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
U.S. Patent No. 8,400,358

PATENT OWNER'S REQUEST FOR REHEARING BY THE DIRECTOR

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d) and the Revised Interim Director Review Process[1], Patent Owner Geoscope Technologies Pte. Ltd. ("Patent Owner") respectfully requests Director Review of the Board's February 20, 2024 Decision Granting Institution of *Inter Partes* Review (Paper 14, "Decision") of U.S. Patent No. 8,400,358 ("'358 Patent").

In granting institution, the Board abused its discretion by misapplying the *Fintiv* factors that govern discretionary denial in view of a parallel district court proceeding under 35 U.S.C § 314(a). The relevant circumstances here are extraordinarily similar to those in the recent *AviaGames* proceeding, in which the Board exercised discretion to deny institution after analyzing the *Fintiv* factors. *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530, Paper 12 at 11-15 (PTAB Aug. 9, 2022). The Director granted review of that decision, vacating and remanding it ***only*** so that the Board could make a "compelling merits determination." *AviaGames*, IPR2022-00530, Paper 14 at 3. In other words, the Director found no fault in the Board's analysis of the *Fintiv* factors themselves in *AviaGames*— the remand was only for a separate merits-based determination. *Id*. The Board's

[1] https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process at § 3.A.

approach here was inconsistent with the remaining *AviaGames* analysis that the Director left intact.

Moreover, this Request presents an important issue of policy as to when discretionary denial is appropriate in the increasingly common scenario in which the claims of a challenged patent are invalidated by a district court before the Board rules on a petition for *inter partes* review ("IPR"). Guidance from the Director on this issue will promote uniformity and prevent inconsistent application of the *Fintiv* factors in proceedings involving these particular circumstances.

II. BACKGROUND OF THE CASE

A. The Related Court Proceedings

On September 18, 2023, a district court ruled that the asserted claims of the '358 Patent are unpatentable under 35 U.S.C. § 101 in two proceedings, one involving Petitioner Google LLC ("Petitioner") and another involving Apple Inc.[2] Preliminary Response (Paper 10, "POPR") at 5. The district court issued final judgments shortly thereafter in October of 2023, closing the district court

[2] These proceedings are *Geoscope Technologies Pte. Ltd. v. Google LLC.*, Civ. Action No. 1:22-cv-01331-MSN (E.D. Va.) ("Google Action") and *Geoscope Technologies Pte. Ltd. v. Apple Inc.*, Civ. Action No. 1:22-cv-01373-MSN (E.D. Va.) ("Apple Action").

proceedings pending Patent Owner's appeal. *Id*. at 5-6. Patent Owner has only appealed the district court's ruling for one claim—dependent claim 18. *Id*. at 6, 15-17. Briefing was completed in Patent Owner's appeal on February 16, 2024.

By the time the district court issued its § 101 decision, the district court had issued *Markman* orders and the parties had completed both fact and expert discovery in the Google Action and the Apple Action. POPR at 9-12. This included extensive written discovery, many depositions of fact and expert witnesses, and expert reports (including those addressing the validity of the '358 Patent under 35 U.S.C. §§ 102 and 103 based on the same prior art raised in the Petition). *Id*. at 9-10.

B. The Board's *Fintiv* Analysis

The Board considered the *Fintiv* factors, set forth below, to determine whether to exercise discretionary denial:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;

5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential).

The Board found that (i) *Fintiv* factors 1, 2, and 4 weigh against discretionary denial; (ii) *Fintiv* factor 3 slightly favors discretionary denial; (iii) *Fintiv* factor 5 weighs in favor of discretionary denial; and (iv) *Fintiv* factor 6 is neutral. Decision at 13-20. The Board then concluded that "factors 1, 2, and 4 outweigh the remaining factors" and declined to exercise discretion to deny institution. *Id*. at 21.

In analyzing the *Fintiv* factors, the Board focused heavily on a determination that the § 101 issues addressed by the district court do not overlap with the §§ 102 and 103 issues to be addressed by the Board. For example, the Board stated that it "did not discern that the § 101 issues addressed in the Federal Circuit appeal would duplicate the anticipation and obviousness issues addressed here." *Id*. at 15; *see also id*. at 19-20. Similarly, the Board found that the district court's § 101 ruling is categorically not "relevant to the issue of discretionary denial" because "there is no overlap of issues between this proceeding and the district court's judgment." *Id*. at 20.

