

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Kubota North America Corporation,

Petitioner

IPR2025-00167

IPR2025-00168

IPR2025-00169

U.S. Patent No. 9,321,386

**PETITIONER'S NOTICE RANKING PETITIONS AND
EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS
FOR U.S. PATENT NO. 9,321,386**

I. INTRODUCTION

Petitioner filed three Petitions challenging claims of U.S. Patent 9,321,386 (the “’386 patent”). Pursuant to the Consolidated Trial Practice Guide November 2019 (“TPG”), 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, 60.

II. RANKING OF PETITIONS

The ’386 Patent includes thirteen (13) independent claims – claims 1, 15, 31, 38, 45, 50, 55, 70, 74, 78, 80, 83, and 86 – and numerous claims depending from these claims to provide a total of 85 claims.¹ Petitioner does not challenge claim 14, and challenges all remaining claims over these three petitions. Each of the three petitions groups the claims and addresses different, non-overlapping claim sets. Each petition is based upon the same primary reference – KR996, and addresses different features recited in each of the independent claims and various dependent

¹ Claims 16 and 18 are canceled by reexamination certificate.

claims. As demonstrated by each petition, the grounds are meritorious and justified.

Per the Board's TPG guidance, Petitioner ranks as follows:

RANK	PETITION	CLAIMS	GROUND
1	IPR2025-00167 (challenges claims 1-13, 15, 17, 19-30, 64-67)	Claims 1-13, 21-22, 64	Obvious over KR996 and JP705
		Claim 65	Obvious over KR996, JP705, and McIlwraith
		Claims 15, 17, 19-20, 23-30, 66-67	Obvious over KR996, JP705 and Beltrami
2	IPR2025-00168 (challenges claims 31-49, 70-79, and 86-87)	Claims 31-36, 38-39, 41-49, 86-87	Obvious over KR996 and JP705
		Claims 37, 40, 70-79	Obvious over KR996, JP705, and Bares
3	IPR2025-00169 (challenges claims 50-63, 68-69, and 80-85)	Claims 50-54	Obvious over KR996 and JP705
		Claims 55-63, 68-69, 80-85	Obvious over KR996, JP705, Bares, and Beltrami

III. EXPLANATION OF MATERIAL DIFFERENCES AND REASONS FOR INSTITUTION OF MULTIPLE PETITIONS

The Board recognized that “there may be circumstances in which more than one petition may be necessary.” CTPG at 59-60. That circumstance is present here:

Parallel Petitions challenge different claims. Different claims are challenged in each Petition as shown in the Table above. There is no overlap of claims challenged between the petitions. The Patent Owner has served a complaint that declines to constrain the claims that it asserts. EX1019 (“at least claim 1 of the ’386 Patent”), p. 4. Thus, Petitioner challenges eighty-four (84) of the eighty-five (85) claims of the ’386 Patent.

Indeed, just the textual language of thirty-one (31) claims challenged in the First Petition alone is over 1,900 words, the thirty-one (31) claims challenged in the Second Petition alone is over 2,850 words, and the twenty-two (22) claims challenged in the Third Petition is 2,220. The considerable number and length of the challenged claims makes presenting the asserted obviousness grounds in a single petition impractical. Thus, institution of all three of the Petitions is warranted and consistent with the Board’s decisions in other cases. *See, e.g., Flex Logix Techs., Inc. v. Venkat Konda*, IPR2020-00261, Paper 22 at 24 (PTAB Aug. 3, 2020) (independent claim more than one column long did not weigh in favor of discretionary denial); *Peloton Interactive, Inc. v. Ifit, Inc.*, IPR2022-00030, Paper 12 at 33-34 (PTAB Apr. 22, 2022) (finding “Petitioner’s filing of three petitions to challenge different claims of the ’062 patent...promotes efficiency” where the patent “include[s] five independent claims” that “differ[.]...in various, potentially

significant ways.”); *Novartis Gene Therapies v. Genzyme Corporation*, IPR2023-01045, Paper 10 at 3 (PTAB Jan. 17, 2024) (instituting multiple petitions where patent included seven independent claims with differing features and scope).

Petitioner files the First, Second, and Third Petitions concurrently and has not sought “a timing advantage that might otherwise occur were the petitions filed serially,” which further supports institution. *Samsung Electronics Col., Ltd. v. Ryan Hardin*, IPR2022-01335, Paper 13, 22-23 (PTAB Feb. 8, 2023) (Institution Decision).

IV. INSTITUTION OF ADDITIONAL PETITIONS IS WARRANTED

Institution of the three petitions would permit Petitioners to challenge all claims, it would not raise concerns of duplicative time and resources, and Petitioner would not oppose and in fact, plans to request, consolidation of the three proceedings under 35 U.S.C. § 315(d), if instituted. Again despite the challenge arising from the number of claims, the Board can efficiently resolve the grounds of the First, Second and Third Petitions, each challenges rely on a combination of the same base prior art (KR996).

V. CONCLUSION

The Board should institute trial on the First, Second, and Third Petitions.

Respectfully submitted,

Dated: November 15, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, service was made on Patent Owner as detailed below.

Date of service November 15, 2024

Manner of service FEDERAL EXPRESS

Documents served Petitioner's Notice Ranking Petitions and Explaining
Material Differences Between Petitions for U.S. Patent
No. 9,321,386

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