

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2020-00224
Patent 7,075,917 B2

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–3, 9, and 10 of U.S. Patent No. 7,075,917 B2 (Ex. 1001, “the ’917 patent”). Paper 1 (“Pet.”). Petitioner also filed a Motion for Joinder with *Microsoft Corporation v. Uniloc 2017 LLC*, Case IPR2019-00973 (“the 973 IPR”). Paper 3 (“Mot.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 9 (“Prelim. Resp.”). Patent Owner also filed an Opposition to the Motion for Joinder. Paper 7 (“Opp.”). Petitioner filed a Reply to Patent Owner’s Opposition. Paper 8 (“Reply”). We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons described below, we institute an *inter partes* review of the challenged claims and grant Petitioner’s Motion for Joinder.

II. RELATED PROCEEDINGS

The parties indicate that the ’917 patent is the subject of several court proceedings and the 973 IPR. Pet. vii; Paper 5, 2. The ’917 patent also was the subject of *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00259 (“the 259 IPR”) where a decision to not institute *inter partes* review was rendered. *Id.* The ’917 patent also is the subject of IPR2020-00315. Paper 5, 2.

In the 973 IPR, we instituted an *inter partes* review of claims 1–3, 9, and 10 of the '917 patent on the following ground:

Claims Challenged	35 U.S.C. §	References
1–3, 9, 10	103(a)	TR25.825 ¹ and Abrol ²

Microsoft Corporation v. Uniloc 2017 LLC, IPR2019-00973, Paper 7 at 5, 28 (PTAB Nov. 19, 2019) (“973 Decision” or “973 Dec.”).

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same ground of unpatentability as the one on which we instituted review in the 973 IPR. *Compare* Pet. 3, with 973 Dec. 5, 28. Indeed, Petitioner contends that the Petition “is substantially substantively identical to the Microsoft Petition, containing only ministerial differences related to formalities of a different party filing the petition.” Mot. 4. Petitioner further explains that it relies on the same declaration from the same expert. *Id.*

We have considered Patent Owner’s Preliminary Response. Prelim. Resp. 1–44. Certain of Patent Owner’s arguments and evidence supporting its position that claims 1–3, 9, and 10 would not have been obvious were previously addressed in the 973 Decision, and we need not address them here again. Certain other arguments against the merits of the Petition closely mirror arguments made in the Patent Owner Response filed in the 973 IPR (*compare* Prelim. Resp. 30–33, with 973 IPR Paper 9, 28–31). Those common arguments will be fully considered in the 973 IPR after Microsoft

¹ 3G TR 25.835 V1.0.0 (2000-09) – 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Report on Hybrid ARQ Type II/III (Release 2000) (Ex. 1005, “TR25.835”).

² US 6,507,582 B1, issued Jan. 14, 2003 (Ex. 1007, “Abrol”).

has filed its Reply and Patent Owner has filed its Sur-Reply, and with the benefit of a complete record. Based on the record before us, Patent Owner's Preliminary Response arguments on the merits do not persuade us that Petitioner has not demonstrated a reasonable likelihood of success in prevailing on the same ground as instituted in the 973 IPR.

Patent Owner also argues that we should exercise our discretion to deny institution under 35 U.S.C. § 314(a), citing and discussing the *General Plastic* factors. Prelim. Resp. 14–16; Opp. 7–9 (citing *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)). Petitioner argues that the *General Plastic* factors do not apply here, where Petitioner seeks to join as a party to the 973 IPR and take an inactive or understudy role. Mot. 8–9 (citing *Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) and *Celltrion, Inc. v. Genentech, Inc.*, IPR2019-01019, Paper 11 at 10 (PTAB Oct. 30, 2018)); Reply 3–5.

