

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner.

IPR2020-00719
Patent 8,739,241 B1

Before GEORGIANNA W. BRADEN, JON M. JURGOVAN, and
JOHN F. HORVATH, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 314(a)

I. INTRODUCTION

Google LLC¹ (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 16, 17, 22, 23, 25, 27, 30, 31, 33–37, and 39 of U.S. Patent No. 8,739,241 B2 (Ex. 1001, “the ’241 patent”). Paper 1 (“Pet.”). Personalized Media Communications, LLC² (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Patent Owner notes it has disclaimed claims 16, 17, 25, 27, and 35. *Id.* at 9 (citing Ex. 2003). Thus, our review is limited to Petitioner’s challenge of claims 22, 23, 30, 31, 33, 34, and 36–39 (“the challenged claims”).

In its Preliminary Response, Patent Owner also requested discretionary denial due to an upcoming district court trial. *See* Prelim. Resp. 3–12. With Board’s approval, Petitioner filed a Reply to the Preliminary Response. Paper 12 (“Pet. Reply”). Patent Owner filed a Sur-Reply to Petitioner’s Reply. Paper 14 (“PO Sur-Reply”).

Under the statute, an *inter partes* review may not be instituted unless the information presented in the petition and the preliminary response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Moreover, the Supreme Court has held that a decision under § 314 may not institute review on fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355–56 (2018); *see also PGS Geophysical AS*

¹ Petitioner identifies itself as the real party-in-interest pursuant to 37 C.F.R. § 42.8. Pet. 95. Petitioner denies that its parent companies XXVI Holdings Inc. and Alphabet Inc. are real parties-in-interest. *Id.*

² Patent Owner identifies only itself as the real party-in-interest pursuant to 37 C.F.R. § 42.8. Paper 5 (Patent Owner’s Mandatory Notices), 1.

v. Iancu, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

After considering the Petition, the Preliminary Response, and associated evidence, and given the pending district court case involving the same challenged claims and grounds for challenging them, we exercise our discretion to decline to institute an *inter partes* review of claims 22, 23, 30, 31, 33, 34, and 36–39 of the ’241 patent.

II. BACKGROUND

A. *Related Proceedings*

Petitioner informs us of three district court proceedings based on the ’241 patent, one of which is pending against Petitioner. Pet. 95. Patent Owner informs us of the same pending district court proceeding against Petitioner: *Personalized Media Communications, LLC v. Google LLC*, No. 2:19-cv-00090-JRG (E.D. Tex.), filed March 21, 2019. Paper 5, 1. Patent Owner also informs us of numerous administrative matters before the USPTO such as reissue applications, *ex parte* reexaminations, or *inter partes* review proceedings of patents that belong to the same patent family as the ’241 patent. *Id.* at 1–3.

B. *Background of Technology and the ’241 Patent*

The ’241 patent was filed on June 7, 1995, issued on May 27, 2014, and is titled “Signal Processing Apparatus and Methods.” Ex. 1001, codes (22), (45), (54). The ’241 patent describes a “unified system of programming communication” where the “system encompasses the prior art (television, radio, broadcast hardcopy, computer communications, etc.) and new user specific mass media.” *Id.* at code (57). The ’241 patent states that

“[w]ithin the unified system, parallel processing computer systems, each having an input (e.g., 77) controlling a plurality of computers (e.g., 205), generate and output user information at receiver stations.” *Id.*

One embodiment disclosed in the '241 patent is Figure 6A, which is reproduced below.

