UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SPEIR TECHNOLOGIES LTD.,
Patent Owner

Case IPR2023-00305
Patent No. 7,321,777

PETITIONER'S CONDITIONAL MOTION FOR JOINDER

I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Apple Inc. ("Apple" or "Petitioner") **conditionally moves** for joinder with the *inter partes* review instituted against U.S. Patent No. 7,321,777 ("the '777 Patent") in *Unified Patents, LLC v. Speir Technologies Ltd.*, IPR2022-00987 ("the Unified Proceeding"). This motion is timely filed no later than one month after the Board's institution decision in the Unified Proceeding on November 9, 2022.

More specifically, Apple respectfully requests that the Board institute review in this proceeding (IPR2023-00305) and grant this joinder motion **if**, **and only if**, the Board has previously denied institution in *Apple Inc., v Speir Technologies Ltd.*, IPR2022-01512 ("the Apple Proceeding"). Conversely, if the Board institutes review in the Apple Proceeding, Apple withdraws this motion. Apple makes this request to ensure that it is a named petitioner in one—**and only one**—instituted *inter partes* review proceeding. In this way, consistent with the Board's policy goals, Apple seeks a fair and efficient resolution to its dispute with Patent Owner.

To be clear, Apple prefers and requests initial consideration of its petition ("Original Petition") in the Apple Proceeding. Apple's Original Petition includes two distinct sets of grounds based on different primary references against all 25 of the '777 patent's claims, where the Joinder Petition leaves claim 4 unchallenged and relies on a single primary reference. Each ground of the Original Petition provides

a compelling case of obviousness based on prior art and arguments that the Office has not yet considered. The '777 patent's claims—allowed without a single narrowing amendment—were not examined thoroughly during prosecution, and Patent Owner asserted these unvetted claims against Apple. Accordingly, Apple has a strong interest in prosecuting a case of unpatentability at the PTAB.

Even setting aside Apple's interests, instituting review in the Apple Proceeding would promote efficiency for all—the parties, the Board, and the District Court. For one, institution of the Apple Proceeding would trigger Apple's contingent stipulation stated in the Original Petition:

> [Apple] will not pursue in the Litigation invalidity challenges against the '777 patent that are the same as Grounds 1-5 in this [Original] Petition or the same as Grounds 1-[5] in the Unified Petition."[1]

Moreover, institution could preclude or abridge a jury trial on validity by encouraging a stay and/or leading to a final written decision that estops Apple under 35 U.S.C. § 315(e)(2) from asserting certain printed publication grounds in the Litigation. The scope of the estoppel would be broader if the Apple Proceeding is instituted and proceeds to a final decision than if Apple is merely joined to the Unified Proceeding. *See Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1026-28 (Fed. Cir. 2020) (finding the scope of estoppel narrowed when a

[1] *Speir Technologies Ltd. v. Apple Inc.*, Case 6:22-cv-00077-ADA (WDTX).

petitioner was limited to joining an instituted proceeding).

Notably, the pace of the Litigation has slowed since Apple filed its Original Petition. The *Markman* hearing and significant discovery deadlines are now delayed by multiple months, increasing the likelihood that the Board's statutory deadline for issuing a final written decision in the Apple Proceeding will precede any jury trial. EX1104, EX1105. Finally, Apple sought to conserve resources for all by challenging a related patent[2]—U.S. Patent No. 7,110,779 in Case No. IPR2023-00151—using similar prior art and arguments from its Original Petition against the '777 patent. Given the substantive overlap between these related patents and parallel *inter partes* review proceedings, it would be most efficient for them to proceed on aligned schedules.

However, if the Board were to decline to institute review in the Apple Proceeding, the next best course of action would be to institute review here and grant this motion for joinder with the Unified Proceeding. As with the Apple Proceeding (albeit to a lesser extent), institution and joinder would promote efficiency in the Litigation and would do so at no expense or prejudice to Patent Owner. On the other hand, if the Board were to deny Apple any opportunity to participate in *inter partes* review, Apple would have no choice but to pursue its printed publication invalidity

[2] Patent Owner amended its complaint in the Litigation to include this patent.

defenses in the Litigation, separate and apart from the already-instituted Unified Proceeding. The Board should avoid this scenario, as it departs from the congressional objective that AIA proceedings serve as "a less-expensive alternative to district court litigation to resolve certain patentability issues." *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 28 (PTAB Oct. 17, 2022).

Under the specific circumstances on which this conditional motion is premised, joinder would help efficiently resolve the parties' disputes without undue prejudice. As such, if the Board were to deny institution in the Apple Proceeding, Apple respectfully submits that it should be allowed to join the Unified Proceeding in an "understudy" role. *See Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 at 4-6 (PTAB Jul. 29, 2013) ("*Dell*").

II. BACKGROUND AND RELATED PROCEEDINGS

Speir Technologies Ltd. is the purported owner of the '777 Patent. Speir asserted the '777 Patent and related U.S. Patent No. 7,110,779 against Apple in *Speir Technologies Ltd. v. Apple Inc.*, Case 6:22-cv-00077-ADA (WDTX). Speir asserted the same patents against Samsung in *Speir Technologies Ltd. v. Samsung Electronics Co., Ltd*. et al., Case 2:21-cv-00474 (EDTX), which is now settled and terminated.

On May 27, 2022, Unified Patents, LLC petitioned for *inter partes* review of the '777 patent in the Unified Proceeding (IPR2022-00987). On September 9, 2022, entirely independent of Unified and based on different prior art, Apple petitioned for

review of the '777 patent in the Apple Proceeding (IPR2022-01512). Apple also petitioned for review of the related '779 patent on November 30, 2022, which Unified has not challenged. Apple now seeks joinder to the Unified Proceeding challenging the '777 patent **if**, **and only if**, the Board denies institution in the Apple Proceeding challenging that same patent.

