UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.
Petitioner

v.

MOJO MOBILITY INC.
Patent Owner

Case No. IPR2023-01094
Patent No. 11,316,371

PATENT OWNER'S PRELIMINARY SUR-REPLY

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TABLE OF AUTHORITIES

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CASES

BOE Tech. Grp. v. Element Cap. Comm. Co.,
No. IPR2023-00808, Paper 9 (P.T.A.B. Nov. 15, 2023) 2

IBM v. Digital Doors, Inc.,
No. IPR2023-00967, Paper 7 (P.T.A.B. Dec. 1, 2023) 3

Sotera Wireless, Inc. v. Masimo Corp.,
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TCO AS v. NCS Multistage Inc.,
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STATUTES

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TABLE OF EXHIBITS

Exhibit	Description
2001	Samsung's District Court Invalidity Contentions
2002	*Mojo Mobility Inc v. Samsung Electronics Co., Ltd, et al.*, Case No. 2-22-cv-00398, Dkt. 41 (Mojo's Response to Samsung's District Court Motion to Stay Pending IPR) (E.D. Tex. Aug. 11, 2023).
2003	*Mojo Mobility Inc v. Samsung Electronics Co., Ltd, et al.*, Case No. 2-22-cv-00398, Dkt. 1 (Complaint) (E.D. Tex. Oct. 7, 2022).
2004	*Omitted* (IPR2023-01086, IPR2023-01087, IPR2023-01088, IPR2023-01091, IPR2023-01092, IPR2023-01093, IPR2023-01094, IPR2023-01095, IPR2023-01096, IPR2023-01098, IPR2023-01099, IPR2023-01101, IPR2023-01102, IPR2023-01124) Collection of "Proximate" Dictionary Definitions (IPR2023-01089 and IPR2023-01090) *Copper Thickness FAQ*, PCBUNIVERSE.COM, https://www.pcbuniverse.com/pcbu-tech-tips.php?a=4 (last visited November 10, 2023) (IPR2023-01097 and IPR2023-01100)
2005	Docket Navigator, *2023 Gilstrap Trial Statistics* (Dec. 6, 2023)
2006	Eastern District of Texas, *Model Order Focusing Patent Claims and Prior Art to Reduce Costs*
2007	Docket Control Order of March 28, 2023, *Mojo Mobility Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22-cv-00398 (E.D. Tex.)

Petitioner seeks to revive its argument against a *Fintiv* denial of institution by now offering an "intermediate" stipulation (that still falls well short of *Sotera)* and pointing to Patent Owner's reduction in the *infringement* assertions in the district court. Petitioner's new arguments are not persuasive. By strategically refusing to make a *Sotera* stipulation, Petitioner continues to seek to have two forums (and two chances) to invalidate the patents based on published prior art—*first* before the district court and *second* before the PTAB. *Fintiv* counsels against such duplication, inefficiency, and wastefulness of judicial and party resources.

Fintiv Factor 1 (stay) continues to weigh in favor of discretionary denial as a district court stay is unlikely. Petitioner's citations to three cases are unpersuasive in light of the overwhelming precedent in the Eastern District of Texas for denying stay requests for pending IPR proceedings, as set forth in Patent Owner's POPRs.

Fintiv Factor 2 (trial proximity) continues to weigh in favor of denial because trial will occur months before any final written decision. The Reply does not dispute that the district court trial date—set for August 5, 2024—is 5 to 6 months before final written decisions would issue. Instead, the Reply cites guidance that a district court's scheduled trial date is not "by itself a good indicator" of the trial date, because many judges extend trial dates as the date approaches. Reply at 4. Judge Gilstrap, however, typically sticks to his trial dates. The current trial date—August 5, 2024—is about 22 months after the case was filed on October 7, 2022. Statistics

show that *none* of Judge Gilstrap's eight patent trials so far in 2023 have been more than 22 months after filing, with an average time to trial of 18 months. *See* Ex. 2005.

Fintiv Factor 3 (investment in the parallel proceeding) continues to weigh in favor of denial given all the work that has been and will be done in the district court. The parties have already made large investments in the district court case and will continue to do so by the time of institution decisions given that fact discovery will close and opening expert reports will be due in March 2024. *See* Ex. 2007.[1]

Fintiv Factor 4 (overlap) continues to weigh in favor of denial given the duplicative invalidity challenges in the district court case. Petitioner's new stipulation does not eliminate the substantial overlap with the district court case—petitioner continues to seek to challenge the patents' validity based on published prior art before both the district court and the PTAB. Petitioner's new "intermediate" stipulation still falls well short of the IPR estoppel that would arise after an IPR final written decision. Reply at 3; 35 U.S.C. § 315(e). The Board recently denied institution where a similar stipulation was presented. *BOE Tech. Grp. v. Element Cap. Comm. Co.*, No. IPR2023-00808, Paper 9, at 24 (P.T.A.B. Nov. 15, 2023) (denying institution where petitioner stipulated to "cease asserting in the district

[1] Petitioner previously submitted the district court docket control order with different exhibit numbers. For simplicity, Patent Owner resubmits it as Ex. 2007.

court any invalidity contention based on the prior art presented in this petition that constitutes part of a ground"); *see also IBM v. Digital Doors, Inc.*, No. IPR2023-00967, Paper 7, at 11 (P.T.A.B. Dec. 1, 2023) (denying institution where stipulation fell short of *Sotera* standard). The fact remains that institution of the IPR petitions would result in published prior art invalidity assertions being made before both the district court and the PTAB. Remarkably, given the rare chance to revise its stipulation, Petitioner decided against proposing a *Sotera*-style stipulation that this Board has previously acknowledged as reducing overlap. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020).

