

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.
Petitioners

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. 7,653,508
Case IPR No.: *To Be Assigned*

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

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners HTC Corporation and HTC America, Inc. (together “HTC” or “Petitioners”) move for joinder with the *Inter Partes* Review of U.S. Patent No. 7,653,508 (“the ’508 patent”), *Apple Inc. v. Uniloc USA, Inc.*, IPR2018-00387 (“the Apple IPR”), for which trial was recently instituted on July 23, 2018. *See* IPR2018-00387, Paper 8. This motion is timely because it is filed within one month of institution of the Apple IPR. *See* 37 C.F.R. § 42.122(b). Petitioners understand that the petitioner in the Apple IPR (“the Apple Petitioner”) does not oppose Petitioners’ requests for joinder.

Petitioners request institution of the concurrently-filed Petition for *Inter Partes* Review. The Petition substantially copies the original Apple IPR petition. Substantive changes have only been made (1) to identify the correct Petitioners and the mandatory notices under 37 C.F.R. § 42.8(b) and (2) to add dependent claim 20 as a challenged claim. The concurrently-filed Petition challenges all of the claims in the Apple IPR petition and, because dependent claim 20 involves substantially similar limitations as dependent claims 3 and 13, the concurrently-filed Petition

presents the same grounds and relies on the same prior art and evidence, including a declaration nearly identical in substance from the same expert.¹

In addition to the arguments advanced for claim 20, Petitioners agree to proceed on the grounds, evidence, and arguments advanced, or that will be advanced, in the Apple IPR as instituted. Thus, the Petition warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Petitioners' joinder to the Apple IPR.

Further, if joined, Petitioners agree to adhere to all applicable deadlines in the Apple IPR and coordinate all filings with the Apple Petitioner in the Apple IPR. The Apple Petitioner will maintain the lead role in the proceedings so long as it is a party to the proceedings and is not estopped under § 315(e)(1). Petitioners will only assume the lead role in the proceedings if the Apple Petitioner is no longer a party to the proceedings or unable to advance arguments for one or more claims, or grounds, for example, because of § 315(e)(1). Petitioners agree to consolidated filings for all substantive papers in the proceeding. The Apple Petitioner and Petitioners will be jointly responsible for the consolidated filings. Absent a Board

¹ The declaration has been updated only to reflect retention by Petitioners and to incorporate the expert's analysis of claim 20 and is otherwise identical to the declaration submitted in the Apple IPR.

order precluding the Apple Petitioner from making arguments that would otherwise be available to Petitioners, Petitioners will not advance any arguments separate from those advanced by the Apple Petitioner in the consolidated filings. These limitations will avoid lengthy and duplicative briefing. Also, Petitioners will not seek additional depositions or deposition time, and will coordinate deposition questioning and hearing presentations with the Apple Petitioner. Petitioners agree to the foregoing conditions even in the event that other IPRs filed by other, third-party petitioners are joined with the Apple IPR.

Joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Apple IPR this Petition for all interested parties. Further, the Patent Owner has asserted the '508 patent in district court against HTC America, Inc. Joinder will estop HTC from asserting in district court those issues resolved in a final decision from the Apple IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2). Finally, joinder would not complicate or delay the Apple IPR, and would not adversely affect any schedule set in that proceeding. In sum, joinder would promote efficient adjudication in multiple forums. On the other hand, if instituted, maintaining the Petitioners' IPR proceeding separate from that of the Apple IPR would entail needless duplication of effort.

Joinder will not unduly prejudice any party. Because joinder will not add any new prior art or combinations thereof, delay the schedule, burden deponents, or increase needless filings, any additional costs on the Patent Owner would be minimal. On the other hand, denial of joinder would prejudice HTC. Its interests may not be adequately protected in the Apple IPR proceedings, particularly if the Apple Petitioner settles with the Patent Owner. Petitioners should be allowed to join in a proceeding affecting a patent asserted against them.

II. BACKGROUND AND RELATED PROCEEDINGS

Uniloc Luxembourg S.A. (the “Patent Owner”) is the owner of the ’508 patent. The Patent Owner asserted the ’508 patent against HTC in *Uniloc USA, Inc. v. HTC America, Inc.*, Case No. 2:17-cv-01629 (W.D. Wash. filed on Nov. 1, 2017) (consolidated with *Uniloc USA, Inc. v. HTC America, Inc.*, Case No. 2:17-cv-01558 (W.D. Wash.) (Lead case) on May 3, 2018). In addition, the Patent Owner asserted the ’508 patent against Huawei Device USA, Inc.; LG Electronics U.S.A., Inc., Samsung Electronics America, Inc.; and Apple Inc. (“Apple”). See *Uniloc USA, Inc. v. Huawei Device USA, Inc.*, 2:17-cv-00737 (E.D. Tex. filed on Nov. 9, 2017); *Uniloc USA, Inc. v. LG Elecs. U.S.A., Inc.*, Case No. 4:17-cv-00832-O (N.D. Tex. filed on Oct. 13, 2017) (transferred and is now *Uniloc USA, Inc. v. LG Elecs. U.S.A., Inc.*, Case No. 4:18-cv-02918-PJH (N.D. Cal. filed on May 17, 2018)); *Uniloc USA, Inc. v. Samsung Elecs. America, Inc.*, 2:17-cv-00650 (E.D. Tex. filed on Sept. 15,

