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 IPR2022-00385
Patent No. 9,843,215

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. (Paper 1), 91-94), developments in the district court further support institution.

For example, the **fourth** *Fintiv* factor now more strongly favors institution. Petitioner has stipulated that it will not pursue any anticipation or obviousness ground that includes any primary reference in the instant Petition (Sakuma and Hiroki) against the asserted claims of the '215 patent in the parallel district court case. Exs-1028-1029. The Board has found that this type of stipulation favors institution. *See, e.g.*, *Samsung Elecs. Co., Ltd. v. Power2B Inc.*, IPR2021-01239, Paper 12 at 12-13 (PTAB Jan. 20, 2022). Thus, PO's arguments regarding the alleged "complete overlap" (POPR (Paper 8), 48-50) are moot.[1]

The **third** *Fintiv* factor also strongly favors institution. PO fails to address Petitioner's diligence in filing the Petition within four months after being served with preliminary infringement contentions and approximately seven or eight months after the complaint filings. POPR, 47-48; *see also* Pet., 92-93. The Board has found this as a "countervailing consideration" to any investment in the district court

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[1] PO's reliance on *Next Caller* (POPR, 50) 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., 93.

proceedings that weighs against exercising discretion. *Tianma Microelectronics Co. Ltd. v. Japan Display Inc.*, IPR2021-01028, Paper 14 at 9-11 (PTAB Dec. 14, 2021); *see also Coolit Sys., Inc. v. Asetek Danmark A/S*, IPR2021-01195, Paper 10 at 11-12 (PTAB Dec. 28, 2021).

Moreover, PO's arguments are premised on claim construction completion. POPR, 47-48. The Board, however, has 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 (PTAB June 16, 2020) (informative). Here, aside from the district court's recent claim construction order,[2] which is unrelated to the unpatentability issues raised in the Petition, "much of the district court's investment relates to ancillary matters untethered to the validity issue itself." *Id*. And, importantly, Petitioner and PO have not proposed any terms for construction in this proceeding. *See generally* Pet.; POPR. In such circumstances, the ***third*** factor favors institution. *See, e.g., Huawei Tech. Co., Ltd., v. WSOU Invs., LLC*, IPR2021-00229, Paper 10 at 12-13 (PTAB Jul. 1, 2021); *Apple Inc. v. Koss Corp*., IPR2021-00381, Paper 15, at 16-17 (PTAB Jul. 2, 2021).

The **second** *Fintiv* factor also favors institution, because, while the district

[2] The district court issued its claim construction order on May 23, 2022. Ex-1030.

court recently set the trial date in both the Samsung and Google litigations for March 6, 2023 (Ex-1031), this trial date may change. Indeed, statistics show that a vast majority of trial dates are delayed. Ex-1032 (article coauthored by Ex-USPTO Solicitor Nathan Kelley highlighting that, "[w]hen evaluating future trial dates, the Board was wrong 94% of the time"). But even if the date holds, the approximate five-month gap between the expected final written decision date and the trial date is not dispositive, as the Board has instituted in similar situations. *See* Pet., 91-92. *See also Tianma*, Paper 14 at 9-11 (instituting IPR when "[FWD] would issue approximately ten months after the start of trial"); *Coolit Sys.*, Paper 10 at 11-12 (instituting IPR despite five-month expected gap between FWD and trial date).

The **first** factor favors institution, or is at best neutral for the reasons previously explained. Pet., 91. 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, PO's attorney argument (POPR, 51; *see also* POPR, 15-32) fails to sufficiently address Petitioner's expert-supported arguments regarding the similarities between Petitioner's references and the '215 patent (Pet., 93-94). And contrary to PO's assertion (POPR, 51-53), Petitioner's claim

construction arguments regarding the "arranged on" term are consistent across the PTAB and district court proceedings (Ex. 2014, 8; Ex. 2020, 8), including with respect to the Hiroki-based grounds. To be sure, Petitioner states in footnote 7 of the Petition that "the '215 Patent uses the term 'on' broadly" and should be read to allow for "the presence of intervening adhesive layers" (Pet., 17, n.7), which is consistent with Petitioner's proposed construction of this term in the district court proceeding (Ex-2014 at 7 (stating that "contact[]" can be established "directly or indirectly through an adhesive layer")). Moreover, as explained in the Petition, Hiroki's antenna discloses this term, because it is on one surface of a non-contact IC card, which is in turn positioned on the polymeric layers without any intervening layer. Pet., 70-75 (citing, e.g., Ex-1007, FIG. 3, [0014], [0002]), 17, n.7, 21 n.9. Additionally, PO does not even dispute that this term is disclosed by the Sakuma-based grounds in the IPR.

PO's citation to *Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01546, Paper 10 at 10-12 (PTAB Feb. 14, 2019) (POPR, 53), is similarly inapposite. As an initial matter, *Orthopediatrics* is not applicable because Petitioner does not take an inconsistent position before the district court. Furthermore, *Orthopediatrics* involved a district court's claim construction order issued before the IPR petition was filed, and the petition did not sufficiently address the district court's order with respect to the challenged claims. *Orthopediatrics Corp.*, IPR2018-01546, Paper 10

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