

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00340
Patent 6,664,891 B2

Before MINN CHUNG, CHARLES J. BOUDREAU, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review and
Granting Petitioner's Motion for Joinder
35 U.S.C. § 314; 37 C.F.R. § 42.122

I. INTRODUCTION

On December 23, 2019, Samsung Electronics America, Inc. (“Samsung” or “Petitioner”) filed a Petition seeking institution of *inter partes* review of claims 1–4, 8, and 14–16 of U.S. Patent No. 6,664,891 B2 (Ex. 1001, “the ’891 patent”). Paper 1 (“Pet.”). Uniloc 2017 LLC (“Patent Owner”) filed its Preliminary Response on April 21, 2020. Paper 9 (“Prelim. Resp.”).

Petitioner also timely filed a Motion for Joinder, seeking to join itself as a petitioner in *Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01188 (“the 1188 IPR”). Paper 3 (“Joinder Motion” or “Mot.”). Patent Owner filed an Opposition to the Motion for Joinder. Paper 7 (“Opposition” or “Opp.”). In addition, Microsoft Corporation (“Microsoft”), the current petitioner in the 1188 IPR, filed a statement regarding the Joinder Motion. *Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01188, Paper 12 (“Microsoft Stmt.”). Petitioner filed a Reply in support of its Joinder Motion. Paper 8 (“Reply”).

Upon considering the information presented in each of these papers, for reasons discussed below, we institute trial in this *inter partes* review, and we grant Petitioner’s Joinder Motion.

II. DISCUSSION

A. *Institution of Trial*

In the 1188 IPR, Microsoft challenges the patentability of claims 1–4, 8, and 14–16 of the ’891 patent on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)
1–4, 8, 14–16	103(a) ¹	Larsson, ² the Bluetooth Specification ³
1–3, 8, 14–16	103(a)	802.11 ⁴

IPR2019-01188, Paper 2 at 2. After considering the petition and Patent Owner’s preliminary response in the 1188 IPR, we instituted trial. *See* IPR2019-01188, Paper 9 at 41 (PTAB Dec. 9, 2019).

Petitioner here (Samsung) represents that the present Petition is substantively identical to the petition in the 1188 IPR, challenges the same claims based on the same grounds, and relies on the same expert declaration. Mot. 1–2 (citing Ex. 1029), 5; *see id.* at 4 (“Other than minor differences, such as differences related to formalities of a different party filing the petition, there are no changes to the facts, citations, evidence, or arguments”). We have considered the relevant petitions and we agree with Petitioner’s representation that this Petition is substantially identical to the petition in the 1188 IPR. *Compare* Pet., *with* IPR2019-01188, Paper 2; *see* Ex. 1029 (redline showing differences between petitions). Accordingly,

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Because the application for the challenged patent was filed before March 16, 2013, we refer to the pre-AIA versions of §§ 102 and 103.

² U.S. Pat. No. 6,704,293 B1 to Larsson et al. (Ex. 1004).

³ Specification of the Bluetooth System, Vol. 1, Bluetooth, v1.0B (Dec. 1, 1999) (Ex. 1005).

⁴ ANSI/IEEE Std 802.11, *Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications* (Aug. 20, 1999) (Ex. 1007).

regarding the underlying patentability challenges, there are no additional issues presented by Petitioner.

Patent Owner’s instant Preliminary Response contains many of the same arguments as its preliminary response filed in the 1188 IPR, but it also adds new arguments and substantively modifies certain arguments that were previously presented. *Compare* Prelim. Resp., *with* IPR2019-01188, Paper 6. In the instant Preliminary Response, Patent Owner also disputes Petitioner’s contentions regarding the knowledge of a person of ordinary skill in the art (Prelim. Resp. 8–11) and argues that the Petition fails as a result (*id.* at 21–24). Patent Owner next argues that the Petition fails to establish that the Bluetooth Specification qualifies as prior art. *Id.* at 24–26. In addition, Patent Owner modifies its argument regarding the construction of “additional data field” (*compare id.* at 13–20, *with* IPR2019-01188, Paper 6 at 19–20⁵), proposes a construction for “inquiry message” (Prelim. Resp. 20), and argues that the Petition fails to establish that Larsson teaches either limitation (*id.* at 26–34, 39–41). Patent Owner also adds analysis contending that 802.11 does not teach or suggest the “additional data field” claim limitations. *Id.* at 45–52. Finally, Patent Owner contends that administrative patent judges are unconstitutionally appointed principal officers and that the case accordingly must be dismissed.⁶ *Id.* at 53–56.

