

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner

v.

UNILOC 2017 LLC,  
Patent Owner

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Case No. IPR2020-00224  
U.S. Patent No. 7,075,917

**REPLY TO PATENT OWNER'S OPPOSITION TO MOTION FOR  
JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22, 42.122(b)  
TO RELATED *INTER PARTES* REVIEW IPR2019-00973**

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## I. APPLE SEEKS A “COMPLETELY INACTIVE” UNDERSTUDY ROLE

Uniloc’s primary argument opposing joinder is that the definition for “understudy” used in the Motion for Joinder (Paper 3) “risk[s] causing undue prejudice to Patent Owner.” (Paper 7 at 4). Uniloc cites a recent Order from the Board in IPR2020-00376, Paper 8. In the cited Order, the Board stated it was “uncertain what is meant by ‘[a]ll filings by [the joinder petitioner] in the joined proceeding shall be consolidated with the filings of [the original petitioner.]’” *Ericsson Inc. v. Uniloc 2017 LLC*, IPR2020-00376, Paper 8 at 2. The Board provided further guidance on its understanding of an understudy role, stating:

In our view, an “understudy role,” if taken by [joinder petitioner], means [joinder petitioner] will not be making any substantive filings and will be bound by whatever substantive filings [original petitioner] makes, so long as [original petitioner] remains a party in the proceeding. The same is true for oral hearing presentations. Also, [joinder petitioner] will not seek to take cross examination testimony of any witness or have a role in defending the cross-examination of a witness, so long as [original petitioner] remains a party in the proceeding. Likewise with other discovery matters. If and when [original petitioner’s] participation in the proceeding terminates, [joinder petitioner] can make its own filings as Petitioner. In short, in its “understudy role,” [joinder petitioner] will remain completely inactive, but for issues that are solely directed and pertinent to [joinder petitioner].

*Ericsson*, IPR2020-00376, Paper 8 at 3.

Apple submits that it will abide by the “completely inactive” role described by the Board and quoted above in the *Ericsson* IPR. Apple will, so long as Microsoft remains a party in IPR2019-00973, agree to the following:

- (i) Apple will not make any substantive filings and will be bound by whatever substantive filings Microsoft makes;
- (ii) Apple will not present any argument at the oral hearing or make any presentation at the oral hearing;
- (iii) Apple will not seek to take cross examination testimony of any witness or have a role in defending the cross-examination of a witness;
- (iv) Apple will not seek any discovery from Uniloc;
- (v) Apple will not seek to file its own appellate brief (addressing Uniloc’s argument at Paper 7 at 7); and
- (vi) Apple will otherwise remain completely inactive.

The above concessions by Apple should address Uniloc’s concerns regarding any Apple participation. However, to the extent Uniloc still remains unclear about Apple’s participation, Apple submits that it will take no substantive action in IPR2019-00973 so long as Microsoft remains a party to the IPR.

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