

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE LLC,
Patent Owner.

IPR2023-00248
U.S. Patent No. 7,376,414

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

Pursuant to the Board’s email dated March 31, 2023 (EX3001), Petitioner Google LLC (“Google”) files this Reply to Patent Owner’s Preliminary Response (“POPR,” Paper 6).

I. THE *FINTIV* FACTORS FAVOR INSTITUTION

As set forth in the Petition, and contrary to Wildseed Mobile LLC’s (“Wildseed”) POPR, the *Fintiv* factors favor institution. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”).

A. Factor 1 – possibility of stay – neutral

This factor remains neutral, as neither party has moved for a stay. *See* POPR, p. 17; Petition, pp. 18-19.

B. Factor 2 – time of trial – favors institution

Wildseed contends this factor “is neutral or does not favor exercising discretion because no trial date has been set.” POPR, p. 18. However, the PTAB has repeatedly held that, without a trial date, “factor 2 **favors not exercising** [] discretion to deny institution.”¹ *See Meta Platforms Inc. v. Thales Visionix, Inc.*, IPR2022-01301, Paper 11 at 11 (PTAB Mar. 13, 2023); *see also Google LLC v. Ikorongo Tech. LLC*, IPR2021-00204, Paper 16 at 8-9 (PTAB Jan. 25, 2022) (“factor[] 2...favor[s] not exercising our discretion because there is no trial date”).

¹ Emphasis in quoted language added unless otherwise specified.

Here, as the Petition states: “the Northern District of California ... has not set a trial date.” Petition, p. 19. Moreover, as of the filing of this paper, the Northern District of California still has not set a trial date, and the earliest time to trial according to median time-to-trial statistics would be February 2025. *See* Petition at 19. Thus, this factor favors institution.

C. Factor 3 - investment in parallel proceedings – favors institution

Wildseed also incorrectly argues this factor favors denial. *See* POPR, pp. 18-19. Factor 3 focuses on investment “in the merits of the invalidity positions” as of institution. *See* Petition, p. 20 (*quoting Sand Revolution II, LLC v. Cont'l Intermodal Grp.—Trucking LLC*, IPR2019-01393, Paper 24 at 10 (PTAB June 16, 2020) (informative) (“*Sand Revolution*”). As *Fintiv* itself states, “[i]f, at the time of the institution decision, the district court **has not issued orders related to the patent** at issue in the petition, this fact **weighs against exercising discretion** to deny institution.” *Fintiv*, IPR2020-00019, Paper 11 at 10.

Under the current schedule, which is unchanged since the Petition, the claim construction hearing will occur on July 12, 2023 (Ex.1026, p. 11), while institution decisions will issue no later than June 16, 2023 (*see* 35 U.S.C. § 314(b)(1)). Thus, the district court will **not issue** orders related to the '414 patent by the time of institution. Accordingly, this factor favors institution and weighs against exercising discretion to deny institution.

Finally, if instituted, Google stipulates it will not pursue in the parallel litigation the grounds raised in the Petition. *Sand Revolution* at 11–12 (stipulation not to pursue the same grounds in the parallel litigation “mitigates to some degree the concerns of duplicative efforts”). Thus, because the district court has minimally invested in invalidity and institution will not result in any overlapping invalidity arguments, this factor favors institution.

D. Factor 4 – overlap of issues – favors institution

As set forth above, Google stipulates that, if the IPR is instituted, it will not pursue in the district court proceeding the Petition's grounds. *See Sand Revolution* at 11–12. Similar stipulations have been found to “eliminate[] specific overlap with the parallel proceeding” and to “favor[] not exercising [] discretion to deny institution.” *Meta Platforms*, IPR2022-01301, Paper 11 at 12-13; *see also Sand Revolution* at 12. This factor therefore favors institution.

E. Factor 5 – overlapping parties – favors institution

As discussed in the Petition, this factor should not be a basis for denying institution. Petition, p. 21. Further, in view of Google's stipulation, a trial in front of PTAB would reduce issues in the district court litigation, favoring institution.

Additionally, multiple panels have recognized that, even when the petitioner is the defendant in the parallel litigation, “this factor favors denial if trial precedes the Board's Final Written Decision and **favors institution if the opposite is true.**”

Huawei Tech Co. v. WSOU Inv., LLC, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021); *see also Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 21 (PTAB Oct. 21, 2020) (“Petitioner is the defendant in the parallel proceeding. This fact could weigh either in favor of, or **against, exercising discretion** to deny institution, depending on which tribunal was likely to address the challenged patent first.”). Because the Board will address the ’414 patent before the district court, this factor favors institution.

F. Factor 6 – other circumstances – favors institution

Here, *Fintiv* factors 1–5 do not favor discretionary denial; rather, four factors (factors 2–5) favor institution, and only one (factor 1) is neutral. With **no** factors weighing in favor of denial, the Board “shall decline to discretionarily deny.” *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4-5 (PTAB Feb. 27, 2023) (“where the Board determines that the other *Fintiv* factors 1–5 do not favor discretionary denial, the Board shall decline to discretionarily deny under *Fintiv* without reaching the compelling merits analysis”).

