

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.
Petitioner

v.

UNILOC LUXEMBOURG, S.A.,
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 6,216,158
Case IPR No.: *IPR2018-01503*

MOTION FOR JOINDER TO *INTER PARTES* REVIEW
(35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b))

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner LG Electronics, Inc. (“LGE”) moves for joinder with the *Inter Partes* Review of U.S. Patent No. 6,216,158, *Apple Inc. v. Uniloc USA, Inc.*, IPR2018-00361 (“the Apple IPR”), for which trial was recently instituted on July 16, 2018. IPR2018-00361, paper 8. This motion is timely because it is filed within one month of institution of the Apple IPR. 37 C.F.R. § 42.122(b). Petitioner understands that the petitioner in the Apple IPR (“the Apple Petitioner”) does not oppose Petitioner’s request for joinder.

Petitioner requests institution of its concurrently filed Petition for *Inter Partes* Review. The Petition is a carbon copy of the original Apple IPR petition in all material respects. The only substantive changes are in the introduction to identify the correct Petitioner and the mandatory notices under 37 C.F.R. § 42.8(b). The concurrently filed Petition and the Apple IPR petition challenge the same claims of the ’158 patent on the same grounds relying on the same prior art and evidence, including declarations identical in substance from the same experts.¹

¹ The declarations have been updated to only reflect retention by Petitioner and is otherwise identical to the declarations submitted in the Apple IPR.

Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Apple IPR as instituted. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioner's joinder to the Apple IPR.

Further, if joined, Petitioner agrees to adhere to all applicable deadlines in the Apple IPR and coordinate all filings with Apple Petitioner in the Apple IPR. The Apple Petitioner will maintain the lead role in the proceedings so long as it is a party to the proceedings and is not estopped under § 315(e)(1). Petitioner will only assume the lead role in the proceedings if the Apple Petitioner is no longer a party to the proceedings or unable to advance arguments for one or more claims, or grounds, for example, because of § 315(e)(1). Petitioner agrees to consolidated filings for all substantive papers in the proceeding. The Apple Petitioner and Petitioner will be jointly responsible for the consolidated filings. Absent a Board order precluding the Apple Petitioner from making arguments that would otherwise be available to Petitioner, Petitioner will not advance any arguments separate from those advanced by the Apple Petitioner in the consolidated filings. These limitations will avoid lengthy and duplicative briefing. Also, Petitioner will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with the Apple Petitioner. Petitioner agrees

to the foregoing conditions even in the event that other IPRs filed by other, third-party petitioners are joined with the Apple IPR.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Apple IPR for all interested parties. Further, the Patent Owner has asserted the '158 patent in district court against LG Electronics, Inc., LG Electronics U.S.A., Inc., and LG Electronics Mobilecomm U.S.A., Inc.. Joinder will estop LGE from asserting in district court those issues resolved in a final decision from the Apple IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Apple IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums. On the other hand, if instituted, maintaining the Petitioner's IPR proceeding separate from that of the Apple IPR would entail needless duplication of effort.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice LGE. Its interests may not be adequately protected in the Apple IPR proceedings, particularly if the Apple

Petitioner settles with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against it.

II. BACKGROUND AND RELATED PROCEEDINGS

Uniloc Luxembourg S.A. (the “Patent Owner”) is the owner of the ’158 Patent. The Patent Owner asserted the ’158 Patent against LGE in *Uniloc USA, Inc. et al. v. LG Electronics U.S.A., Inc. et al.*, Case No. 4:17-cv-00827 (N.D. Tex. Filed Oct. 13, 2017) (transferred and is now *Uniloc USA, Inc. et al. v. LG Electronics U.S.A., Inc. et al.*, Case No. 3:18-cv-02915 (N.D. Cal. Filed May 17, 2018)). In addition, the Patent Owner asserted the ’158 Patent against Exclusive Group LLC; Apple Inc.; and Amazon.com, Inc. See *Uniloc USA, Inc. et al. v. Exclusive Group LLC*, 1:17-cv-03962 (S.D. Ind. filed Oct. 27, 2017); *Uniloc USA, Inc. et al. v. Apple Inc.*, 3:18-cv-00365 (N.D. Cal. filed Jan. 17, 2018), see also 2:17-cv-00470 (E.D. Tex., terminated) and 2:17-cv-00571 (E.D. Tex., terminated); and *Uniloc USA, Inc. et al. v. Amazon.com, Inc.*, 2:18-cv-00123 (E.D. Tex. filed Mar. 31, 2018). On December 20, 2017, Apple filed their IPR petition, IPR2018-00361, against the ’158 patent. The Board instituted the Apple IPR on July 16, 2018. Petitioner here timely moves for joinder with the Apple IPR.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.