

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2019-00889
Patent 7,653,508 B1

Before SALLY C. MEDLEY, JOHN F. HORVATH, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Granting Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

A. Background

Samsung Electronics America, Inc. (“Petitioner” or “Samsung”) filed a Petition for *inter partes* review of claims 1–4, 6–8, 11–16, 19, and 20 of U.S. Patent No. 7,653,508 B1 (Ex. 1001, “the ’508 patent”). Paper 1 (“Pet.”), 1. Concurrently with its petition, Samsung filed a Motion for Joinder with *HTC Corp. v. Uniloc 2017 LLC*, Case IPR2018-01589 (“the HTC IPR”). Paper 3 (“Motion” or “Mot.”). Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response (Paper 9, “Prelim. Resp.”) and an Opposition to the Motion for Joinder (Paper 7, “Opposition” or “Opp.”). Samsung subsequently filed a Reply to the Opposition. Paper 8 (“Reply”). In its Reply, Petitioner stated that it “consents to limit its petition and joinder motion to claim 20.” *Id.* at 4.

For the reasons explained below, we institute an *inter partes* review of claim 20 of the ’508 patent, and grant Petitioner’s Motion for Joinder.

B. Real Parties-in-Interest

The statute governing *inter partes* review proceedings sets forth certain requirements for a petition for *inter partes* review, including that “the petition identif[y] all real parties in interest.” 35 U.S.C. § 312(a)(2); *see also* 37 C.F.R. § 42.8(b)(1) (requiring identification of real parties-in-interest in mandatory notices). The Petition identifies Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. as real parties-in-interest. Pet. 1. Patent Owner states that its sole real party-in-interest is Uniloc 2017 LLC. Paper 4, 1.

C. Related Matters

The parties indicate that the '508 patent is the subject of the several litigation proceedings:

Uniloc USA, Inc. v. Apple Inc., No. 2-17-cv-00522 (E.D. Tex. filed June 30, 2017),

Uniloc USA, Inc. v. Samsung Electronics America, Inc., No. 2-17-cv-00650 (E.D. Tex. filed Sept. 15, 2017),

Uniloc USA, Inc. v. LG Electronics USA, Inc., No. 4-12-cv-00832 (N.D. Tex. filed Oct. 13, 2017),

Uniloc USA, Inc. v. HTC America, Inc., No. 2-17-cv-01629 (W.D. Wash. filed Nov. 1, 2017),

Uniloc USA, Inc. v. Huawei Devices USA, Inc., No. 2-17-cv-00737 (E.D. Tex. filed Nov. 9, 2017),

Uniloc USA, Inc. v. Apple Inc., No. 4-18-cv-00364 (N.D. Cal. filed Jan. 17, 2018), and

Uniloc USA, Inc. v. LG Electronics USA, Inc., No. 4:18-cv-02918 (N.D.Cal. filed May 17, 2018).

Pet. 1–2; Paper 4, 2. The '508 patent is also the subject of several proceedings before the Board:

Apple Inc. v. Uniloc 2017 LLC, Case IPR2018-00387,

Apple Inc. v. Uniloc 2017 LLC, Case IPR2018-01026,

LG Electronics, Inc. v. Uniloc 2017 LLC, Case IPR2018-01577,

HTC Corp. v. Uniloc 2017 LLC, Case IPR2018-01589, and

Samsung Electronics America, Inc. v. Uniloc 2017 LLC, Case IPR2018-01756.

See Pet. 2; Paper 4, 2.

D. Procedural Posture

In the HTC IPR, we instituted an *inter partes* review of claim 20 of the '508 patent as being unpatentable under 35 U.S.C. § 103(a) in view of Pasolini¹ and Fabio.² Although HTC sought review of claims 1–4, 6–8, 11–16, 19, and 20 in the HTC IPR, we explained that only claim 20 would be reviewed:

Given that Petitioner is being joined as a party to [IPR2018-00387 (“the Apple IPR”)] and that “Petitioner[] agree[s] to proceed on the grounds, evidence, and arguments advanced, or that will be advanced, in the Apple IPR as instituted,” Petitioner is bound by the ultimate determination made in the Apple IPR regarding claims 1–4, 6–8, 11–16, and 19. *See* 35 U.S.C. §§ 315(e)(1), 325(d); 37 C.F.R. § 42.73(d)(1). Accordingly, Petitioner shall not advance any arguments regarding these claims in this proceeding; all grounds raised by Petitioner regarding these claims will be addressed in the Apple IPR. The parties are limited to advancing arguments regarding claim 20 in this proceeding.

HTC IPR, Institution Decision (IPR2018-01589, Paper 9, “HTC Decision” or “HTC Dec.”), 10 (all but first alteration in original).