2017); and *Uniloc USA, Inc. v. Apple Inc.*, 2:17-cv-00522 (E.D. Tex. filed on June 30, 2017) (transferred and is now *Uniloc USA, Inc. v. Apple Inc.*, 4:18-cv-00364 (N.D. Cal. filed on Jan. 17, 2018)). On December 22, 2017, Apple filed its IPR petition, IPR2018-00387, against the '508 patent. The Board instituted the Apple IPR on July 23, 2018. Petitioners timely move for joinder with the Apple IPR.

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v. Network-1 Sec. Solutions, Inc.*, IPR2013-00385, Paper 19, at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013- 00326, Paper 15, at 3-4; *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15, at 3-4. “The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” *Dell*, IPR2013-00385, Paper 19, at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should:

(1) set forth the 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.

Dell, IPR2013-00385, Paper 19, at 4.

B. Joinder will not add any new grounds of unpatentability or have an impact on the trial schedule.

The Petition is based on the same grounds and combinations of prior art that the Board considered in deciding to institute the Apple IPR. For simplicity and efficiency, Petitioners have copied the substance of Apple’s petition and accompanying expert declaration. Petitioners also request that the Board’s *inter partes* review be extended to include claim 20 of the ’508 patent. But, because of the substantial similarity between claim 20 and claims 3 and 13, Petitioners do not seek to introduce new grounds or arguments.²

Instituted claims 3 and 13	claim 20
3. The method of claim 1, further comprising: [3.1] maintaining a cadence window, wherein the cadence window is continuously updated as an actual cadence changes; and	20. The device of claim 19, wherein [20.1] the cadence logic adjusts the cadence windows based on a measured cadence associated with the periodic human motion.

² Because claim 20 depends from claim 19, which was challenged in the Apple IPR, no additional argument related to the preamble of claim 20 is necessary.

[3.2] counting a periodic human motion when an acceleration measurement that meets motion criteria is within the cadence window.

13. The device of claim 11, further comprising:

[13.1] a cadence logic to continuously update a dynamic cadence window; and

[13.2] the counting logic to count a periodic human motion when an acceleration measurement that meets motion criteria is taken within the cadence window.

As seen above, claim elements 13.1 and 20.1 both require a “cadence logic.” The Apple IPR petition shows where the prior art discloses a “cadence logic” with regard to instituted claims 13 and 19. *See Apple*, IPR2018-00387, Paper 8 at 59-60, 69. And claim elements 3.1 and 20.1 both require a “cadence window” to be “updated”/“adjusted” based on “an actual cadence”/“measured cadence associated with the periodic human motion.” The Apple IPR petition also demonstrates (with regard to instituted claim 3 that the “cadence window” is continuously updated and, therefore, adjusted. *See id.* at 64-65. Moreover, the ’508 patent does not differentiate between an “actual cadence” and a “measured cadence.” For example, the ’508 patent discloses that a “cadence window may be set based on the period and/or cadence of the actual motion cycle (e.g., a stepping period).” ’508 patent at

3:67-4:2. The “period and/or cadence” is determined by measured data. *See id.* at 11:14-15 (“The cadence window may be set based on previous measurement data.”). Accordingly, the same prior art that discloses a cadence window “updated as an actual cadence changes” similarly discloses a cadence window “adjust[ed] . . . based on a measured cadence.”³

Petitioners have also retained the same expert, who has submitted an identical declaration for all claims challenged in the Apple IPR and has provided a an analysis for claim 20 that recites substantially similar grounds and arguments used for claims 3 and 13. The Patent Owner should not require any discovery beyond that which it may need in the Apple IPR—nor should the Board permit any. The Petition presents no new substantive issues relative to the Apple IPR and does not seek to broaden the scope of the Apple IPR beyond the addition of claim 20.

For efficiency’s sake, Petitioners will:

1. Adhere to all applicable deadlines in the Apple IPR;

³ Claim 13 also requires “a cadence logic to continuously update a dynamic cadence window.” The Board’s institution decision noted that claim 13 “recites similar limitations” to claim 3 although the claim language is not identical. *Apple*, IPR2018-00387, Paper 8 at 26.

2. Submit “consolidated” filings with the Apple Petitioner, as set forth above in the statement of precise relief requested;
3. Refrain from requesting or reserving any additional depositions or deposition time;
4. Refrain from requesting or reserving additional oral hearing time; and
5. Assume a second-chair role as long as the Apple Petitioner remains in the proceeding.⁴

In view of these provisions, joinder should not affect the trial schedule.

