

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC, SAMSUNG ELECTRONICS CO., LTD., and SAMSUNG  
ELECTRONICS AMERICA, INC.,  
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,  
Patent Owner.

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IPR2020-00871  
Patent 9,749,829 B2

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Before TREVOR M. JEFFERSON, CHARLES J. BOUDREAU, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

DECISION  
Denying Petitioner's Request on Rehearing of  
Decision Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

In this case, we issued a Decision Denying Institution of *Inter Partes* review of claims 1–68 (the “challenged claims”) of U.S. Patent No. 9,749,829 B2 (“the ’829 patent”). Paper 16 (“Decision” or “Dec.”). After considering the evidence of record and the parties’ arguments addressing the six factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5 (PTAB Mar. 20, 2020) (precedential) (“Fintiv”), we explained in the Decision that the balancing of those factors weighed in favor of discretionarily denying the Petition under 35 U.S.C. § 314(a). Dec. 7–18.

Google LLC, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “Petitioner”) filed a Request for Rehearing of our Decision. Paper 17 (“Rehearing Request” or “Reh. Req.”). With the Board’s authorization, Petitioner and Patent Owner filed supplemental briefing after the Rehearing Request was filed. Paper 20 (“Petitioner’s First Supplemental Brief” or “Pet. 1st Supp. Br.”); Paper 21 (“Patent Owner’s First Supplemental Brief” or “PO 1st Supp. Br.”); Paper 22 (“Petitioner’s Second Supplemental Brief” or “Pet. 2nd Supp. Br.”); Paper 23 (“Patent Owner’s Second Supplemental Brief” or “PO 2nd Supp. Br.”).

In the Rehearing Request, Petitioner contends that reconsideration of our Decision is appropriate for the following reasons:

- (1) the Board overlooked or misapprehended facts relating to the likelihood of the underlying case being stayed (Factor 1);
- (2) the Board overlooked or misapprehended facts relating to the uncertainty in the anticipated trial date (Factor 2); and
- (3) the Board overlooked or misapprehended facts relating to Petitioner’s prior art stipulation (Factor 4).

Reh. Req. 7–13. Petitioner offers new evidence in the Rehearing Request in support of those contentions and further contends good cause exists to admit and consider that new evidence. *Id.* at 2–6. In its First Supplemental Brief, Petitioner contends that good cause exists to admit and consider still further additional evidence because “a number of [new] developments occurred.” Pet. 1st Supp. Br. 1. Patent Owner disputes Petitioner’s contentions and argues that the Rehearing Request fails to establish any matter the Board actually overlooked or misapprehended. PO 1st Supp. Br. 2; PO 2nd Supp. Br. 1.

For the reasons explained below, Petitioner’s Rehearing Request is *denied*.

## II. LEGAL STANDARD

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

The burdens and requirements of a request for rehearing are stated in 37 C.F.R. § 42.71(d):

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

Further, “[a]bsent a showing of ‘good cause’ . . . new evidence will not be admitted” in connection with a request for rehearing. Patent Trial and Appeal Board Consolidated Trial Practice Guide 90 (Nov. 2019), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“CTPG”) (citing *Huawei Device Co. v. Optis Cellular Tech., LLC*, IPR2018-00816, Paper 19 at 4 (PTAB Jan. 8, 2019) (precedential)). Thus, a request for rehearing is not an opportunity to present new arguments or evidence or merely to disagree with the panel’s assessment of the arguments or weighing of the evidence.

### III. ANALYSIS

Petitioner argues in the Rehearing Request that “[t]he Decision necessarily relied on schedule-related facts that were available” at the time, “[b]ut due to circumstances outside anyone’s control, these facts have been in significant flux.” Reh. Req. 1. Offering several new exhibits of evidence (Exs. 1040–1047; Ex. 1052), Petitioner argues that this new evidence shows that we overlooked or misapprehended facts relating to factors 1 and 2 of *Fintiv*. *Id.* at 7–11; Pet. 1st Supp. Br. 2–4. Notably, none of Petitioner’s arguments regarding factors 1 and 2 actually tie to any arguments or evidence it presented to the Board in the papers filed before the Decision was entered. *See* Reh. Req. 2–4; Pet. 1st Supp. Br. 2–4. Regarding *Fintiv* factor 4, Petitioner argues that we overlooked or misapprehended its prior art stipulation, but offers a new stipulation (Exhibit 1048) “to specifically address any concerns raised in the [Decision]” with the original stipulation. Reh. Req. 11–13.

Before addressing Petitioner’s arguments about any facts we allegedly overlooked or misapprehended when evaluating the *Fintiv* factors, we must

first determine whether Petitioner has established good cause for introducing the new evidence into our consideration of those factors. *See* CTPG 90.

Afterwards, in view of the evidence and arguments properly presented, we turn to Petitioner's allegations of error in the Decision.

