

**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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PTAB Case No. IPR2021-00375

Patent No. 8,265,096 B2

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**SUR-REPLY**  
**IN SUPPORT OF PATENT OWNER'S**  
**PRELIMINARY RESPONSE TO PETITION FOR**  
***INTER PARTES* REVIEW OF U.S. PATENT NO. 8,265,096 B2**

Pursuant to the Board’s May 19, 2021 ORDER (Paper 9), Petitioner and Patent Owner were granted a reply and sur-reply limited to *Fintiv* Factors 2 and 6.

**I. FINTIV FACTOR 2 (TRIAL DATE PROXIMITY)**

The Dell trial is in Nov. 2021. EX2006. The Board’s institution and final written decisions here are due in July of 2021 and 2022, respectively. Even the institution decision would barely beat the Dell trial, and the final written decision cannot be expected until *a full eight months afterwards*. Further, third party ZyXEL’s request to join this IPR and also introduce a new issue, *i.e.*, Patent Owner’s ownership—if granted—would be highly likely to further delay this IPR. IPR2021-00734, Papers 3 and 7 (joinder motion and response).

Further, the WDTX, and particularly Judge Albright, does not easily move trial dates. Indeed, he has once already refused to move this trial date. *Compare id. with* EX2005. Further, Judge Albright “is fully open and equipped to safely conduct jury trials in the COVID-19 pandemic.” *Ecofactor, Inc, v. Vivint, Inc.*, 6:20-cv-00080 (Order dated Apr. 16, 2021) (W.D. Tex.) (Alan D. Albright).

Finally, Petitioner deceptively argues that “Judge Albright booked at least three other trial [sic] to begin on the same November 8, 2021 date, even though only one trial can be held on that date.” Reply at 3. First, courts set trials on the same date because many cases settle “on the courthouse steps.” Thus, on any given trial date, five to ten cases may be scheduled. Most are resolved. Indeed,

one of Petitioner’s three cases set for that date has *already been dismissed*. *FG SRC, LLC2 v. Intel Corp.*, No. 1:20-cv-00834, Dkt. 76 (W.D. Tex. Apr. 6, 2021) (stipulation of dismissal). The second case has been stayed. *Kuster v. Western Digital Techs, Inc.*, No. 6:20-cv-00563, Text Order issued Mar. 12, 2021 (W.D. Tex.) (granting joined motion to stay). Finally, the third case recognized that “the parties feel[] that they have *a need for more time and perhaps new schedule and/or deadlines.*” *Theta IP, LLC v. Samsung Elecs. Co., Ltd.*, No. 6:20-cv-00160, Dkt. 80 (W.D. Tex. May 26, 2021). Thus, the Dell litigation is literally *the only* case ready to proceed to trial on Nov. 8, 2021.

Petitioner’s other citations are highly distinguishable. First, in *HP v. Slingshot*, this factor was neutral despite a five-month delay only because the “Western District of Texas [had] issued a suspension order every month for the past nine months suspending all trials.” *HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 10 (PTAB Jan. 14, 2021). This order is no longer in effect and the court “is fully open and equipped to safely conduct jury trials in the COVID-19 pandemic.” *Ecofactor, Inc. v. Vivint, Inc.*, 6:20-cv-00080 (Order dated Apr. 16, 2021) (W.D. Tex.) (Alan D. Albright). Next, in *Apple Inc. v. Parus Holdings, Inc.*, the Board found this factor to be neutral despite a two-month delay because the WDTX scheduling order—also issued during the trial suspension period—explicitly stated that the “jury selection/trial date” was “predicted” and,

thus, uncertain. *Apple Inc. v. Parus Holdings, Inc.*, IPR2020-00686, Paper 9 at 11 (PTAB Sept. 23, 2020). No such uncertainty exists here because the suspension has been lifted. Next, in *Facebook, Inc. v. USC IP Partnership, L.P.*, the court held this factor only “slightly” in favor of denial of institution because “the case [was] still at a relatively early stage, with fact discovery having begun less than two months ago and not set to close until [three months after the institution decision.]” *Facebook, Inc. v. USC IP Partnership, L.P.*, IPR2021-00033, Paper 13 at 12 (PTAB Apr. 30, 2021). Here, fact discovery closes *even before the institution decision* is likely to be rendered (July 16 versus July 22). EX2006. Finally, in *Samsung Elecs. Co. v. Arbor Global Strategies LLC*, the Board found this factor *moderately* in favor of denial in light of an 8-month delay between trial and IPR only because “the District Court is *likely to allow Petitioner to refile a motion for stay and may grant a stay.*” *Samsung Elecs. Co. v. Arbor Global Strategies LLC*, IPR2020-01020, Paper 11 at 10 (PTAB Dec. 2, 2020). Qualcomm has provided no evidence demonstrating that a stay would be likely here, and the cases cited in Patent Owner’s preliminary response affirmatively demonstrate the opposite. (Paper 8 at 5).

Petitioner’s remaining citations are: (1) outside of the scope of the reply, as they relate to other *Fintiv* factors, and (2) both in support of *Fintiv* factor 2 being *strongly in favor* of denial based on the eight month delay. Reply at 3 (*citing*

*Samsung Elecs. Co., Ltd. v. Nanoco Techs. Ltd.*, IPR2021-00182, Paper 17 at 9–10 (PTAB May 19, 2021) (Factor 2 favors denial due to seven month delay between trial and IPR); *Peag LLC v. Varta Microbattery GMBH*, IPR2020-01212, Paper 8 at 17, 22-23 (PTAB Jan. 6, 2021) (same)). *Fintiv* factor 2 unquestionably strongly favors denying institution because the Dell litigation is virtually guaranteed to conclude 8 months before this IPR, and there is no reasonable likelihood of a stay.

## II. *FINTIV* FACTOR 6

Qualcomm admits that Dell and EMC are RPIs because they are customers named as defendants in a related district court action in the Western District of Texas. Paper 1 at 3. Further, Qualcomm admits that it “has indemnity obligations to Dell and has coordinated with Dell and its subsidiary EMC in defense of the Dell litigation.” Reply at 2. Qualcomm further acknowledges “ASUSTek and LG as customers of Qualcomm” who are similarly situated as Dell and EMC, and that both are also named as a defendant in related district court actions. Notably, Qualcomm does not deny that its customer agreements with ASUSTek and LG contain indemnity provisions akin to its agreements with Dell and EMC. At a minimum, Qualcomm should provide its indemnity agreements with ASUSTek and LG to substantiate its argument that ASUSTek and LG are not similarly situated as Dell and EMC. Evaluation of *Fintiv* factor 6 requires corroboration of Qualcomm’s say-so by review of its ASUSTek and LG indemnity agreements.

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