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Paper 11
Entered: February 3, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

GUI GLOBAL PRODUCTS, LTD., D/B/A GWEE,
Patent Owner.

IPR2021-01292
Patent 10,589,320 B1

Before SALLY C. MEDLEY, BRYAN F. MOORE, and SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314
Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 1–13 of U.S. Patent No. 10,589,320 B1 (Ex. 1001, "the '320 patent"). Paper 3 ("Pet."). GUI Global Products, Ltd., d/b/a Gwee ("Patent Owner") filed a Preliminary Response. Paper 10 ("Prelim. Resp."). Petitioner filed a Conditional Motion for Joinder with IPR2021-00338 ("the 338 IPR"). Paper 4 ("Mot."). Patent Owner filed a Response to Petitioner's Conditional Motion for Joinder, and Petitioner filed a Reply. Paper 8 ("PO Mot. Resp."); Paper 9 ("Pet. Mot. Reply"). Petitioner also filed a Notice Ranking And Explaining Material Differences Between Petitions. Paper 2 ("Not.").

We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

For the reasons described below, we do not institute an *inter partes* review of the challenged claims and deny Petitioner's Conditional Motion for Joinder.

II. RELATED MATTERS

The parties indicate this Petition is related to *GUI Global Prods, Ltd. d/b/a Gwee v. Samsung Elecs. Co.*, No. 4:20-cv-02624 (E.D. Tex.) and *GUI Global Prods, Ltd. d/b/a Gwee v. Apple, Inc.*, No. 4:20-cv-02652 (S.D. Tex.). Paper 6, 1–2; *see* Pet. 72. The parties indicate that the '320 patent is also the subject of the 338 IPR, as well as IPR2021-00473 ("the 473 IPR"), where Petitioner filed a petition challenging claims 1–5 and 7–13 of the '320 patent. Pet. 73, Paper 6, 2. In the 473 IPR, we instituted an *inter partes* review of claims 1–5 and 7–13 of the '320 patent. *Apple Inc. v. GUI Global*

Products, Ltd., *D/B/A Gwee*, IPR2021-00473, Paper 9 at 7–8, 39–40 (PTAB Aug. 13, 2021) ("473 Decision" or "473 Dec."). Thus, before us here is Petitioner's second petition for *inter partes* review. In accordance with the Consolidated Trial Practice Guide,[1] Petitioner filed a separate paper, identifying a ranking of its petitions and explaining the differences between the petitions. *See generally* Not.

In the 338 IPR, we instituted an *inter partes* review of claims 1–13 of the '320 patent on the following grounds:

Claim(s) Challenged	35 U.S.C §	Reference(s)/Basis
1–8	103(a)	Kim[2]
11	103(a)	Kim, Koh[3],
9, 10, 12, 13	103(a)	Kim, Lee[4]

Samsung et al. v. GUI Global Products, Ltd., D/B/A Gwee, IPR2021-00338, Paper 11 at 7–8, 42 (PTAB Jul. 2, 2021) ("338 Decision" or "338 Dec.").

II. DISCUSSION

The Petition in this proceeding asserts the same grounds of unpatentability as those upon which we instituted review in the 338 IPR.

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[1] Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), https://www.uspto.gov/TrialPracticeGuideConsolidated, 59–61 (explaining that the Board may exercise discretion under 35 U.S.C. § 314(a) to deny a petition(s) if it determines that more than one petition challenging claims of the same patent is not warranted) ("Trial Practice Guide" or "TPG").

[2] U.S. Pat. Appl. Pub. No. US 2010/0227642 A1, published September 9, 2010 (Ex. 1010, "Kim").

[3] Korean Pat. Pub. No. 10-2008-0093178, published October 21, 2008 (Ex. 1012, "Koh").

[4] U.S. Pat. Appl. Pub. No. US 2010/0298032 A1, published Nov. 25, 2010 (Ex. 1013, "Lee").

Compare Pet. 1–2, *with* 338 Dec. 7–8, 42. Indeed, Petitioner, Apple, contends that the Petition is "substantively equivalent to the petition instituted in" the 338 IPR. Pet. 1. Petitioner requests that we institute *inter partes* review and conditionally seeks joinder with the 338 IPR. Mot. 1. In the Motion, Petitioner seeks joinder "**if**, **and only if**, the Board has previously denied institution of *Apple Inc., v. GUI Global Products, Ltd.*, IPR2021-00473 ("the '473 Proceeding")." *Id*. at 1; *see* Not. 1. In its Reply, Petitioner revises its request stating, "Apple respectfully requests that the Board institute review of IPR2021-01292 and grant Apple's pending Motion if, and only if, the Board will align in time the issuance of final written decisions in the 338 Proceeding and the 473 Proceeding." Pet. Mot. Reply 2–3. Petitioner asserts that it is seeking alignment of the schedules in the 338 and 473 proceedings in order to avoid a potential prejudice from estoppel under 35 U.S.C. § 315(e)(1). *Id*. at 3.

"To join a party to an instituted IPR, the plain language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). First, we "determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* Second, if the petition warrants institution, we then "decide whether to 'join as a party' the joinder applicant." *Id.* Thus, before determining whether to join Petitioner as a party to the 338 IPR, we first determine whether the petition warrants institution under § 314(a).

The Director has discretionary authority under 35 U.S.C. § 314(a) to institute *inter partes* review and has delegated that authority to the Board. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018); 37 C.F.R. § 42.4(a). Patent Owner argues that "the Board should exercise its discretion and deny institution of trial," citing the Board's precedential

General Plastic[5] and *Uniloc*[6] decisions. Prelim. Resp. 3–4. Petitioner argues we should institute an *inter partes* review of the challenged claims. Pet. 74–78. For the reasons set forth below, we exercise our discretion to deny institution.

In *General Plastic*, the Board articulated a list of non-exclusive factors to be considered in determining whether to exercise discretion under § 314(a) to deny a petition:

> 1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
>
> 2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
>
> 3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
>
> 4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
>
> 5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
>
> 6. the finite resources of the Board; and
>
> 7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 16 (citing *NVIDIA Corp. v. Samsung Elec. Co.*, IPR2016-00134, Paper 9 at 6–7 (PTAB May 4, 2016)). *See also Uniloc* at

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[5] *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential) ("*General Plastic*").
[6] *Apple, Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2320) (precedential) ("*Uniloc*").

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