Filed: January 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

GESTURE TECHNOLOGY PARTNERS LLC,
Patent Owner

Case No. IPR2022-00362
U.S. Patent No. 8,878,949

MOTION FOR JOINDER TO *INTER PARTES* REVIEW
IPR2021-00921

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Google LLC ("Petitioner" or "Google") respectfully submits this Motion for Joinder concurrently with a Petition ("the Google petition") for *inter partes* review of U.S. Patent No. 8,878,949 ("the '949 patent").

Pursuant to 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), Google requests institution of the concurrently filed Petition for *inter partes* review and joinder with *Apple Inc. v. Gesture Technology Partners LLC*, IPR2021-00921 ("the Apple IPR" or "the Apple proceeding"), which the Board instituted on December 13, 2021, and concerns the same claims 1–18 of the '949 patent. This request is being submitted within the time set forth in 37 C.F.R. § 42.122(b).

Google submits that the request for joinder is consistent with the policy surrounding *inter partes* reviews, as it is the most expedient way "to secure the just, speedy, and inexpensive resolution of every proceeding." *See* 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC*., IPR2017-00512, Paper No. 12 at 5–6 (June 1, 2017). The Google petition and the Apple IPR are substantively identical; they contain the same grounds (based on the same prior-art combinations and supporting evidence) against the same claims (*See* Ex. 1018, illustrating changes between the instant Petition and the Petition in IPR2021-00921.) Further, upon joining the Apple proceeding, Google will act as an "understudy" and

will not assume an active role unless the current petitioner ceases to participate in the instituted IPR. Accordingly, the proposed joinder will neither unduly complicate the Apple IPR nor delay its schedule. As such, the joinder will promote judicial efficiency in determining the patentability of the '949 patent without prejudice to Patent Owner. Apple does not oppose this motion for joinder.

II. STATEMENT OF MATERIAL FACTS

1. The '949 patent is or was at issue in the following patent infringement actions: Case Nos. 6:21-cv-00123 (W.D. Tex.) (transferred to District of New Jersey as case number 2:21-cv-19234 (D.N.J)); 6:21-cv-00121 (W.D. Tex.)[1]; 6:21-cv-00122 (W.D. Tex.)[2]; and consolidated cases 2:21-cv-00040 (E.D. Tex.) (defendant Huawei dismissed with prejudice); and 2:21-cv-00041 (E.D. Tex.).

[1] The court granted Apple Inc.'s motion to stay pending the final written decision on the *inter partes* review of the asserted patents. *Gesture Technology Partners, LLC v. Apple Inc.*, No. 6:21-cv-00121 (W.D. Tex. Dec. 29, 2021).

[2] The court granted a motion to dismiss the case against Lenovo (United States) Inc. and Motorola Mobility LLC for improper venue. *Gesture Technology Partners, LLC v. Lenovo Group Ltd. et al.*, No. 6:21-cv-00122, Dkt. 43 (W.D. Tex. Dec. 29, 2021). The remaining defendant in that case—Lenovo Group Ltd.—was not served. Id. at 1 n.1.

2. On June 2, 2021, Apple Inc. filed a petition for *inter partes* review (IPR2021-00921) requesting cancellation of claims 1–18 of the '949 patent.

3. On December 13, 2021, the Board instituted the Apple petition for *inter partes* review as to all challenged claims and all grounds.

4. The Google petition and the Apple IPR are substantially identical; they contain the same grounds (based on the same prior-art combinations and supporting evidence) against the same claims (*See* Ex. 1018.)

5. The '949 patent is or was also at issue in another IPR proceeding: Case No. IPR2022-00092. On November 5, 2021, LG Electronics, Inc., and LG Electronics U.S.A., Inc., concurrently filed a petition for inter partes review (IPR2022-00092) requesting cancellation of claims 1–18 of the '949 patent and a motion for joinder to IPR2021-00921.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

Pursuant to 35 U.S.C. § 315(c), the Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. The Board, in determining whether to exercise its discretion to grant joinder, considers (1) "why joinder is appropriate"; (2) "whether a new ground of unpatentability is raised in the second petition"; (3) "how the cost and schedule of the first proceeding will be impacted if joinder is granted"; and (4) "whether granting joinder will add to the

complexity of the briefing and/or discovery." Consolidated Trial Practice Guide 76 (Nov. 2019); *see also Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); *Dell, Inc. v. Network-1 Security Sols., Inc*., IPR2013-00385, Paper 17 at 3 (PTAB July 29, 2013).