The Board also referred to the *AviaGames* decision cited by Patent Owner but gave it little weight, finding that it did "not have the benefit of the guidance provided by the Director's decisions in *Volvo* and *AviaGames*." Decision at 15 n.10 (citing *Volvo Penta of the Americas, LLC v. Brunswick Corp.*, IPR2022-01366, Paper 15 (PTAB May 2, 2023) and *AviaGames*, IPR2022-00530, Paper 14). The Board found the same for *Snap Inc. v. Blackberry Ltd.*, IPR2020-00391, Paper 8 (PTAB Jul. 13, 2020)—another decision cited by Patent Owner in which the Board exercised discretion to deny institution in view of a district court's prior invalidity determination under § 101 (*see* POPR at 7). Decision at 15 n.10.

III. ARGUMENT

The Board abused its discretion in analyzing the *Fintiv* factors by drawing a bright line that no "overlap" exists between § 101 issues and §§ 102/103 issues, and thus finding the district court's prior § 101 invalidity determination to be irrelevant to the issue of discretionary denial. The Board relied heavily on the basic principle that § 101 issues are different from §§ 102/103 issues. Decision at 14, 19-20. But this is true for all petitions—these are different statutes addressing different bases for invalidating claims. This is not dependent on the facts at issue in the proceeding despite the *Fintiv* analysis requiring "a holistic look at the facts surrounding the parallel proceeding in each case." *Fintiv*, IPR2020-00019, Paper 15 at 6 (designated informative); *see also Fintiv*, IPR2020-00019, Paper 11 at 6 (explaining that the

Board "takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review" based on the "facts" pertaining to each *Fintiv* factor). If prior § 101 determinations were relevant for *AviaGames* and *Snap*, there is no principled reason why they should not be relevant here as well. The legal interplay between § 101 issues and §§ 102/103 issues, as they relate to the *Fintiv* analysis, should be consistent across petitions and Board panels.

Here, the Board went so far as to state that "because there is no overlap of issues between this proceeding and the district court's judgment, ***we do not find the court's invalidity finding to be relevant to the issue of discretionary denial***." Decision at 20 (emphasis added). By finding the district court's § 101 ruling to be ***irrelevant*** to the issue of discretionary denial, the Board effectively adopted a bright-line rule that a prior invalidity determination under § 101 cannot be a basis for discretionary denial in view of the *Fintiv* factors, as patent claims cannot be challenged under § 101 in an IPR. 35 U.S.C. § 311(b) ("A petitioner in an *inter partes* review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications."). As a result, under this approach, there effectively would be no basis for the Board to ever exercise discretion to deny institution in view of a district court's prior invalidation of claims under § 101.

That approach is inconsistent with prior Board decisions—including the recent *AviaGames* decision which the Director reviewed and found no fault in the Board's analysis of the *Fintiv* factors, including its reliance on a prior § 101 ruling by a district court. As explained in the POPR, the facts in *AviaGames* and *Snap* that led the Board to discretionarily deny institution are remarkably similar to those here. POPR at 6-7. And, under those facts, the Board in *AviaGames* and *Snap* found that nearly every *Fintiv* factor favored discretionary denial specifically ***because*** of a prior invalidation under § 101. The Board's approach here is inconsistent with those decisions and their reasoning, and threatens confusion over the proper approach.