Nevertheless, no other circumstances favor institution. Wildseed attempts to draw a distinction between the claims and the teachings of Kawasaki applied in the Petition, by leveraging one of the references cited during prosecution (Owensby). *See* POPR, pp. 4-13. But Wildseed glosses over that Kawasaki teaches “*information taken by the cellular device*” as recited. It does not assert that Owensby taught this

claim language, and does not address Kawasaki's teaching of this limitation. Wildseed's arguments do not show patentability over the Petition's grounds, and to the extent the Board reaches this factor, it too weighs in favor of institution.

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HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219
Customer No. 27683

Respectfully submitted,

/Andrew S. Ehmke /
Andrew S. Ehmke
Lead Counsel for Petitioner
Registration No. 50,271

Petitioner’s Exhibit List

Ex.1001	U.S. Patent No. 7,376,414
Ex.1002	Prosecution History of U.S. Patent No. 7,376,414
Ex.1003	Declaration of Henry Houh under 37 C.F.R. § 1.68
Ex.1004	U.S. Patent No. 6,684,249 to Frerichs et al. (“Frerichs”)
Ex.1005	U.S. Patent No. 6,539,375 to Charles Kawasaki (“Kawasaki”)
Ex.1006	U.S. Patent Pub. No. 2007/0083886 by Kauffman et al. (“Kauffman”)
Ex.1007	U.S. Provisional Application No. 60/290,592
Ex.1008	[Reserved]
Ex.1009	<i>Curriculum Vitae</i> of Henry Houh
Ex.1010	Gallagher et al., “A Framework for Targeting Banner Advertising On the Internet,” Proceedings of the Thirtieth Annual Hawaii International Conference on System Sciences, January 1997.
Ex.1011	Microsoft Computer Dictionary (5 th ed.) (excerpts)
Ex.1012	Complaint for Patent Infringement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:21-cv-01245 (W.D. Tex. Dec. 1, 2021)
Ex.1013	First Amended Complaint for Patent Infringement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:21-cv-01245 (W.D. Tex. Feb. 28, 2022)
Ex.1014	Notice of Voluntary Dismissal Without Prejudice, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:21-cv-01245 (W.D. Tex. Apr. 4, 2022)
Ex.1015	Complaint for Patent Infringement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:22-cv-00357 (W.D. Tex. Apr. 4, 2022)

Ex.1016	First Amended Complaint for Patent Infringement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:22-cv-00357 (W.D. Tex. May 9, 2022)
Ex.1017	Order Granting Agreed Motion to Transfer to the Northern District of California and Stay Pending Deadlines, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 6:22-cv-00357 (W.D. Tex. May 9, 2022)
Ex.1018	Federal Court Statistics
Ex.1019	U.S. Patent 5,978,841 to Louis Berger
Ex.1020	Technical Specifications RIM Wireless Handhelds (https://web.archive.org/web/20000619041725/http://rim.net/products/handhelds/tech.html)
Ex.1021	Nokia 9210 Communicator Nokia (https://web.archive.org/web/20120708090016/http://press.nokia.com:80/2000/11/21/the-nokia-9210-communicator-heralds-the-dawn-of-mobile-multimedia/)
Ex.1022	Ericsson R380 (https://web.archive.org/web/20010216041714/http://www.geek.com/hwsrev/pda/ericr380/)
Ex.1023	Prosecution History of U.S. Application No. 09/734,220
Ex.1024	U.S. Patent No. 6,266,664
Ex.1025	U.S. Patent No. 6,105,060
Ex.1026	Joint Case Management Statement, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 3:22-cv-04928 (N.D. Cal. Nov. 22, 2022)
Ex.1027	Civil Minutes, <i>Wildseed Mobile, LLC v. Google LLC et al.</i> , 3:22-cv-04928 (N.D. Cal. Nov. 29, 2022)

CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. §42.6(e) and 37 C.F.R. §42.105, service was made on Patent Owner as detailed below.

Date of service April 10, 2023

Manner of service Electronic Email: dalberti@kramerday.com;
slim@kramerday.com; mspecht-PTAB@sternekessler.com;
jfitzsimmons-PTAB@sternekessler.com; rbemben-PTAB@sternekessler.com;
PTAB@sternekessler.com;
KramerDay-WildseedMobile@kramerday.com

Documents served **Petitioner's Authorized Reply to Patent Owner's Preliminary Response**

Persons served David Alberti
Sal Lim
KRAMER DAY ALBERTI LIM TONKOVICH & BELLOLI LLP
577 Airport Boulevard, Suite 250
Burlingame, California 94010

Michael D. Specht
Jason A. Fitzsimmons
Richard M. Bemben
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005-3932

/Andrew S. Ehmke /
Andrew S. Ehmke
Lead Counsel for Petitioner
Registration No. 50,271