

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

RFCYBER CORP.,  
Patent Owner

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PGR2021-00029  
U.S. Patent No. 10,600,046

(§ 103 Challenge)

**PETITIONER'S AUTHORIZED REPLY  
TO PATENT OWNER'S PRELIMINARY RESPONSE**

Petitioner submits this reply in response to Patent Owner's Preliminary Response ("POPR") (Paper 7). The *NHK/Fintiv* framework does not support discretionary denial here. Further, Patent Owner's disclaimer of claims 6-11 and 15-16 has no impact on the eligibility of the '046 Patent for post-grant review.

## **I. THE *FINTIV* FACTORS FAVOR INSTITUTION**

Patent Owner has asserted the '046 Patent against Petitioner. Petition, at 1; GOOG-1041. The Board balances six factors in considering discretionary denial when there is parallel litigation. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

### **A. Factor 1 is neutral (Possibility of a Stay)**

This factor is neutral. Patent Owner's speculation that it is "highly unlikely" that the district court will grant a stay is just that—speculation. POPR, 35. A stay pending the outcome of this PGR in the co-pending district court litigation has not been requested, and the Board should not infer the outcome of any motion to stay. *See DISH Network L.L.C. v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15 at 11 (PTAB Feb. 12, 2021) ("It would be improper to speculate, . . . what the Texas court might do regarding a motion to stay," when a stay had not been requested).

### **B. Factor 2 is Neutral (Timing of Trial)**

Factor 2 is neutral. At a May 12, 2021 scheduling conference, the district court scheduled the trial date for March 21, 2022. GOOG-1046, 1. While the

Board would issue a final written decision by approximately July 2022, the short time period between the trial and the issuance of the final written decision does not warrant a discretionary denial. *See Hulu, LLC v. SITO Mobile R&D IP*, IPR2021-00206, Paper 11 at 10-11 (PTAB May 10, 2021) (trial date three months before final written decision weighs only “marginally in favor of” discretionary denial).

Further, this factor is outweighed by other factors identified below, including delays by Patent Owner at the district court, minimal investment in the district court trial, and Petitioner's diligence in filing the Petition. *See PEAG LLC v. Varta Microbattery GmbH*, IPR2020-01214, Paper 8 at 15-18 (PTAB Jan. 6, 2021) (district court trial seven months before final written decision outweighed by minimal investment in district court trial and diligence in filing petition).

### **C. Factor 3 Favors Institution (Investment in Parallel Proceeding)**

This factor, which focuses on work completed “at the time of the institution decision,” strongly favors institution. *Fintiv* at 9–10. The focus of this factor is the amount invested “*in the merits of the invalidity positions.*” *Sand Revolution II v. Cont'l Intermodal Grp.-Trucking*, IPR2019-01393, Paper 24 at 10 (PTAB June 16, 2020) (informative) (emphasis added). There will be minimal investment in the invalidity positions at district court when the Board issues the institution decision.

At Patent Owner's request, the deadline for serving infringement contentions was delayed, resulting in subsequent delays. GOOG-1047; GOOG-1048. Thus,

Petitioner's preliminary invalidity contentions will not be served until July 14, 2021, about two weeks before the Board's institution decision. GOOG-1048, 1. At the time of the institution decision, very little will have been done at the district court as to the merits of the invalidity positions. *See PEAG*, IPR2020-01214, Paper 8 at 17 (minimal investment weighs against discretionary denial).

Examples of investment that will *not* have occurred at the time of the institution decision include: (i) claim construction, GOOG-1046, 3, (ii) Petitioner's final invalidity contentions, GOOG-1049, 58-59 (Patent Rule 3-6(a)(2)), (iii) Petitioner's expert invalidity report, GOOG-1046, 3, and (iv) Patent Owner's expert validity report (if any). GOOG-1046, 3. Invalidity discovery does not close until December 6, 2021, nearly five months after the Board issues the institution decision. GOOG-1046, 3. Dispositive motions on the invalidity of the '046 Patent have not been filed, and, as such, there will be no district court orders related to the validity of the '046 Patent when the institution decision issues. GOOG-1046, 3. Thus, when the Board issues its institution decision, there will be only minimal investment on the merits of the invalidity positions. *See Fintiv* at 10 (minimal investment when the district court has not issued orders related to the patent at the time of the institution decision); *AGIS Software Dev. LLC v. Google LLC*, No. 2:19-cv-00361-JRG, ECF No. 219 at 5 (E.D. Tex. Feb. 9, 2021) (GOOG-1050) (granting stay when significant resources would need to be expended before trial).

Petitioner acted diligently in filing the Petition within three months of being served with the Complaint, and before being served with preliminary infringement contentions. Petitioner's diligence weighs in favor of institution. *See, e.g., Hulu*, IPR2021-00206, Paper 11 at 12 (PTAB May 10, 2021) (Petitioner's diligence in filing five months after complaint and two months after preliminary infringement contentions weighs in favor of institution).

**D. Factor 4 Favors Institution (Overlap of Issues)**

This factor strongly favors institution. Patent Owner speculates that “this Petition will involve the same arguments and evidence as the Texas Action,” despite Petitioner not serving its preliminary invalidity contentions. POPR, 37. To reduce overlap, if the Board institutes trial, Petitioner stipulates that it will not assert in the district court litigation invalidity grounds relying on any of the prior art contained in the obviousness grounds raised in the Petition, for the claims on which trial is instituted, while trial is instituted. This stipulation eliminates any overlap between the grounds in this proceeding and any invalidity challenges to be raised in district court, if the Board institutes review. *See Fintiv* at 12-13 (discretionary denial is unwarranted when “the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court). Petitioner's stipulation is broader than the stipulation in *Sand Revolution* that weighed in favor of institution. *See IPR2019-01393*, Paper 24 at 12 & n.5.

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