UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and GOOGLE LLC,
Petitioner

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner.

Case IPR2022-00284
Patent No. 9,997,962

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

I. THE *FINTIV* FACTORS FAVOR INSTITUTION

While the *Fintiv* factors favor institution for the reasons stated previously (Pet., 81-85), developments in the district court further support institution.

For example, the **fourth** *Fintiv* factor strongly favors institution. Specifically, Petitioner has stipulated that it will not pursue any obviousness ground that includes the primary reference in this IPR petition (Suzuki) against the asserted claims of the '962 patent in the parallel district court case. Exs-1022-1023. The Board has routinely found that this type of stipulation favors institution. *See, e.g.*, *Samsung Electronics Co., Ltd. et al. v. Power2B Inc.*, IPR2021-01239, Paper 12 at 12-13 (January 20, 2022). Thus, PO's arguments regarding the alleged "complete overlap" (POPR (Paper 8), 47-49) are moot.[1]

The **third** *Fintiv* factor also strongly favors institution. PO fails to address Petitioner's diligence in filing the Petition just three months after being served with preliminary infringement contentions and approximately six or seven months after the complaint filings. (POPR, 46-47; *see also* Pet., 83.) The Board has found this

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[1] PO's reliance on *Next Caller* (POPR, 48) regarding additional claims being challenged in this IPR is misplaced. *Next Caller* is a pre-*Fintiv* case and, as Petitioner explained, the number of asserted claims will only be further narrowed before trial in district court. (Pet., 83-84.)

as a "countervailing consideration" to any investment in the district court proceedings that weighs against exercising discretion. *Tianma Microelectronics Co. Ltd. v. Japan Display Inc.*, IPR2021-01028, Paper 14 at 9-11 (December 14, 2021); *see also Coolit Systems, Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11-12 (Dec. 28, 2021).

Moreover, PO's arguments are premised on claim construction completion. (POPR, 46-47.) But the Board emphasized 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, 2020) (informative). Here, "much of the district court's investment relates to ancillary matters untethered to the validity issue itself." *Id*. Importantly, Petitioner and PO have not proposed any terms for construction. (*See generally* Pet.; POPR.) The Board routinely finds the ***third*** factor favors institution when claim construction is unrelated to IPR unpatentability issues. *See, e.g., Huawei Tech. Co., Ltd., v. WSOU Invs., LLC*, IPR2021-00229, Paper 10 at 12-13 (Jul. 1, 2021); *Apple Inc. v. Koss Corp*., IPR2021-00381, Paper 15, at 16-17 (Jul. 2, 2021).

The **second** *Fintiv* factor (proximity of trial date) also favors institution because the trial date is not set in the Samsung litigation and the February 2023 date

in the Google litigation is subject to change.[2] In particular, both Google and Samsung have pending motions to transfer. (Ex-1020; Ex-1024.) If the transfer motions are granted, it is highly unlikely that the current trial schedule will hold. (Exs-2002, 2015, 1027.) And even if not granted, the resolution of the transfer motions may result in a delay in resolution of claim construction, and therefore potentially trial, because the district court will not conduct a *Markman* hearing until after a ruling on the transfer motions. (Ex-1025.)

In any event, the potential four-month gap between the expected final written decision date and the trial date(s) is not dispositive, as the Board has instituted in similar situations. (*See* Pet., 82-83.) *See also MediaTek Inc. et al. v. Nippon Telegraph and Telephone Corp.*, IPR2020-01607, Paper 12 at 14 (April 2, 2021) (finding factor two "as slightly favoring proceeding" where "final decision will be within three months of trial"); *Western Digital Corp. et al. v. Martin Kuster*, IPR2020-01391, Paper 10 at 9 (February 16, 2021) (finding factor two neutral where "there would be only a three-and-a-half month difference between the district court

[2] Moreover, statistics show that a vast majority of trial dates are delayed. (Ex1026 (article coauthored by Ex-USPTO Solicitor Nathan Kelley highlighting that, "[w]hen evaluating future trial dates, the Board was wrong 94% of the time").)

trial date and the due date for the final written decision"); *Tianma*, Paper 14 at 9-11 (December 14, 2021) (instituting IPR when "[FWD] would issue approximately ten months after the start of trial"); *Coolit Systems*, Paper 10 at 11-12 (Dec. 28, 2021) (instituting IPR despite five-month expected gap between FWD and trial date).

The **first** factor (stay) favors institution, or is at best neutral for the reasons previously explained. (Pet., 82.) Indeed, Judge Albright recently granted a motion to stay in another case after the Board instituted an IPR, even though that case was in an "advanced stage," having held the *Markman* hearing six months earlier and on the eve of the close of discovery. *Kirsch Rsch. & Dev., LLC v. IKO Indus., Inc.*, No. 6:20-CV-00317-ADA, 2021 WL 4555610, at *1 (W.D. Tex. Oct. 5, 2021).

With respect to the **sixth** factor (other circumstances), PO fails to sufficiently address Petitioner's arguments regarding the undeniable similarities between Petitioner's references and the '962 patent. (Pet., 84-85.) PO's assertions to the contrary are merely unsupported attorney argument. (POPR, 50; *see also* POPR, 12-29.) Furthermore, PO's assertion regarding inconsistent claim construction arguments (POPR, 50-51) is a red herring, as PO does not even argue that the subject claim term(s) are patentable over the proposed grounds in the IPR (*see* POPR, 12-29).

II. THE *GENERAL PLASTIC* FACTORS FAVOR INSTITUTION

For all the reasons previously explained, this is not a serial petition under the

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