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Paper 30
Entered: May 29, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., WHATSAPP INC., and LG ELECTRONICS, INC.,[1]
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01427
Patent 8,995,433 B2

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

QUINN, *Administrative Patent Judge.*

ORDER
Partial Dismissal of Facebook, Inc. and WhatsApp, Inc.
35 U.S.C. §§ 315(e)(1), 316(b); 37 C.F.R. §§ 42.73(d), 42.5(a)

[1] LG Electronics, Inc. filed a petition and a motion for joinder in IPR2017-02087, which were granted, and, therefore has been joined to this proceeding. Paper 9.

I. INTRODUCTION

On May 11, 2017, Facebook, Inc. ("Facebook") and WhatsApp Inc. ("WhatsApp") filed a Petition, which we granted, requesting *inter partes* review of certain "challenged claims" of U.S. Patent No. 8,966,144 B2 ("the '433 patent[2]"). Paper 2 ("Facebook Petition"); Paper 8 ("Decision on Institution" or "Dec."). A month later, on June 16, 2017, Facebook and WhatsApp filed a second Petition for *inter partes* review of the challenged claims with a corresponding Motion for Joinder to IPR2017-00225, in which *inter partes* review of a subset of the claims challenged in this case, claims 1–6 and 8 of the '144 patent, was instituted on May 25, 2017. *See* IPR2017-01635, Papers 2–3, 7. We granted that second Petition and Motion for Joinder, and, consequently, Facebook and WhatsApp were joined as a petitioner to IPR2017-00225. Accordingly, the petitioner entities in both IPR2017-00225 and IPR2017-01427 include Facebook and WhatsApp.

On May 23, 2018, the Board issued a Final Written Decision in IPR2017-00225, concluding that the challenged claims of the '433 patent were not shown to be unpatentable. *See* IPR2017-00225, Paper 29. Accordingly, a subset of the claims challenged in the instant proceeding have been the subject of a Final Written Decision under 35 U.S.C. § 318(a).

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[2] In IPR2017-01427, the Facebook Petition challenges claims 1–8 of the '433 patent, hereinafter "challenged claims."

The parties have briefed whether Facebook and WhatsApp are estopped under 35 U.S.C. § 315(e)(1).[3] Dec. 29 (ordering the parties to brief estoppel issues); Papers 11 and 12 (briefs concerning estoppel).

II. ANALYSIS

According to 35 U.S.C. § 315(e)(1),

> [t]he petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

By virtue of their joinder to IPR2017-00225, Facebook and WhatsApp are petitioners who have obtained a final written decision on claims 1–6 and 8 the '433 patent. If estoppel under § 315(e)(1) applies in these circumstances, Facebook and WhatsApp may not "maintain" the instant proceeding as to those claims. Therefore, we first determine if Facebook and WhatsApp seek to maintain this proceeding on "any ground that the petitioner raised or reasonably could have raised during" IPR2017-00225,

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[3] *See also* 35 U.S.C. § 316(b) ("In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, *the efficient administration of the Office*, and the ability of the Office to timely complete proceedings instituted under this chapter."; emphasis added); 37 C.F.R. § 42.5(a) ("The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.").

according to § 315(e)(1). If the answer is yes, and Facebook and WhatsApp are estopped, we then determine whether dismissal of these entities is appropriate.

A. Estoppel

We have stated that a ground "reasonably could have been raised" if it encompasses prior art that a "skilled searcher conducting a diligent search reasonably could have been expected to discover." *See Praxair Distribution Inc., v. INO Therapeutics*, 2016 WL 5105519 (PTAB Aug. 25, 2016) (IPR2016-00781) (citing 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl); *see id.* at S1376 (statement of Sen. Kyl) ("This [estoppel] effectively bars such a party or his real parties in interest or privies from later using inter partes review . . . against the same patent, since the only issues that can be raised in an inter partes review . . . are those that could have been raised in [an] earlier post-grant or inter partes review."); 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (statement of Sen. Grassley) ("It also would include a strengthened estoppel standard to prevent petitioners from raising in a subsequent challenge the same patent issues that were raised or reasonably could have been raised in a prior challenge.").

Here, there is no question that Facebook and WhatsApp filed the Facebook Petition before the Petition in IPR2017-00225. Therefore, the asserted grounds here were known to Facebook and WhatsApp at least one month before these entities filed the motion to join IPR2017-00225. As such, there is no evidence or argument in the record that the grounds

involved in the instant proceeding were unavailable to these entities before they joined IPR2017-00225.

Facebook and WhatsApp argue that they could not have raised the grounds asserted here in IPR2017-00225, because trial had been instituted already in that proceeding. Paper 11, 3–4. This is not a fact relevant to our inquiry. We focus on whether the parties did raise or reasonably could have raised the asserted grounds when it filed the motion to join IPR2017-00225. These petitioners *chose* both to join IPR2017-00225, knowing the limited scope of that case, and also to maintain this proceeding, with different prior art asserted against all claims, including claim 7. We recognize that trying to expand the scope of IPR2017-00225 to include the challenges in this case, would substantially decrease the likelihood that the Board would grant the joinder request. A petitioner, however, is not required to join another petitioner's case. Nor is a petitioner prevented from requesting to consolidate, with an earlier case, a petition including additional challenges. Thus, Facebook and WhatsApp had control of how to proceed given the institution of IPR2017-00225.

Accordingly, we do not find persuasive Facebook and WhatsApp's argument that no estoppel arises here merely because they joined a previously instituted trial. Further, because the Board has issued a Final Written Decision in IPR2017-00225 concerning claims 1–6 and 8, we determine that Facebook and WhatsApp are estopped from maintaining the instant proceeding under § 315(e)(1) as to those claims. However, because this proceeding challenges claim 7, which was not addressed in the Final Written Decision in IPR2017-00225, we determine that Facebook and

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