

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner

Patent No. 8,199,747

TITLE: SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING

**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 IPR2017-01799**

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. 8,199,747 (“’747 Patent”) (“the Joinder Petition”) filed contemporaneously herewith.

The Board instituted *inter partes* review of claims 2 and 12 of the ’747 Patent in *Samsung Electronics America, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-01799 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 2 and 12 of the ’747 Patent and request joinder with IPR2017-01799.

The Joinder Petition is narrowly tailored to the same claims, prior art, and grounds for unpatentability currently at issue in IPR2017-01799. 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” or “Original Petitioner”) in IPR2017-01799.

Joinder is appropriate because it will not burden or prejudice the present parties to IPR2017-01799, will not cause any undue delay, and will efficiently resolve the question of the ’747 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 four patents related to the ’747 patent. (Complaint, *Uniloc USA, Inc. v. Samsung Elecs. Am. Inc.* (“Samsung Action”), Case No. 2:16-CV-642-JRG, ECF No. 1.) On August 3, 2016, Uniloc USA, Inc. and Uniloc Luxembourg, S.A. (“Uniloc”) filed a Second Amended Complaint in the Samsung Action, asserting that Samsung has infringed the ’747 patent in addition to the four originally asserted related patents. (Second Amended Complaint, *Samsung Action*, ECF No. 30.)

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 ’747 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 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 ’747 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.)

4. On April 7, 2017, Joinder Petitioners filed a petition for *inter partes* review that challenged claims 1-3, 12, and 13 of the ’747 Patent. (IPR2017-01257.) Institution of a trial in IPR2017-01257 was denied on December 4, 2017. That petition 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) (“Zydney”) and U.S. Patent No. 6,750,881 to Barry Appelman (“Appelman”) as prior art to the ’747 Patent. (*See id.*) Samsung also relies on Zydney as prior art to the ’747 Patent in IPR2017-01799, but combines it with U.S. Patent No. 8,150,922 (“Griffin”) instead of with Appelman.

5. On July 20, 2017, Samsung filed a petition for *inter partes* review (IPR2017-01799) requesting cancellation of claims 1, 2, 3, 12, and 13 of the ’747 Patent.

6. On February 6, 2018, the Board in IPR2017-01799 instituted Samsung’s petition for *inter partes* review as to claims 2 and 12 of the ’747 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* 35 U.S.C. § 315(c). 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. *Samsung Electronics, Co., Ltd., et al. v. Raytheon Company*, Case IPR2016-00962, slip op. at 5 (PTAB Aug. 24, 2016) (Paper 20) (citing *Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15)). In exercising its discretion to grant joinder, the Board is “mindful of the public interest in securing the just, speeding, and inexpensive resolution of every proceeding.” *Anneal Pharmaceuticals, LLC v. Endo Pharmaceuticals Inc.*, Case IPR2016-01365, slip op. at 7 (PTAB February 4, 2015) (Paper 13) (citing 37 C.F.R. § 42.1(b)) (internal quotations omitted).

B. Petitioners’ Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the February 6, 2018, institution decision of the Samsung IPR. *See* 37 C.F.R. § 42.122(b). The one-year bar set forth in 37 C.F.R. § 42.101(b) does not apply to

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