UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD
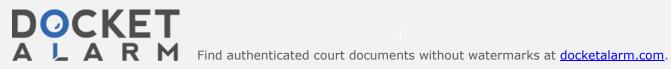
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APPLE INC.,
Petitioner

v.

UNILOC 2017 LLC,
Patent Owner

_____

Case No. IPR2020-00224
U.S. Patent No. 7,075,917

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)
TO RELATED *INTER PARTES* REVIEW IPR2019-00973**

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I.   STATEMENT OF THE PRECISE RELIEF REQUESTED

Apple Inc. ("Petitioner") respectfully submits this Motion for Joinder with a concurrently-filed Petition for *Inter Partes* Review of U.S. Patent No. 7,075,917 (the "Apple Petition"). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Microsoft Corporation v. Uniloc 2017 LLC*, IPR2019-00973 (the "Microsoft IPR"), which the Patent Trial and Appeal Board (the "Board") instituted on November 19, 2019. Petitioner's request for joinder is timely under 37 C.F.R. §§ 42.22 and 42.122(b), as it is submitted no later than one month after the November 19, 2019, institution date of the Microsoft IPR. The Apple Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Microsoft IPR. In addition, Petitioner is willing to streamline discovery and briefing.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Microsoft IPR while efficiently resolving the question of the '917 Patent's validity in a single proceeding.

II.   STATEMENT OF MATERIAL FACTS

1.   Petitioner previously filed an IPR against the '917 Patent challenging claims 1-3 and 9-10, for which institution was denied. *See Apple Inc. v. Uniloc 2017 LLC,* IPR2019-00259, Paper 7 (PTAB Jun. 27, 2019) ("Apple '259 IPR").

2. On April 19, 2019, Microsoft filed a petition for *inter partes* review challenging claims 1-3 and 9-10 (the "Challenged Claims") of the '917 Patent. *See Microsoft IPR*, IPR2019-00973, Paper 2 at 1.

3. On November 19, 2019, the Board instituted Microsoft's petition for *inter partes* review on all Challenged Claims. *See Microsoft IPR*, IPR2019-00973, Paper 7.

4. The '917 Patent has not and is presently not the subject of any district court litigation.

III.   STATEMENT OF THE PRECISE RELIEF REQUESTED

A.   Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). In deciding whether to exercise its discretion and permit joinder, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Ap. 24, 2013).

B. Petitioner's Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the November 19, 2019, institution decision of the Microsoft IPR. *See* 37 C.F.R. § 42.122(b). Further, the one-year bar set forth in 37 C.F.R. § 42.101(b) does not apply to the Apple Petition because Apple has not been sued in a district court proceeding on the '917 Patent. 37 C.F.R. §42.122(b).

C. Each Factor Weighs in Favor ofJoinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the Apple Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Microsoft Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an "understudy" role. *See Sony Corp., et al. v. Memory Integrity, LLC,* IPR2015-01353, Paper 11 at 5-6 (PTAB Oct. 15, 2015) (granting IPR where petitioners requested an "understudy" role); *see also id.* at Paper 4 at 5-7 (Motion for Joinder discussing "understudy" role). Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

Accordingly, joinder is appropriate here. *See id.* at Paper 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied "on the same

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