UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

IPR2020-00854
Patent No. 6,467,088

REPLY TO OPPOSITION TO MOTION FOR JOINDER

I. INTRODUCTION

The Board should institute Apple's IPR and grant the motion for joinder, because Apple's petition is substantively identical to Microsoft's already instituted IPR and Apple has agreed to take an understudy role. Paper 3.

II. PARALLEL TRIAL PROCEEDING

Uniloc's arguments that it would be an inefficient use of resources to institute IPR and grant joinder should be rejected.

Microsoft's IPR has been instituted and Apple agrees to take an understudy role, so no additional burden will be placed on the Board or Uniloc if Apple's petition is instituted and the joinder motion is granted. Should Microsoft settle, Apple's involvement would be similar to Microsoft's involvement, adding little to no burden on the Board or Uniloc. Under similar facts, the Board found the potential for settlement not to result in undue prejudice to a patent owner. *Sawai USA, Inc. et al. v. Biogen MA Inc.*, IPR2019-00789, Paper 17 at 11-12 (PTAB Sept. 12, 2019).

Uniloc's reliance on *NHK Spring* and *Fintiv* (Paper 7 at 2-6) is misplaced. These cases each involved a circumstance where a parallel district court proceeding was scheduled to go to trial before a final written decision would issue in an IPR. But neither of these cases involved a copycat petition of an already instituted IPR and a motion for joinder, where the petitioner would serve in a understudy role. *NHK Spring v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018)

(precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (precedential). Microsoft's IPR has already been instituted, negating the efficiency and fairness concerns of *NHK Spring* and *Fintiv*.

The situation here is similar to that in *Sawai USA*. *Sawai USA, Inc. et al. v. Biogen MA Inc.*, IPR2019-00789, Paper 17 (PTAB Sept. 12, 2019). There, the petitioner filed a copycat of an already instituted IPR petition along with a motion for joinder, and agreed to take an understudy role. *Id.* at 2, 5-7. The Board considered *NHK Spring* and the related district court proceeding, which was scheduled to go to trial before final written decision, and instituted the IPR and granted the joinder motion. *Id.* at 9-12. The Board concluded there would be limited prejudice to the patent owner and little to no waste of Board resources in allowing joinder of the ongoing IPR. *Id.* at 9-12. Such is the case here where Apple would serve as an understudy. Nevertheless, should the Board analyze the *Fintiv* factors, the factors heavily weigh in favor of instituting the IPR, as discussed below.

A. Whether a stay exists or is likely to be granted if IPR is instituted

This factor is irrelevant or neutral. Microsoft's IPR is already instituted.

B. Proximity of court trial date to Board's statutory deadline

This factor is irrelevant, or at best neutral. Trial is set to begin March 22, 2021. Ex. 1017 at 3. The statutory deadline for final written decision falls on April 14, 2021. Thus, whether the district court trial will complete before Microsoft's IPR

is uncertain. Even if trial concludes first, the institution and joinder of Apple's petition to Microsoft's IPR this will not burden the Board or prejudice Uniloc, as Microsoft's IPR is already instituted. *See Sawai USA*, Paper 17 at 11-12.

C. Investment in the parallel proceeding by the court and parties / Overlap between issues in the petition and parallel proceeding

These factors are irrelevant, as Microsoft's IPR is instituted. Moreover, the district court case is still in its early stages. Fact discovery has just begun, and final infringement and invalidity contentions are not due until August 14, 2020. Ex. 1017 at 1. As a result, the extent to which issues overlap is unclear. Microsoft's IPR also challenges claims (4, 9, 19) not asserted against Apple in the district court.

D. Whether party in parallel proceeding is same party

This factor is irrelevant, as Petitioner seeks joinder as an understudy.

E. Other circumstances, including the merits

This factor weighs heavily in favor of institution. Apple's IPR petition is substantively identical to Microsoft's instituted IPR petition. Apple's prior filing of an IPR petition is a non-issue. While whether a petitioner previously filed a petition is one of the *General Plastic* factors, a timely-filed joinder motion "effectively neutralizes" a *General Plastics* analysis. *See Apple v. Uniloc 2017 LLC*, IPR2018-00580, Paper 13 at 10 (PTAB Aug. 21, 2018); *see also Celltrion, Inc. v. Genetech, Inc.*, IPR2019-01019, Paper 11 at 10 (PTAB Oct. 30, 2018); *Mylan Pharms. Inc. v. Almirall, LLC*, IPR2019-01019, Paper 12 at 5 (PTAB Nov. 27, 2019).

III. THE *GENERAL PLASTIC* FACTORS ARE INAPPLICABLE

In *General Plastic*, the Board set forth factors considered in conserving the Board's resources. In the current motion, Apple seeks to join Microsoft's proceeding with a nearly identical petition. *General Plastic* does not apply because Apple's understudy role would have no impact on the Board's resources, and as noted above, a joinder petition "effectively neutralizes" a *General Plastic* analysis. Section II. Notwithstanding the above, *General Plastic* factors weigh in favor of institution, as discussed below.

A. Whether same petitioner previously filed a petition directed to the same claims of the same patent

While Apple filed a petition challenging the same patent, this factor is irrelevant as Apple seeks to join Microsoft's petition in an understudy role.

B. Whether at time of filing the first petition the petitioner knew or should have known of the prior art asserted in the second petition

This factor is neutral or irrelevant. Microsoft's and Apple's first petitions do not share prior art and Apple is merely seeking to join in an understudy role.

C. Whether at time of filing the second petition the petitioner already received the POPR or the institution decision

This factor weighs against denial of institution. Apple is submitting a petition that is substantively identical to Microsoft's petition, and has not changed any of the arguments in response to either the POPR or the Institution Decision. Moreover, because the present Petition is submitted as a joinder and Apple will serve an

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