*A. Petitioner Has Not Established "Good Cause" for Considering Exhibits 1040–1043*

Exhibits 1040–1043 relate to Orders entered by the same district court judge (Judge Gilstrap) that is presiding over the parallel litigation between the parties in this matter. Good cause exists for us to consider this new evidence, Petitioner argues, because it was brought to our attention in a timely manner and because "the [O]rders reflect that [the District Court] may ultimately stay or continue the underlying litigation because the trial dates continued in those orders were scheduled for the months immediately before the underlying litigation." *Reh. Req.* 4. Petitioner concludes that these Orders "are thus highly relevant to whether the trial date in the underlying litigation may be stayed or continued." *Id.* at 5.

Although Petitioner did bring the District Court's Orders to our attention in a timely manner, we are not persuaded good cause has been shown to exist for us to consider these Orders. First, the Orders are all from cases that are separate and distinct from the parallel litigation involving the parties before us. *Ex.* 1040, 1; *Ex.* 1041, 1; *Ex.* 1042, 1; *Ex.* 1043, 1. Second, each Order is limited to cases that are "set for in-person jury trials during December of 2020 and January through February of 2021." *Id.* That limitation further diminishes the value of the Orders in this proceeding because the jury trial in the parties' parallel litigation was scheduled to begin on April 5, 2021 (*Ex.* 2003, 1). In fact, Petitioner acknowledges that the Orders have "not yet been applied in the underlying litigation." *See Reh.*

Req. 3. As a result, we find the relevance of Exhibits 1040–1043 to this matter to be speculative at best.

In the Rehearing Request, Petitioner argues that Exhibits 1040–1043 provide evidence that the parallel litigation may be stayed. Reh. Req. 7. However, in addition to the fact that the Orders in those exhibits do not relate to the parties’ or to their parallel litigation, none of the Orders actually stays a case, which diminishes the relevance of the Orders to the first *Fintiv* factor even further. Petitioner argues additionally that these Orders along with other COVID-related facts demonstrate the uncertainty of the trial date in the parties’ parallel litigation. Nevertheless, Petitioner never argued prior to our Decision that the parallel litigation was uncertain because of COVID-related facts. *See* Pet. 70–71; Pet. Reply 1–5. In other words, Petitioner is not offering this new information to support an argument that was made before the Decision was entered. Petitioner instead offers Exhibits 1040–1043 to support a new argument introduced for the first time in the Rehearing Request, which is improper and immaterial as to any alleged errors in the Decision.

Therefore, we do not find Petitioner has carried its burden of showing good cause exists to justify consideration of those exhibits to evaluate whether we erred by “overlooking or misapprehending” anything in the Decision.

*B. Petitioner Has Established “Good Cause” for Considering Exhibits 1044–1047*

Exhibits 1044–1047 relate to a hearing, and subsequent events, addressing Petitioner’s venue/transfer motions in the parallel litigation, which occurred after the Decision was entered. Petitioner argues that good cause exists for us to consider this new evidence because it was brought to

our attention in a timely manner and because it shows that the District Court “is willing to consider a stay in the case to ensure that [the venue/transfer motions] can be resolved.” Reh. Req. 6. We find Petitioner brought this information to our attention in a timely manner and that the information properly relates to a previously made arguments regarding uncertainty in the April 2021 trial date for the parallel litigation due to Petitioner’s venue/transfer motions. Pet. 71. Therefore, we find Petitioner has established good cause exists for considering Exhibits 1044–1047.

*C. Petitioner Has Not Established “Good Cause” for Considering Exhibit 1048*

Exhibit 1048 is an “amended stipulation” intended to “specifically address any concerns raised in the [Decision]” about the original prior art stipulation and make clear Petitioner is “agreeing to the full scope of estoppel under 315(e)(2) based on an instituted petition.” Reh. Req. 12–13. Petitioner argues that good cause exists for us to consider this new evidence because the amended stipulation simply “reflects Petitioner’s clarified position regarding its intentions with respect to prior art.” *Id.* at 12 n.1.

Petitioner notably does not provide any reason that it could not have introduced the amended stipulation before the Decision was entered, however. We note that the Rehearing Request makes clear that Petitioner was well aware of the decision in *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, Case IPR2019-01393, Paper 24 (June 16, 2020) (informative). *See id.* at 11–12. In the *Sand Revolution* decision, the Board made clear that, to “better address concerns regarding duplicative efforts and potentially conflicting decisions in a much more substantial way,” the Petitioner should “stipulate[] that it would not pursue any ground raised or that could have been reasonably raised in an IPR, i.e.,

any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications.” *Sand Revolution*, IPR2019-01393, Paper 24 at 12 n.5. Nevertheless, Petitioner elected to submit a stipulation that only stipulated to not pursue, in district court, the “same grounds” presented in the petition, which the *Sand Revolution* decision found to provide only “some degree” of mitigation of the concerns of duplicative efforts and conflicting decisions. *Id.* at 12; *see also* Dec. 15–16 (similarly finding that the same concerns articulated in *Sand Revolution* with respect to “duplicative efforts and potentially conflicting decisions” pertain to Petitioner’s original conditional stipulation). Therefore, we do not find Petitioner has persuasively shown good cause exists for us to consider its untimely amended stipulation.

