IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Haller, et al.	
U.S. Patent No.:	7,039,033	Attorney Docket No.: 39521-0020IP3
Issue Date:	May 2, 2006	
Appl. Serial No.:	09/850,399	
Filing Date:	May 7, 2001	
Title:	System, device and computer readable medium for providing a managed wireless network using short-range radio signals	

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PETITIONER'S MOTION FOR JOINDER AND/OR CONSOLIDATION

STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(d) and 37 C.F.R. §§ 41.122(a), Petitioner Apple Inc. ("Apple") files this motion asking the Board to consolidate the present IPR with Case No. IPR2015-01444, which addresses the patentability of claims of U.S. Patent 7,039,033 ("the '033 patent") over prior art references also relied on in this petition.

INTRODUCTION

Apple originally filed a petition seeking *inter partes* review of claims 1, 4-7, 12, 14, 15, 22, 23, 25, 28, 34, 39, 40, 42, and 46 of the '033 patent on June 19, 2015. Apple's first petition was filed well before the statutory bar deadline: IXI initiated suit against Apple in October of 2014, and Apple's petition was filed eight months later. *See id.* at 3; *see also IXI Mobile (R&D) and IXI IP, LLC v. Apple Inc.*, Case 4:15-cv-03755, D.I. 1 (N.D. Cal. October 2, 2014). Notably, Apple's petition sought review of every claim that IXI had asserted against it in litigation. The Board instituted as to every claim challenged (IPR2015-01444, Paper 8), and after briefing and a hearing, cancelled every challenged claim as being unpatentable over PCT Publication No. WO 01/76154 A2 to Marchand ("Marchand") in combination with various other references (*id.*, Paper 27). IXI appealed the Board's decision, contending it was not supported by substantial evidence. *See IXI IP, LLC v. Samsung Elecs. Co. et al.*, Case No. 17-1665, D.I. 16 (Fed. Cir. June 2, 2017). The Federal

Circuit affirmed on September 10, 2018, and issued its mandate giving jurisdiction back to the Board on October 17, 2018.

On March 24, 2017—after the § 315(b) bar date and after this Board found all challenged claims unpatentable in the previous IPR—Patent Owner IXI IP, LLC ("IXI") requested reexamination of the '033 patent to amend the claims in light of substantial new questions of patentability raised by the prior art cited by Apple in the IPR. A reexamination certificate issued on February 1, 2018, which cancelled a number of claims not asserted in the litigation or challenged in the prior IPR, but amended independent claim 56 and added claims 57–124. As explained in Apple's petition, these amendments simply took subject matter already found to be unpatentable in the IPR proceeding and added well-known functionality of mobile devices.

Thus, Apple filed the instant petition to challenge the patentability of the new claims added during IXI's reexamination. Apple respectfully requests joinder of this IPR with its previously-filed IPR (Case No. IPR2015-01444). As will be explained below, joinder is appropriate to secure a just, speedy, and inexpensive resolution of the dispute as to the patentability of the new claims, and is warranted because of the substantial overlap in the issues and art involved in both proceedings. *See Gea Process Engr., Inc. Petr.*, IPR2014-00051, 2014 WL 1253170, at *6 (Patent Tr. & App. Bd. Mar. 10, 2014) (allowing consideration of claims amended in *ex parte*

reexamination because "our consideration of the amended claims in the reexamination certificate at this time advances our obligation to secure the 'just, speedy, and inexpensive resolution' of every proceeding"); *Microsoft Corp. v. Proxyconn, Inc.,* IPR2013-00109, Paper 15 (PTAB Feb. 25, 2013) (allowing joinder because of commonality of issues between two IPRs). Moreover, the minimal amount of work required on the part of the Patent Owner to address the new claims (work which, for the most part, should have already been done during the reexamination and prior IPR) is far outweighed by the public interest in having consistency of outcome concerning similar sets of claimed subject matter and prior art. *See Amneal Pharm. LLC. v. Endo Pharm. Inc.*, IPR2014-01365, Paper 13 (PTAB Feb. 4, 2015); *Samsung Elecs. Co., Ltd. v. Virginia Innovation Scis., Inc.*, IPR2014-00557, Paper 10 at 18 (PTAB June 13, 2014).

LEGAL PRINCIPLES

Section 315(d) of the Patent Act gives the PTO broad discretion to organize proceedings before it in any manner it sees fit. Specifically, where there are multiple proceedings involving the same patent before the Office, this section allows the director (or his assigns, such as the Board) to determine "the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding." 35 U.S.C. § 315(d); *see also* 157 Cong. Rec. S 9988 (daily ed. Sept. 27, 2008)

(statement of Sen. Kyl) (explaining that the analogous "Section 325(c) gives the PTO broad discretion to consolidate, stay, or terminate any PTO proceeding involving a patent if that patent is the subject of a postgrant review proceeding."). Notably, unlike the provision governing joinder of parties (§ 315(c)), this section does not provide for any time limit on when a party may request consolidation or for when the Board may consolidate proceedings.

The PTO has recognized this broad authority in its regulations. In implementing § 315(d), the Board promulgated a regulation providing that "the Board may during the pendency of the inter partes review enter any appropriate order regarding the additional matter including providing for the stay, transfer, consolidation, or termination of any such matter." 37 C.F.R. § 42.122(a). Notably, although the Board has set forth specific time periods for joinder of parties, again no time limit is set for a consolidation of different proceedings. In addition, the PTO has given the Board broad authority to "determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding." 37 C.F.R. § 42.5.

Although this request is made specifically pursuant to section 315(d) of the Patent Act and not section 315(c), the Board has made clear that the principles discussed in relation to section 315(c) are applicable to both requests for joinder of parties and joinder of issues. *See Medtronic,* IPR2014-00823, 2014 WL 6985725,

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