UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

IPR2019-00745
U.S. PATENT NO. 7,167,487

PATENT OWNER OPPOSITION TO MOTION FOR JOINDER

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I. INTRODUCTION

Four months after Apple filed two petitions challenging the '487 patent on November 12, 2018,[1] Microsoft filed two petitions of its own challenging the same patent on March 4, 2019.[2] Rather than seeking to join the Apple IPR, Microsoft argued its petitions "present [the] art in a different light and rel[y] on other art not cited in [Apple's] petitions." *See* Petitions at 8. On July 2, 2019, after trial was instituted in the Apple IPRs and after Uniloc filed its preliminary responses in the Apple IPRs and the Microsoft IPRs, Microsoft made an about face – insisting its petitions are not really *that* different from Apple's and should be joined to the Apple IPRs even though joinder will add new issues to the Apple IPRs. Microsoft's wait and see approach is a transparent attempt to game the system. Its joinder motions should be denied because Microsoft fails to show joinder of new issues to the Apple IPR is necessary to avoid prejudice to Microsoft. To the contrary, joinder will unduly prejudice Uniloc.

II. ARGUMENT

As the moving party, Microsoft has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). When determining whether to grant a motion for joinder, the Board considers factors including: (1) time and cost considerations, including the impact joinder would have on the trial schedule; and (2) how briefing and discovery may be simplified. *See* Order

[1] *See* IPR2019-00222 and IPR2019-00252 (referred to here as the "Apple IPRs").
[2] *See* IPR2019-00744 and IPR2019-00745 (referred to here as the "Microsoft IPRs").

Authorizing Motion for Joinder (Paper 15, 4), *Kyocera Corp. v. SoftView, LLC*, IPR2013-00004 (PTAB Apr. 24, 2013).

Even when a party seeks to join a nearly identical petition, joinder should not be granted as a matter of right. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b); 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Director is given discretion . . . over whether to allow joinder. This safety valve will allow the Office to avoid being overwhelmed if there happens to be a deluge of joinder petitions in a particular case.").

And when a party seeks to join new issues, joinder is granted "only in limited circumstances—namely, where fairness requires it and to avoid undue prejudice to a party." *Proppant Express Investments, LLC v. Oren Techs., LLC*, Case IPR2018-00914, Paper 38, p. 4 (Mar. 13, 2019) (designated: Mar. 13, 2019) (Precedential Opinion Panel decision).

Here, Microsoft's motion should be denied because joinder of new issues will unduly prejudice Uniloc and complicate briefing and discovery. Further, joinder of new issues is not necessary to avoid prejudice to Microsoft. Finally, the *General Plastic* factors weigh against institution and joinder

A. Joinder will *cause* rather than avoid undue prejudice.

Microsoft's motion should be denied under *Proppant* because joinder of Microsoft's new issues will *cause* rather than avoid undue prejudice to a party. *Proppant* explains that the Board will exercise discretion to join new issues to an existing proceeding "only in limited circumstances—namely, where fairness

requires it and to avoid undue prejudice to a party." *Proppant*, Case IPR2018-00914, Paper 38, p. 4. Circumstances leading to this "narrow exercise of [the Board's] jurisdiction may include, for example, actions taken by a patent owner in a co-pending litigation such as the late addition of newly asserted claims." *Id.* On the other hand, "the Board does not generally expect fairness and prejudice concerns to be implicated by, for example, the mistakes or omissions of a petitioner." *Id.*

1. Joinder will cause undue prejudice to Uniloc.

Joinder of new issues to the Apple IPRs will unduly prejudice Uniloc. Uniloc's patent owner responses in the Apple IPRs are due August 27, 2019. If Microsoft's joinder motions are granted, Uniloc will have less than one month to prepare its respective patent owner responses. In each Apple IPR, Uniloc will be required to not only respond to Apple's petition but Microsoft's distinct petition containing art presented "in a different light" and new art. As Microsoft acknowledges, this will also require Uniloc to: (1) address an addition expert report; (2) depose an additional expert; and (3) supplement its own expert testimony. *See* IPR2019-00744, Paper 7, p. 2, 11, 16-17; IPR2019-00745, Paper 7, p. 2, 11, 17. Less than one month is not "ample time" to do this, as Microsoft insists. There is a reason the scheduling orders entered in the Apple IPRs gave approximately three months after institution to accomplish these tasks.

Microsoft insists joinder will cause no prejudice because "Uniloc has already had significant time to consider the arguments presented in the March 4, 2019 Microsoft Petition[s]." *See* IPR2019-00744, Paper 7, p. 17; IPR2019-00745, Paper

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