UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner.

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Case No. IPR2020-00723
U.S. Patent No. 7,747,217

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**PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS**

Pursuant to the Board's Consolidated Trial Practice Guide of November 2019[1] (the "Consolidated TPG"), Petitioner Google LLC files, concurrently with this paper, two petitions for *Inter Partes* Review of U.S. Patent No. 7,747,217 (Case Nos. IPR2020-00722 and IPR2020-00723). In accordance with the Board's guidance at pages 59-61 of the Consolidated TPG, Petitioner submits this Supplemental Paper and Notice Ranking Petitions to explain the material differences between the petitions and why the Board should exercise its discretion to institute both petitions. Petitioner also identifies a ranking of the petitions in the order in which Petitioner wishes the Board to consider the merits.

The grounds of the two petitions are:

| **Petition** | **Grounds** |
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| IPR2020-00723<br>(the "Campbell Petition") | **Ground 1**: claims 1-3, 7-9, 11, 12, 16-18, and 20-22 under 35 U.S.C. § 103 based on *Campbell* in view of *Millar*<br>**Ground 2**: claims 11, 12, and 16-18 under 35 U.S.C. § 103 based on *Campbell* in view of *Millar* and *Thonnart* |
| IPR2020-00722<br>(the "Millar Petition") | **Ground 1**: claims 1-3, 7-9, 11, 12, 16-18, and 20-22 under 35 U.S.C. § 103 based on *Millar* in view of *Keiser* |

[1] Available at: https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

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|---|---|
| | **Ground 2**: claims 11, 12, and 16-18 under 35 U.S.C. § 103 based on *Millar* in view of *Keiser* and *Thonnart* |

Petitioner believes that both Petitions should be instituted for the reasons stated below, but asks the Board to give priority to the Petition in IPR2020-00723 (Campbell Petition).

## I. Material Differences Between the Petitions

The Consolidated TPG expressly recognizes that multiple petitions may be necessary "when there is a dispute about priority date requiring arguments under multiple prior art references." Consolidated TPG at 59. That is the situation here.

While the same claims are challenged in each petition, the two petitions rely on different prior art for different grounds. The Campbell Petition relies on PCT Patent Publication No. WO 81/02961 to Campbell et al. ("*Campbell*") as the primary reference in both obviousness grounds, while the Millar Petition does not rely on *Campbell* for any ground of unpatentability. The Millar Petition also relies on U.S. Patent No. 4,390,901 to Keiser ("*Keiser*") in both of its obviousness grounds, which is not relied on in the Campbell petition.

The earliest claimed priority date of the '217 patent is November 3, 1981.[2]

[2] Petitioner does not concede that any challenged claims of the '217 patent are entitled to this priority date.

*Campbell* published a mere 19 days before this, on October 15, 1981, making it prior art under at least pre-AIA 35 U.S.C. § 102(a). In view of the relatively close timing between the publication date of *Campbell* and the earliest claimed priority date of the '217 patent, Petitioner believes that Patent Owner may attempt to antedate *Campbell*, which would affect both grounds in the Campbell Petition but neither ground in the Millar Petition. As a result, potential antedation presents an important and material distinction between the Campbell and Millar Petitions.

The two petitions therefore differ materially both in substance and in the defenses Patent Owner may assert in response.

## II. The Board Should Institute Both Petitions

The potential for an antedation challenge against *Campbell* in the Campbell Petition, in itself, warrants institution of both petitions. Consolidated TPG at 59-61; *see Chegg, Inc. v. NetSoc, LLC*, IPR2019-01171, Paper 16 at 10-15 (PTAB Dec. 5, 2019) (instituting review of two parallel petitions while noting the "very close" filing date of a primary prior art reference to the filing date of the challenged patent's provisional application); *see also Abbott Labs. v. Integrated Sensing Sys., Inc.*, IPR2019-01338, Paper 7 at 9-12 (PTAB Jan. 23, 2020) (instituting review of two parallel petitions where the prior art "could potentially be antedated by [Patent Owner].").

The Board weighs several factors in determining whether to exercise its discretion to institute review under 35 U.S.C. § 314(a). *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 9-10, 16 (PTAB Sept. 6, 2017) (Precedential as to § II.B.4.i). Of those seven factors, factor 6 (the finite resources of the Board) and factor 7 (the Board's ability to issue a final decision within a year of institution) are most pertinent to the concurrently filed parallel petitions at issue here. *Chegg, Inc. v. NetSoc, LLC*, IPR2019-01171, Paper 16 at 10-11 (PTAB Dec. 5, 2019) ("[F]actors 1 through 5 apply only to 'follow-on' petitions . . . ."). Neither factor weighs in favor of denying institution.

Instituting both petitions would not significantly burden the Board's resources or impede the Board's ability to render timely final decisions. In a similar case, the Board described it as a "minimal" burden to review two parallel petitions when antedation is potentially at issue in one petition. *See Abbott Labs. v. Integrated Sensing Sys., Inc.*, IPR2019-01338, Paper 7 at 11 (PTAB Jan. 23, 2020) ("[T]he minimal burden on the Board of two petitions is outweighed by the reasonable precaution taken by [Petitioner] in case [Patent Owner] antedates a primary reference in one or the other case."). This is particularly true where, as here, "there are only two concurrent petitions, each including a reasonable number of grounds." *Id.* at 11-12 ("Addressing the challenges in both Petitions in these proceedings will provide a timely, fair and efficient resolution for both parties

before the Board, and may ultimately be helpful in reducing issues related to patentability and resolving the dispute in the district court litigation.").

## III. Ranking of Petitions

Petitioner believes that both Petitions should be instituted for the reasons given in the Petitions and above. As to priority, the Petition in IPR2020-00723 (Campbell Petition) should be given priority and considered first by the Board.

Dated: March 21, 2020

/Erika H. Arner/

Erika H. Arner (Reg. No. 57,540)

Attorneys for Petitioner Google LLC

## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a) & (b), the undersigned hereby certifies that on March 21, 2020, a copy of the foregoing PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS was served on Patent Owner via email to the email addresses below. In view of the COVID-19 situation, the parties agreed to electronic service of the Petition and associated exhibits and papers via email under 37 C.F.R. § 42.105(b) to the email addresses below:

| Correspondence Address of Record: | Identified by Patent Owner: |
|---|---|
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Dated: March 21, 2020

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