Petitioner instead disingenuously seeks to avoid a *Fintiv* denial of institution by pointing to Patent Owner's reduction of the *infringement* claims in the district court. Petitioner should not be heard to seek to leverage Patent Owner's reduction of the *infringement* dispute between the parties to avoid a *Fintiv* denial of institution so that Petitioner can continue to seek to challenge the validity of the patents based on published prior art before both the district court and the PTAB. In the district court, the Petitioner has *not* reduced the patent claims it challenges on published prior art validity grounds, so that the overlap as to the claims challenged on published prior art validity grounds remains. Moreover, Petitioner has always known that the Patent Owner would reduce the number of asserted infringement claims in the district court proceeding, as this almost always happens in district court litigation

and in fact the district court's model order specifies this. *See* Ex. 2006. Petitioner (through its seasoned counsel) knew this when it filed the IPR petitions and argued the *Fintiv* factors in its petitions, yet Petitioner made no mention of this in its petitions. Furthermore, Petitioner directed its IPR petitions at the claims on which infringement was asserted in the district court, not all the claims in the patents. Petitioner now suggesting that it is concerned about claims beyond the claims asserted for infringement is disingenuous.

Patent Owner's reduction of the scope of the infringement dispute in the district court should be encouraged, not be penalized and leveraged as Petitioner seeks. Petitioner's implying that it is worried about the dropped infringement claims is not credible. Petitioner would surely argue estoppel if Patent Owner tried to resurrect infringement claims dropped now or in the future. But to make it clear, Patent Owner stipulates: if discretionary denial is granted for this petition on *Fintiv* grounds, Patent Owner agrees not to seek to resurrect or make new infringement claims as to any claims in this IPR petition which have been or will be removed from Patent Owner's infringement case in the district court case per the district court focusing order, against Samsung or its products. *See TCO AS v. NCS Multistage Inc.*, No. PGR2020-00077, Paper 16, at 16-17 (P.T.A.B. Feb. 18. 2021) ("Although this Petition involves two claims not involved in the Nine and TCO litigations, Patent Owner's offer to stipulate that it will not assert those claims mitigates Petitioner's

concerns . . . the facts underlying this factor weigh in favor of denying institution"). "Even without" Patent Owner's offer of this stipulation, there would remain "concerns of inefficiency and the possibility of conflicting decisions," given Petitioner's attempt to maintain published prior art validity challenges before both the district court and the PTAB. *Id*. at 16-17.

Ultimately, Petitioner's pointing to Patent Owner's narrowing of the infringement dispute (which should be encouraged, not penalized and leveraged) is a diversion. The fact remains that Petitioner continues to seek to challenge the patents on published prior art validity grounds before both the district court and the PTAB—this substantial overlap remains.

Fintiv Factor 5 (parties) continues to weigh in favor of denial as the parties are the same. Petitioner agrees this weighs in favor of denial. Reply at 5.

Patent Owner respectfully reiterates its request set forth in its POPRs that the Board exercise its discretion to deny institution under *Fintiv*. Petitioner's Reply does not counsel otherwise.

Dated: December 8, 2023

Respectfully submitted,

/s/ Steven J. Pollinger

Steven J. Pollinger
Reg. No. 35,326
spollinger@mckoolsmith.com
George Fishback
Reg. No. 76,345
gfishback@mckoolsmith.com
McKool Smith, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701
Telephone: (512) 692-8700
Facsimile: (512) 692-8744

Ryan McBeth
Reg. No. 69,817
rmcbeth@mckoolsmith.com
McKool Smith, P.C.
600 Travis St., Suite 7000
Houston, Texas 77002
Telephone: (713) 485-7300
Facsimile: (713) 485-7344

Christopher P. McNett
Reg. No. 64,489
cmcnett@mckoolsmith.com
McKool Smith, P.C.
1999 K Street NW, Suite 600
Washington, D.C. 20006
Telephone: (202) 370-8300
Facsimile: (202) 370-8344

Counsel for Patent Owner, Mojo Mobility Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S PRELIMINARY SUR-REPLY** is being served via electronic mail, in its entirety on the following counsel of record for Petitioner:

Joseph E. Palys
Naveen Modi
Howard Herr
PH-Samsung-MojoMobility-IPR@paulhastings.com

Date: December 8, 2023

Respectfully submitted,

/s/ Steven J. Pollinger
Steven J. Pollinger
Reg. No. 35,326