Trials@uspto.gov
571-272-7822

Paper 16
Date: August 19, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

EXPRESS MOBILE, INC.,
Patent Owner.

IPR2022-00598
Patent 6,546,397 B1

Before JEFFREY S. SMITH, MITCHELL G. WEATHERLY, and DANIEL J. GALLIGAN, *Administrative Patent Judges.*

GALLIGAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Google LLC ("Petitioner") filed a Petition requesting *inter partes* review of claim 1 of U.S. Patent No. 6,546,397 B1 ("the '397 patent," Ex. 1001). Paper 1 ("Pet."). Petitioner also filed a Motion for Joinder seeking to be joined as a party to *Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01224 ("the Facebook IPR"), which involves the same claim of the '397 patent. Paper 3 ("Motion" or "Mot.").

Express Mobile, Inc. ("Patent Owner") opposed the Motion (Paper 8 ("Opposition" or "Opp.")),[1] and Petitioner filed a reply in support of the Motion (Paper 9).

Patent Owner also filed a Preliminary Response. Paper 10 ("Prelim. Resp.").

For the reasons explained below, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the Facebook IPR and grant Petitioner's Motion for Joinder.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including the Facebook IPR, which involves the '397 patent, including *Express Mobile, Inc. v. Google LLC*, No. 6-20-cv-00804 (W.D. Tex.) (transferred to No. 3-21-cv-08944 (N.D. Cal.)) ("the Google district court litigation"). Pet. 1–9; Paper 6, 1–10.

[1] Patent Owner's Opposition was timely filed on April 1, 2022, pursuant to our email extending the deadline. Ex. 3001.

C. Real Parties in Interest

The parties identify themselves as the real parties in interest. Pet. 1; Paper 6, 1.

D. Asserted Grounds of Unpatentability

Petitioner presents the following grounds:

Claim Challenged	35 U.S.C. §	References/Basis
1	103(a)	Reynolds,[2] Bernardo,[3] Meyer,[4] Witkowski[5]
1	103(a)	Reynolds, Bernardo, Meyer, Witkowski, Coombs[6]

II. ANALYSIS

Joinder for purposes of an *inter partes* review is governed by 35 U.S.C. § 315(c), which states:

> JOINDER.—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 parties review under section 314.

"To join a party to an instituted [*inter partes* review (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,

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[2] US 6,052,717, issued Apr. 18, 2000 (Ex. 1003).
[3] US 6,684,369 B1, issued Jan. 27, 2004 (Ex. 1004).
[4] J. Meyer and T. Downing, *Java Virtual Machine*, © 1997 (Ex. 1005).
[5] US 6,125,360, issued Sept. 26, 2000 (Ex. 1007).
[6] J. Coombs et al., *Setting Up an Internet Site for Dummies*, 3rd ed. © 1998 (Ex. 1006).

the statute requires that the Director (or the Board acting through a delegation of authority . . .) determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* "Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to 'join as a party' the joinder applicant." *Id.*

A. Whether the Petition Warrants Institution

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

The patentability challenges in the Facebook IPR met the "reasonable likelihood" standard of § 314(a). IPR2021-01224, Paper 10, 30. The Petition presents the same patentability challenges as those for which a trial was instituted in the Facebook IPR. *See* Pet. 13 (asserting that the Petition "is substantively identical to the Facebook IPR petition"). In the present proceeding, Patent Owner does not dispute the patentability merits of Petitioner's challenges. *See* Prelim. Resp. 7, n.2.

We conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to the challenged claim of the '397 patent for the reasons set forth in the Facebook IPR. *See* IPR2021-01224, Paper 10, 13–30.

Even if a petition meets the "reasonable likelihood" standard, institution of *inter partes* review is still discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding."); 35 U.S.C.

§ 314(a) ("The Director *may not* authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." (emphasis added)).

Patent Owner contends that we should deny institution based on the Board's precedential decisions in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (designated precedential in relevant part) and *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential). Prelim. Resp. 7–24. *General Plastic* sets forth a non-exhaustive series of factors to be considered by the Board in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a petition that challenges a patent that was previously challenged before the Board. *General Plastic*, Paper 19 at 15–18.

These factors are as follows:

> 1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
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> 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;
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> 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.

Id. at 16. These factors are "a non-exhaustive list," and "additional factors may arise in other cases for consideration, where appropriate." *Id.* at 16, 18.

In *Uniloc*, the petitioner (Apple) sought to join an instituted *inter partes* review by filing a petition that was substantially the same as the petition on which a trial had been instituted. *Uniloc*, Paper 9 at 2–3. In that case it was the petitioner's second petition challenging the patent, and the panel applied the *General Plastic* factors and denied the petition. *Uniloc*, Paper 9 at 8–13.

