

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION, MICROSOFT MOBILE INC.,

Petitioners,

v.

KONINKLIJKE PHILIPS ELECTRONICS N.V.,

Patent Owner.

Case No.: IPR2017-01766

Patent No. RE44,913

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

I. INTRODUCTION

Microsoft Corporation and Microsoft Mobile Inc. (collectively, “Microsoft”) submits concurrently a petition for *inter partes* review (the “Microsoft Petition”) of claims 1 and 3-16 of U.S. Patent No. RE44,913 (“the ’913 patent”), which is assigned to Koninklijke Philips Electronics N.V. (“Patent Owner”). Microsoft respectfully requests that this proceeding be joined with the pending *inter partes* review initiated by Google Inc. (“Google”) under PTAB Case No. IPR2017-00386 (hereinafter “Google IPR”). The Microsoft Petition is narrowly tailored to the identical grounds of unpatentability that are subject of the Google IPR, and is essentially a copy of the petition in the Google IPR with respect to the adopted grounds, including the same analyses, prior art references, exhibits, and expert testimony as in the Google IPR. The Microsoft Petition raises no issues beyond the issues raised in the instituted grounds of the Google IPR.

Microsoft’s request for joinder is timely because this request is being filed within one month of the institution of the Google IPR under 37 C.F.R. § 42.122(b) and meets all formal requirements for the requested joinder. Microsoft will also do its part to minimize any effects or delays in the joined proceeding going forward to ensure timely and efficient conduct of the joined proceeding.

In addition, joinder is appropriate because it will efficiently resolve the validity of the challenged claims of the ’913 patent in a single PTAB proceeding.

The requested joinder serves the intent of the AIA by making the PTAB proceedings a cost-effective alternative to litigation. The requested joinder does not prejudice the parties to the Google IPR. In similar circumstances, the Board has routinely granted joinder, and it should grant joinder here as well.

Microsoft is hereby filing this motion pursuant to the joinder provisions under 35 U.S.C. § 315(c) and 37 C.F.R. §42.122(b) to move that:

- (1) The trial requested in the Microsoft Petition be instituted; and
- (2) The new Microsoft IPR be joined with the instituted Google IPR trial.

II. BACKGROUND AND RELATED PROCEEDINGS

Several U.S. Patents, including U.S. Patent No. RE44,913, are asserted against Microsoft in various on-going patent lawsuits filed by Patent Owner in the District of Delaware. Microsoft is also pursuing *inter partes* review of U.S. Patent No. 6,522,695. The '913 patent is asserted in the following cases pending in the District of Delaware (“the Delaware Actions”): (1) *Koninklijke Philips N.V. et al. v. Acer Inc. et al.*, Case No. 1:15-cv-01170-GMS (D. Del.); (2) *Koninklijke Philips N.V. et al. v. Asustek Computer Inc. et al.*, Case No. 1:15-cv-01125-GMS (D. Del.); (3) *Koninklijke Philips N.V. et al. v. Double Power Technology, Inc. et al.*, Case No. 1:15-cv-01130-GMS (D. Del.); (4) *Koninklijke Philips N.V. et al. v. HTC Corp. et al.*, Case No. 1:15-cv-01126-GMS (D. Del.); (5) *Koninklijke Philips N.V. et al. v. Southern Telecom, Inc.*, Case No. 1:15-cv-01128-GMS (D. Del.);

(6) *Koninklijke Philips N.V. et al. v. Visual Land, Inc.*, Case No. 1:15-cv-01127-gms (D. Del.); (7) *Koninklijke Philips N.V. et al. v. Yifang USA, Inc.*, Case No. 1:15-cv-01131-GMS (D. Del.).

On December 5, 2016, Google Inc. filed an IPR petition challenging claims 1 and 3-16 of the '913 Patent, assigned Case No. IPR2017-00386, and the Board determined that trial should be instituted on June 12, 2017.

This Petition proposes the same grounds of rejection that were proposed in the Google IPR and that were instituted by the Board in the Google IPR. In fact, the Petition is entirely similar to Google's petition with respect to the adopted grounds, including the same analysis, prior art, exhibits, and expert testimony.

III. ARGUMENT

A. Legal Standard

The Board has authority to join as a party any person who properly files a petition for *inter partes* review to an instituted *inter partes* review. 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of institution of any *inter partes* review for which joinder is requested. 37 C.F.R. § 42.122(b). In deciding whether to grant a motion for joinder, the Board considers several factors including: (1) the reasons why joinder is appropriate; (2) whether the party to be joined has presented any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how

briefing and discovery may be simplified. *See, e.g., Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014) (quoting *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)). Each of these factors weighs in favor of joinder.

B. Microsoft's Motion for Joinder Is Timely

This motion is timely because it is filed within one month of June 12, 2017, the date the Google IPR was instituted. *See* IPR2017-00386 at Paper 8.

C. The Relevant Factors Weigh in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder. Granting joinder will not enlarge the scope of the Google IPR because Microsoft presents no new grounds of unpatentability, and joinder will not negatively impact the Google IPR schedule. Conversely, a decision denying joinder could severely prejudice Microsoft. Joinder is appropriate and warranted.

1. Joinder Is Appropriate

Joinder with the Google IPR is appropriate. Microsoft's Petition is not only limited to the same grounds adopted by the Board in the Google IPR, but also relies on *exactly* the same analysis, prior art, exhibits, and expert testimony as that submitted by Google. Microsoft's Petition also does not include any grounds or raise any unpatentability issues that were not adopted by the Board.

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