

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

GUI GLOBAL PRODUCTS, LTD.,
Patent Owner

Case IPR2021-01291
Patent 10,562,077

**PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE TO
PETITIONER'S CONDITIONAL MOTION FOR JOINDER**

I. INTRODUCTION AND BACKGROUND

On July 30, 2021, Apple filed a Conditional Motion for Joinder (Pap. 4)(“Motion”) to *Samsung, et al., v. GUI Global Products, Ltd.*, IPR2021-00337 (“the 337 Proceeding”). In the Motion, Apple requested that joinder be granted “**if, and only if**, the Board has previously denied institution of *Apple Inc., v. GUI Global Products, Ltd.*, IPR2021-00472 (‘the 472 Proceeding’).” Pap. 4 at 1 (original emphasis). On August 13, 2021, the Board instituted review in the 472 Proceeding, rendering unmet the necessary condition for joinder expressed in Apple’s pending Motion. On August 30, 2021, GUI filed a Response contending “that joinder is appropriate notwithstanding that Apple’s condition for requesting the same has not been met.” Pap. 8 at 3.

Following GUI’s Response, Apple conferred with GUI regarding the possibility of Apple filing a renewed joinder motion that would instead be conditioned on harmonization of timing between the respective oral hearings and/or final written decisions of the 472 Proceeding and the 337 Proceeding, so as to avoid issues of estoppel that might otherwise arise in connection with 35 U.S.C. § 315(e)(1). GUI opposed the proposed alignment of oral hearings, which it said “would cause a ripple effect and shift all the other dates earlier in the schedule,”¹ but

¹ Petitioner will provide documentation of the email exchange at the Board’s request.

GUI did not respond when asked whether GUI would oppose alignment of *only* the final written decisions. On September 14, 2021, Apple approached the Board by email with its request to file a renewed joinder motion. On September 20, 2021, the Board declined to authorize such a motion, and instead authorized Apple to “address issues raised in Patent Owner’s Responses to Petitioner’s Conditional Motion for Joinder in Replies, which are due on September 30, 2021.” Apple replies as follows.

II. ARGUMENT AND RELIEF REQUESTED

But for the fact that the condition for requesting joinder expressed in Apple’s pending Motion has not been met, Apple and GUI agree that “joinder is appropriate” (Paper 8 at 3), in the sense that all of joinder’s other requirements are satisfied. *See* Paper 4 at 8-14; Paper 8 at 3-9. The parties diverge as to whether unconditioned joinder of Apple as a party to the 337 Proceeding would be appropriate in view of the 472 Proceeding’s institution. GUI “opposes the conditional nature of Apple’s motion” and contends joinder should occur “notwithstanding that Apple’s condition for requesting [the] same has not been met.” Paper 8 at 1, 3. As explained in more detail below, however, unconditioned joinder is potentially prejudicial to Apple.

As such, consistent with GUI’s request that Apple be a joined as a party to the 337 Proceeding if the Board institutes the IPR2021-01291 petition, Apple hereby augments the unmet condition stated in Apple’s pending Motion with the following additional condition by which joinder may be achieved: 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, where alignment is achieved only if the final written decision of the 472 Proceeding issues concurrent with or in advance of the final written decision of the 337 Proceeding. In conditioning joinder in this way, Apple seeks to avoid a scenario in which Apple might be estopped under 35 U.S.C. § 315(e)(1) from maintaining the 472 Proceeding, and in which the 472 Proceeding might potentially be terminated prior to issuance of a final written decision.

A. Unconditioned Joinder Is Potentially Prejudicial to Apple

GUI argues that “not joining [Apple] with the 337 Proceeding would be contrary to the requirement of ensuring just, speedy, and inexpensive resolution of these proceedings.” Paper 8 at 1 (citing 37 C.F.R. §42.1(b)). But GUI fails to address the potential prejudice posed to Apple and to the instituted 472 Proceeding by estoppel under § 315(e)(1), if Apple were joined as a party to the 337 Proceeding, and if the 337 Proceeding's final written decision were to issue in advance of that of the 472 Proceeding. *See Facebook Inc., et al. v. Uniloc USA, Inc., et al.*, IPR2017-01427, Paper 30 at 4-6 (May 29, 2018) (finding petitioner Facebook estopped from maintaining *inter partes* review on claims addressed by an earlier final written decision in a proceeding to which Facebook was joined), *aff'd*, *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1030 (Fed. Cir. 2021).

Unconditioned joinder would open the door to an estoppel scenario similar but not identical to that of *Facebook*, which would prevent Apple from participating in the instituted 472 Proceeding in which Apple is the sole petitioner. Unlike *Facebook*, that estoppel might yield subsequent termination of the 472 Proceeding prior to a final written decision on the merits, a result that would be counter to 37 CFR § 42.1's goal of securing a "just ... resolution of every proceeding."

B. Apple's Reasonable Condition on Joinder is Fair to Both Parties

Conditioning joinder on the alignment in time of final written decisions would promote the parties' shared interest in joinder without prejudice to either party, while also preventing the unnecessary morass of an estoppel issue ripening in the 472 Proceeding. This condition can be implemented without prejudice to GUI because the statutory deadline for a final written decision in the 337 Proceeding (July, 2, 2022) is only 1.5 months ahead of the corresponding deadline in the 472 Proceeding (August 13, 2022). Indeed, as shown in the table below, each proceeding can otherwise progress as presently scheduled, with respective oral hearings on April 12, 2022 (337 Proceeding) and May 19, 2022 (472 Proceeding).

Proceeding	Filing	Institution	Hearing	FWD Deadline
IPR2021-00337	12/29/2020	7/2/2021	4/12/2022	7/2/2022
IPR2021-00472	2/5/2021	8/13/2021	5/19/2022	8/13/2022

GUI's concern of "shift[ing] all the other dates earlier in the schedule" is

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