

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., and HUAWEI DEVICE CO., LTD.,
Petitioners

v.

UNILOC LUXEMBOURG, S.A.,
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 8,995,433
Case IPR No.: *IPR2017-02088*

MOTION FOR JOINDER TO *INTER PARTES* REVIEW
(35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b))

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners LG Electronics, Inc., (LGE) and Huawei Device Co., Ltd. (Huawei) move for joinder with the *Inter Partes* Review of U.S. Patent No. 8,995,433, *Facebook, Inc., WhatsApp Inc. v. Uniloc USA, Inc. Uniloc Luxembourg, S.A.*, IPR2017-01428 (“the Facebook IPR”), for which an institution decision is pending. This motion is timely because it is filed prior to institution of the Facebook IPR. 37 C.F.R. § 42.122(b). Petitioners understand that the petitioners in the Facebook IPR do not oppose Petitioners' request for joinder.

Petitioners request institution of the concurrently filed Petition for *Inter Partes* Review. The Petition is a carbon copy of the original Facebook IPR petition in all material respects. The concurrently filed Petition and the Facebook IPR petition challenge the same claims of the '433 patent on the same grounds relying on the same prior art and evidence, including the declaration identical in substance from the same expert.¹

Petitioners request that the institution of this Petition be limited solely to the grounds that will be instituted in the Facebook IPR. Petitioners agree to proceed

¹ The declaration has been updated only to reflect retention by Petitioners and is otherwise identical to the declaration submitted in the Facebook IPR.

solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Facebook IPR as instituted. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioners' joinder to the Facebook IPR.

Further, if joined, Petitioners agree to adhere to all applicable deadlines in the Facebook IPR and coordinate all filings with the Petitioner in the Facebook IPR ("the Facebook Petitioner"). The Facebook Petitioner will maintain the lead role in the proceedings so long as it is a party to the proceedings. Petitioners agree to consolidated filings for all substantive papers in the proceeding. The Facebook Petitioner and Petitioners will be jointly responsible for the consolidated filings. Petitioners will not advance any arguments separate from those advanced by the Facebook Petitioner in the consolidated filings. These limitations will avoid lengthy and duplicative briefing. Also, Petitioners will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with the Facebook Petitioner. Petitioners agree to the foregoing conditions even in the event that other IPRs filed by other, third-party petitioners are joined with the Facebook IPR.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Facebook IPR for all interested parties. Further, the Patent Owner has asserted the '433

patent in district court against LGE and Huawei. Joinder will estop LGE and Huawei from asserting in district court those issues resolved in a final written decision in the Facebook IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Facebook IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums. On the other hand, if instituted, maintaining the Petitioners' IPR proceeding separate from that of the Facebook IPR would entail needless duplication of effort.

Joinder will not unduly prejudice any party. 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 LGE and Huawei. Their interests may not be adequately protected in the Facebook IPR proceedings, particularly if the Facebook Petitioner settles with the Patent Owner. Petitioners should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

Uniloc Luxembourg, S.A. (the "Patent Owner") is the owner of the '433 Patent. The Patent Owner asserted the '433 Patent against Petitioners in *Uniloc USA, Inc. et al. v. LG Electronics U.S.A., Inc.*, Case No. 2:16-cv-00991-JRG (E.D.

Tex. Filed Sept. 6, 2016), and *Uniloc USA, Inc. et al. v. Huawei Device USA, Inc. et al.*, Case No. 2:16-cv-00994-JRG (E.D. Tex. Filed Sept. 6, 2016), which have been consolidated for pretrial purposes with *Uniloc USA, Inc. et al. v. Motorola Mobility LLC*, Case No. 2:16-cv-00992-JRG (E.D. Tex.) (lead case). In addition, the Patent Owner asserted the '433 Patent against Facebook, Inc. ("Facebook") and WhatsApp Inc. ("WhatsApp"), among others, in *Uniloc USA, Inc. et al. v. Samsung Electronics America, Inc.*, Case No. 2:16-cv-00642-JRG (E.D. Tex.). On May 11, 2017, Facebook and WhatsApp filed their IPR petition, IPR2017-01428, against the '433 patent. The Board has not yet decided whether to institute the Facebook IPR. Petitioners here move for joinder with the Facebook IPR.

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal Standards and Applicable Rules

The time limitation set forth in 35 U.S.C. § 315(b) does not apply to a request for joinder. 35 U.S.C. § 315(b). The Board has discretion to join a properly filed IPR petition to an IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4. "The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each

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