From: Andriy Lytvyn
To: Director_PTABDecision_Review
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Subject: IPR2023-00477 - Rehearing Request by the Director [IWOV-FirmLive.FID1870355]
Date: Friday, August 11, 2023 5:58:48 PM
Attachments: [redacted]
Paper 9 - Petitioner's [redacted] or IPR2023-00477.pdf

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Dear Director,

Petitioner in the above-captioned IPR respectfully requests Director Review of the Board's non-institution decision, in which the Board discretionarily denied the IPR petition—without addressing its merits—solely because institution thereof would result in a parallel IPR proceeding.

Petitioner hereby provides the following priority-ranked list of the issues for which Petitioner seeks Director Review:

I. Important issue of law or policy (issue of first impression):

Whether in light of the Director's decisions in *CommScope Tech. v. Dali Wireless, Inc*., IPR2022-01242, Paper 23 (PTAB Feb. 27, 2023) (precedential) and *AviaGames, Inc. v. Skillz Platform*, *Inc*., IPR2022-00530, Paper 14 (PTAB Mar. 2, 2023), the "compelling merits" test applies in the context of parallel IPR petitions. More specifically, whether the Board erred by discretionarily denying an IPR petition—without determining whether the petition presents a compelling, meritorious unpatentability challenge—solely because institution thereof would result in parallel IPR proceedings.

II. Abuse of discretion

1. Whether the Board abused its discretion by overlooking multiple key issues in its analysis of whether "the *totality* of the circumstances" favors discretional denial of the parallel IPR petition. More specifically, whether the Board erred by failing to give proper weight to the following countervailing factors:

   (1) in its institution decision of the counterpart IPR2023-00451, the Board only analyzed unpatentability of six of the twenty-three challenged claims—this partial analysis is insufficient to reasonably determine

whether efficiency and integrity of the system are best served by denying or instituting review on the additional ground presented in the parallel petition;

(2) the Board provided no rationale as to why review of each claim on a single additional ground would result in an unwarranted burden for Patent Owner and the Board, especially considering that the granted counterpart petition only presented a single unpatentability ground against each claim;

(3) the Board did not address the fact that Patent Owner did not oppose institution of parallel IPR trials;

(4) the Board did not consider its legal precedent that in the context of parallel IPR petitions, "the burden on the Board is outweighed by Petitioner's reasonable precaution taken in case Patent Owner can antedate a reference" (*Abbott Labs. v. Integrated Sensing Sys., Inc.*, IPR2019-01339, Paper 7 at 10 (PTAB Jan. 23, 2020) (granting parallel petitions)), and also that the fees Petitioner paid for filing the parallel petition help mitigate the additional burden on the Board;

(5) the Board's statement that there is "no reason to think that [Petitioner] would prevail on the 477 Petition in the event Petition is unsuccessful in proving the grounds in the 451 Petition" ignores the entirety of the unpatentability argument set forth in the 477 Petition, which establishes the exact reasons as why Petitioner would prevail on that petition, and none of these reasons hinges on Petitioner's success in IPR2023-00451; and

(6) the Board did not consider the merits of the denied petition and the public benefit of cancelling invalid patent claims.

2. Whether the Board's *sua sponte* order in IPR2023-00451 (IPR2023-00451, Paper 8, "Order") soliciting Patent Owner's response to Petitioner's reasons for parallel IPR petitions, after Patent Owner did not file its preliminary responses, constitutes an abuse of discretion for the following reasons:

(1) the Board coached Patent Owner on how to rebut Petitioner's reasons for parallel petitions and signaled that the Board will consider discretionarily denying the parallel petition if Patent Owner were to file the solicited response;

(2) the Order departed from the rules set forth in the Trial Practice Guide by permitting Patent Owner to submit a response to Petitioner's reasons for parallel IPR petitions *without* filing a preliminary response; and

(3) the Order departed from the rules set forth in 37 C.F.R. § 42.107(b) by permitting Patent Owner to respond to Petitioner's reasons for parallel

IPR petitions well outside the regulatory deadline.

Sincerely,

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