UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

IPR2020-00224
U.S. PATENT NO. 7,075,917

PATENT OWNER OPPOSITION TO MOTION FOR JOINDER

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I. INTRODUCTION

This not Apple's first IPR petition challenging the validity of the exact same subset of claims of U.S. Patent No. 7,075,917 ("the '917 patent"). In its prior IPR filing, the Board denied Apple's petition as failing to meet the even the minimal threshold burden for institution for any of the challenged claim (i.e., claims 1–3 and 9–10). *See Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00259, Paper 7 (PTAB Jun. 27, 2019) ("Apple '259 IPR").

On April 19, 2019, Microsoft filed an IPR petition challenging claims 1–3 and 9 and 10 of the '917 Patent. *See Microsoft Corporation v. Uniloc 2017 LLC*, IPR2019-00973 (the "Microsoft IPR"), Paper 2 at 1. Apple seeks to challenge the same subset of claims it failed to challenge in its original IPR (i.e., Apple '259 IPR). *See* Petition (Paper 1) at 1. ("Apple Inc. ('Petitioner') respectfully requests inter partes review ('IPR') of claims 1-3 and 9-10 of U.S. Patent No. 7,075,917 . . . , allegedly assigned to Uniloc 2017 LLC."). While Apple acknowledged conferring with Microsoft regarding its petition and motion *before* filing, Microsoft is not named as a real party in interest. *See* Paper 3 ("Mtn.") at 7 ("Petitioner Apple has conferred with counsel for Petitioner Microsoft[.]").

Relying on at least one reference shared in common with its original petition, Apple now serially files its present follow-on petition after having benefitted from the opportunity to review the arguments and evidence Uniloc had previously presented in its preliminary responses filed in both the Apple '259 IPR and in the Microsoft IPR. The joinder motion should be denied for several reasons.

II. ARGUMENT

As the moving party, Apple has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). When determining whether to grant a motion for joinder, the Board considers factors including: (1) time and cost considerations, including the impact joinder would have on the trial schedule; and (2) how briefing and discovery may be simplified. *See* Order Authorizing Motion for Joinder (Paper 15, 4), *Kyocera Corp. v. SoftView, LLC*, IPR2013-00004 (PTAB Apr. 24, 2013).

Even when a party seeks to join a nearly identical petition, joinder should not be granted as a matter of right. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b); 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Director is given discretion . . . over whether to allow joinder. This safety valve will allow the Office to avoid being overwhelmed if there happens to be a deluge of joinder petitions in a particular case.").

Here, Apple's motion should be denied at least because Apple's definition for "understudy" expressly attempts to reserve the right to actively participate in the Microsoft IPR trial that Apple now seeks to join.

A. Apple's definition for "understudy" risks *causing* undue prejudice to Patent Owner.

Apple's motion should be denied at least because Apple purports to reserve rights by its definition for "understudy" which risk causing undue prejudice to Patent Owner. In another IPR matter involving the same Patent Owner, the Board very recently considered the same definition for "understudy" and found it permissive of

active participation that does not comport with a true "understudy" role. *Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00376, Paper 8 (PTAB January 21, 2020) ("Conduct Order"); *see also Microsoft Corp. v. Uniloc 2017 LLC*, IPR2019-01116, Paper 10 at 3-5 (PTAB January 16, 2020) (referencing the Conduct Order).

There, the Board first addressed language analogous to what is presented in Apple's instant motion as follows: "all filings by [the joinder petitioner] in the joined proceeding be consolidated with [the filings of the original petitioner in the Microsoft IPR], unless a filing solely concerns issues that do not involve [the original petitioner in the Microsoft IPR]." Mtn. 7. The Board observed that such language, on its face, purports to reserve the right to participate in filings. Conduct Order 2–3.

The Board questioned whether such participation might impermissibly include allowing a joinder petitioner to "prepare its own substantive filings and have that material included within a 'joint paper' that also includes separately the substantive arguments and assertions of Petitioner." *Id*. This clearly would "substantially increase[s] the complexity of the proceeding." *Id*.

The Board further questioned whether an "understudy" defined in the same manner at issue here would be allowed to actively participate in drafting filings, "with all positions therein binding on both [original petitioner] and [joinder petitioner], and agreed to by both [original petitioner and joinder petitioner] prior to filing." *Id*. Such active participation exceeds a true "understudy" role. *Id*.

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