

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

RFCYBER CORP.,
Patent Owner.

Patent No. 10,600,046
Filing Date: June 2, 2015
Issue Date: March 24, 2020

Inventors: Xiangzhen Xie, Liang Seng Koh, and Hsin Pan
Title: METHOD AND APPARATUS FOR MOBILE PAYMENTS

**RFCYBER CORP.'S
SUR-REPLY TO PETITIONER'S REPLY**

Case No. PGR2021-00029

Discretionary denial is warranted here because the trial in the Eastern District of Texas (the “Texas Action”), between the same parties as here, will be completed months before the projected Final Written Decision date in this proceeding. Institution thus will result in unnecessary duplication of the parties’ and District Court’s substantial efforts and should be denied.

Moreover, as discussed in Patent Owner’s POPR, the ’046 patent is not eligible for PGR because every claim has a priority date predating March 16, 2013. However, if the Board should find that the limitations in claims 6-11 and 15-16 were not disclosed in the pre-AIA applications, it should deny institution because disclaimed claims are treated as never having existed under controlling law.

I. ALL *FINTIV* FACTORS FAVOR DISCRETIONARY DENIAL

On May 12, 2021, the District Court in the parallel litigation set trial for March 21, 2022, with a claim construction hearing on October 28, 2021. Reply, 1.

A. The Significant Time Between Trial and a Final Written Decision Weighs Strongly in Favor of Denial

The District Court’s trial date of March 21, 2022 will come approximately four months before the projected Final Written Decision in this case. *Id.* At that time, all issues relating to the challenged claims (including claim construction, validity, and infringement) will have been finally determined by the District Court. This factor, therefore, weighs strongly in favor of denial. *See* POPR, 37-39.

Google asserts that this factor is neutral but provides no evidence or argument to support its assertion. Reply, 1-2.

B. There Is No Likelihood of a Stay

As explained in the POPR, there is no likelihood of a stay in the Texas Action because the Court there has explicitly stated that its “*consistent and long established practice* [is] to deny motions to stay pending IPR and EPR when the PTAB or PTO have instituted review on less than all asserted claims of all asserted patents.” *AGIS Software Dev. LLC v. Google LLC*, No. 2:19-cv-00361-JRG, 2021 WL 465424, at *2 (E.D. Tex. Feb. 9, 2021) (emphasis added); *see also* POPR at 62-63. There are no instituted reviews on any of the four other patents in the Texas action, and thus no stay is likely to issue. Accordingly, this factor favors denial. *Stanley Black & Decker, Inc. v. Zircon Corp.*, IPR2020-01572, Paper No. 10, 9-12 (P.T.A.B. Apr. 19, 2021) (finding, even though no stay had been requested, ITC was unlikely to stay investigation and therefore this factor favored denial).

Google ignores the Texas Court’s explicit description of its established practice and suggests that this factor is always neutral when Petitioner has not sought a stay. Reply, 1. But *Fintiv* considers both “whether the court granted a stay *or evidence exists that one may be granted if a proceeding is instituted.*” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020)

(precedential) (emphasis added). Here, there is no evidence that a stay may be granted if a proceeding is instituted; to the contrary, there is strong evidence that a stay will not be granted. Accordingly, this factor favors denial. *See Stanley Black & Decker, Inc.*, IPR2020-01572, Paper No. 10 at 9-12.

C. The Overlapping Parties to The District Court Litigation Favor Denial

Patent Owner and Google are both parties to the parallel District Court litigation. POPR, 58. Thus, this factor favors denial of the Petition. *E.g.*, *Cellco P'ship v. Huawei Techs. Co.*, IPR2020-01352, Paper No. 13 at 15 (P.T.A.B. Mar. 5, 2021). Google offers no substantive argument or explanation as to why this factor does not weigh against it, instead stating, without evidence, analysis, or citation, that the factor is neutral. Reply, 5. But it is well-established that overlap between parties weighs in favor of denial. *E.g.*, *Cellco*, IPR2020-01352, Paper No. 13 at 15. Accordingly, this factor weighs against institution.

D. The Overlap of Issues Weighs in Favor of Denial

Patent Owner has asserted claims 1, 2, and 5 against Google in the Texas Action. Google has challenged those claims in this proceeding as well. Pet., 23. Thus, the same claims are at issue in both proceedings.

Google attempts to sidestep the substantial overlap by nebulously promising that it will not assert “invalidity grounds relying on any of the prior art contained in

the obviousness grounds” that were raised in the Petition but only if trial is instituted. Reply, 4. Even then, Google limits its “stipulation” to “the claims on which trial is instituted, while trial is instituted.” *Id.*

Google’s “stipulation” does not remove the substantial overlap in issues between the Texas Action and this proceeding. It would not prevent Google from raising substantially similar prior art in the District Court, nor would it subject Google to the full estoppel provisions under 35 U.S.C. § 325(e)(2). Accordingly, Google’s stipulation does not obviate the substantial overlap in issues and this factor favors denial.

E. The Significant Investment of the Parties and District Court Favors Denial

Patent Owner served its infringement contentions on May 12, 2021. According to the parties’ agreed schedule, Petitioner will serve its invalidity contentions (including § 101 contentions) on July 14, 2021. *RFCyber Corp. v. Google LLC*, No. 2:20-cv-00274-JRG, Dkt. 55-1 at 4-5 (E.D. Tex. May 26, 2021). Claim construction briefs will be filed with the Court in September and October, with a claim construction hearing on October 28, 2021. *Id.* Accordingly, substantial resources will have been expended by the parties by the time of the institution decision and shortly after. Far more resources will have been expended by the time a Final Written Decision can issue, as by then a claim construction will

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