UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC

Petitioner

v.

UNILOC 2017 LLC

Patent Owner

IPR2020-00757

PATENT 7,012,960

PATENT OWNER SUR REPLY TO PETITIONER'S REPLY TO THE PRELIMINARY RESPONSE

Google's belated arguments as to discretionary denial fail to support Google's request that the Board institute trial, despite the advanced stage of a parallel district court proceeding. Google does not persuasively dispute that, even after transfer of the litigation between the same parties, (1) there is no evidence that a stay is likely or (2) there is no evidence that a final written decision here would necessarily precede a jury trial, and (3) it is a demonstrable and undisputed fact that the validity issues in these parallel proceedings completely overlap. Accordingly, institution should be denied for the reasons emphasized here and in Uniloc's Preliminary Response.

A. There is no evidence the district court would grant a stay (Factor 1).

Google does not dispute that *Apple v. Fintiv*[1] "considers fact-specific and case-specific guidance from the district court, which is entirely, lacking here." POPR at 5. At most, Google's Reply generically asserts that the Northern District of California "frequently" (and hence admittedly not always) stays cases in view of IPRs; and Google cites cases without regard to facts and analyses set forth therein.

Google neglects to mention that one of the cases it cites as granting a stay *after* a Board decision on institution was based on an *unopposed* motion. *See Uniloc 2017 LLC v. Apple Inc.*, No. 3:19-cv-01904, Dkt. 89 (N.D. Cal. Jan. 30, 2020). The two Northern District of California cases Google cites as granting stays *before* a Board decision on institution both acknowledge that motions to stay are highly individualized matters. *Cellwitch Inc. v. Tile, Inc.*, No. 4:19-cv-01315, Dkt. 68 (N.D. Cal. Jan. 17, 2020); *Elekta Ltd. v. ZAP Surgical Sys., Inc.*, No. 4:19-cv-02269, Dkt.

[1] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

42 (N.D. Cal. Nov. 8, 2019). For example, in *Cellwitch*, the court found it significant that the parallel IPR "sought review of every claim in the [challenged patent]." Slip op. at 3. Here, the petition seeks review of only claims 1, 4 and 5.

Google also does not deny, or even acknowledge, that *Cellwitch* also considered the fact that "[c]laims [sic] construction briefing has not yet been filed" weighed in favor of a stay. POPR 6 (citing *Cellwitch*, at 4). This factor weighs against a stay here because claim construction briefing in the parallel proceeding was completed long ago and is made of record as Exhibits 1010, 1011, and 2002.

Cellwitch also found that the defendant seeking stay had "instigated the IPR proceedings in a timely fashion." *Id*. (citing *Cellwitch*, at 5). Here, Google offers no explanation for why it delayed filing its petition until *seven months after* it had served its overlapping invalidity contentions in litigation (Ex. 2002), and long after the court and the parties had already expended considerable resources in litigation.

Cellwitch also favorably cites *Finjan, Inc. v. Symantec Corp.*, 139 F. Supp. 3d 1032, 1037 (N.D. Cal. 2015) for the proposition that the court may consider whether, if the court "were … to deny the stay until a decision on institution is made, the parties and the Court would expend significant resources on issues that could eventually be mooted by the IPR decision." *Cellwitch*, at 5. Here, Google fails to articulate what court resources, if any, allegedly would be expended in the interim.

Each of the other Northern District of California opinions Google cites similarly consider highly individualized factors applied to the particular facts of the case. Google's speculative and unsupported assertion that the Northern District of California will likely stay the litigation simply cannot be squared with the analyses

applied in the court opinions Google has cited. Google's failure to address the analysis in the opinions it cites is both telling and unsurprising, given Uniloc anticipated Google would merely offer citations without explanation. POPR. 5–7.

Accordingly, Google's bald assertion concerning the mere possibility of a stay, which is theoretically present in any case, fails.

B. Google fails to establish it is likely trial will be rescheduled in the transferee district well over an entire year from now (Factor 2).

Google suggests that the court's transfer order renders moot the consideration of the proximity of the court's trial date to the Board's projected statutory deadline for a final written decision. Rep. 3. According to Google, predicting a trial date in the transferee district would be speculative. *Id.* However, the new trial date need not be predicted with absolute certainty. It is sufficient to consider the likelihood of a jury trial being completed sometime prior to an expected final written decision.

Google does not deny that trial would have to be rescheduled in the transferee district well over an *entire year* from now for this factor to weigh against discretionary denial. Google also does not deny that this is highly unlikely under the circumstances. That trial will likely be expedited in the transferee district is evidenced at least by the undisputed fact that claim construction briefing was competed long ago, which is a factor the transferee district considers as disfavoring a stay.

C. Google fails to address or even acknowledge the substantial investment in the parallel proceeding by the court and the parties (Factor 3).

Google misstates this factor as being forward looking. Rep. 3. In doing so, Google fails to recognize that the third factor is *retrospective* at least in that it weighs

the amount of investment the parties and court *have put* into parallel litigation. Indeed, the *Apple v. Fintiv* opinion repeatedly uses the past tense in defining this factor in the context of work already completed. *Fintiv*, at 9–10. As explained above, the investment of resources and advanced stage in the parallel proceeding (prior to transfer) is evidenced at least by the completion of claim construction briefing.

D. The Petition presents completely overlapping issues (Factor 4)

Google waived any argument concerning this well-established factor because it clearly is part of the *NHK* analysis deemed precedential before Google filed its petition. *See* POPR 7 (citing *NHK*, IPR2018-00752, Paper 8 at 19–20). In any event, Google's belated argument grossly misapplies this factor.

Google flips this factor on its head by arguing it weighs *against* discretionary denial here ostensibly because its patentability challenges before the Board represent only some, *but not all*, of the myriad of theories advanced in parallel litigation. Rep. 4–5. However, under *Fintiv*, this factor weighs in favor of denial if "the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding"; and this factor weighs against denial "if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court." *Fintiv*, 12–13. Application of this factor is straightforward.

Google does not dispute that its petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding; and it remains undisputed that Google's petition does *not* include

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