In *General Plastic*, the Board recognized certain goals of the AIA, but also “recognized[d] the potential for abuse of the review process by repeated attacks on patents.” *General Plastic*, Paper 19, at 16–17. We agree with Petitioner that the *General Plastic* factors are not particularly pertinent here where Petitioner seeks to join the 973 IPR in a “completely inactive” role. Reply 2. In general, an identical “me too” or “copycat” petition accompanied by a motion to join an earlier proceeding is not a repeated attack on a patent. For instance, joinder of Petitioner to the 973 IPR will not put additional burden on the Board or interfere with the Board's ability to issue a final written decision in the 973 IPR, where here, Petitioner

represents it will, so long as Microsoft remains a party in the 973 IPR, agree to a “completely inactive” role. Reply 2.

Nor has the Petitioner used prior preliminary responses or decisions of the Board to tailor its substantive arguments in the Petition. Rather, the arguments are identical to those in the 973 IPR petition. Moreover, Petitioner filed its Petition no later than one month after the institution date of the 973 IPR in compliance with 37 C.F.R. § 42.122(b) and is timely, notwithstanding the *General Plastic* timing factors. For these reasons, and based on the record before us, we determine that instituting review here would not result in an abuse of the review process.

IV. GRANT OF MOTION FOR JOINDER

The Petition in this proceeding was accorded a filing date of December 18, 2019. *See* Paper 4. The 973 IPR was instituted on November 19, 2019. Petitioner filed a Motion for Joinder on December 18, 2019. Paper 3. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after the November 19, 2019 institution date of the 973 IPR. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition;

(3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

The Petition in this case asserts the same unpatentability ground on which we instituted review in the 973 IPR. *See* Mot. 4–5. Petitioner further explains that it relies on the same prior art analysis and declaration from the same expert. *Id.* at 5–6. Thus, this *inter partes* review does not present any ground or matter not already at issue in the 973 IPR.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of the petitioner (Microsoft) in the 973 IPR as a party. *Id.* at 6–8. Petitioner agrees to assume an “understudy” role in the 973 IPR, unless “Microsoft ceases to participate in the Microsoft IPR.” *Id.* at 7. Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the 973 IPR. *Id.* at 6–8.

Patent Owner argues that “Apple purports to reserve rights by its definition for ‘understudy’ which risk causing undue prejudice to Patent Owner.” Opp. 4. Patent Owner further argues that a true “understudy role” is one in which the petitioner remains “completely inactive.” *Id.* at 6. Petitioner responds that it will remain “completely inactive” so long as Microsoft remains a party in the 973 IPR. Reply 2. Thus, Patent Owner’s concerns appear moot. Lastly, Patent Owner argues that Petitioner’s Joinder Motion is silent as to whether Petitioner will seek to file its own appeal briefing, separate and apart from Microsoft, should Apple eventually seek appellate review. *Id.* at 7. Patent Owner has failed to explain why matters

before a different tribunal are relevant to whether we should grant the Motion for Joinder. For this reason, we are not persuaded by Patent Owner's argument.

We agree with Petitioner that joinder with the 973 IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner's Motion for Joinder.

V. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–3, 9, and 10 of the '917 patent is instituted in IPR2020-00224;

FURTHER ORDERED that the Motion for Joinder with IPR2019-00973 is *granted*, and Petitioner is joined as a party to IPR2019-00973;

FURTHER ORDERED that all further filings shall be made only in IPR2019-00973;

FURTHER ORDERED that, subsequent to joinder, the ground for trial in IPR2019-00973 remains unchanged;

FURTHER ORDERED that, subsequent to joinder, the Scheduling Order in place for IPR2019-00973 (Paper 8) remains unchanged;

FURTHER ORDERED that, throughout the trial, all filings in IPR2019-00973 will be consolidated, and no filing by Petitioner alone will be considered without prior authorization by the Board;

FURTHER ORDERED that counsel for Microsoft will conduct the cross-examination of any witness produced by Patent Owner and the redirect of any witness produced by Microsoft in IPR2019-00973, within

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the time frames set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that the case caption in IPR2019-00973 shall be changed in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2019-00973.

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EXAMPLE CAPTION

UNITED STATES PATENT AND TRADEMARK OFFICE

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³ Apple Inc., who filed a petition in IPR2020-00224, has been joined as a petitioner in this proceeding. Ericsson Inc., who filed a petition in IPR2020-00315, has been joined as a petitioner in this proceeding.