A Final Written Decision in the Apple IPR issued on June 17, 2019. Apple IPR, Paper 21. In the Decision, we determined claims 1–4, 6–8, 11–16, and 19 of the '508 patent to be unpatentable. *Id.* at 49. As such, the HTC Petitioner is estopped from maintaining any challenges to claims 1–4, 6–8, 11–16, and 19 in the HTC IPR. *See* 35 U.S.C. § 315(e)(1); 37 C.F.R.

¹ US 7,463,997 B2 (filed Oct. 2, 2006, issued Dec. 9, 2008) (Ex. 1005, “Pasolini”).

² US 7,698,097 B2 (filed Oct. 2, 2006, issued Apr. 13, 2010) (Ex. 1006, “Fabio”).

§ 42.73(d)(1). The HTC IPR, therefore, is limited to the challenge of claim 20.

In its Reply, Petitioner stated that it “consents to limit its petition and joinder motion to claim 20.” Reply 4. We understand Petitioner to withdraw its challenges in the Petition regarding claims 1–4, 6–8, 11–16, and 19, and to withdraw its requests in the Motion to join any challenge to claims 1–4, 6–8, 11–16, and 19 to the HTC IPR. As such, the challenges to claims 1–4, 6–8, 11–16, and 19 are withdrawn from consideration in this proceeding. The sole ground of unpatentability remaining in dispute is the challenge to claim 20 as being unpatentable under 35 U.S.C. § 103(a) in view of Pasolini and Fabio.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same ground of unpatentability regarding claim 20 as asserted in the HTC IPR. *Compare* Pet. 16, *with* HTC IPR, Paper 1, 16 (“HTC Petition”). Indeed, Petitioner contends that the Petition “introduces identical arguments and the same ground[] raised in the existing HTC [IPR],” there are no new arguments for the Board to consider, and the Petitioner relies on the same exhibits and expert declaration as in the HTC IPR. Mot. 4–5.

We acknowledge Patent Owner’s arguments and evidence supporting its position that claim 20 would not have been obvious. Prelim. Resp. 34–38. Certain of Patent Owner’s arguments against the merits of the Petition have been previously addressed in the HTC Decision, and we need not address them here again. Certain other arguments against the merits of the Petition closely mirror arguments made in the Patent Owner Response filed

in the HTC IPR (*compare* Prelim. Resp. 34–38, *with* HTC IPR Paper 11, 15–19). Those common arguments will be fully considered in the HTC IPR after HTC has filed its Reply and Patent Owner has filed its Sur-Reply, and with the benefit of a complete record. In sum, based on the current record, Patent Owner’s arguments made in its Preliminary Response in this case do not persuade us that Petitioner has not demonstrated a reasonable likelihood of success in prevailing on the same ground as instituted in the HTC IPR.

III. MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of March 27, 2019. *See* Paper 6, 1. Thus, Petitioner’s Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the HTC IPR, i.e., February 27, 2019. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c):

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-

00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15); *see also* Office Patent Trial Practice Guide, July 2019 Update, 42.³

As noted, the Petition in this case asserts the same challenge to claim 20 as asserted in the HTC IPR. *See* Mot. 4–5. Samsung also relies on the same prior art analysis and expert testimony submitted by the HTC Petitioner. *See id.* Indeed, the Petition is nearly identical to the petition filed by the HTC Petitioner. *See id.* Thus, this *inter partes* review does not present any new ground or add any new matter to the HTC IPR.

If joinder is granted, Samsung anticipates participating in the proceeding in a limited capacity absent termination of the HTC Petitioner as a party. *Id.* at 6–8. “Samsung explicitly agrees to take an ‘understudy’ role . . . so long as the current petitioner in [the HTC IPR] remains an active party.” *Id.* at 6. Samsung further represents that it “presents no new issues or grounds of unpatentability” and that “joinder with the HTC IPR does not unduly burden or negatively impact the trial schedule.” *Id.* at 5–6; *see also* Reply 2 (“no new issues would be added to the HTC IPR because Samsung has merely filed a copy-cat petition against the *same* patent claim[] on the *same* unpatentability ground[] using the *same* expert declaration as that in the HTC IPR”).

Patent Owner presents several arguments opposing joinder. First, Patent Owner argues that because the Petition addresses claims 1–4, 6–8, 11–16, and 19, “Samsung is attempting to add *fourteen* claims to the HTC IPR.” Opp. 5. However, as noted above, Petitioner has withdrawn all

³ The Office Patent Trial Practice Guide, July 2019 Update, is available at <https://www.uspto.gov/sites/default/files/documents/trial-practice-guide-update3.pdf>.

challenges other than its challenge to claim 20. *See* Reply 4. As such, like the HTC Petitioner, if Samsung were to be joined to and take an active role in the HTC IPR, it too would be “limited to advancing arguments regarding claim 20.” *See* HTC Dec. 10.

