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Paper 13
Date: January 25, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., HTC CORPORATION, and HTC AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2018-01458
Patent 8,712,723 B1

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Petitioner's Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

LG Electronics, Inc., HTC Corporation, and HTC America, Inc. (collectively "Petitioner") filed a Petition for *inter partes* review of claims 1–3, 5–7, and 10–18 of U.S. Patent No. 8,712,723 B1 (Ex. 1001, "the '723 patent"). Paper 1 ("Pet."), 1. Concurrently with its petition, Petitioner filed a Motion for Joinder with *Apple Inc. v. Uniloc 2017 LLC*, Case IPR2018-00389 ("the Apple IPR"). Paper 4 ("Motion" or "Mot."). Petitioner represents that the petitioner in the Apple IPR—Apple Inc.—does not oppose the Motion for Joinder. Mot. 1. Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Patent Owner acknowledges the joinder request, but does not state whether it opposes joinder. *Id.* at 1 n.1.

For the reasons explained below, we institute an *inter partes* review of claims 1–3, 5–7, and 10–18 of the '723 patent and grant Petitioner's Motion for Joinder.

B. Real Parties-in-Interest

The statute governing *inter partes* review proceedings sets forth certain requirements for a petition for *inter partes* review, including that "the petition identif[y] all real parties in interest." 35 U.S.C. § 312(a)(2); *see also* 37 C.F.R. § 42.8(b)(1) (requiring identification of real parties-in-interest in mandatory notices). The Petition identifies LG Electronics, Inc., LG Electronics U.S.A., Inc., LG Electronics MobileComm USA, Inc., HTC Corporation, and HTC America, Inc. as the real parties-in-interest. Pet. 2.

Patent Owner states that its real parties-in-interest are Uniloc 2017 LLC, Uniloc USA, Inc., and Uniloc Licensing USA LLC. Paper 7, 2.

C. Related Matters

The parties indicate that the '723 patent is involved in *Uniloc USA, Inc. v. HTC Am., Inc.*, Case No. 2-17-cv-01629 (W.D. Wash), *Uniloc USA, Inc. v. LG Elecs. USA, Inc.*, Case No. 4:18-cv-02918 (N.D. Cal.), and other proceedings. Pet. 2; Prelim. Resp. 3.

In the Apple IPR, we instituted an *inter partes* review of claims 1–3, 5–7, and 10–18 of the '723 patent on the following ground:

References	Basis[1]	Challenged Claims
Fabio[2] and Pasolini[3]	35 U.S.C. § 103(a)	1–3, 5–7, and 10–18

Apple Inc. v. Uniloc 2017 LLC, Case IPR2018-00389, slip. op. at 6, 24 (PTAB June 27, 2018) (Paper 7) ("Apple Decision" or "Apple Dec.").

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same ground of unpatentability as the one on which we instituted review in the Apple IPR. *Compare* Pet. 28–68, *with* Apple Dec. 6, 25. Indeed, Petitioner contends that the Petition asserts only the ground that the Board instituted in the Apple IPR, there are no new arguments for the Board to consider, and the

[1] The '723 patent was filed on January 31, 2011, prior to the date when the Leahy-Smith America Invents Act ("AIA") took effect.
[2] US 7,698,097 B2 (filed Oct. 2, 2006, issued Apr. 13, 2010) (Ex. 1006, "Fabio").
[3] US 7,463,997 B2 (filed Oct. 2, 2006, issued Dec. 9, 2008) (Ex. 1005, "Pasolini").

Petitioner relies on the same exhibits and expert declaration as in the Apple IPR. Mot. 6–8.

We acknowledge Patent Owner's arguments and evidence supporting its position that the claims would not have been obvious. Prelim. Resp. 14–31. Certain of Patent Owner's arguments against the merits of the Petition have been previously addressed in the Apple Decision, and we need not address them here again. Certain other arguments against the merits of the Petition closely mirror arguments made in the Patent Owner Response filed in the Apple IPR (*compare* Prelim. Resp. 14–31, *with* Apple IPR PO Resp. (IPR2018-00389, Paper 11), 9–25). Patent Owner's arguments and evidence will be fully considered in the Apple IPR. Doing so ensures that we review Patent Owner's arguments and evidence in light of a full record, avoids premature evaluation of arguments and evidence at issue in the Apple IPR, and ensures consistency across proceedings involving the same petitions. In sum, Patent Owner's arguments made in its Preliminary Response in this case do not persuade us that Petitioner has not demonstrated a reasonable likelihood of success in prevailing on the same grounds as instituted in the Apple IPR.

Additionally, Patent Owner notes that an argument made in an unrelated appeal pending at the U.S. Court of Appeals for the Federal Circuit asserts that "the Board's appointments of administrative patent judges violate the Appointments Clause of Article II" of the U.S. Constitution. Prelim. Resp. 30. "Patent Owner . . . adopts this constitutional challenge . . . to ensure the issue is preserved pending the appeal." *Id.* at 30–31.

The Board has previously "declin[ed] to consider [the] constitutional challenge as, generally, 'administrative agencies do not have jurisdiction to

decide the constitutionality of congressional enactments.'" *Square, Inc. Unwired Planet LLC*, IPR2014-01165, slip op. at 25 (PTAB Oct. 30, 2015) (Paper 32) (quoting *Riggin v. Office of Senate Fair Emp't Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995)). We, likewise, decline to consider Patent Owner's constitutionality argument.

III. MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of July 27, 2018. *See* Paper 5. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the Apple IPR, i.e., June 27, 2018. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

> 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 partes review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

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