As one example[3], the Board in *AviaGames* found that factor 2 "weighs ***heavily*** in favor of denying institution" because, with its § 101 ruling, "the District Court has completed its consideration of the [challenged] patent." *AviaGames*, IPR2022-00530, Paper 12 at 12-13 (emphasis added). By contrast, the Board here found the same factor to ***weigh against*** the exercise of discretionary denial, reasoning that,

[3] Additional examples, supported by citations to *AviaGames* and *Snap*, are set forth in the POPR as Patent Owner pointed to the Board's analysis of the *Fintiv* factors in those decisions as part of explaining why the factors support discretionary denial here. POPR at 7-8 (factor 1), 8-9 (factor 2), 9 (factor 3), 12 (factor 4), 14 (factor 5), 15 (factor 6).

despite the termination of the proceedings, there is "no district court trial date scheduled" and "the date of any potential trial related to anticipation or obviousness challenges is uncertain … but it is likely … after the completion of this proceeding." Decision at 16. The same could have been said in *AviaGames*. *AviaGames*, IPR2022-00530, Paper 12 at 12 ("There is no trial date for consideration of the [challenged] patent in the district court because a non-final determination that the [challenged] patent is invalid was made on March 14, 2022."). Yet, the Board treated this factor oppositely in these two proceedings under the same circumstances.

The Board here analyzed the *Fintiv* factors inconsistently with how the Board addressed the factors under virtually identical circumstances in *AviaGames* and *Snap*. The Board in *AviaGames* and *Snap* relied heavily on a district court's prior invalidation of claims under § 101 to deny institution. Indeed, in *AviaGames*, the Board explained that "the District Court's invalidity determination is ***the most important relevant circumstance***" impacting the issue of discretionary denial. *AviaGames*, IPR2022-00530, Paper 12 at 14-15 (emphasis added); *see also* POPR at 15 (quoting same). But the Board here found the ***exact opposite***—that the district court's prior invalidation under § 101 is not even "relevant to the issue of discretionary denial." Decision at 20. This discrepancy prevents consistent application of the *Fintiv* factors under identical facts. Thus, granting Director Review would serve an important policy objective—providing certainty and

uniformity in how the *Fintiv* factors are analyzed in view of a prior § 101 invalidity determination.

The Board recognized Patent Owner's reliance on the *AviaGames Fintiv* Analysis.[4] *See, e.g.,* Decision at 13-15. But the Board gave little weight to the *AviaGames Fintiv* Analysis, finding that it "did not have the benefit of the guidance provided by the Director's decisions in *Volvo* and *AviaGames*." Decision at 15 n.10; *see also id*. at 14 (stating that "[t]he Director has additionally distinguished" the *AviaGames Fintiv* Analysis, citing the *AviaGames* Director Decision).

The Board misapprehended how the *AviaGames* Director Decision and *Volvo* Director Decision relate to the *AviaGames Fintiv* Analysis. Neither set aside or found error in the *AviaGames Fintiv* Analysis. In the *AviaGames* Director Decision, the Director stated that "the Board shall not deny institution of an IPR in view of a district court judgment of invalidity ***if the record prior to institution meets the***

[4] This paragraph and the subsequent ones describe different decisions by the Board and Director in the *AviaGames* proceeding. For clarity, (i) the decision analyzing the *Fintiv* factors (Paper 12) is referred to as the "*AviaGames Fintiv* Analysis" and (ii) the Decision on Director Review (Paper 14) is referred to as the "*AviaGames* Director Decision." Additionally, the Decision on Director Review in *Volvo* (Paper 15) is referred to as the "*Volvo* Director Decision."

compelling merits standard." *AviaGames*, IPR2022-00530, Paper 14 at 4 (emphasis added). The *AviaGames* Director Decision is entirely about the "compelling merits test"—none of it finds fault in the Board's analysis of the *Fintiv* factors. *See id*. at 5.

Thus, as Patent Owner stated in the POPR, the Director necessarily reviewed the *AviaGames Fintiv* Analysis, but did not disagree with or take issue with that analysis. POPR at 6. If anything, the *AviaGames* Director Decision is an endorsement of the treatment of the *Fintiv* factors in the *AviaGames Fintiv* Analysis—including the critical importance the district court's § 101 ruling played in that analysis— as the Director stated that "[i]f the Board finds the record does not rise to [the compelling merits] standard, the Board ***will*** exercise discretion to deny institution." *AviaGames*, IPR2022-00530, Paper 14 at 4 (emphasis added). On remand, the Board found the petition did not present a compelling challenge on the merits and maintained its discretionary denial. *AviaGames*, IPR2022-00530, Paper 15 at 2-3.