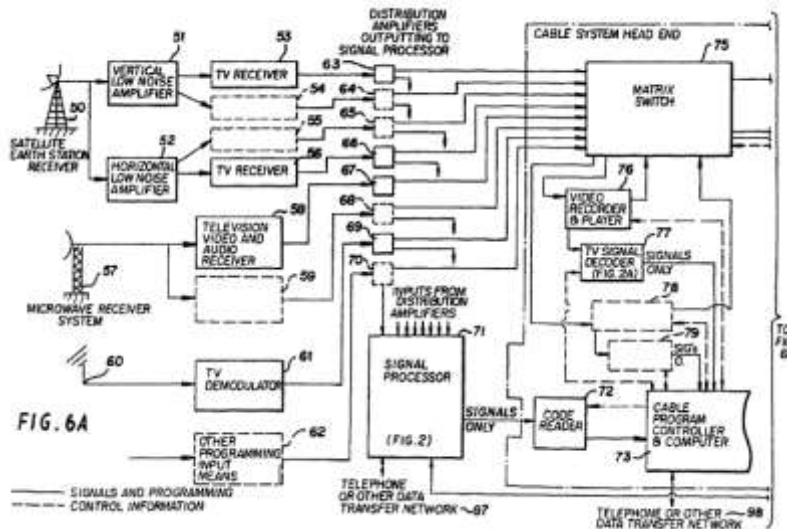


Figure 6A, above, is “a block diagram of one example of signal processing apparatus and methods at an intermediate transmission station, in this case a cable system headend.” Ex. 1001, 11:38–40. Figure 6A shows signal processor system 71 where “in field distribution system, 93, amplifier, 94, inputs programming transmissions to signal processor system, 71,” while “amplifier, 95, inputs programming transmissions to signal processor, 96, which permits both signal processor apparatus to monitor all programming transmitted by the cable television system head end station to field distribution system 93.” *Id.* at 173:64–174:7. The '241 patent states that

[b]y recording all different received “program unit identification code” information [in this way, the] signal processor apparatus can automatically record, for each transmission channel of the station of FIG. 6, information, for example, that the U.S. Federal

Communications Commission requires broadcast station operators to maintain as station logs. And said signal processor apparatus can transmit such records of programming to remote sites via telephone or other data transfer networks, **97** and **99** respectively. In this fashion, said signal processor apparatus can automatically provide their contained records to one or more remote independent auditor stations.

Id. at 174:8–19.

Another embodiment disclosed in the '241 patent is Figure 7C, which is reproduced below.

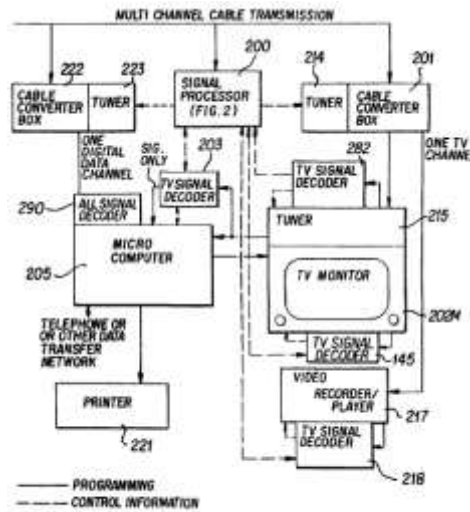


FIG. 7C

Figure 7C, above, is “a block diagram of signal processing apparatus and methods selecting receivable information and programming and controlling combined medium, multi-channel presentations.” *Id.* at 11:49–52. The '241 patent states that Figure 7C “illustrates methods for monitoring multiple programming channels, selecting programming and information of interest, and receiving said selected programming and information.” *Id.* at 215:62–65. According to the '241 patent, “microprocessor, **205**, of the station of FIGS. **7** and **7C**, is preprogrammed to hold records of a portfolio of stocks and to receive and process automatically news items about said stocks and about the

industries of said stocks.” *Id.* at 215:66–216:2. The ’241 patent further states that the intermediate transmission station, shown in Figure 6, “receives and retransmits . . . the transmissions of said remote stations on digital data channels A and B, respectively, that are inputted to converter boxes, **222** and **201**, and to signal processor, **200**.” *Id.* at 216:21–25.

C. Illustrative Claims

As noted above, Petitioner challenges claims 16, 17, 22, 23, 25, 27, 30, 31, 33–37, and 39. Pet. 22–23. Patent Owner has disclaimed claims 16, 17, 25, 27, and 35. Prelim. Resp. 9 (citing Ex. 2003). Independent claim 22 is illustrative of the remaining challenged claims and is reproduced below:

22. A method of controlling an intermediate transmitter station to communicate television programming to a receiver station, said method comprising said steps of:

- receiving said television programming at an origination station;
- transmitting said television programming, a first signal and a second signal from said origination station to said intermediate transmitter station;
- storing identification information at said intermediate transmitter station, said identification information designating programming to be transmitted, said second signal including a control signal for controlling said receiver station;
- receiving at said intermediate transmitter station said television programming, said first signal and said second signal;
- detecting at least said first signal;
- comparing said first signal to said identification information;
- transmitting said television programming and said second signal from said intermediate transmitter station to said receiver station based on said step of comparing;
- receiving at said receiver station said transmitted television programming and said second signal;

outputting at said receiver station said received television programming in a multimedia presentation in response to said control signal included in said second signal.

