

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMAZON.COM, INC., AMAZON DIGITAL SERVICES, INC.,  
AMAZON FULFILLMENT SERVICES, INC., HULU, LLC,  
NETFLIX, INC., and GOOGLE LLC  
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,  
Patent Owner.

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Case IPR2017-00948, Patent 8,566,960 B2  
Case IPR2017-01665, Patent 8,566,960 B2<sup>1</sup>

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Before DAVID C. MCKONE, BARBARA A. PARVIS, and  
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> The parties are not authorized to use this caption.

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On February 17, 2017, Petitioners Amazon.com, Inc., Amazon Digital Services, Inc., Amazon Fulfillment Services, Inc., Hulu, LLC, and Netflix, Inc. (“the Amazon Petitioners”) filed a Petition challenging claims 1–25 of U.S. Patent No. 8,566,960 B2 (“the ’960 patent”). IPR2017-00948, Paper 1. Uniloc Luxembourg, S.A. (“Patent Owner”) filed a Preliminary Response to the Amazon Petitioners’ Petition on June 13, 2017. IPR2017-00948, Paper 9. We instituted an *inter partes* review in IPR2017-00948 on August 14, 2017. IPR2017-00948, Paper 10.

After Patent Owner filed its Preliminary Response in IPR2017-00948, on June 30, 2017, Petitioner Google LLC filed a Petition challenging claims 1–25 of the ’960 patent. IPR2017-01665, Paper 2. Google did not move to join IPR2017-00948. Nevertheless, Google stated that, “[t]o the extent the Board determines to institute on both pending petitions and believes efficiencies would be served by harmonizing the schedules of the respective proceedings, Petitioner here is willing to work with the Patent Owner and Board to achieve those efficiencies.” *Id.* at 14. On October 19, 2017, Patent Owner filed a Preliminary Response arguing, *inter alia*, that Google’s Petition should be denied under 35 U.S.C. § 325(d). IPR2017-01665, Paper 7, 2–8. In response to the above-quoted statement of Google, Patent Owner stated that it “does not consent to Petitioner’s tacit suggestion that the regulations governing joinder can be ignored here and that this matter could somehow be joined together with IPR2017-00948.” *Id.* at 6 n.6.

Although Petitioner has not requested joinder and, thus, has not satisfied 37 C.F.R. § 42.122(b), we nevertheless have discretion to join Google to IPR2017-00948. *See* 35 U.S.C. §§ 315(c), 325(d); 37 C.F.R. § 42.122(a). Section 325(d) also provides that “the Director may take into

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account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” We have reviewed Google’s Petition and note the substantial similarities between its challenges and those raised in IPR2017-00948. We also note Google’s attempts to respond to the arguments raised by Patent Owner in its IPR2017-00948 Preliminary Response. *Cf. General Plastic Indus. Co., LTD. v. Canon Kabushiki Kaisha*, Case IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (precedential), Slip. op. at 17 (“[F]actor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions.”). We also are aware that, should we exercise our discretion to dismiss pursuant to Section 325(d), Google, who is not a party to IPR2017-00948, would be denied an opportunity to advance prior art and arguments that we determined presented a reasonable likelihood of prevailing in showing that claims 1–25 are unpatentable. If the Amazon Petitioners were to settle, Google would not have the benefit of a ruling on those challenges, despite filing a petition reciting such challenges. To be clear, we have not yet decided whether to deny Google’s Petition under 35 U.S.C. § 325(d).

The parties (the Amazon Petitioners, Google, and Patent Owner) are directed to meet and confer to ascertain whether they can agree to joinder of Google to IPR2017-00948 and, if so, the terms of such joinder (e.g., schedule, Google’s participation). The panel believes that joinder could protect Google’s interest in pursuing challenges substantially similar to those brought in its own Petition in the event of settlement of the Amazon Petitioners while protecting Patent Owner from successive challenges to its

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patent based on similar prior art and arguments. The parties must, by Monday, December 18, 2017, state whether they have reached agreement and, if so the terms. The parties can do so by sending an email to the Trials mailbox listed on the first page of this Order. The panel will take into consideration the agreement of the parties in determining the parameters of a joined proceeding, if any. If the parties cannot reach agreement, the parties must provide several dates and times during the week of December 18 at which all parties are available for a teleconference with the Board to discuss objections to joinder. Such a teleconference will not be an opportunity to reargue the merits of Patent Owner's Section 325(d) argument.

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PETITIONERS:

Daniel T. Shvodian  
PERKINS COIE LLP  
[dshvodian@perkinscoie.com](mailto:dshvodian@perkinscoie.com)

W. Karl Renner  
Adam Shartzer  
Matthew Mosteller  
Vivian Lu  
FISH & RICHARDSON P.C.  
[axf-ptab@fr.com](mailto:axf-ptab@fr.com)  
[shartzer@fr.com](mailto:shartzer@fr.com)  
[mosteller@fr.com](mailto:mosteller@fr.com)  
[vlu@fr.com](mailto:vlu@fr.com)

PATENT OWNER:

Brett Mangrum  
Ryan Loveless  
ETHERIDGE LAW GROUP  
[brett@etheridgelaw.com](mailto:brett@etheridgelaw.com)  
[ryan@etheridgelaw.com](mailto:ryan@etheridgelaw.com)

Sean D. Burdick  
UNILOC USA  
[sean.burdick@unilocusa.com](mailto:sean.burdick@unilocusa.com)