

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC., WHATSAPP, INC.,  
Petitioners,

v.

UNILOC LUXEMBOURG S.A.,  
Patent Owner

Patent No. 7,535,890 B2

TITLE: SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING

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**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND  
37 U.S.C. §§ 42.22 AND 42.122(b) TO RELATED *INTER PARTES*  
REVIEW IPR2017-01802**

## I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Facebook, Inc. and WhatsApp, Inc. (“Joinder Petitioners”) respectfully submit this Motion for Joinder together with a Petition for *Inter Partes* Review of U.S. Patent. No. 7,535,890 (“’890 Patent”) (“the Joinder Petition”) filed contemporaneously herewith.

The Board instituted *inter partes* review of claims 1-6, 9, 14, 15, 17-20, 23, 40-43, 51-54, and 57 of the ’890 Patent in *Samsung Electronics America, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-01802 on February 6, 2018. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Joinder Petitioners request institution of *inter partes* review of claims 9, 23, and 57 of the ’890 Patent and request joinder, as to claims 9, 23, and 57<sup>1</sup> **only**, with IPR2017-01802.

The Joinder Petition is narrowly tailored to the same claims, prior art, and grounds for unpatentability currently at issue in IPR2017-01802. In fact, the Joinder Petition and supporting exhibits are substantively the same as the original Petition submission (“Original Petition”) by Samsung Electronics America, Inc. (“Samsung”

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<sup>1</sup> Joinder Petitioners note that although joinder is only requested as to claims 9, 23, and 57, these claims depend from claims 1, 14, and 51 and those underlying claims would necessarily be addressed when analyzing the validity of claims 9, 23, and 57.

or “Original Petitioner”) in IPR2017-01802, except that Joinder Petitioners seek review and joinder as to only a subset of the claims upon which *inter partes* review has been instituted.

Joinder is appropriate because it will not burden or prejudice the present parties to IPR2017-01802, will not cause any undue delay, and will efficiently resolve the question of the ’890 Patent’s validity on the instituted grounds. Further, Joinder Petitioners are willing to serve in a limited “understudy” role to streamline discovery and briefing.

## II. STATEMENT OF MATERIAL FACTS

1. On June 14, 2016, Uniloc USA, Inc. and Uniloc Luxembourg, S.A. (“Uniloc”) filed a civil action for patent infringement against Samsung in the Eastern District of Texas, asserting that Samsung has infringed the ’890 patent and three related patents. (Complaint, *Uniloc USA, Inc. v. Samsung Elecs. Am. Inc.* (“Samsung Action”), Case No. 2:16-CV-642-JRG, ECF No. 1.)

2. On June 14, 2016, Uniloc filed a civil action for patent infringement against WhatsApp, Inc. (“WhatsApp”) in the Eastern District of Texas, asserting that WhatsApp has infringed the ’890 Patent and four other related patents. (Complaint, *Uniloc USA, Inc. v. WhatsApp, Inc.* (“WhatsApp Action”), Case No. 2:16-CV-645-JRG, ECF No. 1.) Uniloc filed a First Amended Complaint against WhatsApp on July 11, 2016. (*WhatsApp Action*, ECF No. 12.) On July 21, 2016, the WhatsApp

Action was combined with the Samsung Action. (Order, *Samsung Action*, ECF No. 14.) Uniloc effectuated service on WhatsApp on July 21, 2016. (*WhatsApp Action*, ECF No. 17.)

3. On June 2, 2017, Joinder Petitioners filed two petitions for *inter partes* review that together challenged claims 1-6, 9, 14-15, 17-20, 23, 28-29, 31-34, 37, 40-43, 46, 51-54, 57, 62-65, and 68 of the '890 Patent. (IPR2017-01523, -01524.) Those petitions were denied institution on December 4, 2017. Those petitions relied on PCT Patent Application No. PCT/US00/21555 to Herbert Zydney et al. (filed August 7, 2000, published February 15, 2001 as WO 01/11824 A2) as prior art to the '890 Patent (along with several other prior references). Joinder Petitioners' petition in IPR2017-01524 also relied on U.S. Patent No. 7,123,695 ("Malik") as prior art to the '890 Patent. (*See id.*) Samsung also relies on Zydney and Malik as prior art to the '890 Patent in IPR2017-01802, but combines these references with U.S. Patent No. 8,150,922 ("Griffin"), prior art which was not asserted in either of Joinder Petitioners' petitions.

4. On June 16, 2017, Joinder Petitioners filed a petition and motion for joinder in IPR2017-01636. In IPR2017-01636, Joinder Petitioners requested joinder with IPR2017-00221, originally filed by Apple Inc., with respect to claims 1-6, 14-15, 17-20, 28-29, 31-34, 40-43, 51-54, 62-65, and 68 of the '890 Patent. Joinder Petitioners' motion for joinder was granted and the petition was instituted on

October 3, 2017. An oral hearing was held in IPR2017-00221 on February 8, 2018. Claims 9, 23, and 57, which Joinder Petitioners seek to join in this Motion, were not addressed in either IPR2017-01636 or IPR2017-00221.

5. On July 5, 2016, Uniloc filed a civil action for patent infringement against Facebook, Inc. (“Facebook”) in the Eastern District of Texas, asserting that Facebook has infringed the ’890 Patent and four other related patents. (Complaint, *Uniloc USA, Inc. v. Facebook, Inc.* (“Facebook Action”), Case No. 2:16-CV-728-JRG, ECF No. 1.) On October 3, 2016, the Facebook Action was combined with the Samsung Action. (Order, *Samsung Action*, ECF No. 98.) Uniloc effectuated service on Facebook on July 11, 2016. (*Facebook Action*, ECF No. 14.)

6. On July 20, 2017, Samsung filed a petition for *inter partes* review (IPR2017-01802) requesting cancellation of claims 1-6, 9, 14, 15 17-20, 23, 40-43, 51-54, and 57 of the ’890 Patent.

7. On February 6, 2018, the Board in IPR2017-01802 instituted Samsung’s petition for *inter partes* review as to claims 1-6, 9, 14, 15 17-20, 23, 40-43, 51-54, and 57 of the ’890 Patent.

### **III. STATEMENT OF REASONS FOR RELIEF REQUESTED**

#### **A. Legal Standard**

The Board has statutory authority under 35 U.S.C. § 315(c) to join a properly-filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See*

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