B. Each of the Factors Weighs in Favor of the Board Granting the Motion for Joinder

All four factors weigh in favor of granting Google's motion for joinder. The Google petition is substantively identical to the petition in the Apple IPR. Google does not present any new grounds of unpatentability. Additionally, as all issues are substantively identical and Google will act as an "understudy," joinder will have minimal or no impact on the pending schedule of the Apple IPR. *See Sony Corp., et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (Oct. 5, 2015) (granting motion for joinder where petitioners requested an "understudy" role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Apple IPR Is Appropriate

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (Aug. 24, 2016) (internal citations omitted). Here joinder with the Apple IPR is appropriate because the Google petition introduces identical arguments and the same

grounds raised in the existing Apple proceeding (i.e., it challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Apple petition). Other than minor differences, such as differences related to formalities of a different party filing the petition and an analysis of *Fintiv* factors, there are no changes to the facts, citations, evidence, or arguments introduced in the Google petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Apple IPR so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of the Google and Apple petitions in a single proceeding.

2. Petitioner Does Not Propose New Grounds of Unpatentability

The Google petition is substantively identical to the petition in the Apple IPR (i.e., challenging the same claims of the same patent, relying on the same expert declaration, and on the same grounds and combinations of prior art submitted in the Apple petition). *See Sony*, IPR2015-01353, Paper 11 at 5–6 (Oct. 5, 2015) (granting institution of IPR and motion for joinder where petitions relied "on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration"); *see also Par Pharm., Inc., v. Novartis AG*, IPR2016-01023, Paper 20 at 14 (Oct. 27, 2016) (granting motion for joinder where petitioners "do not assert any new ground of unpatentability that is not already being

considered in [an instituted IPR proceeding], relying on the same arguments and evidence, and do not require any modification to the existing schedule").

3. Joinder will Not Negatively Impact the Apple IPR Trial Schedule

Joinder will have minimal impact, if any, on the Apple IPR trial schedule because the Google petition presents no new issues or grounds of unpatentability. *See Sony Corp.*, IPR2015-01353, Paper 11 at 6 (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Further, Petitioner explicitly consents to the existing trial schedule. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

Patent Owner's Response will also not be negatively impacted because the issues presented in the Google petition are identical to the issues presented in the Apple petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the petition in the Apple IPR. Also, because the Google petition relies on the same expert and the same declaration, only a single deposition is needed for the proposed joined proceeding.

Accordingly, joinder with the Apple IPR does not unduly burden or negatively impact the trial schedule.

4. Procedures To Simplify Briefing and Discovery

Google explicitly agrees to take an "understudy" role, which will simplify briefing and discovery. Specifically, Google explicitly agrees, upon joining the Apple proceeding, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as the current petitioner in IPR2021-00921 remains an active party:

a. all filings by Google in the joined proceedings will be consolidated with the filings of the current petitioner, unless a filing concerns issues solely involving Google;

b. Google shall not be permitted to raise any new grounds not already instituted by the Board in the Apple IPR, or introduce any argument or discovery not already introduced by the current petitioner;

c. Google shall be bound by any agreement between Patent Owner and the current petitioner concerning discovery and/or depositions; and

d. at deposition, Google shall not receive any direct, cross examination, or redirect time beyond that permitted under 37 C.F.R. § 42.53 or any agreement between Patent Owner and the current petitioner.

See Noven Pharm, Inc. v. Novartis AG, IPR2014-00550, Paper No. 38 at 5 (Apr. 10, 2015). Unless and until the current petitioner ceases to participate in the instituted IPR proceeding, Google will not assume an active role therein.

Thus, by Google accepting an "understudy" role, Patent Owner and the current petitioner can comply with the existing trial schedule without needing any duplicative efforts by the Board or Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See Sony Corp.*, IPR2015-01353, Paper 11 at 6–7 (granting IPR and motion for joinder because "joinder would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the Board" where petitioners agreed to an "understudy" role). Google is further willing to agree to any other reasonable conditions the Board deems necessary.[3]

[3] Google further notes that a joinder petition in these circumstances is not the type of serial petition to which a *General Plastic*'s analysis applies as there is no strategic advantage to be gained by filing this additional petition, and there are no concerns of "road mapping" the Patent Owner's strategy because Petitioner has submitted a petition that is substantively identical to Apple's petition. *See AT&T Services, Inc. v. Broadband iTV, Inc*., IPR2021-00649, Paper 12 at 7-17 (August 25, 2021) (instituting IPR on a "me-too" petition despite being filed after the PTAB's institution decision on the primary petition.).

IV. CONCLUSION

Based on the factors discussed above, Google respectfully requests that the Board grant institution of the Google petition and grant joinder with the Apple IPR.

Dated: January 10, 2021

Respectfully submitted,

By: /Erika H. Arner/
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COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on January 10, 2022, a copy of the foregoing **Motion for Joinder to *Inter Partes* Review IPR2021-00921** was served by FedEx Priority Overnight on the correspondence address of record indicated in the Patent Office's public PAIR system for U.S. Patent No. 8,878,949:

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Further, a courtesy copy of the foregoing was also sent via email to Patent Owner's litigation counsel:

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