

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. and
SAMSUNG ELECTRONICS CO., LTD.,

Petitioners,

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 SUR-REPLY

Case No. IPR2021-00981

Exhibit No.	Description
2001	<i>RF Cyber Corp. v. Google LLC, et al.</i> , No. 2:20-cv-00274-JRG, Dkt. 63 (E.D. Tex. June 10, 2021)
2002	Samsung Notice of Intent to Serve Subpoenas on Nokia Corp., served June 21, 2021
2003	Samsung Notice of Intent to Serve Subpoenas on EMV Co., served June 21, 2021
2004	Samsung Notice of Intent to Serve Subpoenas on Global Platform Inc. served June 21, 2021
2005	Samsung Notice of Intent to Serve Subpoenas on NXP USA, Corp. served June 21, 2021
2006	Samsung's Invalidity and Subject Matter Eligibility Contentions, served July 14, 2021
2007	RF Cyber's First Supplemental Objections and Responses to Defendants Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc.'s First Set of Interrogatories (Nos. 1-14), dated September 14, 2021
2008	<i>RF Cyber Corp. v. Google LLC, et al.</i> , No. 2:20-cv-00274-JRG, Dkt. 85 (E.D. Tex. July 26, 2021)
2009	Proposed Protective Order
2010	A comparison of the proposed Protective Order to the default Protective Order
2011	Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s Preliminary Election of Asserted Prior Art in <i>RF Cyber Corp. v. Google LLC, et al.</i> , No. 2:20-cv-00274-JRG (E.D. Tex. Sept. 29, 2021)
2012	<i>RF Cyber Corp. v. Google LLC, et al.</i> , No. 2:20-cv-00274-JRG, Dkt. 130 (E.D. Tex. October 20, 2021).

I. INTRODUCTION

Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd.’s (collectively, “Samsung” or “Petitioner”) Reply (Paper No. 8, “Reply”) does not set forth any new or valid reason to institute trial in this proceeding. As RFCyber explained in its POPR, all the *Fintiv* factors favor denying institution. Paper No. 6 (“POPR”) at 15-23. Samsung’s arguments on Factors 4 and 6 do not change the balance.

II. FACTOR 4 FAVORS DENYING INSTITUTION

In the co-pending District Court Litigation, the Court ordered RFCyber and Samsung to reduce their asserted claims and elected prior art references, respectively, in advance of the March 2022 trial. RFCyber complied with the Court’s order and eventually elected to assert claims 14 and 16 of the ’009 Patent. Samsung continued to elect the same prior art references it asserts in the Petition. Ex. 2011 at 4.

Samsung now argues that the reduction in claims weighs in favor of instituting trial. Reply at 1-2. Samsung is wrong. The Board does not require complete overlap of claims. Indeed, there is substantial overlap between the limitations of claim 14 and claim 1; thus there are essentially 14 claims in the Petition but not the District Court Litigation. The Board has found that this factor favored denial of institution even when there were 15 claims challenged in the Petition but not asserted in the

district court. *Keyme, LLC v. The Hillman Grp., Inc.*, IPR2020-01485, Paper No. 11 (P.T.A.B. Mar. 31, 2021) (Finding this factor favored institution even when 15 claims not at issue in district court were challenged in an IPR “because it would be inefficient to proceed and there is potential for conflicting decisions due to the substantial overlap between the claims and prior art issues.”). This factor, therefore, favors denying institution. *Id.*; see also *Apple Inc. v. Fintiv, Inc.*, IPR202-00019, Paper No. 11 at 13 (P.T.A.B. Mar. 20, 2020) (precedential) (“[I]f a petition involves the same prior art challenges but challenges claims in addition to those that are challenged in the district court, it may still be inefficient to proceed because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition.”).

III. FACTOR 6 FAVORS DENYING INSTITUTION

As RFCyber explained in its POPR, significant evidence supports its earlier conception with diligent reduction to practice that would antedate Petitioner’s reference, but because the evidence is substantially contained in RFCyber’s source code, the District Court’s trial—nine months earlier than the Final Written Decision in this proceeding—is the proper forum to resolve those issues. POPR at 22-23. Samsung raises meritless arguments that the Board, not the District Court, should consider the patent’s conception and reduction to practice.

Samsung first asks the Board to speculate that the Court will grant Samsung's motion to strike RFCyber's conception date. Reply at 2. Samsung's motion is ill-taken. As RFCyber explained in its opposition (Ex. 2012), the local patent rules in the Eastern District of Texas require a patentee to identify: "For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled." E.D. Tex. Local Patent Rule 3-1(e), *available at* <http://www.txed.uscourts.gov/?q=patent-rules>. As the District Court has previously held, "[T]he rule makes clear that the priority date provided pursuant to P.R. 3-1 is related to claiming priority to 'an earlier application.'" *EMG Tech., LLC v. Chrysler Grp., LLC*, No. 6:12-CV-259, 2013 WL 12147662, at *1 (E.D. Tex. Jul. 3, 2013). Thus, the Court will deny Samsung's motion. *See* Ex. 2012.

Samsung cites *Elbit Sys. Land and C4I Ltd. v. Hughes Network Sys., LLC*, No. 2:15-cv-00037, 2017 WL 2651618 (E.D. Tex. 2017), but that case involved a patentee changing its contended priority date nine days before the close of fact discovery. *Id.* at *9-10. As RFCyber explained in its opposition, it has consistently set forth a conception date of December 2004 since the first time Samsung asked for it, and Samsung itself delayed even raising the issue until near the end of fact discovery. Ex. 2012 at 1-5.

Samsung next argues that "most (if not all) of Patent Owner's alleged swear behind evidence in the [District Court] Litigation appears to be irrelevant and/or

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