

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

GUI GLOBAL PRODUCTS, LTD.,
Patent Owner.

Case IPR2021-01292
Patent 10,589,320 B1

PATENT OWNER'S PRELIMINARY RESPONSE

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REGULATIONS

37 C.F.R. § 42.1(b)	1
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I. INTRODUCTION

Petitioner, Apple, originally sought joinder with the 338 Proceeding, but if, and only if, the Board has previously denied institution of *Apple Inc., v. GUI Global Products, Ltd.*, IPR2021-00473. Apple Mot. for Joinder at 1. That condition was not met and the 473 Proceeding has been instituted. Now Apple seeks joinder “if and only if the Board will align in time the issuance of final written decisions in the 337 Proceeding and the 473 Proceeding, where alignment is achieved only if the final written decision of the 473 Proceeding issues concurrent with or in advance of the final written decision of the 338 Proceeding.” Apple Reply re Mot. for Joinder at 3. The Board should not countenance such litigation tactics and, unless it joins this proceeding with the 338 Proceeding, the Board should exercise its discretion and deny institution of trial. Proceeding otherwise would both subject Patent Owner to the burden of having to defend two identical proceedings and require to the Board to adjudicate same. Apple has already challenged the claims of the ’320 patent in the 473 Proceeding and offers no good explanation as to why it waited seven-plus months to file the instant petition which is a copycat of that in the 338 Proceeding. Under these circumstances, instituting trial and not joining this proceeding with the 338 Proceeding, involving identical grounds and identical unpatentability arguments, would be contrary to the requirement of ensuring just, speedy, and inexpensive resolution of such matters. 37 C.F.R. § 42.1(b).

II. BACKGROUND

On February 5, 2021, Petitioner, Apple, filed a petition in IPR2021-00473 (“the 473 Proceeding”) challenging claims of U.S. Patent No. 10,589,320 (“the ’320 patent”). *Apple Inc. v. GUI Global Products Ltd.*, IPR2020-00473, Paper 3 at 1 (PTAB Feb. 19, 2021). Trial in the 473 Proceeding was instituted on August 13, 2021. IPR2020-00473, Paper 9 at 2 (PTAB Aug. 13, 2021). Apple has now filed an additional petition (the “Copycat Petition”) in this IPR2021-01292 (“the 1292 Proceeding”) challenging claims of the ’320 patent and has concurrently filed a “conditional” motion for joinder with *Samsung, et al., v. GUI Global Products, Ltd.*, IPR2021-00338 (“the 338 Proceeding”), which was instituted on July 2, 2021. The Copycat Petition in this 1292 Proceeding is substantively identical to the petition filed by Samsung in the 338 Proceeding, relies on the same prior art evidence and arguments as in the 338 Proceeding, and is supported by testimony from the same declarant as in the 338 Proceeding, which testimony is substantively identical to that which the declarant provided in the 338 Proceeding. Pet. at 1, Apple Mot. for Joinder at 9.

Apple styled its motion for joinder as being *conditional* upon the Board denying institution of the 473 Proceeding. Apple Mot. for Joinder at 1. That condition was not met, as the Board instituted the 473 Proceeding on August 13, 2021. IPR2020-00473, Paper 9 at 2. After that institution and after receiving Patent

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