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Paper 11
Entered: February 1, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

GUI GLOBAL PRODUCTS, LTD., D/B/A GWEE,
Patent Owner.

IPR2021-01291
Patent 10,562,077 B2

Before SALLY C. MEDLEY, BRYAN F. MOORE, and SHEILA F. McSHANE, *Administrative Patent Judges*.

MEDLEY, *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") filed a Petition for *inter partes* review of claims 1–13 of U.S. Patent No. 10,562,077 B2 (Ex. 1001, "the '077 patent"). Paper 3 ("Pet."). Petitioner also filed a Conditional Motion for Joinder with *Samsung et al. v. GUI Global Products, Ltd.*, IPR2021-00337 ("the 337 IPR" or "the Samsung 337 IPR"). Paper 4 ("Mot."). GUI Global Products, Ltd., d/b/a Gwee ("Patent Owner") filed a Preliminary Response to the Petition. Paper 10 ("Prelim. Resp."). Patent Owner also filed an Opposition to the Conditional Motion for Joinder. Paper 8 ("Opp."). Petitioner filed a Reply to Patent Owner's Opposition. Paper 9 ("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 Conditional Motion for Joinder.

II. RELATED PROCEEDINGS

The parties indicate that the '077 patent is the subject of court proceeding *GUI Global Products, Ltd. d/b/a Gwee v. Apple, Inc.,* Civil Action No. 4:20-cv-2652 (S.D. Tex.), which has been consolidated with Civil Action No. 4:20-cv-2624 (S.D. Tex.). Pet. 78; Paper 6, 2. The parties also indicate that the '077 patent is the subject of the 337 IPR, and IPR2021-00472 ("the 472 IPR"), where Petitioner filed a petition challenging claims 1–5 and 7–13 of the '077 patent. Pet. 78; Paper 6, 2. In the 472 IPR, we instituted an *inter partes* review of claims 1–5 and 7–13 of the '077 patent.

Apple Inc. v. GUI Global Products, Ltd., D/B/A Gwee, IPR2021-00472, Paper 9 at 7–8, 36 (PTAB Aug. 13, 2021) ("472 Decision" or "472 Dec."). Thus, before us here is Petitioner's second petition for *inter partes* review. In accordance with the Consolidated Trial Practice Guide,[1] Petitioner filed a separate paper, identifying a ranking of its petitions and explaining the differences between the petitions. Paper 2 ("Explanation").

In the 337 IPR, we instituted an *inter partes* review of claims 1–13 of the '077 patent on the following grounds:

Claim(s) Challenged	35 U.S.C §	Reference(s)/Basis
1–8	103(a)	Kim[2]
11	103(a)	Kim, Koh[3]
9, 10, 12, 13	103(a)	Kim, Lee[4]

Samsung et al. v. GUI Global Products, Ltd., D/B/A Gwee, Case IPR2021-00337, Paper 11 at 8, 40 (PTAB Jul. 2, 2021) ("337 Decision" or "337 Dec.").

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[1] Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), https://www.uspto.gov/TrialPracticeGuideConsolidated, 59–61 (explaining that the Board may exercise discretion under 35 U.S.C. § 314(a) to deny a petition(s) if it determines that more than one petition challenging claims of the same patent is not warranted) ("Trial Practice Guide" or "TPG").

[2] U.S. Pat. Appl. Pub. No. US 2010/0227642 A1, published Sept. 9, 2010 (Ex. 1010, "Kim").

[3] Korean Pat. Pub. No. 10-2008-0093178, published Oct. 21, 2008 (Ex. 1012, 16–30, "Koh"). Petitioner provides a certified English-language translation of Koh (Ex. 1012, 1–15). Any reference to Koh hereinafter will be to the English-language translation.

[4] U.S. Pat. Appl. Pub. No. US 2010/0298032 A1, published Nov. 25, 2010 (Ex. 1013, "Lee").

III. DISCUSSION

The Petition in this proceeding asserts the same grounds of unpatentability as those upon which we instituted review in the 337 IPR. *Compare* Pet. 1–2, *with* 337 Dec. 8, 40. Indeed, Petitioner, Apple, contends that the Petition is "substantively equivalent to the petition instituted in" the 337 IPR. Pet. 1. Petitioner requests that we institute *inter partes* review and conditionally seeks joinder with the 337 IPR. Mot. 1. In the Motion, Petitioner seeks joinder "**if**, **and only if**, the Board has previously denied institution of *Apple Inc., v. GUI Global Products, Ltd.*, IPR2021-00472 ("the 472 Proceeding")." *Id*. at 1; Explanation 1. In its Reply, Petitioner revises its request stating, "Apple respectfully requests that the Board institute review of IPR2021-01291 and grant Apple's pending Motion if, and only if, the Board will align in time the issuance of final written decisions in the 337 Proceeding and the 472 Proceeding." Reply 2–3. Petitioner asserts that it is seeking alignment of the schedules in the 337 and 472 proceedings in order to avoid a potential prejudice from estoppel under 35 U.S.C. § 315(e)(1). *Id*. at 3.

"To join a party to an instituted IPR, the plain language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). First, we "determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* Second, if the petition warrants institution, we then "decide whether to 'join as a party' the joinder applicant." *Id.* Thus, before determining whether to join Petitioner as a party to the 337 IPR, we first determine whether the petition warrants institution under § 314(a).

The Director has discretionary authority under 35 U.S.C. § 314(a) to institute *inter partes* review and has delegated that authority to the Board. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018); 37 C.F.R. § 42.4(a). Patent Owner argues that "the Board should exercise its discretion and deny institution of trial," citing the Board's precedential *General Plastic*[5] and *Uniloc*[6] decisions. Prelim. Resp. 3–4. Petitioner argues we should institute an *inter partes* review of the challenged claims. Pet. 74–77. For the reasons set forth below, we exercise our discretion to deny institution.

In *General Plastic*, the Board articulated a list of non-exclusive factors to be considered in determining whether to exercise discretion under § 314(a) to deny a petition:

> 1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
>
> 2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
>
> 3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
>
> 4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

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[5] *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential) ("*General Plastic*").
[6] *Apple, Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential) ("*Uniloc*").

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