UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Shenzhen Torras Technology Co., Ltd.

Shenzhen Lechuang Tiancheng Technology Co., Ltd.

Shenzhen Ruixin Digital Technology Co, Ltd.

and

Shanghai Kuke Network Technology Co., Ltd.

Petitioners

v.

Rokform IP, LLC

Patent Owner.

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IPR2027-00012

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PETITIONERS' NOTICE RANKING AND EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS FOR POST-GRANT REVIEW AND INTER PARTES REVIEW

U.S. Patent 12,656,835

I. INTRODUCTION

Petitioners are filing two petitions (*i.e.*, a PGR and an IPR) challenging U.S. Patent No. 12,656,835 ("the '835 Patent").

The '835 Patent recently issued on June 16, 2026; it is a so-called "transition patent" (*i.e.*, a patent filed on or after March 16, 2013 that claims priority to an application filed before March 16, 2013) because it was filed on January 17, 2025 and claims priority on its face, via a chain of continuation applications, to three applications filed prior to March 16, 2013: U.S. Non-provisional patent application no. 13/593,220 ("the 220 application," filed Aug. 23, 2012), Provisional application No. 61/653,618, filed on May 31, 2012, and Provisional application No. 61/585,933, filed on Jan. 12, 2012. EX1001, cover.

In their PGR against the '835 Patent, Petitioners assert that the '835 patent is not, in fact, entitled to claim priority to any of these three pre-AIA applications because none provide written description support for any of the 39 claims of the '835 Patent. If the Patent Trial and Appeal Board (PTAB) were to agree, then the '835 patent is subject to PGR review. 35 U.S.C. § 321(1)(A) ("The post-grant review provisions of the Leahy-Smith America Invents Act (AIA) apply only to patents subject to the first inventor to file provisions of the AIA."); 35 U.S.C. § 100 ("The first inventor to file provisions of the [AIA] apply to . . . any patent . . . that contains or contained at any time – (A) a claim to a claimed invention that

has an effective filing date on or after March 16, 2013 wherein the effective filing date is: . . . (ii) the filing date of the earliest application for which the patent . . . is entitled . . . to the benefit of an earlier filing date under section 120.").

If the PTAB were to find that the '835 patent is a first-to-invent patent and not eligible for PGR review, then the '835 patent is subject to IPR review even though it was granted within the last nine months because of the exception to 35 U.S.C. § 311(c) under Section 1(d)(1) of the AIA Technical Corrections Act (Pub. L. 112–274).

The PTAB has recognized "that there may be circumstances in which more than one petition may be necessary," when there is a "dispute about priority date." Patent Trial and Appeal Board, Consolidated Patent Trial Practice Guide, November 2019 Edition, 59. Indeed, a similar situation was previously presented to the PTAB (*i.e.*, both an IPR and a PGR were filed against the same patent because there was an issue as to whether that patent was entitled to claim priority to a pre-AIA application), and the PTAB resolved it by instituting the PGR and denying the IPR petition upon finding that the patent was not entitled to a pre-AIA filing date. *Samsung Electronics Co., LTD. v. MemoryWeb, LLC*, PGR2022-00034, Paper 11, 14 (PTAB Nov. 17, 2022).

II. RANKING OF PETITIONS

Petitioners are filing both types of petitions to ensure consideration of the

merits of the invalidity grounds set forth within them, regardless of whether Patent Owner's priority claim is deemed valid. Petitioners provide the following rankings:

Rank	Petition	Asserted Grounds
1	PGR2027-00004	§§ 102, 103, 112
2	IPR2027-00012	§ 103

B. Material Differences Between The Petitions.

The two petitions are materially different because they are different types of petitions subject to different statutory requirements (Petition 1 is a PGR petition subject to 35 U.S.C. §§321-329 requirements; Petition 2 is an IPR petition subject to 35 U.S.C. §§311-319 requirements).

Although the '835 Patent claims priority through a chain of continuation applications to three pre-AIA applications including the '220 application, at least one claim is not entitled to the claimed priority because at least one claim does not have written description support in any of these three applications. Petition 1 includes a §102 anticipation ground based on the publication of the '220 application because that publication was published on July 18, 2013 (EX1010), well before the filing date of any post-AIA continuation application of the '835 patent and therefore, is prior art under 35 U.S.C. §102(a)(1). Petition 1 also includes a §112 ground based on insufficient written description because none of the post-AIA continuation applications to which the '835 patent claims priority

provide additional disclosure beyond the inadequate disclosure of the ’220 application. Both Petition 1 and Petition 2 include the same § 103 obviousness grounds based on the same references. These references are prior art under 35 U.S.C. §102(a)(1) to all the claims even if the ’835 Patent were entitled to the earliest priority date of January 12, 2012 specified on its face (EX1001, cover) because all were published well before that date.

That is, Petition 1 is materially different to Petition 2 because it is a PGR while Petition 2 is an IPR, and Petition 1 includes a § 102 anticipation ground and a § 112 insufficient written description ground, which are not in Petition 2.

Finally, Petitioners note that the Board’s rules related to discretionary denial prevent them from taking a wait-and-see approach and dictate the need to file both PGR and IPR petitions concurrently. Although Petitioners could wait the six months to gain the Board’s insight on its PGR petition before deciding whether to pursue an IPR petition because Petitioners would still be within their one year bar date, the *Fintiv* discretionary denial law discourages such a strategy because a six-month advancement in the co-pending litigation would likely push an IPR filed six months from now further beyond trial. Also, a subsequent IPR petition filed after denial of a PGR petition for lack of PGR eligibility could be evaluated under the PTAB’s *General Plastic* precedent, which discourages serial petition filings.

For at least these reasons, the Board's discretionary denial case law has dictated the need to pursue simultaneous PGR and IPR petitions and Petitioners respectfully request that the PTAB institute trial on one of the Petitions, depending on how it rules on the priority issue.

Respectfully submitted,

/Gregory J. Gonsalves/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 10th day of October, 2026, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by USPS Priority Mail Express® on the following:

Via LLP
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A courtesy copy of this Petition and supporting material was also served on litigation counsel for Patent Owner via email:

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Dated: October 10, 2026

Respectfully Submitted,
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