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Paper No. 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2018-01383
Patent US 8,872,646

Before JENNIFER S. BISK, CHARLES J. BOUDREAU, and GARTH D. BAER, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review and Granting Motion for Joinder
35 U.S.C § 314; 35 U.S.C § 315(c); 37 C.F.R. § 42.122(b)

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I. INTRODUCTION

Samsung Electronics America, Inc. ("Samsung") filed a Petition requesting an *inter partes* review of claims 1, 3, 5–11, 13–18, and 20 of U.S. Patent No. 8,872,646 B2 ("the '646 patent"). Paper 1 ("Pet."). Patent Owner Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response to the Petition (Paper 7, "Prelim. Resp.").

Along with its Petition, Samsung filed a Motion for Joinder to join as a petitioner in IPR2018-00289. Paper 3 ("Mot."). Samsung filed the Petition and Motion for Joinder on July 11, 2018, respectively, both within one month after we instituted trial in IPR2018-00289. In its Preliminary Response to the Petition, Patent Owner opposes Samsung's Motion for Joinder. Prelim. Resp. 20.

As explained further below, we determine institution is warranted on the same grounds as instituted in IPR2018-00289 and grant Samsung's Motion for Joinder.

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II. DISCUSSION

In IPR2018-00289, Apple, Inc. ("Apple") challenged claims 1, 3, 5–11, 13–18, and 20 of the '646 patent on the following grounds:

References	Basis	Challenged Claims
Pasolini[1], Goldman[2], McMahan[3], and Mizell[4]	§ 103(a)	1, 3, 5–7, 9–11, 13–15, 17, and 20
Pasolini, Goldman, McMahan, Mizell, and Park[5]	§ 103(a)	8, 16, and 18

IPR2018-00289, Paper 7, 6. After considering the Petition and Patent Owner's Preliminary Response, we instituted an *inter partes* review of claims 1, 3, 5–11, 13–18, and 20 on Petitioner's asserted grounds. *See id.* at 25.

As Petitioner's Motion for Joinder explains, "the Samsung Petition introduces identical arguments and the same grounds raised in the existing Apple proceeding (i.e., challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Apple Petition)." Mot. 4. Petitioner further notes, "[o]ther than minor differences, such as differences related to formalities of a different party filing the petition, there are no

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[1] U.S. Patent No. 7,409,291 B2 (Aug. 5, 2008) (Ex. 1003, "Pasolini").
[2] Ron Goldman, *Using the LIS3L02AQ Accelerometer*, Sun Microsystems Inc. (Feb. 23, 2007) (Ex. 1004, "Goldman").
[3] U.S. Patent No. 7,204,123 B2 (Apr. 17, 2007) (Ex. 1005, "McMahan").
[4] David Mizell, Using Gravity to Estimate Accelerometer Orientation, Proceedings of the Seventh IEEE International Symposium on Wearable Computers (2003) (Ex. 1007, "Mizell").
[5] U.S. Patent No. 7,028,220 B2 (Apr. 11, 2006) (Ex. 1014, "Park").

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changes to the facts, citations, evidence, or arguments introduced in the Apple Petition." *Id*.

In its Preliminary Response to the Petition, Patent Owner raises the same substantive reasons why the Petition fails to prove obviousness as it does in its Patent Owner Response to Apple's petition in IPR2018-00289. *Compare* IPR2018-00289 Paper 11, 2–18, *with* Prelim. Resp. 2–19. We decline to resolve those issues at this point in the proceeding because the trial in IPR2018-00289 is a better forum in which to do so. Specifically, as compared to the pre-trial, preliminary phase of this case, the instituted trial in IPR2018-00289 affords the parties better opportunity to brief, argue, and develop evidence in support of their positions. Thus, for the same reasons stated in our Decision on Institution in IPR2018-00289, we determine institution is warranted here on the same grounds.

Having determined that institution is warranted, we now turn to Samsung's Motion for Joinder. Section 315(c) provides, in relevant part, that "[i]f 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." When determining whether to grant a motion for joinder we consider factors such as timing and impact of joinder on the trial schedule, cost, discovery, and potential simplification of briefing. *Kyocera Corp. v. SoftView, LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Under the circumstances of this case, we determine that joinder is appropriate. As Samsung explains, "[j]oinder will have minimal impact, if any, on the Apple IPR trial schedule because the Samsung Petition presents no new issues or grounds of unpatentability." Mot. at 5. Further, Samsung

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agrees to take an understudy role in the joined proceeding. *See id*. at 6–7 (specifying conditions of joined party's participation previously approved by the Board in similar circumstances). In sum, Samsung explains, "[u]nless and until the current petitioner ceases to participate in the instituted IPR proceeding, Samsung will not assume an active role." *Id*. at 7.

Patent Owner argues we should exercise our discretion to deny joinder. According to Patent Owner:

> Less than two months after filing its motion for joinder on July 11, 2018, Petitioner filed a petition challenging claim 22 of the same patent in IPR2018-01664. When Petitioner filed its joinder petition in this IPR, it knew or should have known of the grounds asserted in IPR2018-01664; and the follow-on petition in IPR2018-01664 does not allege otherwise. Not only did Petitioner delay its joinder petition here to the last possible date for strategic advantage, it appears Petitioner chose to separately challenge claim 22 and to delay filing that separate challenge (in the follow-on petition) only to increase the chances of joinder here and gain a strategic advantage. The Board should discourage such tactics by exercising its discretion to deny joinder.

Prelim. Resp. 20.

We disagree with Patent Owner. We take no issue with Samsung taking the full month permitted under 37 C.F.R. § 42.122(b) to file its joinder petition. In addition, we perceive no unfair tactical advantage with Samsung structuring its petitions to increase its chances of joinder. Under these circumstances, we agree with Samsung that joinder is appropriate and will not unduly impact the ongoing trial in IPR2018-00289. We limit Petitioner Samsung's participation in the joined proceeding, such that (1) Apple alone is responsible for all petitioner filings in the joined proceeding until such time that it is no longer an entity in the joined proceeding, and (2) Samsung is bound by all filings by Apple in the joined

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