

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MARVELL SEMICONDUCTOR, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case No. IPR2019-01350

U.S. Patent No. 7,016,676

PETITIONER'S MOTION FOR CONSOLIDATION PURSUANT TO

35 U.S.C. § 315(d) AND 37 C.F.R. § 42.122(a)

Pursuant to 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a), Petitioner Marvell Semiconductor, Inc. (“Marvell”) respectfully requests consolidation of schedules of this IPR (“Marvell IPR”) with the *inter partes* reviews concerning the same patent in *Microsoft Corporation v. Uniloc 2017 LLC*, Case Nos. IPR2019-01116 and IPR2019-01125 (collectively, the “Microsoft IPRs”).

Marvell and Microsoft filed their petitions independently. Marvell never discussed its petitions with Microsoft, and Microsoft never discussed its petitions with Marvell. Microsoft prepared and filed its petitions without any involvement from Marvell, who had no control, provided no funding, and had no knowledge that Microsoft was preparing petitions. Marvell only learned of Microsoft’s petitions from their publication in PTAB dockets. Nonetheless, Microsoft’s petitions state their uncertainty as to what an RPI is under applicable law and name Marvell as an RPI “out of an abundance of caution”. To be clear, Marvell is not an RPI or privy of the Microsoft petitions.

However, Marvell anticipates that Patent Owner Uniloc may attempt to exploit Microsoft’s improper identification of Marvell and argue that somehow Marvell is an RPI or privy (it is not). To protect Marvell from prejudice in case PO engages in gamesmanship—for example by arguing that Marvell would be estopped under 35 U.S.C. §315(e)(1) from maintaining its IPR should either of the Microsoft proceedings reach final written decision first—Marvell requests that its

IPR (IPR2019-01349) be consolidated and aligned in schedule with the Microsoft IPRs so that any Final Written Decisions issue in all 3 proceedings concurrently. *See Liberty Mut. Ins. Co. v Progressive Cas. Ins. Co.*, No. CBM2012-00004, Paper 64 at 5-9 (PTAB Apr. 1, 2014) (“The estoppel provision under 35 U.S.C. § 325(e)(1) could not have terminated the instant proceeding prior to issuance of the final written decision, because the final written decision was issued concurrently with the final written decision in CBM2012-00002.”).

Marvell emphasizes that it is only requesting consolidation for the purposes of synchronizing the schedules of the Marvell IPR with the Microsoft IPRs. Marvell is not requesting joint briefing or depositions in conjunction with the Microsoft IPRs. While this motion specifically addresses consolidation for IPR2019-01349, Marvell would also be amenable to consolidation of its co-pending IPR2019-01350, which addresses different claims of the same challenged patent.

Consolidation is available here as all IPRs at issue were filed within one year of service of any relevant complaint. Given the improvements to case-management efficiency if consolidation is granted, and the risk of prejudice to Marvell if consolidation is denied, Petitioner Marvell respectfully requests that the Board consolidate and synchronize the schedules of one or both of the Marvell IPRs with the Microsoft IPRs.

Respectfully submitted,

SHEPPARD, MULLIN,
RICHTER & HAMPTON LLP

/Harper Batts/
Harper Batts (Reg. No. 56,160)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on July 26, 2019, a true and correct copy of the foregoing PETITIONER'S MOTION FOR CONSOLIDATION PURSUANT TO 35 U.S.C. § 315 (d) and 37 C.F.R. § 42.122(a) was served in its entirety on the Patent Owner at the following address of record as listed on PAIR via FedEx Express® or Express Mail:

Russell Gross, Esq.
Philips Intellectual Property & Standards
465 Columbus Avenue, Suite 340
Valhalla, NY 10595

The undersigned certifies that a true and correct copy of the PETITIONER'S MOTION FOR CONSOLIDATION PURSUANT TO 35 U.S.C. § 315 (d) and 37 C.F.R. § 42.122(a) was also sent via electronic mail to the attorneys of record for Plaintiff in the concurrent litigation matters:

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