Ex. 1001, 290:58–291:18.

D. The Asserted Challenges to Patentability and Evidence of Record

The information presented in the Petition sets forth proposed challenges to the patentability of claims 16, 17, 22, 23, 25, 27, 30, 31, 33–37, and 39 of the '241 patent under 35 U.S.C. § 103(a) as follows (*see* Pet. 22–23):³

Reference(s)/Basis	35 U.S.C. §⁴	Challenged Claim(s)
Cogswell, ⁵ Cox ⁶	103(a)	16, 22, 23, 25, 27, 30, 31, 33–35, 39
Cogswell, Cox, Campbell ⁷	103(a)	17, 37
Cogswell, Cox, Cox '404 ⁸	103(a)	36
Cogswell, Cox, Haselwood ⁹	103(a)	23, 25, 27

³ Petitioner supports its challenges with the Declaration of Stuart Lipoff, (“Mr. Lipoff”) (Ex. 1003).

⁴ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (September 16, 2011) (“AIA”), included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the '241 patent issued from an application filed before March 16, 2013, we apply the pre-AIA versions of the statutory bases for unpatentability.

⁵ US 4,331,974, issued May 25, 1982 (Ex. 1005, “Cogswell”).

⁶ US 4,388,645, issued June 14, 1983 (Ex. 1006, “Cox”).

⁷ US 4,536,791, issued Aug. 20, 1985 (Ex. 1007, “Campbell”).

⁸ US 4,393,404, issued July 12, 1983 (Ex. 1008, “Cox '404”).

⁹ US 4,025,851, issued May 24, 1977 (Ex. 1012, “Haselwood”).

III. PRELIMINARY MATTERS

A. *Analysis of Discretionary Denial Under 35 U.S.C. § 314(a)*

Patent Owner states that the '241 patent is the subject of a pending district court litigation with a fast approaching trial date. Prelim. Resp. 2. Patent Owner argues we should exercise discretion under 35 U.S.C. § 314(a) and deny institution based on the district court litigation because it involves the same parties, independent claims, and prior art, and is in an advanced stage in which the parties have invested substantially. Prelim. Resp. 4–12; PO Sur-Reply 1–3. To the contrary, Petitioner argues that evaluation of the *Apple v. Fintiv* factors demonstrates we should *not* exercise discretion to deny institution of *inter partes* review. Pet. Reply 1–3 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (Order)). For the reasons stated below, we are persuaded to exercise discretion to deny institution.

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); 37 C.F.R. § 42.108(a) (“[T]he Board may authorize the review to proceed.”). *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS*, 138 S. Ct. at 1356 (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

In the *NHK* case, the Board denied institution relying, in part, on § 314(a), because the parallel district court proceeding was scheduled to finish before the Board reached a final decision. *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). “Thus, *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*, Paper 11 at 3. When determining whether to exercise discretion to deny institution under *NHK* due to an earlier trial date, we consider the following factors (“*Fintiv* factors”):

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. at 6. “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating these factors, we take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* (citing Patent Trial and Appeal Board Consolidated Trial Practice Guide 58 (November 2019), <https://www.uspto.gov/TrialPracticeGuideConsolidated>). We address the

Fintiv factors *in seriatim* and discuss in detail our reasons for exercising discretion to deny institution based on § 314(a).

