UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00755

U.S. Patent No. 6,366,908

PETITIONER'S REPLY TO

PATENT OWNER'S PRELIMINARY RESPONSE

I. Introduction

Petitioner Google LLC submits this reply to explain why, under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board should *not* exercise its discretion to deny institution of this IPR in light of a co-pending district court litigation, which was recently transferred to the Northern District of California. (Ex. 1046.) Uniloc contends that the *Fintiv* factors favor denial, but Uniloc neglected to inform the Board that, before Uniloc filed its preliminary response, the Board rejected Uniloc's nearly identical arguments under a nearly identical set of facts and instituted review in *Google LLC v. Uniloc 2017 LLC*, IPR2020-00441, Paper 13 (PTAB July 17, 2020). In that case, among other things, Uniloc argued that there was no evidence the transferee court would grant a stay. Later, however, Uniloc *agreed* to a stay, which the transferee court granted. (Ex. 1047.)

In this case, Uniloc also contends that, "[w]hile the litigation *was* stayed when Google filed its Petition, that is no longer the case." (Paper 8 at 7.) This is not true. The parties agreed to stay all proceedings until "the Northern District of California has set a schedule." (Ex. 1048.) While that court docketed the case last week and set a case management conference for November 10, 2020, it has not set a schedule—indeed the parties' proposals for such a schedule are not due until November. Thus, the parties' stipulation to treat the case as stayed remains in

effect. For these reasons and those further discussed below, there is no reason to believe that the state of the district court case corresponding to this IPR warrants a discretionary denial of institution any more than the district court case corresponding to IPR2020-00441.

II. Factor 1: The litigation would likely be stayed if the Board institutes this IPR

In discussing the first two *Fintiv* factors, in IPR2020-00441 the Board stated that, "[a]lthough no court-ordered stay is in effect, the fact that the Northern District of California has thus far expended no more than minimal resources weighs in favor of institution." IPR2020-00441, Paper 13 at 35. As in that case, the district court here has expended only minimal resources, only docketing the case and setting a case management conference to occur in nearly three months.

In addition, the Northern District of California frequently stays cases in view of IPRs, both before and after institution. *See, e.g.*, *Uniloc 2017 LLC v. Apple Inc.,* No. 3:19-cv-01904, Dkt. 89 (N.D. Cal. Jan. 30, 2020) (after institution); *J&K IP Assets, LLC v. Armaspec, Inc.*, No. 3:17-cv-07308, Dkt. 61 (N.D. Cal. Sep. 12, 2019) (same); *Cellwitch Inc. v. Tile, Inc.*, No. 4:19-cv-01315, Dkt. 68 (N.D. Cal. Jan. 17, 2020) (before institution). Indeed, it granted the parties' stay pending resolution of IPR2020-00441. In addition, over the past fifteen months, district courts have stayed Uniloc litigations pending IPR twenty-eight times—most of which Uniloc either jointly requested or did not oppose. Google intends to move to

stay the district court case at its earliest opportunity.

Uniloc does not attempt to distinguish the Board's reasoning in IPR2020-00441, but it does attempt to distinguish other cases. For example, Uniloc tries to distinguish *Cellwitch* by explaining that "the court found it significant that the parallel IPR 'sought review of every claim in the [challenged patent].'" Paper 8 at 8 (citing *Cellwitch*, Dkt. 68, slip op. at 3). But in *Cellwitch*, the court found "it is not clear which claims plaintiff will ultimately assert," *Cellwitch*, Dkt. 68, slip op. at 3, so it was meaningful that all claims had been challenged. Here, Petitioner challenged claims 6-12, which encompasses all claims asserted in the litigation.

In determining whether to grant a stay, a court considers "(1) whether discovery is complete and whether a trial date has been set; (2) whether a stay would simplify the issues in question and trial of the case; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party." *Personal Web Techs., LLC v. Apple Inc.*, 69 F. Supp. 3d 1022, 1025 (N.D. Cal. 2014). Here, a stay is likely because discovery in the district court litigation is not yet complete (depositions remain to be taken and expert reports have not been served and will only be delayed by the transfer), claim construction proceedings are not yet complete (the claim construction hearing remains to be set), and no trial date is set. Given that Uniloc previously agreed to stay the corresponding district court case for three months before the transfer decision even issued, Uniloc cannot

claim undue prejudice. 4:20-cv-05346 Dkt. 165. In addition, this IPR would greatly simplify the issues in the district court because the '908 patent is the only patent at issue and the validity of all asserted claims will be assessed by this IPR. Given the new court's unfamiliarity with the case, simplifying the issues may be a particularly compelling factor for granting a stay.

III. Factor 2: There is no set trial date

Due to the transfer, it will be at least three months before the new court sets a schedule including a trial date. The court set an initial case management conference for November 10, 2020, and the court presumably will not enter a schedule until sometime after that conference. *Uniloc 2017 LLC v. Google LLC*, No. 4:20-cv-05346, Dkt. 177 (N.D. Cal. Aug. 7, 2020). In any event, attempting to predict the case schedule would be pure speculation. *See* IPR2020-00441, Paper 13 at 35 ("[W]e agree with Petitioner that 'any expectation of a schedule or trial date would be pure speculation.'").

In addition, trial may be scheduled to occur after the expected IPR decision date. And a possible stay pending IPR in the Northern District of California would only further delay trial. As the Board has observed:

> There is no *per se* rule against instituting an *inter partes* review when any Final Decision may issue after a district court has addressed the patentability of the . . . claims. Nor should there be. Instituting under such circumstances gives the district court the opportunity, at its

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.