

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER INC.,
Petitioner

v.

VIDEOLABS, INC.,
Patent Owner

Inter Partes Review Case No. IPR2025-00305
U.S. Patent No. 8,291,236

**PETITIONER'S NOTICE RANKING PETITIONS AND EXPLAINING
MATERIAL DIFFERENCES**

Petitioner is filing three copycat/understudy parallel petitions for *inter partes* review against U.S. Patent No. 8,291,236 (“the ’236 patent”). Pursuant to the Board’s Consolidated Trial Practice Guide (November 2019) (“TPG”) at 59-60, Petitioner submits this notice to (1) identify a ranking of the petitions and (2) provide a succinct explanation of the differences between the petitions, why issues addressed by the differences are material, and why the Board should use its discretion to institute all petitions.

Petitioner notes that the Board has already considered the arguments presented in this copycat rankings paper and declined to exercise its discretionary denial in the underlying Roku IPRs Petitioner now seeks to join. IPR2024-01024, Paper 12, at n.5 (PTAB Dec. 4, 2024). In the Roku IPRs, the Board reasoning was as follows:

Petitioner filed a Notice Ranking Petitions and Explaining Material Differences. Paper 3. Petitioner states that it filed three parallel IPR petitions challenging three different claim sets of the ’236 patent “solely for word count purposes that preclude all claims from being challenged in [a] single petition,” “there is no duplicative overlap of the same claims across petitions,” and there is a “need to set forth constructions for claim language invoking § 112 ¶ 6.” *Id.* at 1–2 (citing Consol. Tr. Pr. Guide, 59–61). Patent Owner does not address Petitioner’s Notice. We agree with Petitioner’s reasoning and decline to exercise our discretionary denial authority under 35 U.S.C. § 314(c).

Id. Here, Petitioner submits that the same reasoning applies and respectfully requests the Board institute each copycat/understudy petition

I. RANKING OF PETITIONS

Petitioner does not believe a ranking of petitions to be appropriate here, as there is no duplicative overlap of the same claims across petitions and the three petitions are pursued solely for word count purposes that preclude all claims from being challenged in single petition. For example, the petition in IPR2025-00304 is challenging claims 32-36, 38-41, 43, 66-70, 72-75, 77, and 130-137 and has a word count of 13,980 words, while the petition in IPR2025-00305 is directed to claims 48-50, 57, 82-84, 91, 116-118, 125, and 140-142 and has a word count of 11,454 words, and the petition in IPR2025-00306 is directed to claims 100-109 and 111 and has a word count of 13,912 words. Due to word count constraints, the different limitations found in the independent claims of the '236 requiring the application of different arguments, and the need to set forth constructions for claim language invoking §112, ¶6, different subsets of claims have been presented separately in the separate petitions. See PTAB Consolidated Trial Practice Guide, November 2019,¹ 59-61 (permitting parallel petitions in certain circumstances, such as a large number of claims). The multiple petitions are not unnecessarily duplicative because they challenge different independent and dependent claims of the '236, and the multiple petitions will not substantially burden the Board or the parties because they use overlapping prior art references in the grounds of unpatentability (i.e., “Russ” is

¹ <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>

common to all three petitions; “Robert” and “Eskicioglu” are also common to two of the petitions), and the different claims, while directed to different components of an overall system, include overlapping limitations that have overlapping unpatentability arguments. Petitioner only submits three petitions out of necessity. The Board should not exercise discretion to deny any of the petitions directed to the ’394. *See, e.g., Samsung Elecs. Co. Ltd. v. Mojo Mobility Inc.*, IPR2023-01090, Paper 11 at 25-26 (PTAB Jan. 11, 2024) (granting institution and declining to deny a parallel petition where, “in effect, the two petitions were filed instead of one merely because [PTAB] Rules have page limit restrictions”).

Nevertheless, to the extent ranking is necessary, Petitioner ranks the petitions as follows:

IPR No.	Rank
IPR2025-00304	1
IPR2025-00305	2
IPR2025-00306	3

Petitioner respectfully requests that the Board institute all petitions.

Dated: December 17, 2024

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IPR2025-00305

U.S. Patent No. 8,291,236

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COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(b), the undersigned certifies that on December 17, 2024, a complete and entire copy of this *Petitioner's Notice Ranking Petitions And Explaining Material Differences* was provided via Federal Express to the Patent Owner by serving the correspondence address of record for the '236 Patent:

WORKMAN NYDEGGER
60 East South Temple
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Salt Lake City, UT 84111

Further, a courtesy copy of this *Petitioner's Notice Ranking Petitions And Explaining Material Differences* was sent via email to Petitioner's and Patent Owner's counsel for IPR2024-01024:

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Respectfully submitted,

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