

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG, S.A.,
Patent Owner.

IPR2018-00747 (Patent 7,535,890 B2)
IPR2018-00748 (Patent 8,199,747 B2)

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

QUINN, *Administrative Patent Judge.*

ORDER
Terminating Proceeding
37 C.F.R. § 42.71(a)

IPR2018-00747 (Patent 7,535,890 B2)

IPR2018-00748 (Patent 8,199,747 B2)

In each of the captioned proceedings, Facebook, Inc. and WhatsApp, Inc. (“Petitioner”) filed a Petition and a Motion for Joinder under 35 U.S.C. § 315(c). IPR2018-00747, Papers 2, 3; IPR2018-00748, Papers 2, 3. Patent Owner filed a Preliminary Response. IPR2018-00747, Paper 8; IPR2018-00748, Paper 8. In each case, Petitioner seeks to join ongoing *inter partes* reviews (i.e., IPR2017-01802 and IPR2017-01799, respectively) by challenging the unpatentability of less than all the claims currently on trial in those *inter partes* reviews.

In view of *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018) and the Board’s guidance on the impact of SAS on AIA trial proceedings,¹ we held a conference call with the parties to discuss the unobtainability of joinder to an ongoing *inter partes* review by challenging less than all the claims in that *inter partes* review. *See, e.g.*, 35 U.S.C. § 315(c) (giving Director discretion to “join as a party to that *inter partes* review any person who properly files a petition” (emphasis added)); *SAS*, 138 S. Ct. at 1355 (“[I]n an *inter partes* review the petitioner is master of its complaint.”). We gave Petitioner the opportunity to amend its joinder requests by challenging all the claims in the ongoing *inter partes* reviews. *See* IPR2018-00747, Paper 10; IPR2018-00748, Paper 10. Petitioner elected not to join the *inter partes* reviews and requested a dismissal of its petitions. *Id.* (citing Ex. 3001).

Out of an abundance of caution, we issued an order in each case, instructing the parties to show cause why the Petitions should not be dismissed under 37 U.S.C. § 42.71(a). *Id.*; *see also Samsung Elecs. Co. v. NVIDIA Corp.*, Case IPR2015-01270 (PTAB Dec. 9, 2015) (Paper 11). *Id.* Having not heard from the

¹ <https://www-cms.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>

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parties by the given deadline to show cause, we hereby dismiss the Petitions and terminate the proceedings in accordance with § 42.71(a).

ORDER

It is hereby ORDERED that the Petitions filed in IPR2018-00747 and IPR2018-00748 are dismissed; and

FURTHER ORDERED that these proceedings are terminated.

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