Patent Owner argues that the present situation is similar to the circumstances in *Uniloc* that favored denial under *General Plastic* and, therefore, that the Petition should be denied. Prelim. Resp. 7–24. For the reasons explained below, we find the present circumstances distinguishable from those in *Uniloc*, and we decline to deny the Petition based on the *General Plastic* factors.

This is Petitioner's second petition challenging claim 1 of the '397 patent; Petitioner filed its first petition on March 31, 2021. Pet. 12; Prelim. Resp. 3, 13; Ex. 1015 (Petitioner's first petition (IPR2021-00700) challenging claims 1 of the '397 patent). Thus, the first *General Plastic* factor favors denial. *See Uniloc*, Paper 9 at 8.

In *Uniloc*, the panel found that the second *General Plastic* factor favored denial because "Apple ha[d] failed to set forth facts or offer an

explanation concerning its knowledge, at the time it filed the first petition, of the prior art asserted in" the second petition. *Uniloc*, Paper 9 at 9. In contrast to the situation in *Uniloc*, Petitioner "represents that, at the time of filing of the first petition (IPR2021-00700, Paper 1), counsel for Google in any of the actions involving Express Mobile did not identify or consider the prior art used in the Facebook IPR proceeding and in the present Petition, despite extensive prior art search." Pet. 13. Patent Owner argues that "this narrow and carefully worded statement leaves open the possibility that Google or its counsel were aware of the art after all, and simply did not conclude that it was the best art to bring against the challenged claim." Prelim. Resp. 14. Regardless, Petitioner's representation distinguishes the present situation from *Uniloc*, in which there was no explanation of the facts relevant to the second *General Plastic* factor. *See Uniloc*, Paper 9 at 9.

Patent Owner also argues that "the question is not whether Petitioner knew of the art in Facebook's case. The question is whether it ***should have known*** of it." Prelim. Resp. 14. Nothing in the record, however, indicates that Petitioner "should have known of" the prior art asserted in the Facebook IPR when Petitioner filed its first petition. Given Petitioner's representation about its lack of knowledge of the prior art at issue in the Facebook IPR, we do not find that Petitioner knew or should have known of the art when it filed its first petition. Thus, the second *General Plastic* factor does not favor denial.

We also consider the fourth and fifth *General Plastic* factors "to assess and weigh whether a petitioner should have or could have raised the new challenges earlier." *General Plastic*, Paper 19 at 18. In *Uniloc*, the panel determined that the petitioner's lack of explanation of its knowledge of the prior art favored denial based on the fourth and fifth

General Plastic factors. *Uniloc*, Paper 9 at 10–11. As discussed above, Petitioner explains its lack of knowledge of the prior art as of the filing of its first petition (March 31, 2021), and the Facebook IPR petition was filed a little over three months later (July 6, 2021), about three months before Petitioner's first petition was denied on October 4, 2021. Prelim. Resp. 3. Patent Owner filed its preliminary response in the Facebook IPR on October 20, 2021, approximately two weeks after Petitioner's first petition was denied. IPR2021-01224, Paper 6. Even if Petitioner learned of the art on the day the petition in the Facebook IPR was filed (July 6, 2021), we do not view this as a situation in which Petitioner *should have* filed its joinder petition earlier than it did. Petitioner filed the Petition and the Motion within the time allowed by our Rules. Pet. 1; Prelim. Resp. 18. Patent Owner argues that Petitioner filed the Petition "on the last possible day under the joinder rule" and did not explain this "maximum delay." Prelim. Resp. 18–19. Under these circumstances, however, we determine that Petitioner's compliance with our Rules suffices as an explanation. By its filing, Petitioner merely seeks to join an existing proceeding, not to start a parallel proceeding challenging the '397 patent. Our Rules allow a petitioner to wait until after a decision on institution is entered before filing a petition with a request for joinder. 37 C.F.R. § 42.122(b). Thus, under the circumstances here, we find that the fourth and fifth *General Plastic* factors do not favor denial.

Patent Owner's remaining arguments fail to persuade us that discretionary denial is appropriate under the circumstances of this case. Relying on *Uniloc*, Patent Owner argues that the sixth *General Plastic* factor favors denial because, in case of a settlement with Facebook, this

case will continue with Petitioner. Prelim. Resp. 19–21. The present case is distinguishable from the situation in *Uniloc*, in which the proceeding that Apple sought to join had only one petitioner, namely, the original petitioner. *Uniloc*, Paper 9 at 11–12. By contrast, in this case Petitioner seeks to join a proceeding in which multiple petitioners in addition to Facebook already exist, so the Facebook IPR will likely continue even if Facebook were to settle. Therefore, adding Petitioner as one more party along with multiple pre-existing petitioners does not have the same potential impact on the proceeding that adding Apple as a petitioner in *Uniloc* would have had. Thus, the sixth factor, "the finite resources of the Board," does not favor denial in these circumstances.

