UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED,

Petitioner,

v.

UNM RAINFOREST INNOVATIONS,

Patent Owner.

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Case IPR2021-00375

Patent No. 8,265,096 B2

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**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE**[1]

[1] This reply is submitted pursuant to authorization granted by the Board during the parties' May 18, 2021 conference call, as formalized in its May 19, 2021 Order (Paper 9).

In its Preliminary Response, UNM argued that *Fintiv* Factor 6 weighs against institution because the Petition did not identify ASUSTek Computer Inc. ("ASUSTek") and LG Electronics, Inc. ("LG") as real parties in interest (RPIs). POPR (Paper 7) at 10. UNM also argued that *Fintiv* Factor 2 weighs against institution because of the proximity of the trial date in the Dell litigation. *Id.* at 6-7. UNM's arguments are misplaced—neither of these *Fintiv* factors weighs against institution.

## I. ARGUMENT

### A. ASUSTek and LG Are Not RPIs To This Proceeding

UNM has not presented any evidence to "reasonably bring[] into question the accuracy of a petitioner's identification of the real parties in interest." *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018) ("[A] patent owner must produce some evidence to support its argument that a particular third party should be named a real party in interest."). To the contrary, UNM merely identified ASUSTek and LG as customers of Qualcomm; identified ASUSTek as a defendant in a litigation involving the '096 patent; and incorrectly theorized that LG, despite not being a defendant in any active litigation involving the '096 patent, somehow was owed an indemnity obligation from Qualcomm. POPR at 10-11. UNM is incorrect that these relationships qualify either third party as an RPI.

Neither being a customer nor a co-defendant in a related litigation elevates a third party to an RPI. *Wi-Fi One, LLC v. Broadcom Corp.*, 887 F.3d 1329, 1337–40 (Fed. Cir. 2018) (finding that D-Link, who was a customer of petitioner and a named defendant in a related litigation, was not an RPI and affirming the Board's denial of requests for RPI discovery); *WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1321 (Fed. Cir. 2018). Moreover, theoretical, and incorrect, allegations of indemnity obligations also are insufficient to elevate a third party to an RPI. *WesternGeco*, 889 F.3d at 1321 ("ambiguous" indemnity agreement that "did not show any obligation of ION to defend PGS from a patent infringement lawsuit" did not give rise to a RPI relationship).

Moreover, neither ASUSTek nor LG exercised or could have exercised any control over Qualcomm's petition, neither were involved in the drafting of the petition, and neither provided any funding therefor. *Puzhen Life USA, LLC v. ESIP Series 2, LLC*, IPR2017-02197, Paper 24 at 10 (PTAB Feb. 27, 2019). In contrast, Qualcomm has indemnity obligations to Dell and has coordinated with Dell and its subsidiary EMC in defense in the Dell litigation and as it relates to the Petition, including on the submission of a *Sand Revolution*-style stipulation that mitigates the risk of duplicative efforts between the district court and the Board (Petition at 8-9). Qualcomm thus identified Dell and EMC as RPIs out of an abundance of caution.

### B. The Relative Timing Of The District Court Case And This IPR Should Be Given Little If Any Weight

UNM argues that the trial date in the Dell litigation, currently scheduled to begin on November 8, 2021, "strongly favors" the Board exercising its discretion to deny institution. POPR at 6-7. However, UNM fails to mention that Qualcomm, not Dell, has filed this IPR, and that Judge Albright's overbooked trial schedule may cause the trial date to be rescheduled to a later date.

Judge Albright booked at least three other trial to begin on the same November 8, 2021 date, even though only one trial can be held on that date. *FG SRC, LLC*[2] *v. Intel Corp.*, No. 1:20-cv-00834, Dkt. 57 at 1 (W.D. Tex. Feb. 4, 2021) (Order setting jury trial for Nov. 8, 2021); *Theta IP, LLC v. Samsung Elecs. Co., Ltd.*, No. 6:20-cv-00160, Dkt. 35 at 3 (W.D. Tex. Nov. 19, 2020) (same); *Kuster v. Western Digital Techs, Inc.*, No. 6:20-cv-00563, Dkt. 57 at 4 (W.D. Tex. Feb. 9, 2021) (same). Moreover, Judge Albright has numerous other cases scheduled for trial in Nov. 2021.

Because of the substantial uncertainty surrounding the trial date of the Dell litigation, the second *Fintiv* factor is neutral or weighs only slightly against institution. *HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 9–10 (PTAB Jan. 14, 2021) (Factor 2 neutral despite trial scheduled five months before final written decision where "the district court's . . . trial date may slip . . . [b]ecause the same trial date is set for two cases"); *Apple Inc. v. Parus Holdings, Inc.*, IPR2020-00686, Paper 9 at 13 (PTAB Sept. 23, 2020) (Factor 2 neutral in view of

[2] Counsel for UNM in the Dell litigation represents Plaintiff FG SRC in this case.

"the substantial uncertainty in the Texas court's 'Predicted Jury Selection/Trial' date."); *Facebook, Inc. v. USC IP Partnership, L.P.*, IPR2021-00033, Paper 13 at 11–12 (PTAB Apr. 30, 2021) (granting institution despite scheduled trial date being five months before statutory FWD deadline and finding factor 2 to only "slightly" weigh against institution); *Samsung Elecs. Co. v. Arbor Global Strategies LLC*, IPR2020-01020, Paper 11 at 10 (PTAB Dec. 2, 2020) (granting institution despite scheduled trial date being eight months before statutory FWD deadline and finding *Fintiv* factor 2 to weigh only "moderately" against institution).

Lastly, even if the Board were to find that the second *Fintiv* factor weighs in favor of exercising discretion to deny institution, the Board should decline to exercise its discretion in view of the other factors that favor institution. *See Samsung Elecs. Co., Ltd. v. Nanoco Techs. Ltd.*, IPR2021-00182, Paper 17 at 9–10 (PTAB May 19, 2021) (granting institution despite scheduled trial date being more than seven months before statutory FWD deadline under similar procedural facts, including petitioner's submission of a stipulation); *Peag LLC v. Varta Microbattery GMBH*, IPR2020-01212, Paper 8 at 17, 22-23 (PTAB Jan. 6, 2021) (granting institution despite "seven months" difference).

## II. CONCLUSION

For the foregoing reasons, neither *Fintiv* factor 2 nor 6 weighs against institution. Discretionary denial under § 314 is not appropriate.

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