*D. Petitioner Has Not Established “Good Cause” for Considering Exhibit 1052*

Exhibit 1052 is a Memorandum Opinion and Order entered by the District Court in the parallel litigation after the Rehearing Request was filed. Petitioner contends good cause exists for us to consider this Exhibit because it was “created after the rehearing request [was] filed” and “relate[s] directly to the *Fintiv* analysis.” Pet. 1st Supp. Br., 1.

Although Petitioner brought this memorandum and order to our attention in a timely manner, we are not persuaded good cause has been shown to exist for us to consider it as part of the Rehearing Request. We reach this conclusion not only because Exhibit 1052 was created after the Rehearing Request was filed, but because the events leading to its “creation” were also not started by Petitioner until *after* the Decision was entered. In particular, the District Court noted that, after the Decision was entered, Petitioner filed a Request for *Ex Parte* Reexamination of the ’829 patent in



United States Patent and Trademark Office that was granted leading Petitioner to renew its request for a stay pending the resolution of the reexamination proceedings.<sup>1</sup> Ex. 1052, 2. Because the District Court’s Order was “created” only after the time had expired for the Petitioner to file its Rehearing Request and that Order derives from facts “created” by Petitioner’s actions that occurred only after the Decision was entered, we find Exhibit 1052 immaterial as to any alleged errors in the Decision—it is simply not possible for our Decision to have overlooked or misapprehended any facts regarding events that were not even set into motion by Petitioner until after the Decision. Therefore, we do not find Petitioner has shown persuasively that good cause exists for us to consider Exhibit 1052.

*E. Our Fintiv Analysis Did Not Misapprehend or Overlook Any Facts Properly Presented for Consideration*

Based on the evidence that is properly before us, the Rehearing Request boils down two points of contention regarding facts that we allegedly misapprehended or overlooked in the Decision. First, in view of the District Court’s stated willingness to consider “some kind of a temporary stay” to resolve the open venue issues (Ex. 1044, 26:15–16), Petitioner contends that we overlooked or misapprehended the likelihood that the parallel litigation may be stayed because of unresolved venue issues. Reh. Req. 8–9. Second, Petitioner contends that we overlooked or misapprehended in the Decision the stipulation offered that “limit[s] its use

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<sup>1</sup> Petitioner has notified us that the reexamination of the ’829 patent has been completed and that United States Patent and Trademark Office issued a Notice of Intent to Issue *Ex Parte* Reexamination Certificate that confirms the patentability of all claims. Ex. 1054.

of overlapping prior art.” *Id.* at 11–12. Neither contention, however, is persuasive.

On December 4, 2020 (about a week after the Decision was entered), the District Court held a hearing regarding venue related issues. Ex. 1044, 6:8–15. During the course of that hearing, the District Court set forth procedures that the parties should follow to address some outstanding venue related issues. *Id.* at 26:1–10. The District Court also stated that, after the parties followed those procedures and reported back, it would “determine whether [the Court] should leave the current schedule in place or whether [the Court] should enter some kind of a temporary stay to facilitate [additional venue-related discovery].” *Id.* at 26:11–16. Petitioner argues that this comment by the District Court should tip the *Fintiv* factor 1 in favor of institution. Reh. Req. 8–9. We disagree.

Although the December 20th hearing may indicate the District Court’s willingness to *consider* whether “some kind of a temporary stay” should be entered to resolve the outstanding venue issues, it provides little, if any, actual evidence that the District Court would, in fact, enter a stay. Even if we were to guess that the District Court would enter a stay, we would still have to speculate further about the length of the “temporary” stay because, if it were for only a few days or weeks, it would still not avoid the concerns of inefficiency and duplicative efforts addressed by *Fintiv* factor 1.

Regarding our alleged failure to apprehend or consider fully Petitioner’s proposed stipulation, we again do not agree. In the Decision, we specifically addressed Petitioner’s proposed stipulation and explained its shortcomings. Dec. 15–16. Although Petitioner clearly does not agree with our analysis, mere disagreement with our opinion is not a valid basis for reconsideration.

*F. Conclusion*

For the foregoing reasons, Petitioner's Rehearing Request is *denied*.

IV. ORDER

Accordingly, it is

ORDERED Petitioner's Request for Rehearing of the Institution  
Decision is *denied*.

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