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Paper 11
Entered: February 1, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

GUI GLOBAL PRODUCTS, LTD., D/B/A GWEE,
Patent Owner.

IPR2021-01291
Patent 10,562,077 B2

Before SALLY C. MEDLEY, BRYAN F. MOORE, and SHEILA F. McSHANE, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 1–13 of U.S. Patent No. 10,562,077 B2 (Ex. 1001, "the '077 patent"). Paper 3 ("Pet."). Petitioner also filed a Conditional Motion for Joinder with *Samsung et al. v. GUI Global Products, Ltd.*, IPR2021-00337 ("the 337 IPR" or "the Samsung 337 IPR"). Paper 4 ("Mot."). GUI Global Products, Ltd., d/b/a Gwee ("Patent Owner") filed a Preliminary Response to the Petition. Paper 10 ("Prelim. Resp."). Patent Owner also filed an Opposition to the Conditional Motion for Joinder. Paper 8 ("Opp."). Petitioner filed a Reply to Patent Owner's Opposition. Paper 9 ("Reply"). We have authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

For the reasons described below, we do not institute an *inter partes* review of the challenged claims and deny Petitioner's Conditional Motion for Joinder.

II. RELATED PROCEEDINGS

The parties indicate that the '077 patent is the subject of court proceeding *GUI Global Products, Ltd. d/b/a Gwee v. Apple, Inc.,* Civil Action No. 4:20-cv-2652 (S.D. Tex.), which has been consolidated with Civil Action No. 4:20-cv-2624 (S.D. Tex.). Pet. 78; Paper 6, 2. The parties also indicate that the '077 patent is the subject of the 337 IPR, and IPR2021-00472 ("the 472 IPR"), where Petitioner filed a petition challenging claims 1–5 and 7–13 of the '077 patent. Pet. 78; Paper 6, 2. In the 472 IPR, we instituted an *inter partes* review of claims 1–5 and 7–13 of the '077 patent.

Apple Inc. v. GUI Global Products, Ltd., D/B/A Gwee, IPR2021-00472, Paper 9 at 7–8, 36 (PTAB Aug. 13, 2021) ("472 Decision" or "472 Dec."). Thus, before us here is Petitioner's second petition for *inter partes* review. In accordance with the Consolidated Trial Practice Guide,[1] Petitioner filed a separate paper, identifying a ranking of its petitions and explaining the differences between the petitions. Paper 2 ("Explanation").

In the 337 IPR, we instituted an *inter partes* review of claims 1–13 of the '077 patent on the following grounds:

Claim(s) Challenged	35 U.S.C §	Reference(s)/Basis
1–8	103(a)	Kim[2]
11	103(a)	Kim, Koh[3]
9, 10, 12, 13	103(a)	Kim, Lee[4]

Samsung et al. v. GUI Global Products, Ltd., D/B/A Gwee, Case IPR2021-00337, Paper 11 at 8, 40 (PTAB Jul. 2, 2021) ("337 Decision" or "337 Dec.").

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[1] Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), https://www.uspto.gov/TrialPracticeGuideConsolidated, 59–61 (explaining that the Board may exercise discretion under 35 U.S.C. § 314(a) to deny a petition(s) if it determines that more than one petition challenging claims of the same patent is not warranted) ("Trial Practice Guide" or "TPG").

[2] U.S. Pat. Appl. Pub. No. US 2010/0227642 A1, published Sept. 9, 2010 (Ex. 1010, "Kim").

[3] Korean Pat. Pub. No. 10-2008-0093178, published Oct. 21, 2008 (Ex. 1012, 16–30, "Koh"). Petitioner provides a certified English-language translation of Koh (Ex. 1012, 1–15). Any reference to Koh hereinafter will be to the English-language translation.

[4] U.S. Pat. Appl. Pub. No. US 2010/0298032 A1, published Nov. 25, 2010 (Ex. 1013, "Lee").

III. DISCUSSION

The Petition in this proceeding asserts the same grounds of unpatentability as those upon which we instituted review in the 337 IPR. *Compare* Pet. 1–2, *with* 337 Dec. 8, 40. Indeed, Petitioner, Apple, contends that the Petition is "substantively equivalent to the petition instituted in" the 337 IPR. Pet. 1. Petitioner requests that we institute *inter partes* review and conditionally seeks joinder with the 337 IPR. Mot. 1. In the Motion, Petitioner seeks joinder "**if**, **and only if**, the Board has previously denied institution of *Apple Inc., v. GUI Global Products, Ltd.*, IPR2021-00472 ("the 472 Proceeding")." *Id*. at 1; Explanation 1. In its Reply, Petitioner revises its request stating, "Apple respectfully requests that the Board institute review of IPR2021-01291 and grant Apple's pending Motion if, and only if, the Board will align in time the issuance of final written decisions in the 337 Proceeding and the 472 Proceeding." Reply 2–3. Petitioner asserts that it is seeking alignment of the schedules in the 337 and 472 proceedings in order to avoid a potential prejudice from estoppel under 35 U.S.C. § 315(e)(1). *Id*. at 3.

"To join a party to an instituted 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, we "determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* Second, if the petition warrants institution, we then "decide whether to 'join as a party' the joinder applicant." *Id.* Thus, before determining whether to join Petitioner as a party to the 337 IPR, we first determine whether the petition warrants institution under § 314(a).

