Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

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

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

_____

Case No. IPR2025-00369
Patent No. 11,246,024

_____

PETITIONERS' NOTICE RANKING PETITIONS AND EXPLAINING MATERIAL DIFFERENCES

Petitioners are filing two parallel petitions for *inter partes* review against U.S. Patent No. 11,246,024 ("the '024 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) 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 both 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 two petitions are pursued solely for word-count purposes that preclude all claims from being challenged in a single petition. For example, the petition in IPR2025-00368 challenges claims 1-44 and has a word count of 13,995 words, while the petition in IPR2025-00369 challenges claims 45-78 and has a word count of 13,996 words. Due to word-count constraints and the different limitations recited in the different independent claims of the '024 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 in certain circumstances, such as a large number of asserted claims).

[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 ’024 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 both petitions, and are applied in various combinations with secondary references (many of which are common to both petitions), with the combinations differing to address the different features recited in the different claims.

Petitioners only submit two petitions out of necessity. The Board should not exercise discretion to deny either 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
IPR2025-00368	1-44	1
IPR2025-00369	45-78	2

II. EXPLANATION OF MATERIAL DIFFERENCES

The petition in IPR2025-00368 challenges independent claims 1 and 24 together with their dependents (totalling 44 claims). The petition in IPR2025-00369 challenges independent claim 45 together with its dependents (totalling 34 claims). The different independent claims recite different configurations of elements, calling for application of different combinations of prior-art references. For example, "Froeberg" and "Smith" are used as secondary references as to independent claims 1 and 24, while "Darling" and "Futagami" are used as secondary references as to independent claim 45:

Petition	Claims	Grounds for Independent Claims	Prior Art for Dependent Claims
IPR2025-00368	1-44	Claim 1: Sheha+Froeberg Randall+Froeberg Claim 24: Sheha+Smith Randall	De-Vries, Degnbol, Wollrab, Obradovich, Bechtolsheim, Boling
IPR2025-00369	45-78	Claim 45: Randall+Darling+Futagami Sheha+Darling+Futagami	De-Vries, Degnbol, Wollrab, Obradovich, Bechtolsheim, Boling, Froeberg, Smith

III. THE BOARD SHOULD INSTITUTE BOTH 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 70 of the 78 total claims of the '024 patent, including all three independent claims. EX1039 at 1.

In addition, the '024 patent's claims are long, spanning six columns of the patent's text, and containing over 3,200 words. They recite a multiplicity of limitations that require significant numbers of words to address. Further, as discussed above, the three 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 '024 patent's "independent claims are system claims modeled

after…method claims in [Patent Owner's] other patents" (EX1002 at 1416) which are the subject of other IPR petitions recently filed by Petitioners:

'024 Patent Claim	Related Patent Claim	Related IPR Petition	Grounds in Both Petitions
1	'575 patent, claim 1	IPR2025-00124	Sheha+Froeberg Randall+Froeberg
24	'283 patent, claim 1	IPR2025-00019	Sheha+Smith Randall
45	'540 patent, claim 1	IPR2025-00227	Randall+Darling+Futagami Sheha+Darling+Futagami

Petitioners' petitions on the '024 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 '024 patent claims will not substantially burden the Board.

IV. CONCLUSION

Petitioners respectfully request that the Board institute both petitions on the '024 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.