

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

GEOSCOPE TECHNOLOGIES PTE. LTD.
Patent Owner

Case No. IPR2023-01210
Patent 8,400,358

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

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I. INTRODUCTION

Petitioner submits this Reply to Patent Owner’s Preliminary Response (Paper 10, “POPR”) to address the impact of the District Court’s Order and Patent Owner’s appeal to the Federal Circuit on discretionary denial under §314(a). The Board authorized this reply in its email dated December 22, 2023 (EX1029).

II. THE DISTRICT COURT ORDER DOES NOT TRIGGER DISCRETIONARY DENIAL

In the Related Litigation, the District Court determined that Claims 15 and 18 of the ’358 Patent challenged in this IPR are invalid under §101. EX2003. Patent Owner (“PO”) asserts that the Board should deny institution under §314(a) in view of the District Court’s ruling. POPR, 1. However, the mere fact that the District Court has determined that certain claims challenged in this IPR are invalid under §101 does not automatically trigger discretionary denial or necessitate a finding that the *Fintiv* factors weigh in favor of discretionary denial. See *Volvo Penta of the Americas, LLC v. Brunswick Corp.*, IPR2022-01366, Paper 16 (PTAB May 2, 2023) (decision on Director review vacating decision denying institution under §314(a)). In *Volvo*, which issued after *AviaGames* discussed in the POPR, the Director determined that an invalidity determination under §101 in a related litigation does not automatically trigger a finding that the *Fintiv* factors weigh in favor of discretionary denial. *Id.* at 8 (“the claims remain subject to further judicial review during the appeal of the district court’s invalidity determination. Accordingly, I

vacate the Board's § 314(a) analysis and remand for the Board to determine whether to exercise discretion to deny institution...."). The Board should conduct a *Fintiv* analysis and, in view of the District Court's Order and appeal, find that the *Fintiv* factors weigh against discretionary denial.

III. THE *FINTIV* FACTORS WEIGH AGAINST DISCRETIONARY DENIAL IN VIEW OF THE DISTRICT COURT ORDER AND FEDERAL CIRCUIT APPEAL

The *Fintiv* factors weigh against discretionary denial when taken in view of the District Court Order and Federal Circuit appeal for three reasons.

First, whereas the District Court's invalidity determination of Claims 15 and 18 of the '358 Patent was based on 35 U.S.C. §101, this IPR challenges validity under a different statutory basis, *i.e.*, 35 U.S.C. §§102 and/or 103. *See* EX2003. The §§102/103 invalidity challenge in this IPR stands independently from the invalidity determination under §101 being reviewed on appeal, as §§102/103 set forth requirements to patentability that are distinct from the requirements under §101. *See, e.g., Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech.*, 543 F.3d 657, 661 (Fed. Cir. 2008). Even if PO were to prevail on the §101 issue on appeal, the question of invalidity under §§102/103 at issue in this IPR nevertheless would be relevant to the Challenged Claims. There is no overlap of issues between the Federal Circuit appeal and the grounds presented in this IPR. The District Court made no determination concerning invalidity under §§102/103 (*see* EX2003), there is no §§102/103 ground

at issue on appeal (*see* EX2012), nor was trial even held in the Related Litigation addressing §§102/103 issues. PO can only speculate as to the outcome of the Federal Circuit appeal and the timing and scope of any remand. Because there is no District Court trial date, invalidity under §§102/103 is more likely to be resolved in a Final Written Decision well before the District Court addresses any validity and/or infringement issues on remand. *Fintiv* Factors 2-4 therefore weigh against discretionary denial.

