

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 CONDITIONAL MOTION FOR JOINDER

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Apple Inc. (“Apple” or “Petitioner”) **conditionally moves** for joinder with the *inter partes* review instituted against U.S. Patent No. 10,562,077 (“the ’077 Patent”) in *Samsung, et al., v. GUI Global Products, Ltd.*, IPR2021-00337 (“the 337 Proceeding”). This motion is timely filed within one month of the Board’s July 2, 2021 institution decision in the 337 Proceeding.

More specifically, Apple respectfully requests that the Board institute review of IPR2021-01291 based on the concurrently-filed petition and that it grant this motion **if, and only if**, the Board has previously denied institution of *Apple Inc., v. GUI Global Products, Ltd.*, IPR2021-00472 (“the 472 Proceeding”). In making this request, Apple seeks to ensure that, for each of the four patents that GUI presently asserts against Apple and Samsung, Apple is party to one (and only one) instituted *inter partes* review proceeding, preferably the proceeding inspired by Apple’s initial filing but otherwise the proceeding inspired by Samsung’s first filing.¹ In this way, consistent with the goals expressed in each of the Board’s *NHK*, *Fintiv*, *Snap*, *Sotera*, *General Plastic*, and *Uniloc* decisions, Apple seeks to promote a maximally-efficient

¹ Apple is concurrently filing conditional motions for joinder with respect to each of the IPR2021-01289, IPR2021-01290, and IPR2021-01292 petitions.

resolution to the dispute between the parties. *See, e.g., General Plastic Indus. Co. v. Cannon Kabushiki Kaisha*, IPR2016-01357, Pap. 19 at 16 (PTAB Sept. 6, 2017)(precedential)(“In exercising discretion...we are mindful of the goals of the AIA—namely, to improve patent quality and make the patent system more efficient by the use of post-grant review procedures”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Pap. 11 at 6 (PTAB Mar. 20, 2020)(“the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review”).

The parties to the counterpart consolidated district court litigation have already agreed that, if “all four *of Apple’s IPR petitions* are instituted”² then “Plaintiff would not oppose a motion...by Samsung and Apple to stay the [counterpart] litigation pending final decisions from the PTAB in all then-pending...IPRs.” EX1116, 2 (emphasis added). Conversely, GUI has indicated that it *would* oppose a motion to stay the counterpart litigation if any of Apple’s IPR2021-00470, IPR2021-00471, IPR2021-00472, and IPR2021-00473 petitions are not instituted. *Id.*; *see also* EX1115, 1.

² Referring to Apple’s IPR2021-00470, IPR2021-00471, IPR2021-00472, and IPR2021-00473 petitions, on which institution decisions remain pending.

Thus, if all four of Apple’s IPR petitions are instituted, Apple’s and Samsung’s printed publication invalidity grounds would likely be addressed by a single forum—the PTAB. This is the maximally efficient outcome, and the outcome that Apple seeks to promote via this conditional motion for joinder. *Cf. Snap, Inc. v. SRK Technology LLC*, IPR2020-00820 Pap. 15 at 9, 19 (PTAB Oct. 21, 2020)(precedential); *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019 Pap. 12 at 19-21 (PTAB Dec. 1, 2020)(precedential).

However, if the Board were to decline to institute Apple’s IPR2021-00472 petition challenging the ’077 Patent, the next-most efficient course of action would be for the Board to institute review of IPR2021-01291 and grant this motion for joinder with Samsung’s already-instituted 337 Proceeding. Indeed, the district court’s Amended Scheduling Order (entered July 16, 2021) contemplates that “if all of Apple’s IPR Petitions are not instituted,” the parties will brief an opposed motion to stay. EX1115. As to this less preferred alternative, where Apple is joined to the 337 Proceeding in an understudy role, it remains likely that the district court would grant a motion for stay, even if opposed by GUI. The consolidated nature of the counterpart district court litigation combined with the fact that all four of Samsung’s IPR proceedings have already been instituted heavily favors a stay.³ *See* EX1102;

³ The Board instituted each of IPR2021-00335, IPR2021-00336, IPR2021-00337,

EX1103; EX1104; Memorandum and Order granting motion to stay in *Fairfield Industries Inc. v. Seabed Geosolutions (US) Inc.*, Case H-17-cv-1458 (S.D. Tex. Jan. 2019) at 3 (“A stay of patent litigation is ‘particularly justified when the outcome of a PTO proceeding is likely to assist the court in determining patent validity or eliminate the need to try infringement issues.’”); Memorandum and Order in *Onesubsea IP US Ltd. v. FMC Technologies, Inc.*, Case H-16-cv-0051 (S.D. Tex. Aug. 2016) at 4 (“The Court finds that a stay of this case pending the completion of the IPR process will provide the Court and the parties with potentially important guidance from the patent office, will simplify the case, will avoid a needless waste of resources, and will prevent inconsistent results between the IPR proceedings and this lawsuit”).

Thus, while a grant of Apple’s first-filed petitions would maximize the likelihood of the parties avoiding the unnecessary costs of duplicative litigation in different forums on the subject of validity over the same prior art grounds, and decrease the likelihood of potentially inconsistent decisions from different forums addressing those grounds, the grant of this conditional motion for joinder also would increase the likelihood (albeit to a lesser extent) of achieving similar goals.

and IPR2021-00338 on July 2, 2021.

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