

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. IPR2023-01213
Patent 9,097,784

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

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. <i>FINTIV</i> DOES NOT APPLY BECAUSE 7 OF THE 8 CLAIMS CHALLENGED IN THIS IPR WERE NOT ADDRESSED IN THE DISTRICT COURT ORDER	1
III. THE <i>FINTIV</i> FACTORS WEIGH AGAINST DISCRETIONARY DENIAL IN VIEW OF THE DISTRICT COURT ORDER AND FEDERAL CIRCUIT APPEAL	3
IV. CONCLUSION.....	5
APPENDIX A – LIST OF EXHIBITS	
CERTIFICATE OF SERVICE	

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.</i> , 543 F.3d 657 (Fed. Cir. 2008)	3
<i>Samsung Bioepis Co., Ltd. v. Regeneron Pharma, Inc.</i> , IPR2023-00739, Paper 9 (PTAB Oct. 20, 2023)	4, 5
<i>Volvo Penta of the Americas, LLC v. Brunswick Corp.</i> , IPR2022-01366, Paper 16 (PTAB May 2, 2023)	3
 Statutes	
35 U.S.C. §102	2, 3, 4
35 U.S.C. §103	2, 3, 4
35 U.S.C. §112	2, 3, 5
35 U.S.C. §314(a)	1

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. *FINTIV* DOES NOT APPLY BECAUSE 7 OF THE 8 CLAIMS CHALLENGED IN THIS IPR WERE NOT ADDRESSED IN THE DISTRICT COURT ORDER

The District Court Order in the Related Litigation expressly addressed only one claim of the ’784 Patent—Claim 11. EX2003, 2. The District Court entered the parties’ stipulation of invalidity for indefiniteness of such claim. *Id.*; EX2021, 3.

Petitioner challenges Claims 1, 2, 10, 11, 12, 13, 21, and 22 of the ’784 Patent in this IPR. Seven of the eight Challenged Claims were not at issue in the District Court Order. EX2003, 2. Specifically, Claims 1, 2, 10, 12, 13, 21, and 22 were not addressed in the District Court Order and Patent Owner (“PO”) concedes that the ’784 Patent is not the subject of the Federal Circuit appeal. POPR, 1. Thus, the *Fintiv* factors are irrelevant to 7 of the 8 claims challenged in this IPR (Claims 1, 2, 10, 12, 13, 21, and 22) given that such claims were not addressed in the District Court Order and are not the subject of the Federal Circuit appeal. There is no pending parallel litigation or appeal concerning Claims 1, 2, 10, 12, 13, 21, and 22, and there

was never any determination concerning §§102/103 invalidity—which is the subject of this IPR.

That this IPR also challenges a single claim (Claim 11) that was determined to be invalid for indefiniteness in the Related Litigation does not necessitate a *Fintiv* analysis. PO's argument for discretionary denial hinges on its assertion that the District Court Order addressed indefiniteness of "the '784 Patent claims". POPR, 1. However, as noted above, the District Court Order expressly addressed indefiniteness of only a single claim, Claim 11. PO has not filed a disclaimer in the Patent Office with respect any Challenged Claim of the '784 Patent. Nor has PO presented any argument as to why Petitioner cannot challenge the claims of the '784 Patent in this IPR based on principles of collateral estoppel in view the District Court's indefiniteness determination. If PO wishes for the Challenged Claims to be considered invalid under §112 for purposes of the Board's *Fintiv* analysis, it should have filed a disclaimer or requested adverse judgment to such effect; PO did neither. Such a request for adverse judgment would have resulted in termination of this IPR—a judicially efficient outcome—but PO seeks to avoid termination yet confusingly attempts to rely on the indefiniteness of "the '784 Patent claims" to invoke *Fintiv*. Clearly, any inefficiencies are caused by PO's attempt to leverage an indefiniteness finding of a single claim of the '784 Patent as basis for discretionary denial, without actually disclaiming or otherwise requesting adverse judgment with

respect to such claim, or any other Challenged Claim for that matter. These tenuous circumstances are of PO's own making and do not warrant a *Fintiv* analysis.

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

The mere fact that the District Court has determined that a single claim challenged in this IPR is invalid under §112 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). Indeed, *Fintiv* does not even apply for the reasons discussed above.

Assuming (incorrectly) that a *Fintiv* analysis is appropriate, 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 Claim 11 of the '784 Patent was based on 35 U.S.C. §112, 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 §112, as §§102/103 set forth requirements to patentability that are distinct from the requirements under §112. *See, e.g., Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech.*, 543 F.3d 657, 661 (Fed. Cir. 2008). Consequently, there

is no overlap of issues between the District Court’s indefiniteness determination of Claim 11 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. Because the Related Litigation has concluded without appeal of any claim of the ’784 Patent, no trial will ever take place concerning the challenged claims of the ’784 Patent. *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, as noted above. Specifically, Petitioner has challenged Claims 1, 2, 10, 11, 12, 13, 21, and 22 of the ’784 Patent in this IPR. The validity of Claims 1, 2, 10, 12, 13, 21, and 22 were not addressed in the District Court Order, and PO concedes that the ’784 Patent is not the subject of the Federal Circuit appeal. EX2003, 2. 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 “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, as explained above, if PO wishes for the Challenged Claims to be considered invalid under §112 for purposes of the Board’s *Fintiv* analysis, it should have filed a disclaimer or requested adverse judgment to such effect; PO did neither. Any inefficiencies are caused by PO’s attempt to leverage an indefiniteness finding of a single claim of the ’784 Patent as basis for discretionary denial, without actually disclaiming or otherwise requesting adverse judgment with respect to such claim, or any other Challenged Claim for that matter.

IV. CONCLUSION

Fintiv does not apply to this proceeding. Even if *Fintiv* applies, 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. Should the Board determine that the *Fintiv* factors favor denial, Petitioner meets the compelling merits standard for the reasons set forth in the Petition.

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.)
2021	Stipulation of Partial Judgment of Noninfringement and Invalidity dated August 15, 2023, <i>Geoscope Technologies Pte. Ltd. v. Apple Inc.</i> , Civ. Action No. 1:22-cv-01373 (EDVA)

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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