C. Joinder will promote efficiency by consolidating issues, avoiding wasteful duplication, and preventing inconsistency.

Petitioners present identical arguments and supporting evidence as the Apple IPR. Joinder will simplify briefing and discovery. Given that the Apple IPR and the Petition address the same prior art and grounds for rejection, joining these proceedings allows for joint submissions and discovery, further streamlining the

⁴ These limitations are consistent with previously granted joinder motions. *See, e.g., Enzymotech Ltd. v. Neptune Techs.*, IPR2014-00556, Paper 19 (July 9, 2014) (agreeing to procedural concessions, such as “consolidated” responses); *Gillette Co. v. Zond*, IPR2014-01016, Paper 13 (Nov. 10, 2014) (same); *SAP Am. Inc. v. Clouding IP, LLC*, IPR2014-00306, Paper 13 (May 19, 2014) (same).

proceedings. This should promote efficiency and conserve the Board's and the parties' resources. Further, joinder will estop HTC from asserting in district court those issues resolved in a final written decision in the Apple IPR, thus narrowing the issues in the district court actions. *See* 35 U.S.C. § 315(e)(2).

D. Joinder is Appropriate

The Board has previously stated that it is “mindful of a policy preference for joining a party that does not present new issues.” *Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.* IPR2014-00556, Paper No. 19 at 6 (July 9, 2014) (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“The Office anticipates that joinder will be allowed as of right – if an inter partes review is instituted on the basis of a petition, for example, a party that files an identical petition will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.”)). Here, because Petitioners seek institution solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Apple IPR, institution is warranted under 35 U.S.C. § 314 and Petitioners' joinder to the Apple IPR is appropriate under 35 U.S.C. § 315(c). No new grounds of unpatentability are asserted. As explained above, joinder would not adversely impact the trial schedule, briefing, or discovery in the Apple IPR, and the remaining equities compel joinder.

Petitioners are filing this Petition and joinder motion to ensure that the trial is completed in the event that the Apple Petitioner reaches settlement with the Patent Owner.

1. Joinder will not unduly prejudice any party.

The Petition raises issues already before the Board and long known to the Patent Owner. Addressing patent validity in this proceeding, well on its way towards a final determination, serves the parties' and Board's interests.

2. Uniloc will not be subject to an undue additional burden to address claim 20.

The Board has previously joined petitions that included challenges to different claims where the joinder petition “presents substantially similar arguments and evidence as presented in the [instituted IPR],” and where “any differences are not substantial enough to impose an undue burden on [the Patent Owner] beyond its existing burden in the [instituted IPR].” *See Facebook Inc. v. Windy City Innovations, LLC*, IPR2017-00709, Paper 11, at 8 (PTAB Aug. 1, 2017). As shown above, the difference between the claim language in claims 3, 13, and 20 is “sufficiently minor such that it would not unduly burden [Uniloc] to analyze and address it.” *Id.* at 8. Moreover, the concurrently-filed Petition maps dependent claim 20 to Pasolini and/or Fabio, which are the same prior art references used in the Apple IPR for claims 3 and 13. *See* Pet. at 72-73. And the grounds and expert testimony

cited in support thereof for claims 3 and 13 are substantially similar to those for claim 20. Accordingly, the Patent Owner will bear the same burden to defend claims 3 and 13 as it will defending claim 20.

3. Without joinder, HTC will be prejudiced.

A denial of joinder would prejudice HTC. Its substantial interests, as a party against whom the '508 patent has been asserted in a federal district court action, may not be adequately protected by the Apple Petitioner in the Apple IPR proceedings. For example, HTC has an interest that the Apple IPR reach a final determination to facilitate a timely and cost-effective end to the controversy between HTC and the Patent Owner. HTC should be allowed to join in a proceeding affecting a patent asserted against it.

IV. CONCLUSION

Joinder will not affect the substance, procedure, or scheduling of the Apple IPR. Petitioners file this motion under the statutory joinder provisions as contemplated by the Leahy-Smith America Invents Act (AIA). Joinder will simplify the issues and promote efficiency, justice, and speed.

For the foregoing reasons, Petitioners respectfully request *inter partes* review of U.S. Patent No. 7,653,508 and joinder with *Apple Inc. v. Uniloc USA, Inc.*, IPR2018-00387.⁵

Dated: August 23, 2018

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/Todd E. Landis/

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⁵ Although no fee is believed to be required, the Commissioner is authorized to charge any additional fees required for this Motion to Deposit Account No. 220365.

CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105, the foregoing MOTION FOR JOINDER TO *INTER PARTES* REVIEW (35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)) is being served via overnight mail on the 23rd day of August 2018, the same day as the filing of the above-identified documents in the United States Patent and Trademark Office/Patent Trial and Appeal Board, upon the Patent Owner by serving the correspondence address of record with the USPTO as follows:

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Dated: August 23, 2018

/Todd E. Landis/

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