

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MURATA MANUFACTURING CO., LTD

Petitioner

IPR2025-00383

IPR2025-00384

U.S. Patent No. 7,489,914

**PETITIONER'S NOTICE RANKING PETITIONS AND
EXPLAINING MATERIAL DIFFERENCES BETWEEN PETITIONS
FOR U.S. PATENT NO. 7,489,914**

I. INTRODUCTION

Petitioner files herewith two Petitions challenging claims of U.S. Patent No. 7,489,914 (the “’914 patent”). Pursuant to the Consolidated Trial Practice Guide November 2019 (“TPG”), Petitioner submits this paper to “identify: (1) a ranking of the Petitions in the order in which it wishes the Board to consider the merits..., and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions.” TPG, 60.

II. RANKING OF PETITIONS

Per the Board’s TPG guidance, Petitioner ranks as follows:

RANK	PETITION	CLAIMS	GROUND
1	First Petition: IPR2025-00383 (challenges claims 1-2, 4- 20)	1-2, 5, 12-20	35 U.S.C. § 103(a) (Pre-AIA) over Francisco and JP466
		4, 6	35 U.S.C. § 103(a) (Pre-AIA) over Francisco and JP466 and Hirayama
		7-11	35 U.S.C. § 103(a) (Pre-AIA) over Francisco and JP466 and Okubora
2	Second Petition: IPR2025-00384 (challenges claims 1-2, 4- 20)	1-2 and 4-20	35 U.S.C. § 103(a) (Pre-AIA) over Yeh and Dalmia
		1-2 and 4-20	35 U.S.C. § 103(a) (Pre-AIA) over Dalmia and Hashemi

III. EXPLANATION OF MATERIAL DIFFERENCES AND REASONS FOR INSTITUTION OF MULTIPLE PETITIONS

The Board recognized that “there may be circumstances in which more than one petition may be necessary.” CTPG at 59-60. That circumstance is present here as each of the two filed petitions—referred to as the First Petition (IPR2025-00383) and the Second Petition (IPR2025-00384), respectively—relies upon a different priority date of the ’914 patent. The Second Petition demonstrates that the effective filing date for Challenged Claims of the ’914 patent is no earlier than April 23, 2004 and, as such, relies upon one of the inventor’s own publications in 2003 as § 102(b) prior art.

Petitioner files the First and Second Petitions concurrently and has not sought “a timing advantage that might otherwise occur were the petitions filed serially,” which further supports institution. *Samsung Electronics Col., Ltd. v. Ryan Hardin*, IPR2022-01335, Paper 13, 22-23 (PTAB Feb. 8, 2023) (Institution Decision).

IV. INSTITUTION OF ADDITIONAL PETITIONS IS WARRANTED

The Board has recognized “there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” TPG, 59.

These circumstances are present here.

Parallel Petitions here address a priority date dispute. The '914 Patent issued on a continuation-in-part (CIP) application (11/114,733) filed April 25, 2005 claiming priority (as a CIP) to Application 10/402,313 ("the '313 Appl."). EX1001, (63). The '313 Appl. was filed on March 28, 2003. EX1001, (63). The '914 Patent also separately also claims priority to a Provisional Application No. 60/565,254 ("the '254 prov") filed April 23, 2004. EX1001, (60).

The priority date—the effective filing date of the '914 patent claims—is in dispute. Patent Owner has asserted priority based on the '313 Appl. *See* Complaint, EX1035, p. 9. Petitioner asserts that the '313 Appl. does not provide written description support for the subject matter claimed in the '914 patent, and as such, the effective filing date of each of the claims of the '914 patent is no earlier than the filing date of the '254 prov—April 23, 2004. Accordingly, the First Petition presents challenges based on a first primary reference (Francisco) in combination with a second reference (JP466), which are prior art even with respect to the Patent Owner's asserted 2003 effective filing date. The Second Petition presents challenges based on a different primary reference (Dalmia) that is prior art published over one year prior to the filing date of the '254 prov (April 2004), which Petitioner shows is the earliest effective filing date of the '914 patent.

Dalmia is a reference authored by an inventor of the '914 patent (Sidharth Dalmia) published March 2003.

Parallel Petitions here challenge numerous complex claims. Patent Owner currently, in its Complaint, asserts the '914 patent “including **without limitation**” an independent claim and seven dependent claims are infringed. EX1035, p. 38 (emphasis added). Patent Owner’s attempt to reserve of rights to assert further claims on a timeline that could bar Petitioner’s challenge of such claims itself supports the filing both the First Petition and Second Petition. Further, the Challenged Claims, which include those listed in the complaint as well as other related claims, total over 750 words in text. And the claims recite in varied forms limitations concerning impedance, reactance and frequency-dependent characteristics of passive components and the circuits/devices to which matching networks of passives are matched in multi-band amplifier design. These aspects, while conventional to a POSITA, require thorough explanation of background principles.

Parallel Petitions here would not materially increase burden on the Board. The Board can efficiently resolve the grounds of the First and Second Petitions. The First Petition raises only a single challenge for the independent claims of the

Challenged Claims; and the Second Petition adds two challenges for all Challenged Claims each sharing reliance on the Dalmia reference.

V. CONCLUSION

The Board should institute trial on *both* the First and Second Petitions.

Respectfully submitted,

Dated: February 10, 2025
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