UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

IPR2020-00756

PATENT 9,564,952

PATENT OWNER SUR REPLY TO PETITIONER'S REPLY TO THE PRELIMINARY RESPONSE

Google's belated arguments as to discretionary denial fail to support Google's request that the Board institute trial despite the advanced stage of a parallel district court proceeding. Google does not persuasively dispute that, even after transfer of the litigation between the same parties, (1) there is no evidence that a stay is likely or (2) there is no evidence that a final written decision here would necessarily precede a jury trial, and (3) it is a demonstrable and undisputed fact that the validity issues in these parallel proceedings completely overlap. Accordingly, institution should be denied for the reasons emphasized here and in Uniloc's Preliminary Response.

A. There is no evidence the transferee court will grant a stay (Factor 1).

Google does not dispute that *Apple v. Fintiv*[1] "considers fact-specific and case-specific guidance from the district court, which is entirely, lacking here." POPR at 5. At most, Google's Reply generically asserts that the Northern District of California "frequently" (and hence admittedly not always) stays cases in view of IPRs; and Google cites cases without regard to facts and analyses set forth therein.

Google neglects to mention that one of the cases it cites as granting a stay *after* a Board decision on institution was based on an *unopposed* motion. *See Uniloc 2017 LLC v. Apple Inc.*, No. 3:19-cv-01904, Dkt. 89 (N.D. Cal. Jan. 30, 2020). The two Northern District of California cases Google cites as granting stays *before* a Board decision on institution both acknowledge that motions to stay are highly individualized matters. *Cellwitch Inc. v. Tile, Inc.*, No. 4:19-cv-01315, Dkt. 68 (N.D. Cal. Jan. 17, 2020); *Elekta Ltd. v. ZAP Surgical Sys., Inc.*, No. 4:19-cv-02269, Dkt.

[1] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

42 (N.D. Cal. Nov. 8, 2019). For example, in *Cellwitch*, the court found it significant that the parallel IPR "sought review of every claim in the [challenged patent]." Slip op. at 3. Here, the petition seeks review of only claims 6 through 12.

Google also does not deny, or even acknowledge, that *Cellwitch* also considered the fact that "[c]laims [sic] construction briefing has not yet been filed" weighed in favor of a stay. POPR 8–9 (citing *Cellwitch*, at 4). This factor weighs against a stay here because claim construction briefing in the parallel proceeding was completed long ago and is made of record as Exhibits 1004, 1005, and 1006 to the Petition. While Google argues that the transferee district has yet to expend significant resources, Google does not deny that the litigation in the transferee district will commence at an advanced stage and will benefit from the work completed prior to transfer.

Cellwitch also found that the defendant seeking stay had "instigated the IPR proceedings in a timely fashion." *Id*. (citing *Cellwitch*, at 5). Here, Google offers no explanation for why it delayed filing its petition until *seven months after* it had served its overlapping invalidity contentions in litigation (Ex. 2001), and long after the court and the parties had already expended considerable resources in litigation.

Cellwitch also favorably cites *Finjan, Inc. v. Symantec Corp.*, 139 F. Supp. 3d 1032, 1037 (N.D. Cal. 2015) for the proposition that the court may consider whether, if the court "were … to deny the stay until a decision on institution is made, the parties and the Court would expend significant resources on issues that could eventually be mooted by the IPR decision." *Cellwitch*, at 5. Here, Google fails to articulate what court resources, if any, allegedly would be expended in the interim.

The other Northern District of California opinions Google cites each similarly consider highly individualized factors applied to the particular facts of the case. Google's speculative and unsupported assertion that the Northern District of California will likely stay the litigation simply cannot be squared with the analyses applied in the court opinions Google has cited. Google's failure to address the analysis in the opinions it cites is both telling and unsurprising, given Uniloc anticipated in its Preliminary Response that Google would (yet again) merely offer citations without explanation. POPR 7–9.

Accordingly, Google's bald assertion concerning the mere possibility of a stay, which is theoretically present in any case, fails.

B. Google fails to establish it is likely trial will be rescheduled in the transferee district well over an entire year from now (Factor 2).

Google suggests that the court's transfer order renders moot the consideration of the proximity of the court's trial date to the Board's projected statutory deadline for a final written decision. Rep. 4. According to Google, predicting a trial date in the transferee district would be speculative. *Id.* However, the new trial date need not be predicted with absolute certainty. It is sufficient to consider the likelihood of a jury trial being completed sometime prior to an expected final written decision.

Google does not deny that trial would have to be rescheduled in the transferee district well over an *entire year* from now for this factor to weigh against discretionary denial. Google also does not deny that this is highly unlikely under the circumstances. That trial will likely be expedited in the transferee district is evidenced at least by the undisputed fact that claim construction briefing was competed long

ago, which is a factor the transferee district considers as disfavoring a stay *because it indicates the litigation has reached an advanced stage*.

Google also provides no authority for its apparent interpretation of this factor as being independently dispositive in the event there is no trial date set. Google provides no precedential authority in support of such an interpretation. This factor is simply listed on one of several other relevant factors in *Fintiv*; and while the burden of proof lies with Google, it offers no evidence in support of any speculation that a jury trial will postdate an expected final written decision (in the event of institution).

C. Google fails to address or even acknowledge the substantial investment in the parallel proceeding by the court and the parties (Factor 3).

Google misstates this factor as being forward looking. Rep. 5. In doing so, Google fails to recognize that the third factor is *retrospective* at least in that it weighs the amount of investment the parties and court *have put* into parallel litigation. Indeed, the *Apple v. Fintiv* opinion repeatedly uses the past tense in defining this factor in the context of work *already completed*. *Fintiv*, at 9–10. For example, the *Apple v. Fintiv* opinion itself offers the following instruction:

> If, at the time of the institution decision, the district court ***has issued substantive orders*** related to the patent at issue in the petition, this fact favors denial. Likewise, district ***court claim construction orders*** may indicate that the court and parties ***have invested*** sufficient time in the parallel proceeding to favor denial. … This investment factor is related to the trial date factor, in that more work ***completed*** by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.

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