

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.
Petitioners

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 7,653,508
Case IPR No.: *To Be Assigned*

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), Petitioners HTC Corporation and HTC America, Inc. (together “HTC” or “Petitioners”) move for joinder with the *Inter Partes* Review of U.S. Patent No. 7,653,508 (“the ’508 patent”), *Apple Inc. v. Uniloc USA, Inc.*, IPR2018-00387 (“the Apple IPR”), for which trial was recently instituted on July 23, 2018. *See* IPR2018-00387, Paper 8. This motion is timely because it is filed within one month of institution of the Apple IPR. *See* 37 C.F.R. § 42.122(b). Petitioners understand that the petitioner in the Apple IPR (“the Apple Petitioner”) does not oppose Petitioners’ requests for joinder.

Petitioners request institution of the concurrently-filed Petition for *Inter Partes* Review. The Petition substantially copies the original Apple IPR petition. Substantive changes have only been made (1) to identify the correct Petitioners and the mandatory notices under 37 C.F.R. § 42.8(b) and (2) to add dependent claim 20 as a challenged claim. The concurrently-filed Petition challenges all of the claims in the Apple IPR petition and, because dependent claim 20 involves substantially similar limitations as dependent claims 3 and 13, the concurrently-filed Petition

presents the same grounds and relies on the same prior art and evidence, including a declaration nearly identical in substance from the same expert.¹

In addition to the arguments advanced for claim 20, Petitioners agree to proceed 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 Petitioners' joinder to the Apple IPR.

Further, if joined, Petitioners agree to adhere to all applicable deadlines in the Apple IPR and coordinate all filings with the 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). Petitioners 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). Petitioners agree to consolidated filings for all substantive papers in the proceeding. The Apple Petitioner and Petitioners will be jointly responsible for the consolidated filings. Absent a Board

¹ The declaration has been updated only to reflect retention by Petitioners and to incorporate the expert's analysis of claim 20 and is otherwise identical to the declaration submitted in the Apple IPR.

order precluding the Apple Petitioner from making arguments that would otherwise be available to Petitioners, Petitioners 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, Petitioners will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with the Apple Petitioner. Petitioners agree 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 this Petition for all interested parties. Further, the Patent Owner has asserted the '508 patent in district court against HTC America, Inc. Joinder will estop HTC 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 Petitioners' 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 prior art or combinations thereof, 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 HTC. Its interests may not be adequately protected in the Apple IPR proceedings, particularly if the Apple Petitioner settles with the Patent Owner. Petitioners should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

Uniloc Luxembourg S.A. (the “Patent Owner”) is the owner of the ’508 patent. The Patent Owner asserted the ’508 patent against HTC in *Uniloc USA, Inc. v. HTC America, Inc.*, Case No. 2:17-cv-01629 (W.D. Wash. filed on Nov. 1, 2017) (consolidated with *Uniloc USA, Inc. v. HTC America, Inc.*, Case No. 2:17-cv-01558 (W.D. Wash.) (Lead case) on May 3, 2018). In addition, the Patent Owner asserted the ’508 patent against Huawei Device USA, Inc.; LG Electronics U.S.A., Inc., Samsung Electronics America, Inc.; and Apple Inc. (“Apple”). See *Uniloc USA, Inc. v. Huawei Device USA, Inc.*, 2:17-cv-00737 (E.D. Tex. filed on Nov. 9, 2017); *Uniloc USA, Inc. v. LG Elecs. U.S.A., Inc.*, Case No. 4:17-cv-00832-O (N.D. Tex. filed on Oct. 13, 2017) (transferred and is now *Uniloc USA, Inc. v. LG Elecs. U.S.A., Inc.*, Case No. 4:18-cv-02918-PJH (N.D. Cal. filed on May 17, 2018)); *Uniloc USA, Inc. v. Samsung Elecs. America, Inc.*, 2:17-cv-00650 (E.D. Tex. filed on Sept. 15,

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