

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

Case IPR2022-01244
Patent No. 8,280,072

**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 IPR2022-00630 (“Google IPR”), which was filed on March 1, 2022. *Google LLC v. Jawbone Innovations, LLC*, IPR2022-00630. Apple’s Petition is substantively the same as the Google IPR petition. It challenges the same claims, on the same grounds, relies on the same prior art as the Google IPR, and relies on the same expert declaration. Therefore, joinder would create no additional burden for the Board, the Google IPR Petitioner (“Google”), 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.¹

¹ Apple is concurrently filing a second petition for IPR against the ’072 Patent on different grounds and relying on different references. *See* IPR2022-01243.

Apple stipulates that if joinder is granted, it will act as an “understudy” and will not assume an active role unless Google ceases to participate in the proceeding. Google 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 Google IPR is in its early stages.

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 Google IPR for all interested parties.

Joinder will not unduly prejudice any party. Indeed, Google does not oppose this motion. Also, 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 Google IPR, particularly if Google 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 Owner, and the potential benefit to the public and to the Board that would accrue by

Apple's cooperative participation in the Google IPR in the event that Google'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.*, IPR2013-00385, 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 Google IPR was filed on March 1, 2022, and the Patent Owner Preliminary Response was filed on June 16, 2022. IPR2022-00630, Paper 3 (March 1, 2022), Paper 6 (June 16, 2022). The Board is yet to issue its decision on institution, which is not due until September 16, 2022. *Id.* at Paper 5. Apple's current motion is timely as it is being filed within the permissible time frame.

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 Google IPR; it presents no new grounds of unpatentability. Joinder will have no impact on the pending schedule of the Google 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 Google IPR in order to ensure that an accused infringer with an active interest in the proceeding remains a party to this IPR if Google's participation is terminated prior to completion. Thus, joining Apple to the Google 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 Google IPR can be determined in a single proceeding. Joinder also is appropriate because

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