UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

WILDSEED MOBILE LLC,
Patent Owner

Case IPR2023-00246
U.S. Patent No. 9,141,960

PATENT OWNER'S SUR-REPLY IN SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE

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I. *FINTIV* FACTORS 1-5 FAVOR DISCRETIONARY DENIAL

Patent Owner agrees that factor 1 is neutral. Reply, 1. Factor 2 is not dispositive. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, 9 (P.T.A.B. Mar. 20, 2020) (precedential) ("If the court's trial date is…after the projected statutory deadline, *the decision whether to institute will likely implicate other factors* discussed herein." (emphasis added throughout)). Patent Owner addresses factors 3-5, which favor denial, and the lack of "compelling merits" under factor 6 below.

A. Factor 3: The parties have and will continue to invest heavily in the co-pending case, and Petitioner fails to explain its lack of diligence.

Factor 3 considers investment "by the court and parties" and a petitioner's diligence in filing the petition, *Fintiv*, Paper 11, 9-12, not simply whether the court has issued orders, as Petitioner implies, Reply, 2. Whether the court has issued a substantive order is a "fact" that the Board considers, as is whether the petitioner filed the petition shortly after becoming aware of the asserted claims.

Weighing these and other facts confirms that factor 3 favors denial: the parties have and will continue to invest heavily in the co-pending case (which is not stayed) by the institution deadline, and Petitioner was far from diligent. The parties

have *twice* exchanged contentions, are embroiled in fact discovery, and will be in the thick of claim construction briefing by the institution deadline. POPR, 33-34.

This investment is a direct result of Petitioner waiting 12 months after the Complaint was served before filing the Petition. *Id*. *Fintiv* instructs parties to explain facts relevant to the Petition's timing. *Fintiv*, Paper 11, 11. Despite opportunities in its Petition and its Reply, Petitioner says nothing beyond a conclusory unsupported statement in the Petition. Petitioner's continued silence despite Patent Owner's arguments, *see* POPR, 34, confirms it was not diligent. Petitioner's unexplained decision to wait as long as possible before filing the Petition caused the parties to continue investing time and resources in the co-pending case, tipping factor 3 in favor of denial. *See Fintiv*, Paper 11, 11-12 ("If…the evidence shows that the petitioner did not file the petition expeditiously, … or even if the petitioner cannot explain the delay in filing its petition, these facts have favored denial.").

B. Factor 4: Petitioner's narrow stipulation does nothing to mitigate concerns of duplicative efforts or potentially conflicting decisions.

Petitioner's narrow stipulation that "it will not pursue in the parallel litigation the grounds raised in the Petition," Reply, 2-3, does little to mitigate "concerns of duplicative efforts between the district court and the Board, [or] concerns of potentially conflicting decisions." *Sand Revolution II, LLC v. Cont'l Intermodal Grp.—Trucking LLC*, IPR2019-01393, Paper 24, 12 (P.T.A.B. June 16, 2020) (informative); *see also id.*, 12 n.5 ("A broader stipulation…might better address con-

cerns regarding duplicative efforts and potentially conflicting decisions in a much more substantial way."). As in *Sand Revolution*, this factor *at best* "weighs *marginally* in favor of not exercising discretion to deny institution." *Id.*, 11-12. Remarkably, Petitioner omits this important qualifier—marginally—in discussing a case with a similar stipulation. *See* Reply, 3 (quoting *Meta Platforms Inc. v. Thales Visionix, Inc.*, IPR2022-01301, Paper 11, 12-13 (P.T.A.B. Mar. 13, 2023), but leaving out "marginally" from the conclusion that the factor favors institution).

Petitioner's stipulation does little, if anything, to eliminate overlap with the parallel proceeding and should be given little weight. It does not even eliminate the references asserted in the Petition from availability in the parallel proceeding. Notably, Petitioner's invalidity contentions include combinations with significant but not exact overlap to the Grounds presented in the Petition. And Petitioner stipulates only that it will not pursue the specific Grounds 1-3, Pet., 20, in the district court. Petitioner's invalidity contentions, however, assert that Sasaki "*anticipates* and/or renders obvious, *alone or in combination* with one or more references" including "Ellis, Jacobi, Teicher, Havinis, *or one or more references* identified as disclosing" claim limitations. EX2003, 1.

