

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. IPR2023-01214
Patent 8,320,264

**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 9, “POPR”) to address the impact of the District Court’s Order and Patent Owner’s (“PO”) 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

The *Fintiv* factors identified by the Board in *Apple Inc. v. Fintiv* under §314(a) are inapplicable in this case and should not be considered when determining whether to exercise discretion to deny institution. *See* IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential). *See also NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential).

PO contends that “[t]he Board should exercise its discretion to deny institution under § 314(a) because institution would be an ‘inefficient use of Board resources.’” POPR, p.2 (citing *NHK* at 19-20). PO supports this by asserting that “two district court litigations involving the ’264 Patent are not just at advanced stages but, in fact, have ***already resulted in final judgments***.” POPR, p.2. PO also points to the District Court’s §101 Order, which “did not address the ’264 Patent due to the parties’ prior stipulation of non-infringement” that issued after the Petition was filed. POPR, p.7, n.2.

The *Fintiv* factors are inapplicable because there is no parallel related litigation and none of the claims of the '264 Patent are on appeal. As PO stated, litigation involving the '264 Patent has already resulted in judgments of **non-infringement** due to a stipulation of non-infringement. The litigation involving the '264 Patent is closed. PO admits that "Patent Owner's appeal does not involve the '264 Patent." POPR, p.5; *see* EX2024 (Docketing Statement for PO's appeal indicating that the '264 Patent is not at issue on appeal). There is no longer a parallel district court proceeding involving the '264 Patent. POPR, p.5.

According to the Board in *Fintiv*, the factors relate to supporting the exercise of authority to deny institution "in view of an earlier trial date *in the parallel proceeding.*" *Fintiv* at 6, *see also* *Fintiv* at 5 (heading, "B. Factors Related to a *Parallel, Co-Pending Proceeding* in Determining Whether to Exercise Discretionary Institution or Denial") (emphasis added). Close of the litigation involving the '264 Patent based on non-infringement, with no decisions on invalidity, ends the case permanently. This is akin to a permanent stay of the District Court proceeding since the lawsuit is now over. *See Precision Planning, LLC v. Deere & Co.*, IPR2019-01052, Paper 19 at 10 (PTAB Jan. 7, 2020) (finding that the district court stay of the parallel district court case rendered moot the patent owner's argument for discretionary denial). There is no longer a parallel, co-pending proceeding involving

the '264 Patent. POPR, p.5. PO's appeal of claims in separate patents do not impact any *Fintiv* analysis for the Petition against claims of the '264 Patent.

The *Fintiv* factors should therefore not be considered because there is no longer any parallel proceeding. Because the *Fintiv* factors do not apply when considering the Board's discretion to deny institution under §314(a), Petitioner does not bear the burden of demonstrating compelling merits. To the extent *Fintiv* is considered, Petitioner meets the compelling merits standard as set forth in the Petition.

III. THE BOARD SHOULD NOT CONSIDER THE DISTRICT COURT'S §101 ORDER AND PATENT OWNER'S APPEALS

PO points to the "final judgments" in both the Google and Apple actions. POPR, pp.4-5. The "final judgments" involved judgments of non-infringement as to the '264 Patent and no other issues. POPR, p.7, n.2 (explaining that "the district court's § 101 ruling did not address the '264 Patent"). The final judgments identified by PO do not involve invalidity of the claims of the '264 Patent. PO's appeals to the Federal Circuit do not involve claims of the '264 Patent. POPR, p.5.

The "final judgments" PO identifies and their associated appeals are irrelevant to this proceeding and should not be considered. They do not involve the '264 Patent and are irrelevant to the evaluation of whether the Board should exercise discretion under §314(a).

IV. THE DISTRICT COURT’S ORDER AND PATENT OWNER’S APPEAL HAVE NO IMPACT ON A *FINTIV* ANALYSIS

To the extent the Board finds that the *Fintiv* factors apply to a determination of whether to exercise discretion to deny institution under §314(a), the District Court Order and PO’s appeal identified by PO do not weigh in favor of denial. The litigation involving the ’264 Patent has concluded and cannot be stayed. The District Court did not consider any invalidity arguments and no final judgment was entered concerning invalidity of any of the claims of the ’264 Patent. Invalidity of the claims at-issue in this proceeding will never be addressed by the District Court as the Related Litigation has concluded. POPR, p.5.

PO admits that “[t]here is no further scheduled or proposed trial date in the Google Action.” POPR, p.6. “*NHK* applies to the situation where the district court has set a trial date to occur earlier than the Board’s deadline to issue a final written decision in an instituted proceeding.” *Fintiv*, at 3. There is no longer a looming trial date because the District Court issued a final ruling of non-infringement that has not been appealed. POPR, p.5.

According to the Board, “weighing the degree of overlap is highly fact dependent.” *Fintiv*, p.13. There is no overlap of issues with this Petition because invalidity of the ’264 Patent was not addressed and will never be addressed by the District Court. The final judgment of non-infringement with regard to the ’264 Patent has no bearing on invalidity, and thus no bearing on the Petition. Arguments

relating to invalidity under §§102 and 103 were not substantively presented or adjudicated at trial and will never be addressed by the Related Litigation because the Related Litigation is complete. POPR, p.5.

There is no longer any parallel proceeding and there is no ruling issued by the District Court in the previously pending lawsuits related to invalidity of any of the claims at issue in this proceeding. Nor are there any overlapping issues related to the now complete District Court proceedings.

When taking “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review”, it is evident the Board should institute review. Invalidity of the claims of the '264 Patent have not yet been determined and PO is litigious. Thus, institution of trial by the Board is appropriate and should be instituted.

V. CONCLUSION

Petitioner need not satisfy the compelling merits standard given that the *Fintiv* factors are inapplicable in this Petition. To the extent *Fintiv* is considered under §314(a), the District Court’s order of non-infringement and PO’s appeals that do not involve the '264 Patent (POPR, p.5) have no impact on a *Fintiv* analysis. Even if the Board considers *Fintiv* and determines 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
2024	Docketing Statement dated October 16, 2023, <i>Geoscope Technologies Pte. Ltd. v. Google LLC</i> , Case No. 24-1003 (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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