⁵ For clarity and consistency with the IPR2019-01188 institution decision, this Decision cites to pages in this paper using the decimal numbers that correspond to the paper’s Roman numeral page numbers.

⁶ Although this argument has been rejected by the Federal Circuit in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019), *reh’g and reh’g en banc denied*, 953 F.3d 760 (Fed. Cir. 2020), Patent Owner contends “the issue is ripe for Supreme Court review.” Prelim. Resp. 55.

We have considered each of Patent Owner’s arguments, including its newly presented arguments. We conclude that they do not compel denial of the Petition under the circumstances presented here, where the instant Petition is substantially identical to that in the 1188 IPR already instituted, and Petitioner seeks joinder as a party to that proceeding. In view of the identity of the issues in the instant Petition and the petition in the 1188 IPR and the already-considered arguments from Patent Owner made in the 1188 IPR, we determine that this proceeding warrants institution on the grounds presented in the Petition for the same reasons stated in our Decision on Institution in the 1188 IPR. *See* IPR2019-01188, Paper 9. Moreover, the Federal Circuit held that there is “no constitutional infirmity in [an] institution decision as the statute clearly bestows such authority on the Director pursuant to 35 U.S.C. § 314,” *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320, 1340 (Fed. Cir. 2019); accordingly, we proceed with the IPR.

B. Motion for Joinder

Based on authority delegated to us by the Director, we have discretion to join a petitioner as a party to a previously instituted *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides, in relevant part, that “[i]f 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” *Id.*

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should (1) set forth the reasons joinder is appropriate; (2) identify any new

grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We find that Petitioner timely filed its motion for joinder, in accordance with 37 C.F.R. § 42.122(b). We further determine that Petitioner has met its burden of showing that joinder is appropriate, at least because, as set forth above, the Petition here: (1) is substantively identical to the petition in the 1188 IPR; (2) contains the same grounds based on the same evidence; and (3) relies on the same declaration of Mr. Peter B. Rysavy. Mot. 4–5; Ex. 1029; Ex. 1003. Petitioner also represents that it “agrees to take an ‘understudy’ role.” Mot. 6. Petitioner clarifies that, “[u]nless and until the current petitioner ceases to participate in the instituted IPR proceeding, Samsung will not assume an active role therein.” *Id.* at 7; *see* Reply 1–2 (confirming willingness to additional conditions).

In its Opposition, Patent Owner advances two arguments. First, Patent Owner contends that the Board should deny the Joinder Motion because Petitioner previously filed another petition challenging the ’891 patent, together with a motion to join an IPR filed by Cisco Systems, Inc. Opp. 2 (citing *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2020-00227, Paper 1; *Cisco Sys., Inc. v. Uniloc 2017 LLC*, IPR2019-00965, Paper 1 (“the 965 IPR”)). Patent Owner states that Samsung’s “second bite at the apple . . . implicates the same efficiency concerns underpinning the Valve opinions.” *Id.* at 6–7 (citing, *inter alia*, *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, Paper 10 (PTAB May 1, 2019)).

We disagree. Granting Petitioner’s Joinder Motion does not create an additional proceeding, and we perceive no significant efficiency concerns associated with granting Petitioner’s request. *Accord Apple Inc. v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018) (noting that similar filing of a petition with a motion for joinder, which agreed to a passive understudy role and existing trial schedule, “effectively neutraliz[ed] the *General Plastic* factors”). We granted Samsung’s motion to join the 965 IPR as a passive understudy. *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2020-00227, Paper 9 at 7–8. Joining Petitioner to the 1188 IPR, also as a passive understudy, will not put a significant additional burden on the Board or jeopardize the Board’s ability to issue a final written decision in the 1188 IPR. Moreover, the present case is distinguishable from *Valve*, as this is not a case in which a petitioner has used prior preliminary responses or decisions of the Board to tailor the substantive arguments presented in its petition. *See* IPR2019-00064, Paper 10 at 12–13 (denying institution of second petition where petitioner had joined a first petition and used that earlier proceeding as a roadmap in preparing the second petition).

