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Paper 12
Entered: October 3, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01611
Patent 8,995,433 B2

Before MIRIAM L. QUINN, KERRY BEGLEY, and CHARLES J. BOUDREAU, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Snap Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–3, 5, 6, and 8 of U.S. Patent No. 8,995,433 B2 (Ex. 1001, "the '433 patent"). Paper 2 ("Pet."). Petitioner also filed a Motion for Joinder seeking joinder of this proceeding with *Apple Inc. v. Uniloc*, Case No. IPR2017-00225 (the "Apple IPR"). Paper 3 ("Mot."). Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 10 ("Prelim. Resp.").[1] Patent Owner did not file an opposition to the Motion for Joinder. For the reasons that follow, we institute *inter partes* review of claims 1–3, 5, 6, and 8, and grant Petitioner's Motion for Joinder.

II. INSTITUTION OF INTER PARTES REVIEW

On May 25, 2017, we instituted *inter partes* review in IPR2017-00225 based on the following prior art and grounds of unpatentability (Apple IPR, slip op. at 26 (PTAB May 25, 2017) (Paper 7):

a) *Abburi*: U.S. Patent Appl. Pub. No. US 2003/0147512 A1, published Aug. 7, 2003, filed in the record as Exhibit 1005.

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[1] The Board authorized Patent Owner to file a Notice of Patent Owner Preliminary Response and the Preliminary Response filed in IPR2017-00225, which would be accepted as the preliminary response in the instant proceeding. Paper 8.

b) *Holtzberg*: U.S. Patent No. 6,625,261 B2, issued Sept. 23, 2003, filed in the record as Exhibit 1007;

c) *Vuori*: U.S. Patent Appl. Pub. No. US 2002/0146097 A1, published Oct. 10, 2002, filed in the record as Exhibit 1009;

d) *Logan*: U.S. Patent No. 5,732,216, issued Mar. 24, 1998, filed in the record as Exhibit 1008; and

e) *Väänänen*: U.S. Patent No. 7,218,919 B2, issued May 15, 2007, filed in the record as Exhibit 1006.

Challenged Claim(s)	Basis	Reference(s)
1, 2, 4, and 8	§ 103(a)	Abburi and Holtzberg
3	§ 103(a)	Abburi, Holtzberg, and Vuori
5 and 6	§ 103(a)	Abburi, Holtzberg, and Logan
1, 2, 4–6, and 8	§ 103(a)	Väänänen and Holtzberg
3	§ 103(a)	Väänänen, Holtzberg, and Vuori

The Petition in this proceeding asserts the same grounds as those we instituted in the Apple IPR, except that Petitioner does not challenge claim 4 in this proceeding. Pet. 2–3 (stating that Petitioner asserts the same grounds instituted in the Apple IPR except for claim 4). Petitioner also presents testimony from the same declarant relied on in the Apple IPR. Ex. 1003 (Declaration of Leonard J. Forys, Ph.D.).

In view of the identicalness of the issues in the instant Petition and in the Apple IPR, the already considered arguments from Patent Owner proffered in the Apple IPR, and for the same reasons stated in our Decision on Institution in the Apple IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition.

III. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

> (c) JOINDER.—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 parties review under section 314.

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. *See* Frequently Asked Question H5, https://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0.

Petitioner asserts it has grounds for standing because, in accordance with 35 U.S.C. § 315(c), Petitioner filed a motion for joinder concurrently with the Petition and not later than one month after institution of the Apple IPR. Mot. 5. Patent Owner did not file an opposition to the Motion. Patent Owner has indicated, off-the-record, that it understands Petitioner's motion in this case and related cases to involve petitions "identical to their respective original Petition submissions (except where they seek review as to only a subset of the claims upon which *inter partes* review has been instituted), and that the Joinder Petitioners have stipulated to a circumscribed 'understudy' role without a separate opportunity to actively participate while the original petitioner remains active." Ex. 3001. We find that the Motion is timely. We also find that Petitioner has met its burden of showing that joinder is appropriate. For the challenged claims, the Petition here is substantively identical to the petition in the Apple IPR. Mot. 6–8. The evidence also is identical, including the reliance on the same declaration of Dr. Forys. *Id.*

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 7–8. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner will not impact the timeline of the ongoing trial.

Petitioner shall adhere to the existing schedule of IPR2017-00225 and the understudy role it has agreed to assume. More specifically, so long as

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