UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner

IPR2018-00579
PATENT 8,724,622

PATENT OWNER'S OBJECTION TO JOINDER

Petitioner has now filed *six* IPR petitions against U.S. Patent No. 8,724,622 ("the '622 patent"). It filed its first two petitions against the '622 patent (Case Nos. IPR2017-0223 and -0224) on November 14, 2016 and its third and fourth petitions (Case Nos. IPR2017-1804 and -1805) on July 20, 2017. Having failed in its first four IPR petitions, Petitioner now seeks to join its fifth and sixth petitions (the instant petition, IPR2017-00579, and IPR2017-00580) against the same patent to Case Nos. IPR2017-1667 and -1668.

Contrary to what Petitioner alleges, the *Blue Coat Systems*[1] factors (later adopted and made precedential by *General Plastic*[2]) weigh heavily against institution and, therefore, joinder. Indeed, under nearly identical circumstances in Petitioner's third and fourth IPR petitions against the '622 patent (involving the same challenged claims and the same cited references), the Board already "agree[d] with Patent Owner's arguments that the factors set forth in *Blue Coat Systems* . . . do not weigh in Petitioner's favor."[3] Here, it is even more clear that the *Blue Coat Systems*/*General Plastic*[4] factors require denial of institution, and therefore denial of

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[1] *Blue Coat Systems LLC v. Finjan, Inc.*, Case IPR2016-01443 (Paper 13, pp. 8-9) (PTAB Jan. 23, 2017).
[2] *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (Paper 19) (PTAB Sept. 6, 2017).
[3] IPR1804, paper 8 at 5 n.3 (citing Prelim. Resp. 8-11).
[4] For simplicity and consistency, going forward Patent Owner refers to the factors as *Blue Coat Systems* factors, but notes these factors were made precedential by *General Plastic.* While all of the factors weigh against institution in this case, Patent

joinder.

I. STATEMENT OF PRECISE RELIEF REQUESTED.

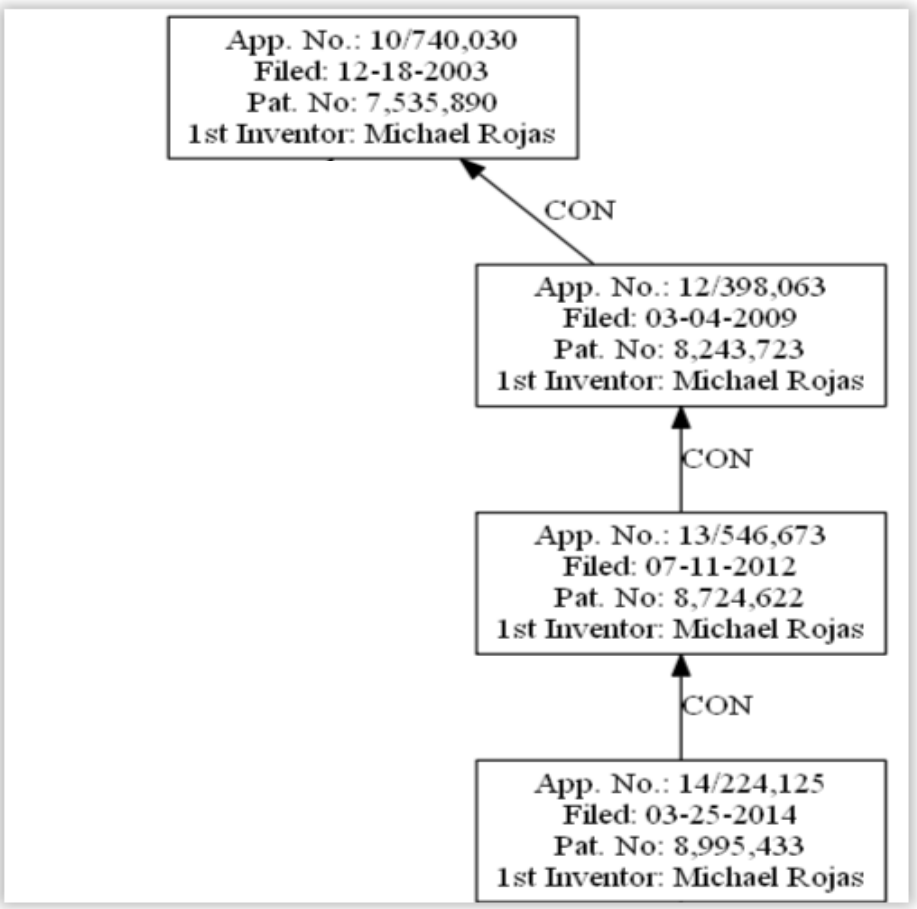
The Board should deny Petitioner's motion for joinder (and ultimately its petition[5]) under 35 U.S.C. § 325(d) because Petitioner provides no persuasive justification for its latest piecemeal challenges based on a combination of references it knew (or reasonably should have known) before it filed any of its petitions against the '622 patent.

