IPR2024-01311	16-30	1. U.S. Patent Publication No. 2014/0229992 to Ellis et al. ("Ellis")

			2. U.S. Patent Publication No. 2016/0036910 to Spivey ("Spivey") 3. U.S. Patent Publication No. 2015/0163379 to Herzog ("Herzog")

3. CONCLUSION

Petitioner is only filing these two IPR petitions against the '218, and has not previously filed any IPR petitions against the '218. Petitioner is thus not abusing process, rather Petitioner is merely providing the Board with sufficient context to fully understand the nature of the challenged claims and the asserted prior art. For these reasons, the Board should institute both petitions.[1]

[1] The Administrative Procedures Act and substantive and procedural due process weigh against denying the institution of either petition under 35 U.S.C. §314(a).

Date: August 23, 2024

Respectfully submitted,

/s/ *W. Todd Baker*

W. Todd Baker (Reg. No. 45,265)
todd.baker@kirkland.com
Kirkland & Ellis LLP
1301 Pennsylvania Ave., N.W.
Washington, D.C. 20004
(202) 389-5000

Jeanne M. Heffernan (*pro hac vice* admission to be requested)
jheffernan@kirkland.com
Michael T. Dinnella
Reg. No. 82,580
michael.dinnella@kirkland.com
Postal and Hand-Delivery Address:
KIRKLAND & ELLIS LLP
401 Congress Avenue
Austin, TX 78701
Telephone: (512) 678-9123
Facsimile: (512) 678-9101

Attorneys For Petitioner Genius Sports Ltd.

CERTIFICATE OF SERVICE

In compliance with 37 C.F.R. §§42.105, 42.6(e), the undersigned hereby certifies that a copy of the foregoing Petition and supporting exhibits were served on the 23rd day of August, 2024, via Federal Express® directed to PO at the correspondence address of record:

149890 - Smith Baluch LLP
376 Boylston St,
Suite 401
Boston, MA 02116

A courtesy copy was also served by electronic mail on PO's counsel of record in the Texas litigation:

Britton F. Davis
KING & SPALDING LLP
1401 Lawrence Street
Suite 1900
Denver, CO 80202
(720) 535-2300
bfdavis@kslaw.com

Christopher C. Campbell
KING & SPALDING LLP
1700 Pennsylvania Avenue, NW
Suite 200
Washington, DC 20006
(202) 626-5578
ccampbell@kslaw.com

Ryan A. Schmid
KING & SPALDING LLP
1700 Pennsylvania Avenue, NW
Suite 200
Washington, DC 20006
(202) 626-5578
rschmid@kslaw.com

Matthew D. Wood
KING & SPALDING LLP
500 West 2nd Street
Suite 1800
Austin, TX 78701
(512) 457-2000
mwood@kslaw.com

/s/ *W. Todd Baker*
W. Todd Baker