UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

RFCYBER CORP.,
Patent Owner

Case No. PGR2022-00003
U.S. Patent No. 10,600,046

PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 35 U.S.C. § 325(c) AND 37 C.F.R. § 42.222(b) TO RELATED POST-GRANT REVIEW PGR2021-00028

I. INTRODUCTION

Patent Owner ("PO") strategically sequenced its lawsuits, depriving Petitioner the opportunity to file its own PGR or to timely join Google's instituted PGR. PO's tactics open the door to abuse and gamesmanship, encourage duplication of issues, and waste judicial resources. The Board should not embolden such gamesmanship. Nor should it prejudice Petitioner by depriving it of the work already completed by the Board. In the interests of fairness and efficiency, the Board should permit joinder.

II. ARGUMENT

A. Joinder is Proper Under 35 U.S.C. §§ 321(c) and 325(c)

PO argues 35 U.S.C. § 321 "makes clear that joinder requests do not allow PGRs to be instituted after the nine-month window closes." *Paper 7*, 5. First, PO entirely ignores that 37 C.F.R. § 42.5(b) gives the Board discretion to "waive or suspend" any requirements enumerated in its rules, including the 9-month deadline set forth in Rule 42.202. Second, PO is wrong about the 35 U.S.C. § 321, which is silent as to joinder. This is likely why PO seeks to manufacture a statutory provision from Congressional silence. To do so, PO argues that because 35 U.S.C. § 315(b) contains an express time bar exception for IPR joinder, the Board should impute upon Congress an intent to exclude PGR joinder as well. The Supreme Court has soundly rejected attempts to make law out of what the legislature has *not* said. *Pauley v. BethEnergy Mines, Inc.*, 501 U.S. 680, 703 (recognizing "the dubious reliability

of inferring specific intent from silence") (quoting *Sunstein, Law and Administration After Chevron*, 90 Colum.L.Rev. 2071, 2085–2088 (1990)). Congress did not draft 35 U.S.C. § 321 to foreclose a petitioner's ability to join a properly instituted PGR past the 9-month window and no such prohibition should be read into this provision.

Turning from timing to the discretionary analysis that governs whether joinder should be granted, PO insists that language differences between the IPR joinder provisions in § 315(c) and the PGR joinder provisions in § 325(c) should be interpreted to disallow PGR party joinder even where no new grounds are introduced. *Paper 7*, 7-8; *id*. at 4 (arguing "Apple cites no case where the Board has applied the same test to joinder in PGRs as it does in IPRs" and "the joinder provision for IPRs is vastly different than that for PGRs"). In fact, the Board has treated the discretionary joinder provisions similarly and, as explained in Apple's motion, has applied the same *Kyocera* analysis to a petition governed by the PGR joinder provisions of § 325(c), granting joinder of copycat petition as it routinely does for IPRs. *Paper 3*, 2-3 (discussing joinder in CBM2019-00025).

B. PO's Lawsuit Sequencing Dictated the Joinder Timing

PO filed suit ***after*** both the 9-month PGR eligibility window and the 30-day window to file a motion for joinder had closed. Yet PO argues Petitioner should be punished for "fail[ing] to follow the Rules"—rules it could not have followed due to PO's sequenced lawsuit timing. *Paper 7*, 12. The reality is, Petitioner acted

diligently after PO's long delayed lawsuit was filed. In just over five weeks, Petitioner assessed eight separate PTAB proceedings against PO's patents and moved to join Google's PGR. PO decided when to sue Petitioner and must live with the impact of its strategic choices—its gamesmanship should not be encouraged as a means to avoid joinder of parties sued late in a lawsuit campaign.

The PTAB expressly recognizes gamesmanship as justification for exercising even the Board's narrowest discretion. *PTAB Cons. Trial Practice Guide*, Nov. 2019, 76-77 (discussing a matter of narrow discretion and identifying as compelling justification a PO's "attempts to game the system," including a "plaintiff [] strategically wait[ing] to alter or add late-asserted patent claims…to wait out the one-year bar"). Here, Petitioner is not seeking a broad exception allowing PGR joinder outside the permitted window, but is instead seeking a narrow exception in light of PO's lawsuit sequencing gamesmanship. To combat these inequities, the Board should exercise its discretion and waive the joinder deadlines as it has repeatedly in the past. *See Sony Corp. of Am. and Hewlett-Packard Co v. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13, slip op. at 4 (PTAB Sept. 16, 2013) (waiving statutory time bar under 37 C.F.R. § 42.5(b)); *see also Globalfoundries U.S. Inc. v. Godo Kaisha IP Bridge 1*, IPR 2017-00925, Paper 12, slip op. at 8-11 (PTAB Jun. 9, 2017) (same); *SL Corp. v. Adaptive Headlamp Tech., Inc.*, IPR2016-01368, Paper 9, at 6-9 (same).

Emphasizing the importance of encouraging settlements, PO argues that the Board *must* rule on its pending motion to terminate, mooting Petitioner's joinder request. *Paper 7*, 8-10. However, Rule 42.72 leaves it to the Board's discretion to join Petitioner prior to ruling on the pending motion to terminate. 37 C.F.R. § 42.72 ("The Board ***may*** terminate . . . pursuant to a joint request under 35 U.S.C. [] 327(a)") (emphasis added). Exercising this discretion, the Board in *AT&T Services, Inc. v. Covergent Media Solutions, LLC*, "decide[d] Petitioner's motion for joinder ***prior to acting on Patent Owner's [pending] joint motion to terminate***[.]" IPR2017-01237, Paper 10, at 27 (May 10, 2017) (emphasis added); *see also Globalfoundries,* IPR2017-00925, Paper 13 at 9 (recognizing the "possible chilling effect of joinder on settlement is a factor present in most, if not all, joinder situations" and concluding this must simply "weighed together with all of the other facts"). Where, as here, the PO's own tactics created any settlement tension, the Board should find such tension does not outweigh the strong interests in preserving the existing PGR.

C. The Joinder Factors Overwhelmingly Favor Joinder

Contrary to PO's insistence that a "different" test applies to PGR joinder under § 325, the Board in fact applies the four-factor *Kyocera* calculus to both IPR joinder under § 315 and PGR joinder under § 325. *See, e.g.*, *Visa*, CBM2019-00025, Paper 7 at 3-5 (applying *Kyocera* test to CBM joinder under § 325). These four factors weigh heavily in favor of joinder here.

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