1. Whether a Stay Exists or Is Likely to Be Granted if a Proceeding Is Instituted

The district court proceeding, in which Petitioner is a defendant, has not been stayed. Prelim. Resp. 4–5. Petitioner argues it intends to seek a stay after an institution decision is made, when a court in the Eastern District of Texas is more likely to grant a stay request, even if the trial date is imminent. Pet. Reply 1 (citing *Ericsson Inc. v. TCL Commc’n Tech. Holdings, Ltd.*, 2016 WL 1162162, *2–3 (E.D. Tex. Mar. 23, 2016) (granting stay within two months of trial because of “high likelihood” of simplification)). To the contrary, Patent Owner argues that even if Petitioner were to file a motion to stay, the Court where the litigation is pending has denied stays in similar circumstances. Prelim. Resp. 5 (citing *Uniloc 2017 LLC v. Samsung Electronics America, Inc.*, 2020 U.S. Dist. LEXIS 50354, *12, C.A. No. 2:19-cv-00259-JRG-RSP, Dkt. No. 55 at 8–9 (E.D. Tex. Mar. 24, 2020) (denying stay after considering, among other factors, “(1) whether discovery is complete and whether a trial date has been set; and (2) whether the movant has unreasonably delayed filing its IPR petition and motion to stay”); *KIPB LLC v. Samsung Electronics Co.*, 2019 U.S. Dist. LEXIS 200902, C.A. No. 2:19-cv-00056-JRG-RSP, Dkt. No. 55 at 7 (E.D. Tex. Nov. 20, 2019) (denying stay); *KAIST IP US LLC v. Samsung Electronics Co., LTD.*, 2020 U.S. Dist. LEXIS 26609, C.A. No. 2:16-CV-01314-JRG, Dkt. No. 676 at 6 (E.D. Tex. Feb. 13, 2020) (denying stay)).

We understand Petitioner’s position, but no stay exists at present and none has been sought. The cases cited by Petitioner and Patent Owner show

that this district court has granted a stay in some cases, and denied one in others, so we decline to speculate. Accordingly, this factor is neutral.

2. *Proximity of the Court's Trial Date to the Board's Projected Statutory Deadline*

Both Petitioner and Patent Owner agree that the district court proceeding is scheduled for a trial in October 2020. Prelim. Resp. 6 (citing Ex. 2001, Litigation Scheduling Order); Pet. Reply 1.

Petitioner argues that it has filed for a writ of mandamus at the Court of Appeals for the Federal Circuit to correct an erroneous venue finding by the district court and to stay the litigation. Pet. Reply 1 (citing Ex. 1027, 9). Petitioner contends that a finding of improper venue will moot the trial date. *Id.* at 2. Petitioner further argues that the trial date may change because the COVID-19 pandemic has “significantly disrupted docket schedules including in Texas, which may cause delay of the trial that is still months away.” *Id.*

We understand Petitioner's position, but we decline to speculate whether that date will change due to COVID-19 disruptions or a writ of mandamus from the Federal Circuit. We are cognizant of the impact of COVID-19 on any proceeding, before the Board, in district courts, or otherwise. We are also cognizant, however, that the District Court for the Eastern District of Texas has recently completed a jury trial. *See* Ex. 2021, 60–63 (docket for *Optis Wireless Tech., LLC v. Apple, Inc.*, 2:19-cv-00066 (E.D. Tex. Feb. 25, 2019) (showing a jury trial held between August 3, 2020 and August 11, 2020)). As it stands, on this record, the jury trial in this case in the District Court for the Eastern District of Texas is set for October 2020, approximately ten months before the statutory deadline for final written decision, should we institute trial. Generalized speculation as to trial dates universally (e.g., due to impacts of COVID-19), are outweighed by the fact

that the jury trial in this case is scheduled to occur approximately ten months before the Board’s statutory deadline and the fact that the record lacks specific evidence showing that the jury trial is in doubt at this time. Accordingly, on this record, we determine that the facts underlying this factor weigh in favor of exercise of our discretion to deny institution.

3. *Investment in the Parallel Proceeding by the Court and Parties*

Patent Owner contends the district court has used substantial resources by reviewing all the briefings related to claim construction, held a *Markman* hearing, and issued a 94-page claim construction order. Prelim. Resp. 7 (citing Ex. 1017). Patent Owner further contends the parties have a substantial investment in the district court proceeding because expert discovery closed on July 8, 2020 with motions for summary judgment and *Daubert* motions both due on July 8, 2020 while Motions *in Limine* were due August 19, 2020. *Id.* at 7–8 (citing Ex. 2001, 3).

Petitioner does not address this issue directly. Pet. Reply 2.

