Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

_____

Case No. IPR2025-00365
Patent No. 11,234,117

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**PETITIONERS' NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES**

Petitioners are filing three parallel petitions for *inter partes* review against U.S. Patent No. 11,234,117 ("the '117 patent"). Pursuant to the Board's Consolidated Trial Practice Guide (November 2019) ("TPG")[1] at 59-60, Petitioners submit this notice to (1) identify a ranking of the petitions and (2) explain the differences between the petitions, why issues addressed by the differences are material, and why the Board should use its discretion to institute all three petitions.

## I. RANKING OF PETITIONS

Petitioners do 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 a single petition. For example, the petition in IPR2025-00365 challenges claims 1-14 and 73-92 and has a word count of 13,992 words, while the petition in IPR2025-00366 challenges claims 15-41 and has a word count of 13,971 words, and the petition in IPR2025-00367 challenges claims 42-72 and has a word count of 13,890 words. Due to word-count constraints and the different limitations recited in the different independent claims of the '117 patent requiring application of different prior art and arguments, different sets of claims have been presented separately in the separate petitions. *See* TPG at 59-61 (permitting parallel petitions where a large number of claims are asserted).

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

The parallel petitions are not unnecessarily duplicative, because they challenge different independent claims of the ’117 patent, together with their dependent claims. The parallel petitions will not substantially burden the Board or the parties because they use overlapping prior-art references in the grounds of unpatentability, and because the different claims, while directed to different features of an overall system, include overlapping limitations that have overlapping unpatentability arguments. Primary references “Sheha” and “Randall” are common to all three petitions, and are applied in various combinations with secondary references (many of which are common to all three petitions), with the combinations differing to address the different features recited in different claims.

Petitioners only submit three petitions out of necessity. The Board should not exercise discretion to deny any of the petitions. *See*, *e.g.*, *Samsung Elecs. Co. Ltd. v. Mojo Mobility Inc.*, IPR2023-01090, Paper 11 at 25-26 (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”).

To the extent ranking is necessary, Petitioners rank the petitions as follows:

| Petition | Claims | Rank |
|---|---|---|
| IPR2025-00365 | 1-14, 73-92 | 1 |
| IPR2025-00366 | 15-41 | 2 |
| IPR2025-00367 | 42-72 | 3 |

## II. EXPLANATION OF MATERIAL DIFFERENCES

IPR2025-00365 challenges independent claims 1 and 73 together with their dependents (totalling 34 claims). IPR2025-00366 challenges independent claims 15 and 29 together with their dependents (totalling 27 claims). IPR2025-00367 challenges independent claim 42 together with its dependents (totalling 31 claims). The different independent claims recite different configurations of elements, calling for application of different combinations of prior-art references. For example, "Froeberg" is used as a secondary reference as to independent claim 1; "Smith," "Degnbol," "McNulty," and "De-Vries" are used as secondary references as to independent claims 15 and 29; while "Darling" and "Futagami" are used as secondary references as to independent claim 42:

| Petition | Claims | Grounds for Independent Claims | Prior Art for Dependent Claims |
|---|---|---|---|
| IPR2025-00365 | 1-14, 73-92 | Claim 1: Sheha+Froeberg<br>Randall+Froeberg<br>Claim 73: Sheha<br>Randall | De-Vries, Degnbol, Bechtolsheim, Boling, Smith |
| IPR2025-00366 | 15-41 | Claim 15: Sheha+Smith<br>Randall<br>Claim 29: Sheha+Degnbol+McNulty<br>Randall+De-Vries | De-Vries, Degnbol, Bechtolsheim, Boling, Wako |
| IPR2025-00367 | 42-72 | Claim 42: Randall+Darling+Futagami<br>Sheha+Darling+Futagami | De-Vries, Degnbol, Bechtolsheim, Boling, Smith, Wako |

## III. THE BOARD SHOULD INSTITUTE ALL THREE PETITIONS

The TPG (at 59) recognizes that "more than one petition may be necessary…when the patent owner has asserted a large number of claims in litigation." Here, Patent Owner has asserted ***all 92*** claims of the '117 patent, including all five independent claims. EX1039 at 1.

In addition, the '117 patent's claims are long, spanning eight columns of the patent's text, and containing over 3,700 words. They recite a multiplicity of limitations that require significant numbers of words to address. As discussed above, the five independent claims have differing limitations requiring different mappings to prior-art combinations. The Board has concluded in prior cases that such circumstances warrant institution of more than one petition. *See, e.g., Adobe Inc. v. SynKloud Techs., LLC*, IPR2020-01392, Paper 8 at 9 (Mar. 11, 2021) ("[I]t is reasonable to conclude that the length of the claims, and the difference in scope of independent claims 1 and 12, warranted the filing of two petitions.").

As discussed above, the parallel petitions are not unnecessarily duplicative, and will not substantially burden the Board or the parties because they use overlapping prior-art references. Additionally, as the Examiner noted in prosecution, the '117 patent's independent claims are "similar to [Patent Owner's] claims in other patents with small word or small phrase changes" (EX1002 at 1503) which are the subject of other IPR petitions recently filed by Petitioners:

| ’117 Patent Claim | Related Patent Claim | Related IPR Petition | Grounds in Both Petitions |
|---|---|---|---|
| 1 | ’575 patent, claim 1 | IPR2025-00124 | Sheha+Froeberg<br>Randall+Froeberg |
| 15 | ’283 patent, claim 1 | IPR2025-00019 | Sheha+Smith<br>Randall |
| 29 | ’039 patent, claim 1 | IPR2025-00021 | Sheha+Degnbol+McNulty<br>Randall+De-Vries |
| 42 | ’540 patent, claim 1 | IPR2025-00227 | Randall+Darling+Futagami<br>Sheha+Darling+Futagami |
| 73 | ’418 patent, claim 1 | IPR2025-00018 | Sheha<br>Randall |

Petitioners’ petitions on the ’117 patent’s independent claims present similar grounds relying on the same prior art as in the petitions on the related patent claims. The Board’s familiarity with the issues from the related IPRs on the related patent claims provide a further reason why the parallel petitions on the different ’117 patent claims will not substantially burden the Board.

## IV. CONCLUSION

Petitioners respectfully request that the Board institute all three petitions on the ’117 patent.

Respectfully submitted,

Date: 2024-12-30

/Elisabeth Hunt/

Elisabeth Hunt, Reg. No. 67,336
WOLF, GREENFIELD & SACKS, P.C.

**CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)**

I certify that on December 30, 2024, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via Overnight FedEx at the following correspondence address of record for the patent:

Jeffrey D. Mullen
2212 Hassinger Lane
Glenshaw, PA 15116

Date: December 30, 2024

/Dara Del Rosario/
Dara Del Rosario
Paralegal
WOLF, GREENFIELD & SACKS, P.C.