UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00115

U.S. Patent No. 8,407,609

PETITIONER'S REQUEST FOR REHEARING

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I. Introduction

Petitioner respectfully submits that, pursuant to 37 C.F.R. § 42.71(d), the Board should revisit and modify its decision to exercise its discretion under 35 U.S.C. § 314(a) to deny institution of this proceeding in light of the parallel district court litigation, *Uniloc 2017 LLC v. Google LLC*, No. 2:18-cv-502 (E.D. Tex.) ("Texas Litigation").

The Board's decision was based solely on its weighing of the factors articulated in *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). For the reasons discussed below, the Board's decision "represents an unreasonable judgment in weighing [these] relevant factors." *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 39 at 2-3 (PTAB Feb. 14,2014). Accordingly, Petitioner requests that the Board reweigh the *NHK Spring* factors and institute this proceeding.

II. Legal Standard

Under § 42.71(d), this "request must specifically identify all matters [Petitioner] believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or reply." The Board will review its Decision for abuse of discretion. 37 C.F.R. § 42.71(c). "An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence,

or if the decision represents an unreasonable judgment in weighing relevant factors." *Palo Alto Networks,* IPR2013-00369, Paper 39 at 2-3.

III. Argument

The Board's decision represents an unreasonable judgment in weighing the relevant factors for three reasons. First, the Board deviated from prior Board decisions by giving little weight to the inability of the Texas Litigation to address the validity of two of the three claims at issue. Second, the Board misapprehended and gave too little weight to the uncertainty surrounding when validity will be resolved in the Texas Litigation. And, third, the Board's decision undermines Congress' intent in creating IPR.

A. The Board's decision deviated from prior Board decisions by giving little weight to the inability of the Texas Litigation to address the validity of two of the three claims at issue.

Unlike in *NHK Spring*, where the Board determined the parallel district court litigation would "analyze the same issues" as the IPR, here the Texas Litigation cannot and will not analyze the majority of the issues presented in the petition. *NHK Spring*, Paper 8 at 20; Paper 7 at 2; Paper 6 at 12. This is because, as the Board acknowledged, "only claim 1 is currently at issue in the Texas Litigation," while "the Petition challenges both independent claim 1 and its dependent claims 2 and 3." Decision at 9. Nevertheless, the Board denied institution.

In this manner, the Board's decision deviates from prior Board decisions that gave significant weight to whether a district court would address the validity of all claims challenged in an IPR. In *Resideo Technologies, Inc. v. Innovation Sciences, LLC*, for example, Patent Owner urged the Board to deny institution in light of a district court litigation in which the pre-trial conference was scheduled more than nine months before a Final Written Decision would issue. IPR2019-01306, Paper 19 at 10 (PTAB Jan. 27, 2020). The Board declined, finding "there is not a substantial overlap in the issues" in part because, as in this case, "the district court will not resolve the patentability of most of the claims challenged in the Petition." *Id.* at 13. *Facebook, Inc.et al. v. Blackberry Ltd.*, is similar. IPR2019-00899, Paper 15 at 11–12 (PTAB Oct. 8, 2019). There, the Board instituted IPR notwithstanding trial scheduled six months before a Final Written Decision would issue because, as in this case, trial would not resolve the patentability of most of the claims challenged in the IPR. *See also Oticon Med. AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 23 (Oct. 16, 2019) (precedential) (instituting IPR where it "would not be directly duplicative of the District Court consideration of validity"); *Uniden Am. Corp. v. Escort Inc.*, IPR2019-00724, Paper 6 at 7 (PTAB Sep. 17, 2019) (instituting IPR notwithstanding a district court trial scheduled three months before a Final Written Decision would issue because the IPR challenged claims not at issue in the district court).

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