

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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**GOOGLE LLC,**  
Petitioner,

v.

**GEOSCOPE TECHNOLOGIES PTE. LTD.**  
Patent Owner

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Case No. IPR2023-01214  
U.S. Patent No. 8,320,264

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**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 10, “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 9, “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 4-11. 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 3-4, 11; *see also id.* at § VII. Thus, discretionary denial is appropriate.

Petitioner’s Reply does not warrant a different result. Petitioner argues that *Fintiv* does not apply “because there is no parallel related litigation and none of the claims of the ’264 Patent are on appeal.” Reply at 2. However, the ultimate inquiry here is whether institution is an “inefficient use of Board resources.” *NHK*, IPR2018-00752, Paper 8 at 19-20. As Petitioner recognizes, this involves taking a “holistic

view of whether efficiency and integrity of the system are best served by denying or instituting review.” *See* Reply at 5 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential)). It is an inefficient use of the Board’s resources to institute given that the claims of the ’264 Patent are no longer being asserted against Petitioner or any other party. *See* POPR at 4-5. Institution would require the Board to adjudicate the validity of twelve claims that are no longer being asserted, several of which were not even asserted at the time the Petition was filed. *See id.* at 7-8. Indeed, Petitioner acknowledges that “[t]he litigation involving the ’264 Patent is closed” (Reply at 2) and identifies no reason why it would be an efficient use of the Board’s resources to institute given that fact.

### **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.

Date: January 11, 2024

Respectfully submitted,

/Ryan J. Singer/

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APPENDIX A – LIST OF EXHIBITS

| <b>Exhibit No.</b> | <b>Description</b>                                                                                                                               |
|--------------------|--------------------------------------------------------------------------------------------------------------------------------------------------|
| 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 11<sup>th</sup> 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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