Trial@uspto.gov
Tel: 571-272-7822

Paper 10
Entered: January 15, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2018-01503
Patent 6,216,158 B1

Before JENNIFER S. BISK, MIRIAM L. QUINN, and CHARLES J. BOUDREAU, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Granting Motion for Joinder
35 U.S.C. §§ 314(a), 315(c); 37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

LG Electronics, Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 1, 2, 6–9, 12, 14, 15, and 20 ("the challenged claims") of U.S. Patent No. 6,216,158 B1 (Ex. 1001, "the '158 patent"). Paper 2 ("Pet."), 1. Concurrently with the Petition, Petitioner filed a Motion for Joinder with *Apple Inc. v. Uniloc 2017 LLC*, Case IPR2018-00361 ("the Apple IPR"). Paper 3 ("Motion" or "Mot."). Petitioner represents that the petitioner in the Apple IPR—Apple Inc.—does not oppose the Motion for Joinder. Mot. 1. Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). Patent Owner acknowledges the joinder request, and does not otherwise state whether it opposes joinder. *Id.* at 1 n.1.

For the reasons explained below, we institute an *inter partes* review of the challenged claims of the '158 patent, and grant Petitioner's Motion for Joinder.

B. Related Matters

The parties indicate that the '158 patent is involved in *Uniloc USA, Inc. v. LG Electronics USA, Inc.*, Case No. 4-17-cv-00827 (N.D. Tex.) and Case No. 4-17-cv-02915 (N.D. Cal.), and other proceedings. Pet. 2–3; Prelim. Resp. 2.

In the Apple IPR, we instituted an *inter partes* review of the challenged claims on the following grounds:

Claims	Basis	References
1, 2, 6–9, 12, 14, 15, and 20	§ 103	Jini-QS,[1] Arnold,[2] and McCandless[3]
1, 2, 6–9, 12, 14, 15	§ 103	Riggins[4] and Devarakonda[5]

IPR2018-00361, slip op. at 23–24 (PTAB July 15, 2018) (Paper 8) ("Decision on Institution").

II. INSTITUTION OF *INTER PARTES* REVIEW

Petitioner contends that the Petition is "a carbon copy" of the Petition in the Apple IPR and, thus, asserts the grounds that the Board instituted in the Apple IPR, with no new arguments for the Board to consider, and relies on the same exhibits and expert declaration as in the Apple IPR. Mot. 1, 6.

We acknowledge Patent Owner's arguments and evidence supporting its position that the claims would not have been obvious. Prelim. Resp. 12–44. Certain of Patent Owner's arguments against the merits of the Petition have been previously addressed in the Decision on Institution in the Apple IPR, and we need not address them here again. Certain other arguments against the merits of the Petition mirror arguments made in the Patent Owner Response filed in the Apple IPR. For instance, Patent Owner now introduces argument and evidence concerning whether Jini-QS qualifies as prior art. Prelim. Resp. 12–13. Patent Owner's arguments and evidence

---

[1] *Jini: Quick Study*, COMPUTERWORLD, Dec. 7, 1998 (Exhibit 1005) ("Jini-QS").

[2] U.S. Patent No. 6,393,497 B1 (Exhibit 1006) ("Arnold").

[3] *The PalmPilot and the Handheld Revolution*, (IEEE Expert, 1997), (Exhibit 1007) ("McCandless").

[4] U.S. Patent No. 6,131,116 (Exhibit 1008) ("Riggins").

[5] U.S. Patent No. 6,757,729 B1 (Exhibit 1009) ("Devarakonda").

will be fully considered in the Apple IPR. Doing so ensures that we review Patent Owner's arguments and evidence in light of a full record, avoids premature evaluation of arguments and evidence at issue in the Apple IPR, and ensures consistency across proceedings involving the same petitions. In sum, Patent Owner's arguments made in its Preliminary Response in this case do not persuade us that Petitioner has not demonstrated a reasonable likelihood of success in prevailing on the same grounds as instituted in the Apple IPR.

Additionally, Patent Owner notes that an argument made in an unrelated appeal pending at the U.S. Court of Appeals for the Federal Circuit asserts that "the Board's appointments of administrative patent judges violate the Appointments Clause of Article II" of the U.S. Constitution. Prelim. Resp. 44. "Patent Owner . . . adopts this constitutional challenge now to ensure the issue is preserved pending the appeal." *Id.*

The Board has previously "declin[ed] to consider [the] constitutional challenge as, generally, 'administrative agencies do not have jurisdiction to decide the constitutionality of congressional enactments.'" *Square, Inc. v. Unwired Planet LLC*, IPR2014-01165, slip op. at 25 (PTAB Oct. 30, 2015) (Paper 32) (quoting *Riggin v. Office of Senate Fair Emp't Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995)). We, likewise, decline to consider Patent Owner's constitutionality argument.

III. MOTION FOR JOINDER

We instituted the Apple IPR on July 15, 2018. The Petition here was filed on August 3, 2018, concurrently with the Motion. Petitioner's Motion

for Joinder is timely because joinder was requested no later than one month after the institution date of the Apple IPR. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which states:

> If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, Paper 15, 4 (PTAB Apr. 24, 2013).

As noted, the Petition in this case asserts the same unpatentability ground on which we instituted review in the Apple IPR. Petitioner also relies on the same prior art analysis and expert testimony submitted in the Apple IPR. Indeed, the Petition is substantively "a carbon copy" of the petition filed by in the Apple IPR. Mot. 1. Thus, this *inter partes* review does not present any ground or matter not already at issue in the Apple IPR.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of Apple Inc. as a party. *Id.* at 6–7. Petitioner agrees to "[a]ssume a second-chair role as long as Apple Inc. remains in the proceeding." *Id.* at 7. Petitioner further represents that "[n]o new grounds of unpatentability are asserted" and that "joinder

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.