Thus, contrary to the Board's characterization here, the *AviaGames* Director Decision did not "distinguish[]" the *AviaGames Fintiv* analysis. Decision at 14. Nor did it provide any contrary "guidance" as to how each *Fintiv* factor should be analyzed. *Id*. at 15 n.10. The *AviaGames* Director Decision merely explains that institution is required if a petition presents "compelling merits" even if the *Fintiv* factors support discretionary denial. *AviaGames*, IPR2022-00530, Paper 14 at 4. The

AviaGames Director Decision did not fault or alter any of the Board's underlying *Fintiv* analysis, including the relevance of the prior § 101 ruling. The Board's analysis here—that the district court's § 101 ruling is categorically irrelevant to the *Fintiv* analysis—is inconsistent with the analysis of the *Fintiv* factors in *AviaGames* that the Director did not alter or criticize.

The *Volvo* Director Decision also does not contradict the *AviaGames Fintiv* Analysis. In that decision, the Director vacated the Board's finding that it lacked statutory authority to institute on claims that were invalidated under § 101 by a district court but pending appeal. *Volvo*, IPR2022-01366, Paper 15 at 5-7. Additionally, the Director remanded for the Board to perform a *Fintiv* analysis, stating that "*AviaGames* recognizes that a *Fintiv* analysis should be conducted in scenarios like this, where a district court has rendered a non-final invalidity determination that some or all of the claims challenged in an IPR petition are invalid, even on grounds that cannot be raised in that IPR." *Id*. at 8. Thus, the *Volvo* Director Decision stands for the proposition that the Board should conduct a *Fintiv* analysis under the circumstances present here. That is not disputed here—both parties addressed the *Fintiv* factors in their papers.

Contrary to the Board's determination, the *Volvo* Director Decision does not provide new "guidance" on the application of the *Fintiv* factors nor does it demonstrate any error in the *AviaGames Fintiv* Analysis. Decision at 15 n.10. If

anything, the *Volvo* Director Decision supports Patent Owner's position. The Director's reliance on the *AviaGames* Director Decision and instruction to the Board to "evaluate *Fintiv* factors 1-5" in view of a district court's prior § 101 invalidity determination further confirm that such determination is relevant to the issue of discretionary denial. *Volvo*, IPR2022-01366, Paper 15 at 8 (citing *AviaGames*, IPR2022-00530, Paper 14 at 3). If the district court's § 101 invalidity determination was categorically irrelevant to the issue of discretionary denial—as the Board found here (Decision at 20)—the Director's remand for evaluation of the *Fintiv* factors in view of that determination would be unnecessary.

Additionally, the Board gave little credit to the *AviaGames Fintiv* Analysis because "[o]ther panels decisions are not binding." Decision at 15 n.10. Although the *AviaGames Fintiv* Analysis is not precedential, the Director reviewed that decision and found no error in its treatment of the *Fintiv* factors. Despite this—and despite the similarity of circumstances—the Board here analyzed the *Fintiv* factors significantly differently from how they were analyzed in the *AviaGames Fintiv* Analysis.

At a minimum, this creates an inconsistency in how the *Fintiv* factors are analyzed where a district court has invalidated claims under § 101 prior to institution. Harmonizing the analysis of the *Fintiv* factors under these circumstances would promote uniformity and predictability in the Board's institution decisions. Patent

Owner respectfully submits that the approach in *AviaGames*—which gives weight to the district court's § 101 invalidity determination—is more effective than the Board's approach here—which found the district court's § 101 invalidity determination to be irrelevant (Decision at 20)—in promoting the "efficiency and integrity of the system." *Fintiv*, IPR2020-00019, Paper 11 at 6.

IV. CONCLUSION

For the reasons above, Patent Owner respectfully requests that the Director grant review of the Board's decision to institute an *inter partes* review, vacate that decision, and remand for further proceedings consistent with the Director's guidance.

Respectfully submitted,

Dated: March 5, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Request for Rehearing by the Director**, was served on March 5, 2024 *via* email directed to counsel of record and by filing documents through the Patent Trial and Appeal Case Tracking System (P-TACTS):

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