Second, Patent Owner argues that Samsung “seeks to actively participate in a manner that is inconsistent with a true ‘understudy’ role.” Opp. 3 (citing *Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00376, Paper 8 (PTAB January 21, 2020)); *see id.* at 3–6 (summarizing *Ericsson* decision and identifying inconsistent verbal statements by Samsung).⁷ Relatedly,

⁷ Patent Owner also argues that joinder should be denied because Petitioner may seek to file “its own appeal briefing” if it seeks appellate review. Opp. 6. We are not persuaded that it is appropriate to consider Petitioner’s potential appeal rights when deciding a motion presented to the Board. But even if we were to consider Patent Owner’s argument, we have no reason to

Microsoft does not oppose the Joinder Motion if Samsung joins “in a true ‘understudy’ role.” Microsoft Stmt. 1. According to Microsoft, it will “not ‘coordinate behind the scenes’ with Samsung” due to Samsung’s involvement in IPR2019-00965 and the “lack of clear precedent on whether and under what circumstances Section 315(e)(1) estoppel may be imputed from a joining petitioner to the original petitioner.” *Id.* at 1–2.

Samsung responds to these arguments by noting that the Board “has repeatedly adopted” Samsung’s definition of “understudy role” in various proceedings. Reply 1. However, Samsung confirms that it “is amenable to a definition that is consistent with the Board’s decision in *Ericsson*,” and Samsung argues that its Joinder Motion “should still be granted subject to the conditions the Board believes are appropriate.” *Id.* at 2.

Although some of Samsung’s statements are arguably in tension with Samsung’s representation that it “will not assume an active role” in the IPR proceeding “[u]nless and until the current petitioner ceases to participate” (Mot. 7), we are persuaded that expressly limiting Petitioner’s participation in the joined proceeding is the appropriate way both to resolve the potential discrepancy and to address the concerns raised by Patent Owner and Microsoft (*see* Opp. 3; Microsoft Stmt. 1).

In particular, we limit Petitioner’s participation, such that:

- (1) Microsoft alone is responsible for all petitioner filings in the joined proceeding unless and until Microsoft is terminated from the 1188 IPR;
- (2) Petitioner must obtain Board authorization prior to filing any paper or taking any action on its own until Microsoft is terminated from the 1188

expect that Patent Owner will be prejudiced by our reviewing court with an unfair allocation of briefing pages.

IPR, except that Petitioner may file a motion to modify these provisions on the ground that Microsoft is no longer an active party in the 1188 IPR; and (3) Petitioner is bound by all filings by Microsoft and discovery agreements between Patent Owner and Microsoft in the joined proceeding, except for (a) filings regarding termination or settlement and (b) filings where Petitioner receives permission from the Board to file an independent paper. Although these limitations do not preclude Petitioner from providing suggestions to and coordinating with Microsoft behind the scenes, Microsoft is under no obligation to solicit or adopt suggestions from Petitioner. *See* Microsoft Stmt. 1–2 (identifying concerns). This arrangement promotes the just and efficient administration of the ongoing trial in the 1188 IPR, and protects the interests of Microsoft, as the original petitioner in IPR2019-01188, and of Patent Owner.

On this record, joinder would result in the just, speedy, and inexpensive resolution of the instant Petition as well as the petition filed in the 1188 IPR. *See* 37 C.F.R. § 42.1(b). Accordingly, Petitioner’s Joinder Motion is granted.

III. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 1–4, 8, 14–16 of the ’891 patent on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)
1–4, 8, 14–16	103(a)	Larsson, the Bluetooth Specification
1–3, 8, 14–16	103(a)	802.11

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2019-01188 is *granted*, and Samsung is joined as a petitioner in IPR2019-01188 pursuant to 37 C.F.R. § 42.122(b);

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2019-01188;

FURTHER ORDERED that the grounds on which an *inter partes* review was instituted in IPR2019-01188 remain unchanged;

FURTHER ORDERED that the Scheduling Order currently in place for IPR2019-01188 (Paper 10) shall govern the joined proceeding;

FURTHER ORDERED that, unless and until Microsoft is terminated from IPR2019-01188, Samsung is bound by all filings by Microsoft without a separate opportunity to be heard, whether orally or in writing (except for filings regarding termination or settlement and filings where Petitioner receives permission from the Board to file an independent paper);

FURTHER ORDERED that Samsung must obtain prior Board authorization to file any paper or take any action on its own in IPR2019-01188 (except a motion to modify these provisions on the ground that Microsoft is no longer an active party);

FURTHER ORDERED that the case caption in IPR2019-01188 for all further submissions shall be changed to add Samsung as a named petitioner, and to indicate by footnote the joinder of Petitioner Samsung to that proceeding, as indicated in the attached sample case caption; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2019-01188.

IPR2020-00340
Patent 6,664,891 B2

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IPR2019-01188¹
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¹ Samsung Electronics America, Inc., which filed a petition in IPR2020-00340, has been joined as a petitioner in this proceeding.