

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORP.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00744
Case IPR2019-00745¹
Patent 7,167,487 B2

Before ROBERT J. WEINSCHENK, JOHN F. HORVATH, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

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

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers

INTRODUCTION

Microsoft Corp. (“Microsoft”) has filed two petitions, IPR2019-00744 and IPR2019-00745 (“the Microsoft IPRs”), respectively challenging claims 1–6 and 11–13 in US Patent No. 7,167,487 B2. *See* Paper 2.² Microsoft has also filed, in each case, a request to respectively join the instituted proceeding in IPR2019-00222, *Apple Inc. v. Uniloc 2017 LLC*, Paper 11 (PTAB, June 4, 2019) and IPR2019-00252, *Apple Inc. v. Uniloc 2017 LLC*, Paper 11 (PTAB, June 4, 2019) (“the Apple IPRs”). *See* Paper 7.

On August 5, 2019, Microsoft requested a conference call to discuss the timely management of the Microsoft and Apple IPRs. On August 8, 2019, Judges Weinschenk, Horvath, and O’Hanlon conducted a conference call with all of the parties in the Microsoft and Apple IPRs. During the call, Microsoft was represented by Andrew Mason, Uniloc was represented by Brett Mangrum, and Apple was represented by Roberto Devoto.

During the call, we advised the parties that because the Board has not yet decided the petitions and motions for joinder in the Microsoft IPRs, the Scheduling Orders in the Apple IPRs remain in effect, and Uniloc’s responses to the petitions in the Apple IPRs remain due on August 27, 2019. We further advised the parties that once decisions are made on the petitions and motions for joinder in the Microsoft IPRs, the Board will reconsider, if necessary, any changes needed to the Scheduling Orders in the Apple IPRs.

We then asked Mr. Mason, counsel for Microsoft, whether Microsoft’s joinder motions sought to join Microsoft as a party to the Apple

² Unless otherwise indicated, all citations are to the papers filed in IPR2019-00744. Similar papers have been filed in IPR2019-00745.

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IPRs, or to join Microsoft together with the issues challenging the patentability of claims 1–6 and 11–13 based on the additional TS 23.107³ reference to the Apple IPRs. Mr. Mason replied that the joinder motions sought to join Microsoft and the additional TS 23.107 issues to the Apple IPRs. Mr. Mason also explained that Microsoft filed the joinder motions to promote efficiency, but it would be acceptable to Microsoft to consider the Microsoft IPRs without joinder to the Apple IPRs. We further asked Mr. Mason what changes he suggested be made to the trial schedules in the Apple IPRs in the event we granted Microsoft’s petitions and motions for joinder. In response, Mr. Mason suggested extending the trial schedules in the Apple IPRs to track any trial schedules determined for the Microsoft IPRs pursuant to 35 U.S.C. § 316(a)(11), which permits extending trial schedules “in the case of joinder under section 315(c).”

We next asked Mr. Devoto, counsel for Apple, whether Apple objected to joining either Microsoft or Microsoft and the TS 23.107 issues to the Apple IPRs, and what changes he suggested be made to the trial schedules in the Apple IPRs in the event we granted Microsoft’s petitions and motions for joinder. Mr. Devoto indicated that Apple takes no position on Microsoft’s joinder motions, and that Mr. Devoto would need to consult with his clients regarding any changes to the trial schedules in the Apple IPRs.

Lastly, we asked Mr. Mangrum, counsel for Uniloc, the same questions we asked of Mr. Devoto. Mr. Mangrum objected to joining

³ *QoS Concept and Architecture*, 3rd Generation Partnership Project, 3GPP TS 23.107 V3.5.0 (2000–12) (“TS 23.107”).

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Microsoft and the TS 23.107 issues to the Apple IPRs for the reasons discussed in Uniloc's oppositions to Microsoft's motions for joinder. *See* Paper 8. Mr. Mangrum further indicated that Uniloc would not object if Microsoft was simply added as a party to the Apple IPRs without adding any new issues regarding TS 23.107.

ORDER

Accordingly, for the reasons discussed above, it is hereby:

ORDERED that the Scheduling Order in IPR2019-00222 remains pending and in full effect; and

FURTHER ORDERED that the Scheduling Order in IPR2019-00252 remains pending and in full effect.

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