UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

RFCYBER CORP.,
Patent Owner.

Patent No. 9,240,009
Filing Date: January 16, 2012
Issue Date: January 19, 2016

Inventors: Liang Seng Koh, Hsin Pan, and Xiangzhen Xie
Title: MOBILE DEVICES FOR COMMERCE OVER UNSECURED NETWORKS

PATENT OWNER'S SURREPLY

Case No. IPR2021-00956

I. INTRODUCTION

Google's Reply does not identify any developments in the District Court Litigation that would tilt the *Fintiv* analysis towards institution. In a case like this one, where the nearly all substantive work will be complete before the Board's Institution Decision, Google's belated stipulation is not enough to justify institution.

II. THE DISTRICT COURT'S TRIAL DATE IS EIGHT MONTHS BEFORE THE PROJECTED STATUTORY DEADLINE FOR A FINAL WRITTEN DECISION

As noted in Patent Owner's POPR, the District Court in the Texas Action has scheduled trial for March 2022. POPR at 20-21. The projected statutory deadline for this proceeding is in November 2022, eight months later. *Id.* This factor thus weighs heavily in favor of discretionary denial. *E.g.*, *Google LLC v. Ecofactor, Inc.*, IPR2021-00488, Paper No. 12, at 11-12 (P.T.A.B. Aug. 11, 2021) ("*Ecofactor*") (trial date six months ahead of Final Written Decision deadline weighed in favor of denying institution).

Google's only response is to speculate, again, that the case may be transferred or stayed pending resolution of Google's motion to transfer. Reply at 4-5. As explained in the POPR, the Court is unlikely to grant Google's Motion. POPR at 20-21. In any event, the Board considers "trial dates that have been set in parallel litigations," and speculative delays are not relevant to this factor. *E.g.*, *Ecofactor*, IPR2021-00488, Paper No. 12, at 11-12 (finding factor weighed in favor of

discretionary denial and noting "Because the trial in the District Court proceeding is scheduled more than six months before the due date for the Final Written Decision, even if there are some delays, the District Court proceeding is likely to result in a trial verdict in advance of our statutory due date.").

III. THE PARTIES HAVE INVESTED HEAVILY IN THE DISTRICT COURT PROCEEDINGS AND WILL HAVE INVESTED EVEN MORE BY THE INSTITUTION DECISION

Google argues that this factor weighs against denial because, in Google's view, little work will have been completed relating to validity. Reply at 2-4. Google is wrong.

The parties have already invested heavily in validity issues. As discussed in the POPR, the parties have invested heavily in claim construction issues and discovery, including discovery related to validity. POPR at 21-23.

Moreover, by the time of the Board's Institution Decision, the parties and the District Court will have invested far more. Fact discovery will be complete, and expert discovery will be nearly so. *Id.* The parties will have served both opening and rebuttal expert reports on validity and infringement and will be in the midst of expert depositions and preparing dispositive motions. *Id.* In similar circumstances, the Board has held that this factor strongly favors denying institution. *E.g.*, *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper No. 12 at 10-11 (P.T.A.B. Jul. 7, 2021).

Google's cited cases dealt with far different situations. In *Huawei Techs. Co., v. WSOU Invs., LLC*, the Board found this factor to weigh in favor of institution when fact discovery and expert discovery would not be complete until four and six months after the institution decision, respectively. IPR2021-00229, Paper 10 at 11-13 (P.T.A.B. Jul. 1, 2021). Similarly, in *Apple, Inc. v. Koss Corp.*, at the time of the institution decision, "fact discovery ha[d] just begun, final infringement and invalidity contentions are not yet due, and expert discovery is months away." IPR2021-00381, Paper No. 15 at 16-17 (P.T.A.B. Jul. 2, 2021). Finally, in *Sand*, the Board again noted that "fact discovery is still ongoing, expert reports are not yet due, and substantive motion practice is yet to come." *Sand Revolution II, LLC v. Cont'l Intermodal Group-Trucking LLC*, IPR2019-001393, Paper No. 24 at 10-11 (P.T.A.B. Jun. 16, 2020). Even then, the Board did not find that this factor weighed against denying institution. *Id.* at 11.

Google also suggests that it was diligent in filing its Petition roughly nine months after it was served with the complaint in the District Court Litigation because it filed the Petition one week after being served with RFCyber's infringement contentions. Reply at 4. But the Petition challenges every claim of the '009 Patent; this is not a situation where Google carefully chose which claims to challenge based on infringement contentions. Google's alleged diligence is thus of little weight.

Accordingly, this factor weighs strongly in favor of denying institution.

IV. GOOGLE'S BELATED STIPULATION DOES NOT JUSTIFY INSTITUTION

Google submitted a stipulation with its Reply. Google does not explain why it did not provide a stipulation with its Petition. In any event, Google's stipulation does not justify ignoring the *Fintiv* factors and instituting trial on this Petition.

As discussed above, all other factors weigh in favor of denying institution. In similar circumstances, where trial is long before the Final Written Decision date and the parties will have completed or nearly completed discovery at institution, the Board has denied institution. *E.g.*, *Cisco*, IPR2021-00333, Paper No. 12 at 12-13. Accordingly, the Board should disregard Google's stipulation and deny institution.

V. ALL OTHER FACTORS FAVOR DENYING INSTITUTION

Google makes no argument in its Reply as to *Fintiv* Factor 1 (evidence that a stay will be granted) and Factor 5 (that Petitioner is the Defendant in the District Court Litigation). Accordingly, as explained in the POPR, these factors weigh in favor of denying institution.

Factor 6 (other circumstances) also weighs in favor of denying institution. Google argues that the public is best served by determining validity as soon as possible because "RFCyber separately asserted the same patent against three additional defendants over the course of a year." Reply at 5. Other proceedings are not relevant to the *Fintiv* factors, which consider "all relevant circumstances of the

DOCKET ALARM

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.