Next, Patent Owner avers that “Samsung was served with a complaint alleging infringement of the ’508 patent on September 18, 2017,” and notes that the HTC Petition sought to join the Apple IPR. Opp. 6. Patent Owner argues that the Motion “is an untimely attempt to circumvent the deadline to join Apple’s IPR, and thereby circumvent the one-year bar to Samsung’s [P]etition.” *Id.* We do not agree with Patent Owner’s contentions for the same reasons as stated above. Petitioner has withdrawn all challenges other than its challenge to claim 20, which is not challenged in the Apple IPR, and Petitioner avers that it “is not seeking to join the Apple IPR. Instead, Samsung is simply seeking to join the HTC IPR.” Reply 2. Furthermore, because Petitioner filed the Motion concurrently with the Petition, the one-year time limit does not apply to the Petition. *See* 35 U.S.C. § 315(b) (“The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).”).

Next, Patent Owner argues that, “[u]nder [*SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018),] the Board ‘must address *every* claim the petitioner has challenged’ in a Final Written Decision.” Opp. 7 (citing *SAS*, 138 S. Ct. at 1354). Thus, Patent Owner asserts, Samsung cannot be joined to the HTC IPR because, although “HTC’s challenges will either be addressed in the HTC IPR or the Apple IPR[, t]hat is not the case for Samsung.” *Id.* However, as noted above, Petitioner has withdrawn all challenges other than its challenge to claim 20. *See* Reply 4. The sole ground of unpatentability

remaining in dispute is the challenge to claim 20, which will be addressed in the HTC IPR.

Next Patent Owner characterizes the Petition as a serial attack on the '508 patent and argues that “[a]llowing Samsung to now join the Apple IPR by way of HTC’s joinder petition will prejudice Patent Owner and obviate filing deadlines that Congress and the Patent Office saw fit to impose.”

Opp. 8. We are not persuaded by Patent Owner’s arguments because Samsung seeks to join the HTC IPR, not the Apple IPR. *See* Reply 2.

Finally, Patent Owner argues that “the joinder motion should be denied because it is an attempt to cure the deficiencies of its already-rejected, first-filed petition.” Opp. 9. According to Patent Owner, “[t]he Board has denied joinder under these circumstances even when the patent owner does not oppose the motion.” *Id.*; *see also id.* at n.2 (citing five Board decisions). We disagree with Patent Owner’s contentions. The Petition largely copies the HTC Petition (*see* Ex. 1007, 74–75), and Petitioner seeks to be joined as a party to the HTC IPR (*see* Mot. 1); *see also id.* at 2 (“The Samsung Petition and the Petition in the HTC IPR are substantially identical; they contain the same ground[] (based on the same prior art combinations and supporting evidence) against the same claim[.]”). Thus, the Petition does not seek to cure any deficiencies noted in Petitioner’s prior petition challenging the '508 patent (*see* IPR2018-01756). Nor are we persuaded by Patent Owner’s citation to prior Board decisions (*see* Opp. 9, n.2), all of which sought to add issues to an existing proceeding and none of which involved a “me too” petition such as in the present case.

For the foregoing reasons, we agree with Petitioner that joinder with the HTC IPR is appropriate under the circumstances. Accordingly, we grant Petitioner's Motion for Joinder.

IV. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review is instituted in IPR2019-00889;

FURTHER ORDERED that the Motion for Joinder with IPR2018-01589 is *granted*, and Samsung Electronics America, Inc. is joined as a petitioner in IPR2018-01589;

FURTHER ORDERED that IPR2019-00889 is terminated under 37 C.F.R. § 42.72, and all further filings shall be made only in IPR2018-01589;

FURTHER ORDERED that, subsequent to joinder, the grounds for trial in IPR2018-01589 remain unchanged;

FURTHER ORDERED that, subsequent to joinder, the Scheduling Order in place for IPR2018-01589 (Paper 10) remains unchanged;

FURTHER ORDERED that in IPR2018-01589, the HTC Petitioner and Samsung will file each paper, except for a motion that does not involve the other party, as a single, consolidated filing, subject to the page limits set forth in 37 C.F.R. § 42.24, and shall identify each such filing as a consolidated filing;

FURTHER ORDERED that for any consolidated filing, if Samsung wishes to file an additional paper to address points of disagreement with the HTC Petitioner, Samsung must request authorization from the Board to file a

motion for additional pages, and no additional paper may be filed unless the Board grants such a motion;

FURTHER ORDERED that the HTC Petitioner and Samsung shall collectively designate attorneys to conduct the cross-examination of any witness produced by Patent Owner and the redirect of any witness produced by the HTC Petitioner and Samsung, within the timeframes set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that the HTC Petitioner and Samsung shall collectively designate attorneys to present at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that the case caption in IPR2018-01589 shall be changed to reflect joinder of Samsung Electronics America, Inc. as a petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2018-01589.

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EXAMPLE CAPTION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, HTC AMERICA, INC., and
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Case IPR2018-01589¹
Patent 7,653,508 B1

¹ Samsung Electronics America, Inc., which filed a petition in IPR2019-00889, has been joined as a petitioner in this proceeding.