# 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.

UNILOC 2017 LLC,
Patent Owner.

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IPR2020-00757

U.S. Patent No. 7,012,960

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## PETITIONER'S REPLY TO

## PATENT OWNER'S PRELIMINARY RESPONSE

## LIST OF EXHIBITS

| Ex. No. | Description | Previously Submitted |
|---------|-------------|:---:|
| Ex. 1001 | U.S. Patent No. 7,012,960 to Bourge *et al.* | X |
| Ex. 1002 | Declaration of Jeffrey J. Rodriguez, Ph.D. | X |
| Ex. 1003 | Curriculum Vitae of Jeffrey J. Rodriguez, Ph.D. | X |
| Ex. 1004 | Prosecution History of U.S. Patent No. 7,012,960 | X |
| Ex. 1005 | Keesman *et al.* "Transcoding of MPEG bitstreams," Signal Processing: Image Communication, Vol. 8, No. 6 (September 1996) | X |
| Ex. 1006 | Neri *et al.* "Inter-block filtering and downsampling in DCT domain," Signal Processing: Image Communication, Vol. 6, No. 4 (August 1994) | X |
| Ex. 1007 | Dubois *et al.*, "Noise Reduction in Image Sequences Using Motion-Compensated Temporal Filtering," IEEE Transactions on Communications, Vol. Com-32, No. 7 (July 1984) | X |
| Ex. 1008 | U.S. Patent No. 6,249,549 to Kim | X |
| Ex. 1009 | U.S. Patent No. 6,792,045 to Matsumura *et al.* | X |
| Ex. 1010 | Excerpts from *Smith*, The Scientist and Engineer's Guide to Digital Signal Processing (1997) | X |
| Ex. 1011 | Opening Claim Construction Brief of Uniloc 2017 in *Uniloc 2017 LLC v. Google LLC*, Case No. 2:18-CV-551-JRG (E.D. Tex. Jan. 23, 2020), ECF No. 121 | X |
| Ex. 1012 | Defendant Google LLC's Responsive Claim Construction Brief in *Uniloc 2017 LLC v. Google LLC*, Case No. 2:18-CV-551-JRG (E.D. Tex. Jan. 23, 2020), ECF No. 130 | X |

| Ex. 1013 | U.S. Patent No. 6,456,663 to Kim | X |
| Ex. 1014 | U.S. Patent No. 5,428,456 to Parulski et al. | X |
| Ex. 1015 | European Application No. 00402939 | X |
| Ex. 1016 | European Application No. 01400588 | X |
| Ex. 1017 | Declaration of Ingrid Hsieh-Yee, Ph.D. | X |
| Ex. 1018 | Mitchell *et al.*, MPEG Video Compression Standard, Chapman & Hall (1996) | X |
| Ex. 1019 | Memorandum and Order Granting Defendant's Motion to Transfer Venue to the Northern District of California in *Uniloc 2017, LLC v. Google LLC*, No. 2-18-cv-00551 (E.D. Tex. Jun. 19, 2020), ECF No. 163. | |
| Ex. 1020 | Joint Stipulation for Stay Pending Transfer in *Uniloc 2017, LLC v. Google LLC*, No. 2-18-cv-00551 (E.D. Tex. Jun. 10, 2020), ECF No. 162. | |
| Ex. 1021 | Order Setting Initial Case Management Conference and ADR Deadlines in *Uniloc 2017, LLC v. Google LLC*, No. 3-20-cv-05344 (N.D. Cal. Aug. 6, 2020), ECF No. 167. | |
| Ex. 1022 | Clerk's Notice re Consent or Declination To Proceed Before a Magistrate Judge in *Uniloc 2017, LLC v. Google LLC*, No. 3-20-cv-05344 (N.D. Cal. Aug. 6, 2020), ECF No. 168. | |
| Ex. 1023 | Declination To Proceed Before a Magistrate Judge in *Uniloc 2017, LLC v. Google LLC*, No. 3-20-cv-05344 (N.D. Cal. Aug. 6, 2020), ECF No. 169. | |
| Ex. 1024 | Clerk's Notice of Pending Reassignment To a U.S. District Court Judge in *Uniloc 2017, LLC v. Google LLC*, No. 3-20-cv-05344 (N.D. Cal. Aug. 6, 2020), ECF No. 170. | |

| Ex. 1025 | Order Staying *Uniloc 2017, LLC v. Google LLC*, No. 2-18-cv-00551 (E.D. Tex. Feb. 14, 2020), ECF No. 147. | |
|----------|---------------------------------------------------------|---|
| Ex. 1026 | Order Continuing Stay in *Uniloc 2017, LLC v. Google LLC*, No. 2-18-cv-00551 (E.D. Tex. Mar. 20, 2020), ECF No. 159. | |
| Ex. 1027 | Joint Motion To Continue Stay in *Uniloc 2017, LLC v. Google LLC*, No. 2-18-cv-00551 (E.D. Tex. May 19, 2020), ECF No. 160. | |
| Ex. 1028 | Lex Machina 2020 Patent Litigation Report, Excerpted | |
| Ex. 1029 | Docket Navigator Listing of Cases with Uniloc 2017 LLC Filed since June 8, 2018 | |

## I.  Introduction

Petitioner Google LLC submits this reply to explain why, under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board should not exercise its discretion to deny institution of this IPR in light of a co-pending district court litigation, *Uniloc 2017 LLC v. Google LLC*, No. 2:18-cv-00551 (E.D. Tex.) ("the parallel litigation").

The circumstances of the parallel litigation are very different from those suggested by Uniloc in its Preliminary Response ("POPR").  The district court granted Google's transfer to the Northern District of California, further delaying trial.  Ex. 1019.  The parties have agreed to stay all proceedings until the case is formally transferred, Ex. 1020, and the formal transfer occurred just yesterday (August 6, 2020), Ex. 1021.  A new schedule including a trial date will not be set until the case is transferred and assigned to a judge in the Northern District of California, and most likely not until the parties appear for a status conference before the new court.  Exs. 1022-1024.  As a result of these significant changes, the *Fintiv* factors weigh against discretionary denial even more strongly than before.

Notably, the Board has declined to exercise its discretion to deny institution in substantially similar circumstances involving the same parties, finding that "[t]he various impacts of transferring the Texas litigation proceeding to the Northern District of California weight against a discretionary denial of the Petition because

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