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 IPR2023-01096
Patent 11,316,371

PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE

In response to the Board's November 28 email granting leave, Petitioner submits this reply to Patent Owner's ("PO") preliminary response (Paper 7) ("POPR").[1]

PO looks to avoid institution under *Fintiv*. (POPR, 1-2, 15-25.)[2] But, contrary to PO's assertions, "one single proceeding" will not "address all the issues in the eighteen IPRs." (POPR, 20.) Nor will it "cover all the invalidity grounds raised across the eighteen IPR petitions." (*Id.*, 16.) Indeed, PO recently narrowed the number of asserted claims to thirty-two claims from the seven asserted patents (Ex. 1201, 1) in the parallel "Texas Litigation" (*see* Pet., §II) and is required by mid-February 2024 to further reduce that number to "no more than a total of 16 claims" (Ex. 1202, 2). Thus, currently, challenged claims 21-23 in this petition will not be addressed in the Texas Litigation. Coupled with Petitioner's stipulation (further

[1] Consistent with that requested by the Board, this reply is substantively the "same" reply filed in the other pending IPRs, although references to papers/exhibits and underlying information may vary to accommodate the different proceedings.

[2] The petitions (including this one) are the result of PO's assertion of nearly one hundred lengthy claims across seven patents, most requiring multiple petitions (none of which challenge the same claims) to ensure such claim features were properly addressed.

addressed below), there will be no complete overlap of claims and prior art combinations amongst the Texas Litigation and IPR proceeding(s) should any Petitioner's IPR(s) be instituted. The Board has found that reduced issues in district court litigation, including the reduced number of asserted claims and prior art, "tilt[] in favor of institution." *Apple, Inc. v. SEVEN Networks, LLC*, IPR2020-00156, Paper 10 at 17, 21-22 (P.T.A.B. June 15, 2020). Moreover, institution here will serve the "interest of overall system efficiency and integrity" because it would allow this proceeding to "continue in the event" the Texas Litigation "fails to resolve the patentability question[s] presented in" this IPR. *Fintiv,* Paper 11 at 15.

While the above-noted lack of overlap further tips **factor 4** against denial, Petitioner expands its previous stipulation to further mitigate concerns on *Fintiv*.[3] Namely, Petitioner hereby further stipulates that if this IPR is instituted, Petitioner will not pursue an invalidity defense in the Texas Litigation with respect to the challenged claims of the '371 patent in this Petition based on (i) any of the same instituted grounds or (ii) any prior art reference that forms the basis of any instituted ground. The updated stipulation is broader than the previous one (encompassed by (i) above) because Petitioner will *additionally* forego an invalidity defense in the

[3] Petitioner previously stipulated "if the IPR is instituted, Petitioner will not pursue the IPR grounds in the district court litigation." (Pet., 84.)

Texas Litigation with respect to the challenged claims of the '371 patent in this Petition based on *any prior art reference that forms the basis of any instituted ground* (encompassed by (ii) above). The updated stipulation was filed with the district court on December 1, 2023. (Ex. 1203.) This intermediate-scope stipulation is broader than the hybrid stipulation previously presented, and thus further mitigates concerns the Board may have regarding overlapping issues in the Texas Litigation.

As to the other *Fintiv* factors, under the "holistic view" of whether integrity of the system and efficiency are best served, institution is favored. *Samsung Elecs. Co. Ltd. v. Dynamics Inc.*, IPR2020-00505, Paper 11 at 15 (P.T.A.B. Aug. 12, 2020). **Factor 1 (stay)** remains neutral, as there has been no actual denial of a stay (POPR, 18-20), and thus PO's assertion regarding the outcome of the motion to stay is speculative (*Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 12 (P.T.A.B. May 13, 2020) (informative)), especially when the court has granted such motions with at least a four-month difference between trial and the final written decision (FWD). *Scorpcast v. Boutique Media*, Case No. 2:20-cv-00193-JRG-RSP, Dkt. 177 at 2-5 (E.D. Tex. June 8, 2021) (stay granted where the FWD was expected more than six months after scheduled trial and, "[a]t the time the Motion was filed, jury selection…is scheduled [five months away], the claim construction hearing took place the previous week, and (both expert and fact) discovery were open."); *Arbor Global Strategies LLC v. Samsung Elecs. Co.*, No. 2:19-cv-00333-JRG-RSP, Dkt.

175 at 2 (E.D. Tex. January 7, 2021) (stay granted where the FWD was expected eight months after scheduled trial, and after the court had issued its claim construction order and "the trial was less than four months away."); *Communications Technologies, Inc. v. Samsung Electronics America, Inc. et al.*, 2:21-cv-00444-JRG, Dkt. 134 at 2-5 (E.D. Tex. February 2, 2023) (stay granted where the FWD was expected four months after scheduled trial, and it was "several weeks" before a Markman hearing and six months from the scheduled trial).

Factor 2 (trial proximity) weighs against denial or is at least neutral. As the Board recognizes, "[a] court's scheduled trial date…is not by itself a good indicator of whether the district court trial will occur before the [FWD]." (Ex. 1051, 8.) Petitioner diligently prepared and filed this petition along with seventeen others within four months of PO's infringement contentions identifying nearly 100 claims. (Exs. 1018, 1022.) Despite the proximity between the scheduled trial date and the FWD, taken as a whole, other relevant factors weigh against exercising discretion to deny institution, including *e.g.*, the lack of overlap (**factor 4** discussed above) and the relatively early stage of the litigation **(factor 3** discussed below), contrary to PO's assertions otherwise (POPR, 21).

Factor 3 weighs against discretional denial. Indeed, PO's alleged timeline (POPR, 22) shows that claim construction, fact/expert discovery, and other significant briefings (*e.g.*, dispositive motions) will not be resolved/addressed until

after the institution deadline of February 14, 2024. Thus, "further effort remains to be expended in [the Texas Litigation] before trial." *Fintiv*, Paper 15 at 14. PO's reliance on the *Verizon Business* to allege lack of diligence is misplaced as PO compared the time "after being served infringement contentions" in the *Verizon Business* case with the time after "the district court complaint was filed" in the current proceeding. (POPR, 22-23.) Relevant here is Petitioner's significant investment to expeditiously prepare and file this petition, along with seventeen others within four months of PO's infringement contentions to address ***nearly one hundred*** PO-asserted claims. (Exs. 1018, 1022.) Such prompt action "after becoming aware of the claims being asserted," weighs against discretionary denial. *Fintiv*, Paper 11 at 11; *Verizon Business*, IPR2020-01141, Paper 12 at 12.

While **Factor 5 (parties)** may weigh slightly in favor of denial simply because the parties are the same as in district court, this is outweighed for reasons supporting institution under factors 2-4, and 6. Thus, under the "holistic view" of whether integrity of the system and efficiency is best served, institution is favored. *Samsung Elecs.*, IPR2020-00505, Paper 11 at 15.

Respectfully submitted,

Dated: December 1, 2023

By: /Joseph E. Palys/
Joseph E. Palys (Reg. No. 46,508)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on December 1, 2023, I caused a true and correct copy of the foregoing Petitioner's Reply to Patent Owner's Preliminary Response to be served electronically on counsel for Patent Owner at the following addresses:

Steve Pollinger (spollinger@mckoolsmith.com)
Ryan McBeth (rmcbeth@mckoolsmith.com)
George Fishback (gfishback@mckoolsmith.com)
Christopher McNett (cmcnett@mckoolsmith.com)
MojoMobility_Samsung_IPR@mckoolsmith.com

By: /Joseph E. Palys/
Joseph E. Palys (Reg. No. 46,508)