Because at this late stage in the district court proceeding the investment made by the court and both parties is significant, we find this factor weighs in favor of exercising our discretion to deny.

4. *Overlap Between Issues Raised in the Petition and in the Parallel Proceeding*

Patent Owner states that “[t]he claims at issue in this proceeding are identical to the claims at issue in the [district court proceeding].” Prelim. Resp. 9. According to Patent Owner, it had already withdrawn claims 16, 17, and 35 in the district court proceeding following claim construction so they are no longer asserted against Petitioner. *Id.* Patent Owner also states it has disclaimed claims 16, 17, 25, 27, and 35. *Id.* (citing Ex. 2003). Thus, Patent Owner concludes, “there is now a one-to-one match between the claims at

issue in this proceeding and the claims challenged by [Petitioner] in the [district court proceeding].” *Id.*

Patent Owner further argues the Petition includes the same primary and secondary references relied on by Petitioner in the district court proceeding. Prelim. Resp. 10. Patent Owner contends that Petitioner also raises the same arguments in the Petition and in the district court proceeding, including the same secondary reference and obviousness arguments. *Id.* Patent Owner walks through the permutations of invalidity challenges invoked by Petitioner in the district court proceeding and concludes that every claim at issue in the Petition is being challenged on several grounds in district court. Prelim. Resp. 11.

Petitioner states it “has stipulated that, if this IPR proceeding is instituted, it will withdraw the identical grounds from the district court, thus eliminating any overlap in issues.” Pet. Reply 2–3 (citing Ex. 1028). Petitioner argues that the Board has found that such stipulations weigh in favor of institution. *Id.* at 3 (citing *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 11–12 (June 16, 2020) (informative), *Apple Inc. v. Maxell, Ltd.*, IPR2020-00204, Paper 11 at 15–17 (June 19, 2020)).

Based on the record, we are persuaded Petitioner’s stipulation would remove any overlap between this proceeding and the district court proceeding. Petitioner’s stipulation to withdraw the identical grounds mitigates to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions. As noted in *Sand Revolution*, however, a broader stipulation that Petitioner would not “pursue any ground raised or that could have been

reasonably raised in an IPR” might have better addressed these concerns in a much more substantial way. *Sand Revolution II, LLC v. Continental Intermodal Group-Trucking, LLC*, IPR2019-01393, Paper 24 at 12 n.5.

Given Petitioner’s narrow stipulation that it will not pursue the identical grounds in the district court case if the Petition is granted, this factor weighs marginally against exercising discretion to deny institution. *Id.* at 12.

5. *Whether the Petitioner and the Defendant in the Parallel Proceeding Are the Same Party*

The parties in the district court proceeding and this proceeding are the same. Prelim. Resp. 12. Petitioner does not dispute this fact. *See generally* Pet. Reply. This factor weighs in favor of exercising our discretion to deny institution.

6. *Other Circumstances that Impact the Board’s Exercise of Discretion, Including the Merits*

Patent Owner argues this factor weighs in favor of denying institution because “[t]here are numerous weaknesses on the merits of the grounds in [the] Petition.” Prelim. Resp. 12.¹⁰

¹⁰ Patent Owner also contends “Petitioner waited until the last moment to file the Petition and failed to seek a stay of the [district court proceeding] even after filing the Petition.” Prelim. Resp. 8. Patent Owner argues this indicates Petitioner expects to go through with the trial, thus causing Patent Owner to incur additional pre-trial and trial-related expenses. *Id.* According to Patent Owner, such tactics by Petitioner favor denial of institution. *Id.* at 8–9 (citing *Fintiv*, Paper 11 at 11–12 (failure to file the petition expeditiously and inability to explain the delay in filing favored denial); *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 at 16 (PTAB Oct. 16, 2019) (weighing the petitioner’s unexplained delay in filing the petition in favor of denial of the petition)). We considered this argument in our analysis of Factor 3 above. As explained in *Fintiv*, the timing of the Petition filing is relevant to the amount of investment made by the parties in the parallel