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

The Board has discretion to join a party that properly files an *inter partes* review petition to an existing instituted proceeding addressing the same patent. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell* at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15 at 3-4 (PTAB Sep. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 3-4 (PTAB Feb. 25, 2013). "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* at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). A motion for joinder should:

> [A] set forth the reasons why joinder is appropriate; [B] identify any new grounds of unpatentability asserted in the petition; [C] explain what impact (if any) joinder would have on the trial schedule for the existing review; and [D] address specifically how briefing and discovery may be simplified.

Dell at 4.

A. The Statutory Requirements Are Satisfied, and Joinder Would Properly Balance the Parties' Interests

If, and only if, the Board denies intuition in the Apple Proceeding, Apple requests institution of the concurrently filed petition for *inter partes* review ("the Joinder Petition") and submits that joinder with the Unified Proceeding would be appropriate. The challenge raised against the '777 patent in the Joinder Petition is materially the same as that of the petition filed to initiate the Unified Proceeding. The Joinder Petition and the petition in the Unified Proceeding challenge the same claims based on the same prior art grounds and evidence, including an identical declaration from the same expert.[3]

Apple agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Unified Proceeding as instituted. The Joinder Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Apple's joinder to the Unified Proceeding.

Upon joining the Unified Proceeding, Apple will act as an "understudy" and will not assume an active role unless the current petitioner ceases to participate in the Unified Proceeding. The current petitioner will maintain the lead role so long as the current petitioner remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Apple also will not seek additional depositions or

[3] The declaration is an exact duplicate of the declaration in the Unified Proceeding.

deposition time. Apple further agrees to the foregoing conditions even in the event that other third-party petitioners are joined with the Unified Proceeding. The proposed joinder will neither unduly complicate the Unified Proceeding nor delay its schedule.

Joinder also will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional cost to Patent Owner would be minimal. On the other hand, denial of joinder **would** prejudice Apple. Apple's interests may not be adequately protected in the Unified Proceeding, particularly if the current petitioner settles with Patent Owner.

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 (PTAB Aug. 24, 2016) (cleaned up) (emphasis added). Here, joinder with the Unified Proceeding is appropriate because Apple's Joinder Petition introduces **identical** unpatentability arguments and the **same** grounds raised in the petition of the Unified Proceeding with no material changes to the facts, citations, evidence, or analysis. Because these proceedings introduce identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive

resolution" of this proceeding and the Unified Proceeding.

B. Joinder Would Not Add Any New Grounds of Unpatentability

Apple's Joinder Petition is based on the same grounds and combinations of prior art in the Unified Proceeding. For simplicity and efficiency, Petitioner has copied the substance of the petition in the Unified Proceeding and its accompanying expert declaration. Petitioner does not seek to introduce grounds or claims not currently in the Unified Proceeding and seeks only to join the proceeding as instituted. Patent Owner should not require any discovery beyond that which it may need in the Unified Proceeding—nor should the Board permit any. The present Joinder Petition introduces no new substantive issues relative to the Unified Proceeding and does not seek to broaden the scope of the Unified Proceeding.

C. Joinder Would Not Impact the Unified Proceeding's Trial Schedule

Joinder will not impact the Unified Proceeding's trial schedule because Apple's Joinder Petition presents no new issues or grounds of unpatentability. *See Sony Corp., et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting a motion where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Indeed, Apple expressly consents to the existing trial schedule in the Unified Proceeding.

Patent Owner's post-institution Response and Sur-Reply will not be negatively impacted because the substantive issues presented in the Joinder Petition are identical to the issues presented in the Unified Proceeding. 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 Unified Proceeding. Also, because Apple's Joinder Petition relies on the same expert declaration, only a single deposition is needed for the proposed joined proceeding.

For all these reasons, Apple's joinder with the Unified Proceeding would not unduly burden or negatively impact the trial schedule.

D. Procedures to Simplify Briefing and Discovery

Apple expressly agrees to take an "understudy" role, which would simplify briefing and discovery. Specifically, Apple expressly agrees, upon joining the Unified Proceeding, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as the current petitioner remains an active party:

a) all filings by Apple in the Unified Proceeding shall be consolidated with the filings of the current petitioner, unless a filing concerns issues solely involving Apple;

b) Apple shall not be permitted to raise any new grounds not instituted by the Board in the Unified Proceeding, or introduce any argument or

discovery not introduced by the current petitioner;

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

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

See Noven Pharmaceuticals, Inc. v. Novartis AG, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015). Unless and until the current petitioner ceases to participate, Apple will not assume an active role in the Unified Proceeding.

Thus, by Apple accepting an "understudy" role, the parties can comply with the trial schedule assigned to the Unified Proceeding without duplicative efforts. These steps minimize the possibility of any complication or delay from joinder. *See Sony*, IPR2015-01353, Paper 11 at 6-7 (granting a motion for joinder where petitioner agreed to an "understudy" role 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"). Apple is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. CONCLUSION

For the foregoing reasons, Apple respectfully requests **if**, **and only if**, the Board has previously denied institution of the Apple Proceeding, that the Board institute review in this proceeding (IPR2023-00305) and grant this motion for joinder with the Unified Proceeding (IPR2022-00987).

Respectfully submitted,

Dated: December 9, 2022

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(Control No. IPR2023-00305)

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on December 9, 2022 a complete and entire copy of this Motion for Joinder was provided via email to the Patent Owner by serving the correspondence email addresses of record as follows:

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