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Paper 9
Entered: October 28, 2020

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 6,467,088 B1

Before MIRIAM L QUINN, AMANDA F. WIEKER, and SCOTT RAEVSKY, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

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

Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Apple Inc. ("Petitioner" or "Apple") filed a Petition for *inter partes* review of claims 1–4, 6–14, and 16–21 of U.S. Patent No. 6,467,088 B1 (Ex. 1001, "the '088 patent"). Paper 1 ("Pet."). Petitioner also filed a Motion for Joinder with *Microsoft Corp. v. Uniloc 2017 LLC*, IPR2020-00023 ("the 023 IPR"). Paper 3 ("Mot."). Uniloc 2017 LLC ("Patent Owner") filed an Opposition to the Motion for Joinder. Paper 7 ("Opp.").[1] Petitioner filed a Reply to Patent Owner's Opposition. Paper 8 ("Reply"). We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . 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 do not institute an *inter partes* review of the challenged claims and deny Petitioner's Motion for Joinder.

II. RELATED PROCEEDINGS

The parties indicate that the '088 patent is the subject of several court proceedings, the 023 IPR filed by Microsoft, and a prior petition for *inter partes* review filed by Petitioner. Pet. 10; Paper 5, 2. In particular, the '088 patent was the subject of *Apple Inc. v. Uniloc 2017 LLC*, IPR2019-00056 ("the 056 IPR"), where the Board issued a decision not to institute *inter partes* review. Pet. 10.

In the 023 IPR, we instituted an *inter partes* review of claims 1–4, 6–14, and 16–21 of the '088 patent based on the following asserted prior art and grounds:

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[1] Patent Owner did not file a Preliminary Response.

1) *Apfel*: U.S. Patent No. 5,974,454, filed as Exhibit 1004;

2) *Lillich:* U.S. Patent No. 5,613,101, filed as Exhibit 1005;

3) *Todd:* U.S. Patent No. 5,867,714, filed as Exhibit 1006; and

4) *Pedrizetti*: U.S. Patent No. 6,151,708, filed as Exhibit 1007.

Microsoft Corp. v. Uniloc 2017 LLC, IPR2020-00023, Paper 7 at 6, 29–31 (PTAB Apr. 14, 2020) ("023 Decision" or "023 Dec."). The following table summarizes the grounds of unpatentability in the 023 IPR:

Claims Challenged in 023 IPR	**35 U.S.C. §[2]**	**References/Basis**
1–4, 6–14, 16–21	103(a)	Apfel, Lillich, Todd
9, 19	103(a)	Apfel, Lillich, Todd, Pedrizetti
1–3, 9–13, 19–21	103(a)	Apfel, Lillich
1, 3, 4, 6–11, 13, 14, 16–21	103(a)	Apfel, Todd

Id.

III. WHETHER TO INSTITUTE *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as those upon which we instituted review in the 023 IPR. *Compare* Pet. 13–15, *with* 023 Dec. 5, 30. Indeed, Petitioner contends that the Petition "is substantially identical to the petition filed in the [023] IPR Proceeding." Pet. 11; *see also* Ex. 1016 (comparing in redline the differences between the petition in the 023 IPR and the instant Petition). We agree that the Petition here asserts challenges and evidence identical to those

[2] Because the application leading to the '088 patent was filed before March 16, 2013, patentability is governed by the version of 35 U.S.C. § 103 preceding the Leahy-Smith America Invents Act ("AIA"), Pub L. No. 112–29, 125 Stat. 284 (2011).

asserted in the 023 IPR. Having already considered the merits of those challenges and evidence vis-à-vis the threshold of institution for *inter partes* review, we determine that the Petition here also presents a reasonable likelihood of prevailing on the challenge of at least one claim of the '088 patent.

Notwithstanding the merits, however, Patent Owner argues that we should exercise our discretion to deny institution under 35 U.S.C. § 314(a) and, accordingly, deny joinder, citing and discussing the *Fintiv* and *General Plastic* factors. Opp. 2–9 (citing *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv* Order") and *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)). Petitioner argues that neither the *Fintiv* Order nor the *General Plastic* factors applies here, where Petitioner seeks to join as a party to the 023 IPR and take an inactive or understudy role. Reply 1–2, 4. As explained in further detail below, Petitioner's understudy argument is not persuasive here where the copied petition is Petitioner's second challenge to the patent, and should Microsoft settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated. In effect, it would be as if Apple had brought the second challenge to the patent in the first instance. This is the kind of serial attack that *General Plastic* was intended to address. *General Plastic*, Paper 19 at 17 ("Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.").

That Petitioner seeks to join the 023 IPR does not obligate us to institute this proceeding without first considering whether to exercise

discretion under § 314(a). The statutory provision governing joinder in *inter partes* review proceedings is 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.

See also Facebook, Inc. v. Windy City Innov., LLC, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (determining that § 315(c) requires "two different decisions," first "whether the joinder applicant's petition for IPR 'warrants' institution under § 314," and then whether to "exercise . . . discretion to decide whether to 'join as a party' the joinder applicant"). Under 35 U.S.C. § 315(c), the discretion of the Director to join a party to an ongoing IPR is premised on the Director's determination that the petition warrants institution. That determination is not limited to determining whether the merits of the petition meet the reasonable likelihood threshold for at least one challenged claim. Under *General Plastic*, the Board may deny a petition based on the Director's discretionary authority of § 314(a). *General Plastic*, Paper 19 at 15. Thus, before determining whether to join Apple as a party to the 023 IPR, even though the Petition is a "me-too petition," we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).

A. Prior Petitions

In *General Plastic*, the Board recognized certain goals of the AIA but also "recognize[d] the potential for abuse of the review process by repeated attacks on patents." *General Plastic*, Paper 19 at 16–17. On October 17,

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