

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,  
Patent Owner.

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Case IPR2022-01243  
Patent No. 8,280,072

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**PETITIONER'S MOTION FOR JOINDER UNDER  
35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)**

## I. STATEMENT OF PRECISE RELIEF REQUESTED

Apple Inc. (“Apple”) respectfully submits this Motion for Joinder, concurrently with a Petition (“Apple’s Petition”) for *inter partes* review of U.S. Patent No. 8,280,072 (“the ’072 Patent”).

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Apple requests institution of an *inter partes* review and joinder with IPR2022-00213 (“Samsung IPR”), which was instituted on June 8, 2022. *Samsung Electronics Co. Ltd. et al. v. Jawbone Innovations, LLC*, IPR2022-00213, Paper 10 (PTAB June 8, 2022). Apple’s Petition is substantively the same as the Samsung IPR petition. It challenges the same claims, on the same grounds, relies on the same prior art as instituted in the Samsung IPR, and relies on the same expert declaration. Therefore, joinder would create no additional burden for the Board, the Samsung IPR Petitioner (“Samsung”), or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’072 Patent.

Apple is currently a defendant in a district court litigation in the Western District of Texas, Case No. 6:21-cv-00984 (W.D. Tex.). In that proceeding, Apple has been accused of infringing the ’072 Patent. Apple has not previously filed a petition for IPR challenging the validity of the ’072 Patent.<sup>1</sup>

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<sup>1</sup> Apple is concurrently filing a second petition for IPR against the ’072 Patent on

Apple stipulates that if joinder is granted, it will act as an “understudy” and will not assume an active role unless Samsung ceases to participate in the proceeding. Samsung will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Apple also will not seek additional depositions or deposition time. Joinder will not impact the trial schedule because the proceeding based on the Samsung IPR is in its early stages, having just instituted on June 8, 2022.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Samsung IPR for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal. On the other hand, denial of joinder would prejudice Apple. Apple’s interests may not be adequately protected in the Samsung IPR, particularly if Samsung settles with Patent Owner and ceases to participate. Apple should be allowed to join in a proceeding affecting a patent asserted against it.

Given the similarities of the proceedings, the lack of undue prejudice to Patent

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different grounds and relying on different references. *See* IPR2022-01244.

Owner, and the potential benefit to the public and to the Board that would accrue by Apple's cooperative participation in the Samsung IPR in the event that Samsung's participation terminates, the Board should institute IPR and grant Apple's Motion for Joinder.

## II. ARGUMENT

### A. Legal Standards and Applicable Rules

A petitioner may request joinder, without prior authorization, no later than one month after the institution date of the proceeding to which joinder is requested. 37 C.F.R. § 42.122(b); *Taiwan Semiconductor Mfg. Co., Ltd. v. Zond LLC*, IPR2014-00781 and IPR2014-00782, Paper 5 at 3 (PTAB May 29, 2014).

The Board has discretion to grant a motion for joinder of a petitioner for *inter partes* review to another *inter partes* review proceeding. See 35 U.S.C. § 315(c). In determining whether to exercise its discretion to grant a motion for joinder, the Board considers: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. See *Dell, Inc. v. Network-1 Security Solutions, Inc.*, IPR201300385, Paper 17 at 3 (July 29, 2013).

**B. Apple’s Motion for Joinder is Timely**

Joinder may be requested “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). The Samsung IPR was instituted on June 8, 2022. IPR2022-00213, Paper 10 (PTAB June 8, 2022). Apple’s current motion is timely as it is being filed within one month of the institution date.

**C. The Four Factors Favor Joinder**

Each of the four factors weighs in favor of granting Apple’s Motion for Joinder. Apple’s Petition is substantively identical to the petition in the Samsung IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the Samsung IPR. Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

**1. Joinder of Apple Is Appropriate Because It Will Promote an Efficient Determination of the Validity of the ’072 Patent Without Prejudice to Any Party**

Apple seeks to join the Samsung IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if Samsung’s participation is terminated prior to completion. Thus, joining Apple to the Samsung IPR is the most practical way to secure the just, speedy, and inexpensive resolution of the challenge to the ’072 Patent. *See* 37 C.F.R. § 42.1(b).

If Apple is joined as a party, the validity of the grounds raised in the

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