

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

UNILOC USA, INC., UNILOC LUXEMBOURG, S.A.
Patent Owners

Case IPR2018-00580
Patent 8,724,622

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c)
AND 37 C.F.R. §§ 42.22 AND 42.122(b)**

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*Motion for Joinder
Inter Partes Review of U.S. Patent No. 8,724,622*

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner Apple Inc. (“Apple”) respectfully requests joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the concurrently filed Petition for *Inter Partes* Review of U.S. Patent No. 8,724,622 (“the ’622 patent”) (“Apple Petition”) with pending *Inter Partes* review, IPR2017-01668 (“Facebook IPR”).

Joinder is appropriate because it will promote efficient resolution of the validity of the ’622 patent, as the timely Apple Petition involves the same ’622 patent, covers the claims instituted in the Facebook IPR, while relying on the same arguments and evidentiary record.¹ No new grounds of unpatentability are asserted in the Apple Petition and there will be, at most, a minimal impact on the trial schedule for the existing review. Apple further identifies procedures the Board may adopt to simplify briefing and discovery. Therefore, joinder would neither complicate the issues nor unduly delay IPR2017-01668.

Apple has notified counsel for Petitioners in the Facebook IPR regarding the subject of this motion and counsel has indicated they do not oppose this motion.

¹ Apple’s Exhibits are identical to the corresponding Facebook Exhibits and have been re-labeled as “Apple” Exhibits.

II. STATEMENT OF MATERIAL FACTS

On July 20, 2017, Apple filed a petition for *Inter Partes* Review (“IPR”) Apple Inc. v. Uniloc USA, Inc., IPR2017-01805, Paper 2 (PTAB July 20, 2017). The ’1805 petition was substantively identical to the Facebook Petition--aside from Sections VII-VIII of the Apple-filed ’1805 petition.

On January 19, 2018, the Board denied institution of the ’1805 petition “without prejudice to Petitioner’s ability to file a new petition accompanied by a request for joinder pursuant to and within the time period permitted by 37 C.F.R. § 42.122(b).” Apple Inc. v. Uniloc USA, Inc., IPR2017-01805, Paper 9, pp. 6-7 (PTAB January 19, 2018).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Leahy-Smith America Invents Act (“AIA”) permits joinder of *Inter Partes* Review (“IPR”) proceedings. The statutory provision governing joinder of post-grant review proceedings is 35 U.S.C. § 315(c):

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.

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37 C.F.R. § 42.122(a) provides that, “[w]here another matter involving the patent is before the Office, the Board may during the pendency of the *inter partes* review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter.”

“The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” IPR2013-00385, Paper 17 at 3 (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl)). “The Board’s rules for AIA proceedings ‘shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.’” CBM2014-00115, Paper 8 at 19 (citing 37 C.F.R. § 42.1(b); 77 Red. Reg. at 48,758). Indeed, there is a “policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *See Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 17 at 10 (PTAB July 29, 2013) (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an *inter partes* review is instituted on the basis of a petition, for example, a party that files an *identical petition* will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”) (emphasis added)). That is precisely the situation here.

In accordance with the Board’s governing law and rules, each of the factors

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