

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. IPR2025-00081, IPR2025-00082
Patent 10,986,403

**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. Given that Petitioner is requesting *inter partes* reexamination of the same independent claims of the same patent in each Petition, using different references, IPR2025-00081 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, IPR2025-00081 & IPR2025-00082, 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 ’403 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 2) that multiple petitions are justified because “Patent Owner asserts 19 out of the 23 claims of the ’403 patent” and that “[a]ddressing these grounds in one petition would materially reduce the petition’s thoroughness and unduly the burden the Board with overly terse analysis that would be more difficult to analyze.” Petitioner cites no case law that permits multiple petitions so that there can be more “thoroughness” of analysis by the Petitioner. Both Petitions challenge the *same* 19 claims (1, 2, 4-11, 13-15, 17-19, 21-23). 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.*, 1), but fails to substantiate this assertion too. First, Petitioner admits that Patent Owner’s asserted claims of the ’403 patent do not even meet the low bar of 20 claims, but is only asserting 19 claims. Second, Petitioner misrepresents the reasoning in the decisions it cites. Each case instituted multiple petitions that challenged *different* claims of the same patent with the *same references*. In contrast, 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 “detail and specificity and the nature of the subject matter” are also considered when permitting multiple Petitions, and “[t]he claim language is extremely lengthy, spanning about 5 columns and 3000 words, and reciting long limitations concerning scheduling and rescheduling advertisements and controlling their display based on rules.” Paper 3, 2. Petitioner fails to explain why *word length* of the claims justifies multiple Petitions, when Petitioner has not cited any cases showing that this is a criterion considered by the Board when determining if multiple Petitions are justified, especially where, as here, Petitioner was able to discuss the same claims in two petitions, 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 “[t]he petitions rely on different prior art disclosures” that “do not overlap” (Paper 3, 3) and that the “two petitions combine prior-art references in different manners” which “provide different obviousness issues for the Board’s consideration” (*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 -00081 and Eldering-I in the -00082—as different as Petitioner contends. Indeed, Eldering-I was denied allowance based on Doherty. Ex. 2008, 2.

IV. Conclusion

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

Respectfully submitted,

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Dated: February 25, 2025

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by agreement between the parties, on February 25, 2025:

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

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