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Paper No. 8
Filed: March 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-01530
Patent 6,993,049

Before SALLY C. MEDLEY, JEFFREY S. SMITH, and GARTH D. BAER, *Administrative Patent Judges.*

BAER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

LG Electronics, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") to institute an *inter partes* review of claims 11 and 12 of U.S. Patent No. 6,993,049 B2 (Ex. 1001, "the '049 Patent"). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as a party to *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00251 (PTAB) ("Apple IPR"). Paper 3 ("Mot."). Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response, but did not file a motion opposing joinder. Paper 7. We have authority under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons described below, we institute *inter partes* review of all the challenged claims, and grant Petitioner's Motion for Joinder.

B. Related Proceedings

The parties inform us that the '049 patent is involved in a number of related matters. *See* Pet. 57–58; Paper 4, 2.

C. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. 2.

Challenged Claims	35 U.S.C. §	Reference(s)
11, 12	§ 103	Larsson[1]

[1] US 6,704,293 B1 (issued Mar. 9, 2004) (Ex. 1005, "Larsson").

Challenged Claims	35 U.S.C. §	Reference(s)
11, 12	§ 103	Larsson, BT Core[2]
11, 12	§ 103	IrOBEX[3]

II. DISCUSSION

A. Institution of Inter Partes Review

In its Motion for Joinder, Petitioner represents that this Petition "is a copy of the original Apple IPR petition in all material respects." Mot. 1. Petitioner, therefore, represents that "[t]he concurrently filed Petition and the Apple IPR petition challenge the same claims of the '049 patent on the same grounds relying on the same prior art and evidence, including an identical declaration from the same expert." *Id.* Our independent review of the Petition and the Apple IPR petition confirms Petitioner's representations.

The Apple IPR petition was filed on November 12, 2018, challenging claims 11 and 12 of the '049 patent on the same grounds raised in this Petition. *See* Apple IPR, Paper 2, 2. Patent Owner filed a preliminary response to the Apple IPR petition on May 8, 2019. Apple IPR, Paper 6. We instituted *inter partes* review based on the Apple IPR petition on July 22, 2019. Apple IPR, Paper 7. Patent Owner filed a Response to the Apple IPR petition on October 17, 2019. Apple IPR, Paper 11. On December 13, 2019, Patent Owner filed a Preliminary Response to the Petition in this case. Paper 7 ("Prelim. Resp.").

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[2] Bluetooth™ Core Specification Vol. 1, ver. 1.0 B (pub. Dec. 1, 1999) (Ex. 1014, "BT Core").

[3] Infrared Data Association, "IrDA Object Exchange Protocol IrOBEX," ver. 1.2, 1–85 (1999) (Ex. 1006, "IrOBEX").

We acknowledge Patent Owner's arguments supporting its position that Petitioner has not shown sufficiently that claims 11 and 12 would have been obvious. Prelim. Resp. 3–35. Based on our independent review, Patent Owner's Preliminary Response arguments are the same as or substantially similar to those in Patent Owner's Response to the Apple IPR petition. *Compare id.* at 3–35, *with* Apple IPR, Paper 11 at 1–27.

At this stage of the proceeding and based on our preliminary review, we find Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the challenged claims for the same reasons discussed in our Decision on Institution in the Apple IPR. Granting the Petition and joining Petitioner to the Apple IPR will provide us with the opportunity to more fully consider Patent Owner's arguments—first raised in response to the petition in the Apple IPR—in the context in which they were first raised. Those common arguments will be fully considered in the Apple IPR, with the benefit of a complete record. In sum, based on the current record, Patent Owner's arguments made in its Preliminary Response in this case do not persuade us that Petitioner has not demonstrated a reasonable likelihood of success in prevailing on the same ground as instituted in the Apple IPR.

Accordingly, for the reasons discussed above, we are persuaded Petitioner has demonstrated a reasonable likelihood of showing the unpatentability of the challenged claims of the '049 patent. We therefore grant the Petition, and institute *inter partes* review of the challenged claims.

B. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which reads:

> If 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 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

We instituted the Apple IPR on July 22, 2019. *See* Apple IPR, Paper 7. Petitioner filed this Petition and Motion for Joinder on August 22, 2019, i.e., within one month of the institution date of the Apple IPR. *See* Paper 2; Mot. Thus, Petitioner timely filed its Motion for Joinder. *See* 37 C.F.R. § 42.122(b).

As discussed above, Petitioner represents that its Petition "is a copy of the original Apple IPR petition in all material respects" and that "[t]he concurrently filed Petition and the Apple IPR petition challenge the same claims of the '049 patent on the same grounds relying on the same prior art and evidence, including an identical declaration from the same expert." Mot. 1. Petitioner further represents that, should it be joined to the Apple IPR, Petitioner "will act as an 'understudy' and will not assume an active role unless the Apple Petitioner ceases to participate in the instituted IPR." *Id.* at 2. Thus, Petitioner agrees to consolidate all filings with the Apple IPR petitioner, refrain from advancing any arguments not advanced by the Apple

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