

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

RFCYBER CORP.,
Patent Owner

IPR2021-00956
U.S. Patent No. 9,240,009

**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.¹

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

Patent Owner identifies 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 at 10 (June 16,

¹ 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.

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.*

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 two terms in the Petition: (1) “secure element” or “SE,” and (2) “an interface to receive a secure element.” Petition, 13-15. Patent Owner does not construe any terms in the POPR. In the district court proceeding, neither party proposes construing term 2, and Patent Owner proposes only “Plain and ordinary meaning” for term 1 while Petitioner proposes the same construction as in the Petition. GOOG-1034, 1-3; GOOG-1041, 6; GOOG-1042, 16. Thus, even if the district court issues a *Markman* order prior to institution, that order will reflect minimal 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) (factor 3 favored institution 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 transferred²) or delayed (if

² 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.

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.