Petitioner's stipulation does not prevent substantially similar, yet not identical, invalidity positions in the district court. Factor 4 thus favors denial, despite Petitioner's narrow stipulation, because the possibility of "duplicative efforts" or "po-

tentially conflicting decisions" remains significant. *Sand Revolution*, Paper 24, 12.

C. Factor 5: Same parties favors denying institution.

The parties in the co-pending case and here are the same, *see* Reply, 3-4, favoring denial. *See, e.g.*, *Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 16 (P.T.A.B. Oct. 21, 2020) (precedential as to § II.A) (factor 5 was "neutral or … weigh[s] slightly in favor of exercising discretion to deny institution" when same parties and the litigation was stayed, even *without* substantial overlap).

"[T]ak[ing] a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review," the Board should find that the first five *Fintiv* factors favor denial here. *Fintiv*, Paper 11, 6.

II. THE PETITION DOES NOT PRESENT COMPELLING MERITS.

Fintiv factors 1-5 favor denying institution, so the Board must assess whether the Petition presents compelling evidence of unpatentability. *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23, 5 (P.T.A.B. Feb. 27, 2023) (precedential). It does not. The compelling merits standard requires more than a mere likelihood of prevailing. *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102, 49 (P.T.A.B. Oct. 4, 2022) (precedential). Petitioner has not met even the reasonable likelihood standard, let alone shown compelling merits.

Petitioner argues Ellis teaches sending the user's information about media consumed to a "central facility." Reply, 4 (citing EX1005, ¶¶236, 265). But these

passages do not state that the central facility infers user preferences. EX1005, ¶¶236, 265; POPR, 23-24, 26. Petitioner also argues Sasaki discloses a server that receives information about consumed media. Reply, 4-5 (citing EX1004, ¶¶21, 30, 74). But the user preferences are entered by the user rather than inferred by the server. EX1004, ¶¶73, 85; POPR, 24-25.

Petitioner further argues Sasaki "teaches a server in communication with a portable media player device where the portable media player device can 'directly transmit location information.'" Reply, 5 (citing EX1004, ¶¶69, 81). This ignores that Sasaki's disclosure of a portable terminal transmitting location information to another portable terminal is unrelated to the separate embodiment where a portable terminal receives recommendations from a server. EX1004, ¶¶68-69, 80-81, 112-130; POPR, 22-23, 29. Finally, Petitioner argues Ellis teaches using location information to "acquire information about local events." Reply, 5 (citing EX1005, ¶¶233-234). Ellis does not disclose sending location information to a server; and in Ellis the event information is not accessed by a server, but rather by the portable ERS, which selects one or more events that match the user's preferences. EX1005, ¶¶233-234; POPR 23-24, 30.

III. CONCLUSION

The *Fintiv* factors favor denial and Petitioner has not shown compelling merits. The Board should exercise its discretion to deny institution.

Respectfully submitted,
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jason A. Fitzsimmons/

Jason A. Fitzsimmons
Registration No. 65,367
Counsel for Patent Owner

Date: April 20, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005
(202) 371-2600

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S SUR-REPLY IN SUPPORT OF PATENT OWNER'S PRELIMINARY RESPONSE** was served electronically via e-mail on April 20, 2023, in its entirety on the following counsel of record for Petitioner:

Andrew S. Ehmke (Lead Counsel) andy.ehmke.ipr@haynesboone.com
Raghav Bajaj (Back-up Counsel) raghav.bajaj.ipr@haynesboone.com
Calmann J. Clements (Back-up Counsel) calmann.clements.ipr@haynesboone.com
HAYNES AND BOONE LLP

Respectfully submitted,
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jason A. Fitzsimmons/

Jason A. Fitzsimmons
Registration No. 65,367
Counsel for Patent Owner

Date: April 20, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005
(202) 371-2600