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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.
Petitioner

v.

QURIO HOLDINGS, INC.
Patent Owner

IPR2016-00998
Patent 7,787,904
Seeking to Party Join IPR2015-02005

MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)

I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner Unified Patents Inc. requests silent party joinder with the recently instituted *Inter Partes* Review of U.S. Patent No. 7,787,904 (the “’904 patent”) in *DirectTV, LLC v. Qurio Holdings, Inc.*, IPR2015-02005 (the “DirecTV IPR”). The original petitioners have taken no position on Unified’s joinder request at this time. Qurio Holdings, LLC opposes. This motion is timely because it is filed no later than one month after institution of the DirecTV IPR, which the Board instituted on April 4, 2016. IPR2015-02005, Paper 9 (Apr. 4, 2016); 37 C.F.R. § 42.122(b).

Unified requests institution of its concurrently filed Petition for *Inter Partes* Review and silent party joinder to the instituted proceeding. Unified’s Petition is a near copy of the original DirecTV IPR petition in all material respects. Unified seeks to add no new substance, arguments, or exhibits to the dispute. In its petition, Unified copied sections IV to VII of the DirecTV IPR—the substantive sections. Unified made changes to sections I to III and VII to identify the correct petitioner and the petitioner’s wish for joinder, to supply the mandatory notices required by 37 C.F.R. § 42.8(b), and to comply with the new word-count requirement under 37 C.F.R. § 42.24 et seq. Unified’s petition and the DirecTV IPR petition challenge the same claims of the ’904 patent on the same grounds, relying on the same prior art

and evidence, and includes declarations identical in substance to those submitted in the DirecTV IPR petition. Unified agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the DirecTV IPR as instituted, and agrees to a silent, subordinate role in those proceedings. Unified is in the process of seeking to retain the expert from the original proceeding. Thus, the petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits (and encourages) Unified's joinder to the DirecTV IPR.

If joined, Unified agrees to subordinate itself with a silent role, requesting no briefing or participation in depositions or the oral argument absent settlement by the original petitioners, thus allowing the original petitioners to lead the joined proceedings, in line with common Board practice. Thus, joinder with the DirecTV IPR would have almost no effect on either procedure or substance.

Further, Unified Patents Inc. has been instituted into IPR2016-01940 on a related patent also owned by Qurio, who is represented by the same counsel, on a similar schedule, before the same Board panel. To the extent there are any facts relevant to any procedural issues raised here, such as a real party-in-interest challenge, that have not already been timely raised or are not based on facts redundant in the other proceeding, Unified agrees to stipulate to being bound in this

IPR to any procedural decisions made in IPR2016-01940, and submits additional voluntary discovery here.

Unified believes that the vast majority of relevant information between this IPR and IPR2016-01940 will be the same, but has nonetheless filed updated voluntary discovery. (We note that Qurio has not asked for any additional discovery in instituted IPR2016-01940 or the denied IPR2016-01991 based on the same patent at issue here, either from Unified or from the Board.) These actions eliminate the possibility that joinder would complicate the issues if joined or might contribute to delay.

Without joinder, if both the DirecTV IPR and Unified IPR are instituted on identical grounds, the two proceedings would go forward on a similar schedule but as two separate proceedings. Both the Patent Owner and the Board would need to duplicate efforts, and both Unified and the original petitioners may be prejudiced by inconsistent arguments and decisions. And a denial of joinder and denial of institution would prejudice Unified Patents, as it would lose the not insignificant filing fee and would lose its opportunity to timely resolve the patentability of the patent in question.

Joinder will not unduly prejudice any party. The original petitioners have taken no position on Unified's joinder at this time, but have filed two similar

petitions and motions to join days ago, on related patents.) Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal.

On the other hand, denial of joinder would prejudice Petitioner. Its interests may not be adequately protected in the DirecTV IPR, particularly if the original petitioners settle with the Patent Owner.

II. BACKGROUND AND RELATED PROCEEDINGS

A. Related Proceedings

Patent Owner Qurio Holdings, Inc., asserted the '904 patent against a number of companies: *Qurio Holdings, Inc. v. DirecTV, LLC*, No. 3-15-cv-01986 (N.D. CA May 4, 2015) and *Qurio Holdings, Inc. v. Dish Network Corp., et al.*, No. 3-15-cv-00930 (N.D. CA, Feb. 27, 2015). In addition to the DirecTV IPR, the Board instituted *inter partes* review in IPR2016-00007, *Dish Network, LLC v. Qurio Holdings, LLC*, on April 4, 2016, and in IPR2016-00080, on April 24, 2016. On May 1, 2016, DirecTV itself filed IPR2016-00993 and IPR2016-00994, seeking to join Dish network's IPR2016-00005 and IPR2016-00080, respectively.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has discretion to join a properly filed IPR petition to an IPR proceeding, particularly where the parties seek to add new substantive issues or

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