UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner

IPR2022-00385
Patent 9,843,215

PATENT OWNER'S PRELIMINARY RESPONSE SUR-REPLY

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The district court case concerns the same parties, same patent, same claims, and the same invalidity references. Trial in the district court is also set to occur five months before the deadline for a final written decision in this matter. IPRs were intended to be "an effective and efficient alternative" to district court litigation, but this IPR cannot be such an alternative under these circumstances. Allowing this IPR to proceed simultaneously with the district court litigation would result in duplicative work, risk conflicting decisions, and be an inefficient use of the Board's finite resources. Institution should be denied.

I. The *Fintiv* Factors Favor Discretionary Denial

Factor 1. Petitioner argues that this factor favors institution or is neutral, citing to a single district court case (*Kirsch*) where Judge Albright granted a motion to stay pending IPR despite the advanced stage of the case. Reply at 3. But *Kirsch* is easily distinguishable. The district court specifically noted that the defendants had filed their motion to stay "more than sixth months before the Court held the Markman hearing in this case." *Kirsch Rsch. & Dev., LLC v. IKO Indus., Inc.*, No. 6:20-CV-00317-ADA, 2021 WL 4555610, at *3 (W.D. Tex. Oct. 5, 2021). Accordingly, the district court "credit[ed] that early filing" and found the stage of the case factor neutral. In contrast, in the district court litigation here, Petitioner has not even filed a motion to stay. And the district court has already held the Markman hearing and issued its claim construction order. Thus, it is highly unlikely that the

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district court will grant any future motion to stay filed by Petitioner. Indeed, the district court very recently denied an IPR stay where the parties had not even started claim construction briefing or discovery. *See* Ex. 2025. Petitioner presents no evidence or authority demonstrating that a stay is likely to be granted. Accordingly, this factor weighs against institution. *See Samsung Elecs. Co. Ltd. v. Evolved Wireless LLC*, IPR2021-00950, Paper 10 at 10–11 (PTAB Nov. 29, 2021) ("*Evolved*") (finding this factor weighed in favor of denial and denying institution where patent owner showed a stay was unlikely based on the advanced stage of the case and past decisions denying stays); *Google LLC v. EcoFactor, Inc.*, IPR2021-01578, Paper 9 at 8 (Mar. 18, 2022) (finding this factor weighed against institution where there was "no evidence that Petitioner had requested a stay" and a stay was unlikely given the stage of the proceeding).

Factor 2. Petitioner admits that the Samsung and Google cases have been set for trial on March 6, 2023—five months before the deadline for a final written decision—but nonetheless argues that this factor favors institution because the "trial date may change." Reply at 3. This argument should be rejected, as the Board "generally take[s] courts' trial schedules at face value absent some strong evidence to the contrary." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 7–8, at 13 (PTAB May 13, 2020) ("*Fintiv II*") (denying institution where trial was scheduled two months before the final written decision deadline). Petitioner has presented no

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such evidence. The two-page article cited by Petitioner (Ex. 1032), written on behalf of a law firm, only examined a very narrow subset of cases. And those cases say nothing about the likelihood of the trial date changing *in this case*. Indeed, Judge Albright's standing order governing proceedings in patent cases expressly states that "[a]fter the trial date is set, the Court will not move the trial date ***except in extreme situations***." Ex. 2008 at 6 (emphasis added). Accordingly, this factor also favors discretionary denial. *See, e.g.*, *Evolved* at 13 (denying institution trial was scheduled two months before final written decision deadline); *Immersion Systems LLC v. Midas Green Techs., LLC*, IPR2021-01176, Paper 16 at 12–13 (PTAB Jan. 6, 2022) ("*Midas*") (three months).

Factor 3. Petitioner asserts that the Board should simply ignore the parties' and the district court's significant investment in the litigation because some of the work done does not directly relate to invalidity issues. This is contrary to the Board's decisions finding that "substantive orders related to the patent at issue," including claim construction orders entered by the district court, favor discretionary denial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 9–10 (PTAB Mar. 20, 2020) (precedential, designated May 5, 2020) ("*Fintiv I*"). For example, in *Midas*, the Board found the fact that a claim construction order been entered and discovery was underway was "not insignificant" and denied institution. *Midas* at 13–14. The Board further found that "although it appears that much is left to occur in the related district

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