From:	Singer, Ryan
To:	Director_PTABDecision_Review
Cc:	patrick.keane@bipc.com; roger.lee@bipc.com; matthew.fedowitz@bipc.com; andrew.cheslock@bipc.com; mythili.markowski@bipc.com; samuel.harrod@bipc.com; ralph.fischer@bipc.com; Gerson, Chris; Patent
Subject:	Request for Director Review: Google LLC v. Geoscope Technologies Pte. Ltd. (IPR2023-01209, IPR2023-01210, IPR2023-01211, IPR2023-01212)
Date:	Tuesday, March 5, 2024 7:53:55 PM
Attachments:	IPR2023-01209 - 2024-03-05 - Paper 16.pdf IPR2023-01210 - 2024-03-05 - Paper 16.pdf IPR2023-01211 - 2024-03-05 - Paper 16.pdf IPR2023-01212 - 2024-03-05 - Paper 16.pdf

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Dear Director Vidal,

Patent Owner Geoscope Technologies Pte. Ltd. respectfully seeks Director Review of a Board panel's February 20, 2024 decisions to grant institution of four related IPRs (IPR2023-01209, IPR2023-01210, IPR2023-01211, IPR2023-01212) that challenge claims of U.S. Patent Nos. (i) 7,561,104, (ii) 8,400,358, (iii) 8,786,494, and (iv) 8,406,753. Pursuant to Section 3.A of the Revised Interim Director Review Process and 37 C.F.R. § 42.71(d), Patent Owner has filed Requests for Rehearing by the Director ("Requests") in each of these proceedings using the P-TACTS system and submits this email, copying counsel for all parties to the proceedings. The Requests are also attached to this email.

Each of the Requests presents the same issue regarding how a district court's prior invalidation of claims under § 101—*i.e.*, a basis for invalidation that cannot be raised in a petition for IPR—relates to the *Fintiv* factors that govern discretionary denial in view of a parallel district court proceeding under 35 U.S.C § 314(a). As explained in the Requests, the Board panel abused its discretion in each of these proceedings by finding that a district court's prior invalidation of claims under § 101 is categorically irrelevant to the *Fintiv* analysis because there is no "overlap" between § 101 issues and the §§ 102/103 issues raised in the petitions. This approach is contrary to the Board's heavy reliance on a district court's prior invalidation of claims under § 101 to discretionarily deny institution in *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530, Paper 12 (PTAB Aug. 9, 2022) and *Snap Inc. v. Blackberry Ltd.*, IPR2020-00391, Paper 8 (PTAB Jul. 13, 2020). Indeed, whereas the panel in *AviaGames* found that a district court's § 101 invalidity determination was "the most important relevant circumstance" impacting the issue of discretionary denial, this panel found that the district court's § 101 invalidity determination was not relevant to the issue of discretionary denial. *AviaGames*, IPR2022-00530, Paper 12 at 14-15. Importantly, the Director granted review in *AviaGames* but only instructed that the Board make a "compelling merits determination"—the Director found no fault in the Board's analysis of the *Fintiv* factors themselves, including the Board's substantial focus on the district court's prior § 101 invalidity determination, and left that analysis intact. *AviaGames*, IPR2022-00530, Paper 14 at 3.

These Requests also present important an important issue of policy regarding the application of the *Fintiv* factors in the increasingly common scenario in which the claims of a challenged patent are invalidated under § 101 by a district court prior to institution. There are significant discrepancies in how different Board panels consider these same

circumstances when analyzing the *Fintiv* factors, resulting in inconsistency and unpredictability in institution decisions. Granting Director Review would help promote certainty and uniformity in how the *Fintiv* factors are analyzed in these particular circumstances. As explained in the Requests, the approach taken by the Board in *AviaGames*—which gives weight to a district court's prior § 101 invalidity determination—promotes the efficient use of Board resources more than the approach taken by the Board panel here, which treats a prior § 101 invalidity determination as irrelevant to the issue of discretionary denial.

Accordingly, Patent Owner respectfully requests that the Director grant review of the Board's decision to institute in each of these proceedings, vacate the decisions, and remand for further proceedings consistent with the Director's guidance.

Sincerely,
Ryan Singer
Counsel for Patent Owner Geoscope Technologies Pte. Ltd.

Ryan J. Singer
Associate

T: +1 212.756.2561
E: Ryan.Singer@srz.com

Schulte Roth & Zabel LLP
919 Third Avenue, New York, NY 10022
srz.com | LinkedIn | Twitter

SCHULTE ROTH + ZABEL

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