

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
U.S. Patent No. 9,097,784

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

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I. INTRODUCTION

Patent Owner submits this Sur-Reply to Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 12, “Reply”). The Board authorized this sur-reply in its email dated December 22, 2023. Ex. 1029. For the reasons set forth herein and in Patent Owner’s Preliminary Response (Paper 10, “POPR”), the Board should exercise its discretion to deny institution under § 314(a) because institution would be an “inefficient use of Board resources.” *NHK Spring Co., Ltd. v. Intrix-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 at 19-20 (PTAB Sept. 12, 2018).

II. THE *FINTIV* FACTORS WEIGH IN FAVOR OF DISCRETIONARY DENIAL UNDER § 314(A)

As explained in the POPR, all of the *Fintiv* factors weigh in favor of discretionary denial. POPR at 5-18. And the Petition fails to meet the “high standard” needed to demonstrate a “compelling unpatentability challenge” that would require institution despite those factors. *Id.* at 3-5, 15; *see also id.* at § VII. Thus, discretionary denial is appropriate. Indeed, the Board’s analyses resulting in discretionary denial in *AviaGames* and *Snap*—both addressed extensively in the POPR—are directly applicable to this proceeding and further demonstrate why the Board should exercise its discretion to deny institution here. *Id.* at 6-11, 13-18.

Petitioner’s Reply does not warrant a different result. Petitioner first argues that *Fintiv* does not apply because “[s]even of the eight Challenged Claims were not

at issue in the District Court Order” and “the District Court Order expressly addressed indefiniteness of only a single claim, Claim 11.” Reply at 1-2. Petitioner ignores that the claim terms found indefinite by the district court—“in proximity” and “determining said most likely street as a first one of said plural geographic locations” (*see* Ex. 1028 at 24-30)—are in every claim of the ’784 Patent. POPR at 5 n.2 (citing Ex. 1001 at cls. 1, 12).

Moreover, the Director has recently confirmed that the Board should conduct a *Fintiv* analysis under the present circumstances. In *Volvo*—which Petitioner cites (Reply at 3)—the Board initially found “*Fintiv* [] is inapplicable to the circumstances presented here” because of a district court’s adverse § 101 ruling in a related litigation. *Volvo Penta of the Americas, LLC v. Brunswick Corp.*, IPR2022-01366, Paper 12 at 13 (PTAB Feb. 8, 2023). The Director vacated the decision and required the Board to perform a *Fintiv* analysis, stating “*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.” *Volvo*, IPR2022-01366, Paper 16 at 7-8 (PTAB May 2, 2023). Thus, the Board should perform a *Fintiv* analysis here.

Petitioner also suggests that Patent Owner should have filed a “disclaimer or requested adverse judgment” with respect to the claims of the ’784 Patent. Reply at 2. Petitioner identifies no authority for any purported requirement for Patent Owner

to file a disclaimer or request adverse judgment as to the claims. And despite the parties corresponding after the POPR was filed, Petitioner never proposed that Patent Owner should file a disclaimer or request adverse judgment. As demonstrated by Patent Owner's analysis of the *Fintiv* factors, the inefficiency of institution is a result of what Petitioner has challenged and what the district court has already adjudicated. No disclaimer or adverse judgment is necessary to show that inefficiency.

Petitioner additionally asserts that even if *Fintiv* applies—which it does—the factors weigh against discretionary denial. Reply at 3-5. Petitioner contends that discretionary denial is inappropriate because the district court's invalidity determination was based on § 112 whereas the Petition presents challenges under §§ 102 and/or 103. Reply at 3-4. But this has no bearing on the ultimate inquiry here—whether institution is an “inefficient use of Board resources.” *NHK*, IPR2018-00752, Paper 8 at 19-20. Indeed, the same was true in *AviaGames* and *Snap* (*i.e.*, the district court's invalidity ruling was not based on §§ 102 and/or 103). Despite that, the Board recognized in both that it is an inefficient use of resources to consider invalidity of claims under §§ 102 and/or 103 where they have already been found invalid for a different reason. POPR at 6-7 (citing *AviaGames, Inc. v. Skillz Platform, Inc.*, IPR2022-00530, Paper 12 at 11-15 (PTAB Aug. 9, 2022); *Snap Inc. v. Blackberry Ltd.*, IPR2020-00391, Paper 8 at 17 (PTAB July 13, 2020)).

Next, Petitioner contends discretionary denial is unwarranted because the Petition “challenges additional claims that are not at issue in the District Court Order and Federal Circuit appeal.” Reply at 4-5. As explained above, however, this assertion is incorrect because the basis for the district court’s § 112 invalidity ruling applies to the other challenged claims as they include the same claim terms found indefinite by the district court. Put simply, the challenged claims were inherently addressed by the district court because it found terms in those claims to be indefinite even if those terms were addressed in the context of claim 11.

Moreover, even if Petitioner’s “additional claims” assertion were correct, the Board recognized in *Fintiv* that if a petition “challenges claims in addition to those that are challenged in the district court, it may still be inefficient to proceed....” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13 (PTAB Mar. 20, 2020) (precedential); *see also Samsung Elecs. Co., Ltd. v. Clear Imaging Rsch., LLC*, IPR2020-01399, Paper 13 at 21 (PTAB Feb. 3, 2021) (“*Clear Imaging*”) (exercising discretion to deny institution where the petition challenged 29 claims, only three of which were at issue in the parallel litigation, because “the mere existence of non-overlapping claims” does not favor institution). Petitioner relies on *Samsung Bioepis Co., Ltd. v. Regeneron Pharma., Inc.*, IPR2023-00739, Paper 9 (PTAB Oct. 20, 2023) but it is readily distinguishable. In *Samsung*, the Board relied on the petitioner’s arguments regarding differences between the claims addressed by the

district court and the additional challenged claims in finding that *Fintiv* factors weighed in favor of institution. *Id.* at 56-57 (“the ten non-overlapping challenged claims recite ... a different dosing regiment ... as well as exclusion criteria”). The Board has repeatedly considered a petitioner’s arguments regarding such differences in the non-overlapping claims—or failure to make such arguments—in assessing the *Fintiv* factors. *See Clear Imaging*, IPR2020-01399, Paper 13 at 22 (“Petitioner does not show that the non-overlapping claims differ significantly in some way. ... Therefore, notwithstanding that there are non-overlapping claims, this factor does not weigh against exercising our discretion to deny institution under § 314(a).”). Petitioner has not even attempted to explain the differences between the non-overlapping and overlapping claims, or the relevance of any such differences, despite having ample opportunity to do so in its Petition and Reply. Thus, Petitioner effectively contends that the mere existence of non-overlapping claims is enough to avoid discretionary denial but the Board has previously rejected that argument and should do so again. *Id.* at 21-22.

III. CONCLUSION

As explained in the POPR and herein, because institution of any ground raised in the Petition would be an inefficient use of the Board’s resources and the Petition fails to satisfy the “compelling merits test,” the Board should exercise its discretion under § 314(a) to deny institution.

Respectfully submitted,

Date: January 11, 2024

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APPENDIX A – LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 9,097,784, issued on July 14,2009 (“the ’784 Patent”)
1028	Claim Construction Memorandum Opinion & Order dated July 19, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Civ. Action No. 1:22-cv-01331 (EDVA) filed on November 22,2022
1029	Email from Board granting Petitioner’s Request for Authorization to file Replies to Patent Owner’s Preliminary Responses dated December 22, 2023

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 11th day of January, 2024, a true and correct copy of the foregoing **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** are being served by electronic mail to Patent Owner's counsel as follows:

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Dated: January 11, 2024

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