

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

ANONYMOUS MEDIA RESEARCH HOLDINGS, LLC,
Patent Owner.

IPR2024-01349
Patent 10,719,849

PETITIONER’S REPLY BRIEF REGARDING *FINTIV*

Pursuant to the Board’s Order (EX2041), Petitioner files this reply brief addressing the factors under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) (“*Fintiv*”), which weigh in favor of institution. Patent Owner’s (“PO’s”) *Fintiv* brief (Paper 12, “PO *Fintiv* Br.”) does not properly balance the various factors at issue. Indeed, PO affords just two sentences of its entire brief to the key issue counseling against discretionary denial under *Fintiv*: where a “Petitioner broadly stipulates to not pursue [in district court] any ground raised or that could have been reasonably raised”—as Petitioner has here (Pet. at 82)—this is a factor that “weighs strongly in favor of not exercising discretion to deny institution.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential as to §II.A) (“*Sotera*”); *see also* PO *Fintiv* Br. at 4-5.

A careful review of the *Fintiv* factors confirms the Board should not exercise discretion to deny institution. The **first *Fintiv* factor** weighs against denial and is at most neutral. Petitioner’s motion to stay is pending. PO *Fintiv* Br. at 1. Contrary to PO’s suggestions, *id.* at 1-2, the Board will not infer how the district court would rule on a pending motion. *See, e.g., Hulu, LLC v. SITO Mobile R&D IP, LLC*, IPR2021-00298, Paper 11 at 10-11 (May 19, 2021); *Western Digital Corp. v. Kuster*, IPR2020-01391, Paper 10 at 8-9 (Feb. 16, 2020). To the extent the Board were to even accept PO’s invitation for speculation, the fact that the motion to stay has remained pending for “[f]ive months,” PO *Fintiv* Br. at 1, suggests the district court

may be waiting to see if the Board will institute review. In any event, *Fintiv* discusses this factor in the context of “allay[ing] concerns about inefficiency and duplication of efforts,” *Fintiv* at 6—concerns eliminated by a *Sotera* stipulation.

The **second *Fintiv* factor** weighs against denial and is at most neutral. Even “an early trial date” is “non-dispositive” and simply means that “the decision whether to institute will likely implicate other factors,” which, as explained, weigh against denial *Fintiv* at 5, 9. Here, in view of Petitioner’s *Sotera* stipulation, if the Board institutes this IPR, any grounds that were raised or reasonably could have been raised in this IPR will not be tried in district court. *See Dish Network, L.L.C. v. Broadband iTV, Inc.*, IPR2020-01267, Paper 15 at 17-18 (Jan. 21, 2021) (explaining that the second *Fintiv* factor “is a proxy for the likelihood that the trial court will reach a decision on validity issues before the Board reaches a [FWD]”). Indeed, even prior to the now-withdrawn Interim Procedure memorandum, the Board consistently instituted review where a Petitioner offered a *Sotera* stipulation notwithstanding an early scheduled trial date. *See, e.g.*, IPR2021-01214, Paper 10 at 8-12 (Dec. 16, 2021) (trial date 7 months before FWD); IPR2021-01057, Paper 15 at 8-14 (Jan. 6, 2022) (11 months); IPR2021-01073, Paper 20 at 24-30 (Jan. 24, 2022) (9 months); IPR2022-00076, Paper 20 at 10-15 (May 11, 2022) (9 months); IPR2022-00087, Paper 8 at 12-20 (Jun. 8, 2022) (6 months); IPR2022-00244, Paper 17 at 14-18 (Jun. 10, 2022) (9 months). After withdrawal of the Interim Procedure

memorandum, the Board has similarly declined to exercise discretion to deny institution for a seven-month difference between the trial date and FWD date even where there was a narrower *Sand Revolution* stipulation. *Samsung Display Co., Ltd. v. Pictiva Displays Int'l Ltd.*, IPR2024-01222, Paper 12 at 6-9 (Mar. 6, 2025).

