

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Gregory G. Raleigh, et al.
U.S. Patent No.: 9,647,918 Attorney Docket No.: 39843-0182IP1
Issue Date: May 9, 2017
Appl. Serial No.: 15/227,814
Filing Date: August 3, 2016
Title: MOBILE DEVICE AND METHOD ATTRIBUTING
MEDIA SERVICES NETWORK USAGE TO
REQUESTING APPLICATION

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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**PETITIONER'S NOTICE RANKING PETITIONS AND EXPLAINING
MATERIAL DIFFERENCES BETWEEN PETITIONS FOR U.S. PATENT
NO. 9,647,918**

Petitioner is filing two concurrent Petitions challenging the validity of claims of U.S. Patent No. 9,647,918 (“the ’918 patent”). Pursuant to the Board’s July 2019 Trial Practice Guide Update, Petitioner submits this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits..., and (2) a succinct explanation of the differences between the Petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.” TPG, 59-60.

I. Ranking of Petitions

Although Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Ground
1	IPR2024-01396	Bennett-Vadde
2	IPR2024-01397	Bennett-Rakoshitz-Rybak

II. Material Differences Between the Petitions

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” TPG, 59. One of the examples provided by the Board for justifying the institution of multiple petitions is a “dispute about priority date.” *Id.* In these proceedings, the priority date accorded to the ’918 patent has potential for dispute. As background, the ’918 patent includes a priority claim to multiple provisional applications, the earliest of which was filed on January 28, 2009. The Applicant of the ’918 patent has filed multiple patents and

continuations in a lengthy priority chain that all recite portions of an omnibus specification based on these earlier provisional filings, including the earliest provisional filed on January 28, 2009. However, with the '918 patent specifically, the Applicant added additional disclosure to this omnibus specification—subject matter that was not disclosed or suggested in the earlier provisional filings, including the earliest provisional filed on January 28, 2009. This added disclosure corresponds specifically to a later provisional application, filed on January 24, 2011, that includes nearly identical figures and description as compared to what was added to the '918 patent¹.

Patent Owner has claimed the January 24, 2011 priority date in litigation in their infringement contentions served on May 15, 2024. However, nothing in this pleading binds Patent Owner to the January 24, 2011 priority date in IPR, or otherwise prevents it from retracting the January 24, 2011 priority date later in the co-pending litigation through amended infringement contentions. Thus, although Patent Owner appears to have initially disclaimed its January 28, 2009 priority claim, nothing prevents Patent Owner from asserting a January 28, 2009 priority date in this forum. For these reasons, the priority date is in sufficient dispute to

¹ Petition 1 provides specific examples of disclosure from the January 24, 2011 provisional that was added to the '918 patent by the Applicant.

justify institution of two petitions against the '918 patent.

Further, the petitions challenging the '918 patent are materially different because they rely on different prior art with different dates. Specifically, Petition 1 applies prior art (Vadde) that qualifies as prior art to January 24, 2011, but does not qualify as prior art to January 28, 2009. Accordingly, Petition 1 is valid if Patent Owner is held to a priority date of January 24, 2011 and rightfully prevented from reaching back to a priority of January 28, 2009. In contrast, Petition 2 applies prior art (Rakoshitz and Rybak) that qualifies as prior art to January 28, 2009. With these material differences, two petitions are necessary to account for Patent Owner's complex priority chain and confusion related to the priority date of the '918 patent. Indeed, it was Patent Owner's numerous priority claims and application filing strategy that have created the dispute over priority.

Thus, the present circumstance is consistent with the example in the July 2019 Trial Practice Guide Update (pg. 59), where "the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, ... when there is a dispute about priority date requiring arguments under multiple prior art references." Here, Petitioner contends that Patent Owner should be held to the January 24, 2011 priority date that Patent Owner has asserted in litigation and the references in Petition 1 qualify as prior art. But in the event that Patent Owner attempts to rely on an earlier priority date in

IPR, Petition 2 provides arguments based on prior art references that pre-date the '918 patent's earliest claimed priority date of January 28, 2009.

In view of the material differences shown above, the Board should exercise its discretion to institute both Petitions. Both Petitions are necessary to show the breadth of prior art that reads on the '918 patent's overly broad claims. The Petitions are not redundant or duplicative, and this is not a situation in which it would be reasonable to include all challenges in a single petition, as both petitions challenge nineteen claims (1-19). Moreover, each Petition provides a strong showing of unpatentability. Instituting on only one Petition would give Patent Owner an unfair advantage, allowing Patent Owner to strategically attempt to distinguish its claims over the instituted prior art even if those same arguments would be ineffective over the non-instituted prior art.

Moreover, this is not a situation where Petitioner has filed many IPR petitions against one patent or is asserting dozens of independent grounds. Rather, Petitioner has filed only two petitions, each based on a single primary ground. Because the differences between the petitions are due to Patent Owner's ability to allege an earlier priority date in IPR, institution of both petitions is justified.

Respectfully submitted,

Dated September 9, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on September 9, 2024, a complete and entire copy of this Petitioner's Notice Ranking Petitions And Explaining Material Differences Between Petitions was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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