Petitioner contends this factor weighs against denying institution because the merits are strong and its Petition is “the first patentability challenge at the Board, despite multiple assertions by Patent Owner, which should favor . . . institution.” Pet. Reply 3. According to Petitioner, “[t]his is especially true here, where the patent appears to be part of a systematic campaign to subvert the quid-pro-quo of limited exclusivity through perpetual continuations claiming priority back *forty years*.” *Id.* Indeed, Petitioner notes “the ’241 patent is one of 329 related applications having combined ‘between 10,000 and 20,000 claims.’” *Id.* (citing Ex. 1002, 2424). Petitioner also argues there was no delay in filing the Petition. Pet. Reply 2. Specifically, Petitioner argues it filed “within the allotted one-year and waited so that the parties could develop claim construction positions addressed in the petition.” *Id.*

As the Board explained in *Fintiv*, this factor is considered as “part of a balanced assessment of all the relevant circumstances in the case.” *Fintiv*, Paper 11 at 14. The goal of that assessment is to determine “whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6. The assessment requires consideration of the “strengths or weaknesses regarding the merits,” but “[t]his is not to suggest that a full merits analysis is necessary to evaluate this factor.” *Id.* at 15–16.

As noted above, Petitioner avers “the ’241 patent is one of 329 related applications having combined ‘between 10,000 and 20,000 claims,’” and one

proceeding. *Fintiv*, Paper 11 at 11 (“notwithstanding that a defendant has one year to file a petition, it may impose unfair costs to a patent owner if the petitioner, faced with the prospect of a looming trial date, waits until the district court trial has progressed significantly before filing a petition at the Office.”) (footnote omitted).

of a number of “continuations claiming priority back *forty years*.” Pet. Reply 3 (citing Ex. 1002, 2424). Patent Owner does not dispute this. *See* PO Sur-Reply 3. Rather, Patent Owner identifies more than 50 matters before the Office that could affect or be affected by this proceeding. Paper 5, 1–3.

The prosecution history for the ’241 patent, filed in three parts, is more than 3,100 pages in length. *See* Ex. 1002, parts 1–3. It includes five office actions and responses to the same, an appeal to the Board, and an Examiner’s amendment that resulted in the allowance of the patent. *Id.* This brief review of the prosecution history of the ’241 patent, involving potentially broadening or narrowing claim amendments, illustrates how difficult the task of claim construction would be in this case. Further complicating that task is that ten terms in the ’241 patent’s claims have been construed already by the district court.¹¹ Our construction of the same terms would require us to duplicate the efforts of the district court.

In short, a brief consideration of the prosecution history illustrates the significant resources that will be required to resolve issues of claim construction to reach preliminary conclusions on the merits of the Petition. Given the significant resources already expended by the parties and the district court in the related district court case, it would be an inefficient use of the parties’ and the Board’s resources to institute a trial on this Petition when

¹¹ The terms are “video”; “origination station”; “programming (as a noun)”; “television programming”; “intermediate transmitter station”; “automatically controlling the operation of said intermediate transmitter station”; “control signal”; “identification information”; “how and where to search for signals”; and “controlling the operation and identification of signals by controlling how and where to search for signals.” Ex. 1017, 13, 17, 23, 26, 33, 38, 42, 45.

Petitioner likely will have litigated validity nearly a full year prior to our being able to reach a final decision on the merits. Accordingly, this factor weighs in favor of exercising our discretion to deny institution.

7. *Balancing the Fintiv Factors*

We have considered the circumstances and facts before us in view of the *Fintiv* factors. Because our analysis is fact driven, no single factor is determinative of whether we exercise our discretion to deny institution under § 314(a). Based on the facts of this case, the quickly approaching trial date in the district court proceeding, the complexity of the case, and the significant investment already made by the court and both parties outweigh Petitioner's narrow stipulation. Thus, we find the *Fintiv* factors overall weigh in favor of denial. Although we recognize Petitioner's filing of a motion for writ of mandamus with the appellate court, divining the timing and outcome of such a motion would be speculation, which we decline to do. Additionally, even if the merits of the Petition are strong, as argued by Petitioner (Pet. Reply 3), that factor is insufficient to overcome the other factors in this case that weigh in favor of denying institution.

Accordingly, balancing all of the factors on this record, we determine that the circumstances presented here weigh in favor of exercising our discretion under § 314(a) to deny institution of *inter partes* review.

VI. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that the Petition is *denied*.

IPR2020-00719
Patent 8,739,241 B1

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