

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

RFCYBER CORP.,  
Patent Owner

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IPR2021-00955  
U.S. Patent No. 9,189,787

**PETITIONER'S AUTHORIZED REPLY TO  
PATENT OWNER'S PRELIMINARY RESPONSE**

Petitioner submits this reply in response to Patent Owner's Preliminary Response ("POPR") (Paper 6). Due to developments after the Petition was filed, the *Fintiv* factors now more strongly favor institution. Petitioner's new *Sotera*-type stipulation eliminates all overlap between this IPR and the district court proceeding, and the parties' Joint Claim Construction Statement confirms that the district court and parties will have invested very little in the pertinent invalidity issues at the time of institution.

**I. There is No Overlap Between This IPR and the District Court Proceeding (Factor 4)**

To avoid any overlap between this IPR and the parallel district court proceeding, Petitioner stipulates that, if this IPR is instituted, it will not pursue in the district court litigation (*RF Cyber Corp. v. Google LLC et al.*, No. 2:20-cv-00274) the specific grounds asserted in the IPR petition, or any other ground that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under 35 U.S.C. §§ 102 or 103 on the basis of prior art patents or printed publications). See *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (Dec. 1, 2020) (precedential) ("*Sotera*"). For these grounds, Petitioner defers to the Board's recognized technical "expertise." See *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1079 (Fed. Cir. 2015). Thus, there will be no overlap between this IPR and the district court proceeding, which "weighs strongly in favor of not exercising discretion to deny institution." *Sotera* at 19.

The Board regularly finds that *Sotera*-type stipulations overcome earlier trial dates, including trial dates even earlier than the one scheduled in this case. *See, e.g., Samsung Elecs. Co., Ltd. v. Acorn Semi, LLC*, IPR2020-01183, Paper 17 at 43, 38 (Feb. 10, 2021) (instituting when district court trial was scheduled 10 months before final written decision, and petitioner made *Sotera*-type stipulation); *Cosentino S.A.U. v. Cambria Co., LLC*, IPR2021-00216, Paper 11 at 8-17 (May 18, 2021) (instituting when district court trial was scheduled 7 months before final written decision). Thus, *Fintiv* factor 4 strongly favors institution.<sup>1</sup>

## **II. There is Minimal Investment in the Validity Issues in the District Court Proceeding (Factor 3)**

Patent Owner identifies many litigation-related activities, including *Markman* briefing, as evidence of significant investment in the parallel proceeding. POPR, 21-22. *Sand Revolution II* emphasized, however, that the focus of this factor is not the total amount invested by the court and parties, but rather the amount invested “in the merits of the invalidity positions.” *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24

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<sup>1</sup> Patent Owner's arguments regarding overlap ring hollow. In co-pending PGR2021-00028 and -00029, Patent Owner similarly argued for discretionary denial alleging overlap, but upon institution of those PGRs, ceased asserting the challenged patent in the district court.

at 10 (June 16, 2020) (informative) (“*Sand*”). Here, as in *Sand*, “much of the district court’s investment relates to ancillary matters untethered to the validity issue itself.” *Id.*

For example, although *Markman* briefing and the *Markman* hearing will likely take place before institution, this activity is ancillary to the invalidity issues raised in the Petition. Petitioner construes only a single term in the Petition (“emulator”), and that term is agreed upon by the parties in the Joint Claim Construction Statement. Petition, 16-17; GOOG-1034, 2. Patent Owner does not construe any terms in the POPR. *See generally* POPR. Accordingly, even if the district court issues a *Markman* order prior to institution, that order will not reflect any investment in the merits of the invalidity issues here. Under similar circumstances, the Board consistently finds that Factor 3 favors institution. *See, e.g., Huawei Tech. Co., Ltd., v. WSOU Invs., LLC*, IPR2021-00229, Paper 10 at 12-13 (Jul. 1, 2021) (finding factor 3 favoring institution and noting that “while a *Markman* hearing has occurred, much of the invested effort is unconnected to the patentability challenges”); *Apple Inc. v. Koss Corp.*, IPR2021-00381, Paper 15, at 16-17 (Jul. 2, 2021) (finding “little evidence of risk that we will duplicate work performed in the District Court Lawsuit” when “there is no indication as to how [the *Markman*] order might impact questions of patentability”). Moreover, as in *Sand*, “much work remains in the district court case as it relates to invalidity,”

including completing expert discovery and filing dispositive motions on validity issues. Ex. 2001, 3; *Sand* at 10-11.

Accordingly, a lack of investment in invalidity, combined with Petitioner's promptness in filing only *one week* after being served infringement contentions "weigh[s] against" denial. *Apple Inc. v. Fintiv, Inc.*, IPR2019-00019, Paper 11 at 11 (Mar. 20, 2020) (precedential); *see also Dell Technologies Inc. v. WSOU Invs., LLC*, IPR2021-00272, Paper 13 at 11 (Jul. 1, 2021).

### **III. Petitioner's Pending Transfer Motion in the District Court Proceeding May Impact the Scheduled Trial Date (Factor 2)**

On August 27, 2021, Petitioner filed a renewed motion to stay the district court proceeding to permit the district court to resolve Petitioner's pending motion to dismiss or transfer the case. GOOG-1035, 1-2; GOOG-1036 ("transfer motion"). Petitioner's transfer motion was filed on December 7, 2020, and the district court held a hearing on the venue motion on June 29, 2021. Given the nine-month pendency of the transfer motion, it is likely that the district court will soon decide both the transfer motion and the renewed stay motion. If the district court grants the transfer motion or stays the district court proceeding, the scheduled trial date would be replaced with a new trial date (if transferred<sup>2</sup>) or delayed (if

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<sup>2</sup> Petitioner will seek authorization for further briefing if, prior to institution, the motion is granted or Petitioner is granted relief in its N.D. Cal. APA action.

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