UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., FACEBOOK, INC. AND WHATSAPP, INC.,
Petitioners

v.

UNILOC 2017 LLC[1]
Patent Owner

Case IPR2017-00222[2]
Patent 8,243,723

JOINDER PETITIONERS FACEBOOK, INC. AND WHATSAPP, INC.'S NOTICE OF APPEAL

[1] Uniloc Luxembourg S.A. filed Updated Mandatory Notices on September 13, 2018 (Paper 34), changing the real party-in-interest to Uniloc 2017 LLC.

[2] Facebook, Inc. and WhatsApp, Inc., who filed a petition in IPR2017-01635, have been joined as petitioners in this proceeding.

INTRODUCTION

Joinder Petitioners Facebook, Inc. and WhatsApp, Inc.'s ("Joinder Petitioners") appeal stems from the Patent Trial and Appeal Board's Decision on Petitioner's Request for Rehearing entered on September 6, 2018 (Paper 32) (the "Rehearing Decision") and the Board's Final Written Decision entered on May 23, 2018 (Paper 29) (the "FWD") in the above-captioned *inter partes* review of United States Patent No. 8,243,723. This notice is timely filed within 63 days of the Rehearing Decision. 37 C.F.R. § 90.3(b)(1).

JOINDER PETITIONERS' APPEAL

Please take notice that under 35 U.S.C. §§ 141(c), 142, 319; 37 C.F.R. §§ 90.2(a), 90.3(a), and Federal Rules of Appellate Procedure/Federal Circuit Rule 4(3)(a), Joinder Petitioners hereby appeal to the United States Court of Appeals for the Federal Circuit from the FWD and Rehearing Decision, including all underlying orders, decisions, rulings, and opinions related thereto or subsumed therein.

Original Petitioner Apple Inc. has already noticed its appeal of the Board's Rehearing Decision and Final Decision. (Paper 35, Petitioner's Notice of Appeal (Nov. 1, 2018); *see also* Case No. 13-1151 (Fed. Cir., docketed Nov. 2, 2018).) Joinder Petitioners join that appeal with respect to claims 1-3 of United States Patent No. 8,243,723.

JOINDER PETITIONERS' ISSUES ON APPEAL

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Joinder Petitioners' issues on appeal include at least: (i) the Board's finding that claim 3 would not have been obvious over the combination of Vuori and Malik; (ii) the Board's finding that claims 1-3 would not have been obvious over the combination of Stubbs and Abburi; and (iii) any findings or determinations supporting or related to the aforementioned issues as well as all other issues decided adversely to Apple Inc. or Joinder Petitioners in any orders, decisions, rulings, phone conference decisions, and/or opinions. These issues are identical to issues (i), (ii), and (v) raised by Apple Inc. in its Notice of Appeal, but address only a subset of the claims addressed by Apple Inc.

Simultaneously with this submission, Joinder Petitioners are filing a true and correct copy of this Notice of Appeal with the Director of the United States Patent and Trademark Office and a true and correct copy of the same, along with the required docketing fee, with the Clerk of the United States Court of Appeals for the Federal Circuit as set forth in the accompanying Certificate of Filing.

Dated: November 8, 2018

Respectfully submitted,

By: /Heidi L. Keefe/
Heidi L. Keefe
Reg. No. 40,673
Counsel for Joinder Petitioners
Facebook, Inc. and WhatsApp, Inc.

COOLEY LLP
ATTN: Patent Docketing
1299 Pennsylvania Ave., NW, Suite 700
Washington, DC 20004
Tel: (650) 843-5001
Fax: (650) 949-7400
Email: hkeefe@cooley.com

Trials@uspto.gov
571-272-7822

Paper 29
Entered: May 23, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., FACEBOOK, INC., and WHATSAPP, INC.,[1]
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-00222
Patent 8,243,723 B2

Before JENNIFER S. BISK, MIRIAM L. QUINN, CHARLES J. BOUDREAU, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

[1] Facebook, Inc. and WhatsApp, Inc. filed a petition and motion for joinder in IPR2017-01635, which we granted, and, thus, these entities are joined, as Petitioner, to this proceeding. Paper 12.

I. INTRODUCTION

We instituted this *inter partes* review pursuant to 35 U.S.C. § 314 to review claims 1–8 of U.S. Patent No. 8,243,723 B2 ("the '723 patent"), owned by Uniloc Luxembourg S.A. We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that claims 1 and 2 of the '723 patent are unpatentable. Petitioner has not shown by a preponderance of the evidence that claims 3–8 are unpatentable.

A. PROCEDURAL HISTORY

Apple Inc. filed a Petition to institute *inter partes* review of claims 1–8 of the '723 patent. Paper 2 ("Pet."). Patent Owner filed a Preliminary Response. Paper 6 ("Prelim. Resp."). On May 25, 2017, we instituted *inter partes* review as to challenged claims 1–7. Paper 7 ("Institution Decision" or "Dec"). We did not institute trial as to claim 8. *Id.* Facebook, Inc. and WhatsApp, Inc. are joined to this proceeding pursuant to our grant of the petition and motion for joinder filed in IPR2017-01635 (Paper 12).

After institution, Patent Owner filed a Patent Owner Response. Paper 11 ("PO Resp."). And Petitioner filed a Reply. Paper 14 ("Reply"). We heard oral arguments on February 8, 2018. A transcript of the hearing is in the record. Paper 25 ("Tr.").

On April 24, 2018, the Supreme Court held that a decision to institute under U.S.C. § 314 may not institute on fewer than all claims challenged in a petition. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). In light of the Guidance on the Impact of *SAS* on AIA Trial Proceedings posted on

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.