Second, discretionary denial is unwarranted because the Petition challenges additional claims that are not at issue in the District Court Order and Federal Circuit appeal. Specifically, Petitioner has challenged Claims 1, 15, 18, 41, and 52 of the '358 Patent in this IPR. The validity of Claims 1 and 41 was not addressed in the District Court Order. EX2003, 2. PO itself asserts that such claims are not the subject of the Federal Circuit appeal. POPR, 2 (“Patent Owner has only appealed the district court’s §101 ruling as to dependent claim 18...”). The Board has determined that Factors 2 and 3 weigh against denial where—as is the case here—Petitioner challenges additional claims that were not addressed in the District Court’s judgment. *Samsung Bioepis Co., Ltd. v. Regeneron Pharma, Inc.*, IPR2023-00739, Paper 9 (PTAB Oct. 20, 2023) at pp. 57-58. In *Samsung*, the Board determined that “[b]ecause the district court action does not include all of the challenged claims within the scope of the litigation, we find that *Fintiv* factors 2 and 3 favor[s]

institution” (*id.* at p. 58). PO asserts that the initial panel decision in *AviaGames* (Paper 12) is “directly analogous” (POPR at 6) but overlooks that the panel decision did not involve additional claims challenged in the IPR that were not addressed in the District Court judgment—as was the case in *Samsung*, and as is the case here.

Third, PO asserts that discretionary denial is warranted because it has only sought appeal of Claim 18, and not Claim 15.¹ POPR, 1-2. The thrust of PO’s argument seems to be that a prior art-based challenge of non-appealed Claim 15 in this IPR is judicially inefficient given that Claim 15 has already been invalidated under §101 in District Court. PO has not filed a disclaimer in the Patent Office with respect to Claim 15, nor requested adverse judgment with respect to such claim in this IPR. Nor has PO presented any argument as to why Petitioner cannot challenge Claim 15 in this IPR based on principles of collateral estoppel in view of the §101 invalidity determination. If PO wishes for Claim 15 to be considered invalid for purposes of the Board’s *Fintiv* analysis, it should have filed a disclaimer or requested

¹ Discretionary denial is unwarranted given that Claims 1 and 41 challenged in this IPR were not expressly at issue in the District Court Order and are not at issue on appeal. *Samsung*, IPR2023-00739, Paper 9 at 57 (institution is favored where certain challenged claims “are not expressly at issue in the district court litigation”).

adverse judgment to such effect; PO did neither.² Any inefficiencies are caused by PO's attempt to leverage the non-appeal of Claim 15 as basis for discretionary denial, without disclaiming or otherwise requesting adverse judgment with respect to such claim. Even if PO had filed a disclaimer or requested adverse judgment with respect to non-appealed Claim 15, there is no overlap between the §§102/103 challenges presented in this IPR and the §101 issue on appeal, and the IPR grounds would be relevant if PO were to prevail on the §101 issue currently under review before the Federal Circuit.

IV. CONCLUSION

Petitioner need not satisfy the compelling merits standard given that the *Fintiv* factors do not favor discretionary denial in view of the District Court's Order and the Federal Circuit appeal. Even if the Board determines that the *Fintiv* factors favor denial, Petitioner meets the compelling merits standard for the reasons set forth in the Petition.

² Claim 52 was determined to be invalid under §112 based on a stipulation of invalidity following claim construction. *See* EX2003, 2. To the extent PO argues that Claim 52 should be considered invalid for purposes of *Fintiv*, PO should have requested adverse judgment to such effect, but failed to do so.

Date: January 5, 2024

Respectfully submitted,

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APPENDIX A – LIST OF EXHIBITS

Exhibit No.	Description
1029	Email from Board granting Petitioner's Request for Authorization to file Replies to Patent Owner's Preliminary Responses dated December 22, 2023
2003	Memorandum Opinion on Google's Motion for Judgment on the Pleadings on Patent Eligibility dated September 18, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA)
2012	Geoscope's Opening Appeal Brief dated November 17, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC, Apple Inc.</i> , Case Nos. 24-1003 (Lead) 24-1018 (member) (Fed. Cir.)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 5th day of January, 2024, a true and correct copy of the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE and EXHIBIT 1029** are being served by electronic mail to Patent Owner's counsel as follows:

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