

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Roy Shkedi
U.S. Patent No.: 7,861,260
Issue Date: December 28, 2010
Appl. Serial No.: 11/736,544
Filing Date: April 17, 2007
Title: TARGETED TELEVISION ADVERTISEMENTS BASED ON
ONLINE BEHAVIOR

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**PETITIONER'S NOTICE RANKING AND EXPLAINING MATERIAL
DIFFERENCES BETWEEN PETITIONS FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 7,861,260**

Petitioner is filing two petitions (IPR2025-00128 and IPR2025-00129) challenging U.S. Patent No. 7,861,260 (the “’260 Patent”) together with Motions for Joinder to two previously instituted proceedings (IPR2024-0421 and IPR2024-0422). Given that Petitioner is requesting joinder of its petitions to two already instituted proceedings, both petitions should be instituted. Nonetheless, as required by the November 2019 Trial Practice Guide Update (hereinafter “TPG”), this paper provides: “(1) a ranking of the petitions in the order in which [Petitioner] wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, 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, 59-61.

I. Ranking of Petitions

As noted above, both petitions should be instituted and joined to the already instituted proceedings. Notably, IPR2025-00128 (the “’128 Petition”) has copied the grounds and exhibits of the IPR2024-00421 petition (the “Freewheel 1 Petition”), which Petitioner has requested to join and which has been instituted. IPR2025-00129 (the “’129 Petition”) has copied the grounds and exhibits of the IPR2024-00422 petition (the “Freewheel 2 Petition”), which Petitioner has requested to join and which has been instituted.

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

Rank	Petition	Challenged Claims	Primary Ref.
1	IPR2025-00128	1-5, 7, 11-20, 22, 26-28, 35-38, 41, 44, 54, 56-58, 61-62, 71-75, 77-80, 83-84, 86, 90-99, 101, 105-106, 116, 118-119, 125, 127-128, 137-141, 143-144, 148, and 151-152	Baig-Costa-Zwicky, Baig-Costa-Banga690
2	IPR2025-00129	1, 6, 8-10, 21, 23-26, 29-34, 38-40, 42-43, 45-53, 55, 59-61, 63-70, 76, 81-82, 85, 87-89, 100, 102-104, 107-115, 117, 120-124, 126, 129-136, 142, 145-147, and 149-150	Baig-Costa-Zwicky, Baig-Costa-Banga690

II. Circumstances in Which the Board has Instituted Multiple Petitions

The Board has recognized “that there may be circumstances in which more than one petition may be necessary.” TPG, 59. Among these circumstances, the Board has previously recognized that two petitions may warrant institution if the patent owner has asserted a large number of claims. *Id.* The Board has also previously instituted two petitions when the claims are addressed by different prior art references, and thereby present materially different grounds challenging a patent. *Solaredge Technologies Ltd. v. SMA Solar Technology AG*, IPR2019-01224, Paper 10 at 11-13 (PTAB Jan 23, 2020).

III. Material Differences Between the Petitions

Petitioner has filed multiple petitions, here, in order to join the multiple instituted petitions under the same substantive grounds for unpatentability. Multiple petitions are necessitated due to the large number of challenged claims which represent the claims of the '260 Patent that Patent Owner has asserted against Petitioner in litigation, or which Petitioner reasonably believes Patent Owner may assert in the litigation.

Accordingly, the Board should consider all both concurrently filed petitions and not exercise its discretion to deny institution of any one in view of the other.

Respectfully submitted,

Dated: November 1, 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 November 1, 2024, a complete and entire copy of this Notice Ranking Petitions was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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