II. STATEMENT OF MATERIAL FACTS.

The '622 patent is in a family of patents including United States Patent Nos. 7,535,890 (the '890 Patent); 8,243,723 (the '723 Patent); 8,199,747 (the '747 Patent); and 8,995,433 (the '433 Patent). The diagram below illustrates how this family of patents are interrelated by priority claims.

Owner does not imply that each factor must be weighed and instead notes that a single factor may require denial of institution, as is the case with several of the factors in this case.

[5] Patent Owner files this objection to timely oppose Petitioner's motion for joinder, to the extent the deadline to oppose such a motion is governed by 37 C.F.R. § 42.25. Patent Owner notes, however, that the plain language of 35 U.S.C. § 315(c) requires the Board to wait until "after receiving a preliminary response under section 313" before ruling on a motion for joinder. Patent Owner will timely file a preliminary response and understands the Board will wait for that preliminary response before ruling on Petitioner's motion to join.



Forty petitions have been filed against the Rojas patents to which the ’622 patent belongs. Ten of those were filed by Petitioner, as highlighted in the following table:

Petitioner	IPR#	Date	Patent
Apple	IPR2017-0220	14-Nov-16	'890
Apple	IPR2017-0221	14-Nov-16	'890
Apple	IPR2017-0222	14-Nov-16	'723
Apple	IPR2017-0223	14-Nov-16	'622
Apple	IPR2017-0224	14-Nov-16	'622
Apple	IPR2017-0225	14-Nov-16	'433
Facebook / WhatsApp	IPR2017-1257	7-Apr-17	'747

Petitioner	IPR#	Date	Patent
Facebook / WhatsApp	IPR2017-1365	3-May-17	'723
Facebook / WhatsApp	IPR2017-1427	11-May-17	'433
Facebook / WhatsApp	IPR2017-1428	11-May-17	'433
Facebook / WhatsApp	IPR2017-1523	2-Jun-17	'890
Facebook / WhatsApp	IPR2017-1524	2-Jun-17	'890
Facebook / WhatsApp	IPR2017-1667	22-Jun-17	'622
Facebook / WhatsApp	IPR2017-1668	22-Jun-17	'622
Snap	IPR2017-1611	15-Jun-17	'433
Snap	IPR2017-1612	16-Jun-17	'890
Facebook / WhatsApp	IPR2017-1634	16-Jun-17	'433
Facebook / WhatsApp	IPR2017-1635	16-Jun-17	'723
Facebook / WhatsApp	IPR2017-1636	16-Jun-17	'890
Samsung Elec	IPR2017-1797	20-Jul-17	'622
Samsung Elec	IPR2017-1798	20-Jul-17	'622
Samsung Elec	IPR2017-1799	20-Jul-17	'747
Samsung Elec	IPR2017-1800	20-Jul-17	'723
Samsung Elec	IPR2017-1801	20-Jul-17	'433
Samsung Elec	IPR2017-1802	20-Jul-17	'890
Apple	IPR2017-1804	20-Jul-17	'622
Apple	IPR2017-1805	20-Jul-17	'622
Huawei / LG Electronics	IPR2017-2090	11-Sep-17	'622
LG Electronics	IPR2017-2087	11-Sep-17	'433
LG Electronics / Huawei	IPR2017-2088	11-Sep-17	'433
Google/Huawei/Motorola	IPR2017-2080	12-Sep-17	'622
Google/Huawei/Motorola	IPR2017-2081	12-Sep-17	'622
Google/Huawei/Motorola	IPR2017-2082	11-Sep-17	'890
Google/Huawei/Motorola	IPR2017-2083	11-Sep-17	'890
Google/Huawei/Motorola	IPR2017-2084	11-Sep-17	'890

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