The **third *Fintiv* factor** weighs against denial. Investment in the parallel proceeding takes into account whether the district court has “issued substantive orders related to the patent at issue in the petition” including “claim construction orders.” *Fintiv* at 9-10. The district court has issued no such substantive orders at this time. *See generally* EX2042. While PO points to general litigation activity (including post-institution activity, which is irrelevant under this factor), along with a *Markman* hearing scheduled for March 18, 2025, PO *Fintiv* Br. at 3-4, case activity (outside claim construction) unrelated to validity should “not weigh in [the Board’s] consideration of this issue.” *Western Digital*, IPR2020-01391, Paper 10 at 11. And at the time the Board will issue its institution decision, fact and expert discovery will not have closed, and dispositive motions and briefings would not have been submitted. EX2047 at 3; *see also* PO *Fintiv* Br. at 3-4. These facts are insufficient to support discretionary denial. *Juniper Networks, Inc. v. Huawei Digital Techs. (Cheng Du) Co., Ltd.*, IPR2020-01130, Paper 13 at 12-13 (Jan. 22, 2021); *Dish* at 19-21 (similar); *HP Inc. v. Slingshot Printing LLC*, IPR2020-01085, Paper 12 at 7 (Jan. 14, 2021); *Samsung Display Co., Ltd.*, IPR2024-01222, Paper 12 at 7 (finding

factor three weighs against denial because “much remains to be done, including expert discovery.”).

PO also suggests the IPR filing timing “tilts [the third] factor even heavier toward denial.” PO *Fintiv* Br. at 4. Not so. PO’s original complaint asserted six patents containing 80 issued claims. Thus, it was reasonable for Petitioner to wait to file the IPR Petition until after receiving and analyzing the contentions. *Facebook, Inc. v. USC IP P’ship, L.P.*, IPR2021-00033, Paper 13 at 13 (Apr. 30, 2021).

Accordingly, at least because no substantive orders related to the patent have been issued, this factor weighs against discretionary denial. *Hulu*, Paper 11 at 13.

The **fourth *Fintiv* factor** heavily weighs against denial in light of Petitioner’s *Sotera* stipulation. As explained above, if this IPR is instituted, Petitioner’s stipulation eliminates any “concerns of inefficiency and the possibility of conflicting decisions” from the Board and the district court. *Fintiv* at 12. PO’s reliance on *Cisco Sys., Inc. v. Estech Sys., Inc.* is inapposite. IPR2021-00333, Paper 12 at 12 (July 7, 2021); PO *Fintiv* Br. at 4-5. In *Cisco*, the patent-at-issue was asserted in several litigations involving Cisco’s seven RPIs, and the investment in the litigations was “substantial.” *Cisco* at 3, 7-11. The Board found that the substantial investment in the litigations (unlike here) weighed against the *Sotera* stipulation. *Id.* at 12-13. “Petitioner’s broad stipulation ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding” and “weighs strongly in favor of not

exercising discretion to deny institution.” *Sotera* at 19; *see also supra* at 2-3 (citing cases showing a *Sotera* stipulation mitigates any concerns associated with an early scheduled trial date).

Furthermore, the challenged claims include claim 4—which is not asserted in the district court proceeding. *Fintiv* at 13. Thus, the validity of claim 4 will only be adjudicated in this proceeding, not in district court. *Samsung Display Co., Ltd.*, IPR2024-01222, Paper 12 at 8 (finding factor four weighs against denial because of a narrower stipulation and “additional challenged claims not at issue in the district court”).

Regarding the **fifth *Fintiv* factor**, while Petitioner and PO are the same parties as in district court, that is the case in the vast majority of proceedings.

The **sixth *Fintiv* factor** also favors institution. The merits of the IPR Petition are particularly strong given Petitioner’s grounds are based on two earlier patent applications in the ’849 patent’s family which qualify as prior art given the multiple breaks in the ’849 patent’s priority chain. Pet. at 5-7; *see also* EX2101 at 2-5 (USPTO’s Office of Petitions noting additional issues in the ’849 patent’s priority chain). Thus, most of the claim features are undeniably disclosed by that prior art.

Accordingly, under a “holistic view,” the *Fintiv* factors weigh strongly against discretionary denial. This is particularly true given Petitioner’s *Sotera* stipulation, which eliminates the concerns motivating the *Fintiv* factors.

Respectfully submitted,

Dated: March 12, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on March 12, 2025, I caused a true and correct copy of the foregoing Petitioner's Reply Brief Regarding *Fintiv* to be served electronically on counsel for Patent Owner at the following addresses:

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