The seventh *General Plastic* factor does not favor discretionary denial because Petitioner merely seeks to join an ongoing proceeding, and we discern no difficulty in timely issuing a final written decision in that proceeding.

The only remaining *General Plastic* factor is the third, namely, "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." As discussed above, Petitioner filed this second petition after its first petition was denied, but this and the first factor do not outweigh the remaining factors, which we find do not favor denial.

As noted above, the seven *General Plastic* factors are "a non-exhaustive list," and "additional factors may arise in other cases for consideration, where appropriate." *General Plastic*, Paper 19 at 16, 18. One additional factor that we consider is that the Google district court litigation

has been stayed based on the Facebook IPR. Paper 13. This alleviates concerns about potential issues that may arise from having Board and district court proceedings occurring in parallel.

Based on the foregoing, we determine that the Petition warrants institution, and we turn to Petitioner's request for joinder.

B. Whether the Motion Should Be Granted

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). Petitioner argues that its Motion is timely and should be granted because the Facebook IPR will not be impacted if it were to join that proceeding. Mot. 8–12. Petitioner also agrees to take an "understudy" role in the Facebook IPR. Mot. 12–13.

Patent Owner argues that the fact that the Petition is time-barred under 35 U.S.C. § 315(b) weighs against joinder. Opp. 8. We disagree because § 315(b) states that the one-year time bar "shall not apply to a request for joinder under subsection (c)." Patent Owner also argues that granting joinder would complicate the proceedings because Petitioner reserves the right to participate in the Facebook IPR under certain conditions. Opp. 9–10. We disagree because Facebook has already filed its reply in the Facebook IPR, and, therefore, the petitioner-side briefing on the merits in the Facebook IPR is complete. Furthermore, Facebook has not filed any objections to Patent Owner's evidence in the Facebook IPR, and, thus, there is no basis for a motion to exclude Patent Owner's evidence. As such, briefing on the petitioner's side in the Facebook IPR is essentially closed.

Having considered the parties' arguments, we determine that it is appropriate under these circumstances to join Petitioner as a party to the Facebook IPR.

III. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted on the challenges raised in the Petition; and

FURTHER ORDERED that Petitioner's Motion for Joinder with Case IPR2021-01224 is *granted*, and Petitioner is hereby joined as a petitioner in Case IPR2021-01224;

FURTHER ORDERED that the grounds on which trial in Case IPR2021-01224 were instituted are unchanged, and no other grounds are added in Case IPR2021-01224;

FURTHER ORDERED that the Scheduling Order entered in Case IPR2021-01224 (Paper 11) and schedule changes agreed by the parties in Case IPR2021-01224 (pursuant to the Scheduling Order) shall govern the trial schedule in Case IPR2021-01224;

FURTHER ORDERED that Petitioner's role in Case IPR2021-01224 shall be limited as stated by Petitioner in the Motion for Joinder (Paper 3, 1–2, 12–13) unless and until Facebook is terminated from that proceeding;

FURTHER ORDERED that the case caption in Case IPR2021-01224 shall be changed to reflect joinder of Petitioner and the petitioners in IPR2022-00570 as petitioners in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision be entered into the record of Case IPR2021-01224; and

FURTHER ORDERED that all further filings shall be made in Case IPR2021-01224.

PETITIONER:

Naveen Modi
Joseph E. Palys
Daniel Zeilberger
Arvind Jairam
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
danielzeilberger@paulhastings.com
arvindjairam@paulhastings.com

PATENT OWNER:

David L. Alberti
Robert F. Kramer
Sal Lim
Jerry Tice
KRAMER DAY ALBERTI LIM TONKOVICH & BELLOLI LLP
dalberti@kramerday.com
slim@kramerday.com
jtice@kramerday.com

Kenneth J. Weatherwax
LOWENSTEIN & WEATHERWAX LLP
weatherwax@lowensteinweatherwax.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., ATLASSIAN CORP. PLC, ATLASSIAN, INC., EBAY INC., EXPEDIA, INC., HOMEAWAY.COM, INC., PINTEREST, INC., SQUARESPACE, INC., WIX.COM, LTD., WIX.COM, INC., and GOOGLE LLC,[7]
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EXPRESS MOBILE, INC.,
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[7] Atlassian Corp. PLC., Atlassian, Inc., eBay Inc., Expedia, Inc., Homeaway.com, Inc., Pinterest, Inc., Squarespace, Inc., Wix.com, Ltd., and Wix.com, Inc. filed a motion for joinder and a petition in Case IPR2022-00570. Google LLC filed a motion for joinder and a petition in Case IPR2022-00598. All of these parties have been joined as petitioners in this proceeding.