

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
U.S. Patent No. 6,993,049

PETITIONER'S MOTION FOR JOINDER

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner, LG Electronics, Inc. (“LG” or “Petitioner”) moves for joinder with the *Inter Partes* Review of U.S. Patent No. 6,993,049 (“the ’049 patent”), *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00251 (“the Apple IPR”), for which trial was instituted on July 22, 2019. *See* IPR2019-00251, Paper 7. This motion is timely because it is being 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 the Petition for *Inter Partes* Review being filed concurrently herewith. The Petition is a copy of the original Apple IPR petition in all material respects. The 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.¹

Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Apple IPR as instituted.

¹ The expert declaration is an exact duplicate of the declaration filed in IPR2019-00251.

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, upon joining the Apple proceeding, Petitioner will act as an "understudy" and will not assume an active role unless the Apple Petitioner ceases to participate in the instituted IPR. The Apple Petitioner will maintain the lead role in the proceeding so long as it is a party to the proceeding. Petitioner will only assume the lead role in the proceeding if the Apple Petitioner is no longer a party to the proceeding or is unable to advance arguments for one or more claims, or grounds. 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. These limitations will avoid lengthy and duplicative briefing. Also, Petitioner will not seek additional depositions or deposition time. 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. Accordingly, the proposed joinder will neither unduly complicate the Apple IPR nor delay its schedule.

In fact, 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 '049 patent in district court against LG Electronics U.S.A., Inc., LG Electronics, Inc.,

and LG Electronics Mobilecomm U.S.A., Inc. Joinder will, thus, narrow 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.

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 LG. Its interests may not be adequately protected in the Apple IPR proceeding, particularly if the Apple Petitioner settles with the Patent Owner. Petitioner should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

Uniloc 2017 LLC (the “Patent Owner”) is the owner of the ’049 patent. The Patent Owner asserted the ’049 patent against LG in *Uniloc USA, Inc. et al v. LG Electronics USA, Inc. et al* 3-18-cv-00559 (N.D. Tex.) and *Uniloc USA Inc. et al v. LG Electronics USA Inc. et al* 5-18-cv-06738 (N.D. Cal.) and against Apple Inc., HTC, Motorola Mobility, ZTE, Inc., Blackberry Corporation, Microsoft, Huawei, Logitech, and Samsung in the following cases: *Uniloc USA, Inc. et al v. Apple, Inc.* 5-19-cv-01695 (N.D. Cal.); *Uniloc 2017 LLC v.*

HTC America, Inc. 2-18-cv-01727 (W.D. Wash.); *Uniloc 2017 LLC v. Motorola Mobility, LLC* 1-18-cv-01840 (D. Del.); *Uniloc 2017 LLC v. ZTE, Inc. et al* 3-18-cv-03063 (N.D. Tex.); *Uniloc 2017 LLC v. Blackberry Corporation* 3-18-cv-03068 (N.D. TEX.); *Apple Inc. et al v. Uniloc 2017 LLC* IPR2019-00251 (PTAB); *Uniloc USA Inc. et al v. ZTE (USA) Inc. et al* 3-18-cv-02839 (N.D. TEX.); *Uniloc 2017 LLC et al v. Microsoft Corporation* 8-18-cv-01279 (C.D. Cal.); *Uniloc USA, Inc. et al v. ZTE (USA), Inc. et al* 2-18-cv-00307 (E.D. TEX.); *Uniloc USA Inc. et al v. Blackberry Corporation* 3-18-cv-01885 (N.D. TEX.); *Uniloc USA, Inc. et al v. Huawei Device USA, Inc. et al* 2-18-cv-00074 (E.D. TEX.); *Uniloc USA, Inc. et al v. Logitech Inc. et al* 5-18-cv-01304 (N.D. Cal.); *Uniloc USA, Inc. et al v. Samsung Electronics America, Inc. et al* 2-18-cv-00040 (E.D. TEX.); and *Uniloc USA, Inc. et al v. Apple Inc.* 1-18-cv-00164 (W.D. Tex.). In addition, U.S. Patent No. 6,993,049 is the subject of an *inter partes* review in *Microsoft Corporation v. Uniloc 2017 LLC*, IPR2019-01026, filed June 6, 2019.

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v.*

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