UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORP.
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

IPR2019-01282
U.S. PATENT NO. 7,167,487

PATENT OWNER OPPOSITION TO MOTION FOR JOINDER

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I. INTRODUCTION

Petitioner's two IPRs against the '487 patent (IPR2019-01282 and IPR2019-01283) are the third and fourth IPRs filed against the same patent. Petitioner's petitions are cumulative of the first three petitions, filed by Apple Inc. (IPR2019-00222, IPR2019-00252) and Microsoft Corporation (IPR2019-00744, IPR2019-00745). Petitioner challenges the same claims as Apple and Microsoft. Further, Petitioner's references are identical to those asserted by Apple and, with the exception of the TS23.107 reference asserted by Microsoft for each ground, identical to the references asserted by Microsoft. Patent Owner requests that the Board exercise its discretion under 35 U.S.C. § 325(d) to reject Petitioner's petitions and joinder motions.[1]

II. ARGUMENT

Section 315(c) requires that a petition accompanying a request for joinder "warrants the institution of an inter partes review under section 314." 35 U.S.C. § 315(c). Here, the Board should exercise its discretion under 35 U.S.C. § 325(d) to reject Petitioner's petitions, and consequently its joinder motions, because the same prior art and arguments are pending before the Board in the Apple IPRs (IPR2019-00222 and IPR2019-00252) and the Microsoft IPRs (IPR2019-00744 and IPR2019-00745). Before Petitioner filed its petitions and joinder motions, the Board had already issued decisions for institution in the Apple IPRs. *See* IPR2019-00222,

[1] Patent Owner reserves the right to file a preliminary response more fully articulating the reasons for denying the petition. It files this opposition to preserve, to the extent necessary, certain arguments it may raise in its preliminary response.

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Paper 11 (June 4, 2019); IPR2019-00252, Paper 11 (June 4, 2019). Further, Patent Owner had already filed preliminary responses in the Apple IPRs and the Microsoft IPRs.

> Under 35 U.S.C. § 325(d),
>
> In determining whether to institute or order a proceeding under . . . chapter 31, the Director may take into 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.

In *Unified Patents, Inc. v. Personal Web Tech.*, the Board denied Unified Patents' petitions and joinder motions where there were already "multiple, overlapping petitions, each of which presented grounds of unpatentability based on [the same primary reference] for many of the same claims." *Unified Patents, Inc. v. Personal Web Tech., LLC,* IPR2014- 00702, Paper 13, p. 6 (PTAB 7/24/2014). The Board reasoned that the pending outcome of one IPR before the Federal Circuit "may render moot" the need to reach a final written decision regarding certain claims. *Id.* at 8. It further reasoned that:

> regardless of the outcome of [the IPR] before the Federal Circuit, each of the challenged claims is under review [in another IPR] and, if that trial were to proceed to a final written decision, a determination will be made as to whether [the claims challenged by Unified] are unpatentable as anticipated by, or obvious over, [the reference relied on by Unified].

Id. The same reasoning applies here. The Apple IPRs have already been instituted on the same claims challenged and the same references relied on by Petitioner.

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III. CONCLUSION

Taking into consideration the efficient administration of the Office under 35 U.S.C. § 316(b), the Board should exercise its discretion under 35 U.S.C. § 325(d) and deny Petitioner's petitions and joinder motions.

Date: August 1, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), we certify that we served an electronic copy of the foregoing document along with any accompanying exhibits via the Patent Review Processing System (PRPS) and email to Petitioner's counsel of record at the following address:

Lead Counsel	Robert Mattson	42850	cpdocketmattson@oblon.com
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Date: August 1, 2019

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