The Director has discretionary authority under 35 U.S.C. § 314(a) to institute *inter partes* review and has delegated that authority to the Board. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018); 37 C.F.R. § 42.4(a). Patent Owner argues that "the Board should exercise its discretion and deny institution of trial," citing the Board's precedential *General Plastic*[5] and *Uniloc*[6] decisions. Prelim. Resp. 3–4. Petitioner argues we should institute an *inter partes* review of the challenged claims. Pet. 74–77. For the reasons set forth below, we exercise our discretion to deny institution.

In *General Plastic*, the Board articulated a list of non-exclusive factors to be considered in determining whether to exercise discretion under § 314(a) to deny a petition:

> 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;
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> 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;

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[5] *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential) ("*General Plastic*").
[6] *Apple, Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential) ("*Uniloc*").

> 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;
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> 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.

General Plastic, Paper 19 at 16 (citing *NVIDIA Corp. v. Samsung Elec. Co.*, IPR2016-00134, Paper 9 at 6–7 (PTAB May 4, 2016)). *See also Uniloc* at 4–5 ("before determining whether to join [petitioner] as a party to the [instituted] IPR, even though the [p]etition is a 'me-too petition,' we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the [p]etition under 314(a)").

> *Factor 1: "whether the same petitioner previously filed a petition directed to the same claims of the same patent"*

As explained above, before us is Petitioner's second petition challenging the claims of the '077 patent. Pet. 74; Prelim. Resp. 6. We understand that Petitioner filed this Petition in case we did not institute review in the 472 IPR. Pet. 74; Explanation 4–5 (Petitioner "respectfully requests that the Board institute" review in the 472 IPR, but if the Board does not "the next-most efficient course of action would be for the Board to institute" in this proceeding). As stated above, we instituted *inter partes* review in the 472 IPR.

The 472 IPR involves claims 1–5 and 7–13 of the '077 patent and the 337 IPR involves claims 1–13. Thus, one more claim is challenged here than in the 472 IPR. Nonetheless, Petitioner provides no explanation why it is again challenging claims 1–5 and 7–13 here or why Petitioner needs two instituted *inter partes* reviews on the common claims. Pet. 74–75. In none

of its briefs does Petitioner explain "why the Board should exercise its discretion to institute additional petitions if it [the Board] identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)," short of saying that "(Gundlach (472 IPR) and Kim (this Petition) offer very different disclosures." Explanation 3; TPG 60.[7] However, Petitioner does not identify any circumstances identified in the Trial Practice Guide supporting a need for a second petition, such as a large number of claims in litigation or a potential dispute about priority date. TPG 59. Accordingly, based on the record before us, we agree with Patent Owner (Prelim. Resp. 6) that this *General Plastic* factor weighs in favor of denying institution of the proceeding.

> *Factor 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"*

Petitioner argues that it "learned of the prior art in the Samsung Petition [in the 337 IPR] around the time that petition was filed." Pet. 75. Petitioner argues that because it filed its petition in the 472 IPR five weeks after the petition was filed in the 337 IPR, it "could not have reasonably leveraged its knowledge" of the prior art involved in the 337 IPR against Patent Owner. *Id.* Patent Owner argues that because Petitioner admitted that it knew of the prior art asserted in the 337 IPR prior to Petitioner filing the petition in the 472 IPR, *General Plastic* factor two weighs in favor of

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[7] As discussed above, in the Explanation, Petitioner requests that we should institute *inter partes* review in the 472 IPR, and if we do not, then we should institute here. Explanation 3–5. In the Reply, however, Petitioner requests that we institute here, despite having instituted the 472 IPR, without explaining why we should do so. Reply 2–3.

denying institution of the proceeding. Prelim. Resp. 7. We agree that this factor weighs in favor of denying institution of the proceeding because Petitioner does not explain sufficiently why it had to file the petition in the 472 IPR five weeks after the petition was filed in the 337 IPR such that Petitioner could not have "leveraged its knowledge" of the prior art involved in the 337 IPR against Patent Owner. In other words, Petitioner fails to explain sufficiently why it could not have included the claims or prior art it asserts here in the 472 IPR. Accordingly, we determine that this second *General Plastic* factor weighs in favor of denying institution of the proceeding.

> *Factor 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"*

For this factor, Patent Owner argues that by the time Petitioner filed the instant Petition, Petitioner had already received Patent Owner's preliminary responses in the 337 and 472 IPRs and the Board's 337 Decision. Prelim. Resp. 8. Patent Owner also argues that even though Petitioner's Petition is "styled as a Copycat Petition" that "is of no moment." *Id.* (citing *Uniloc*, Paper 9 at 10). Petitioner argues that unlike the petitioners in *General Plastic* and *Uniloc*, Petitioner has not received the Board's institution decision on its first petition in the 472 IPR. Pet. 75.

We determine that Petitioner had access to the preliminary response in the 472 IPR, and, therefore, this third *General Plastic* factor weighs in favor of denying institution of the proceeding.

Factor 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"

Factor 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"

For the fourth and fifth *General Plastic* factor, Patent Owner argues that Petitioner acknowledges that it knew of the prior art it asserts in this proceeding in "late 2020," but did not file the Petition until July 30, 2021. Prelim. Resp. 8 (citing Pet. 76). Patent Owner argues "simply because Apple's second petition is a Copycat Petition that is no excuse for the delay." *Id.* at 9 (citing *Uniloc*, Paper 9 at 11).

Petitioner argues that "this Copycat Petition is within the one-month timeline set by the Board's rules." Pet. 76. Petitioner, however, provides no explanation why it could not have included the prior art or claims it asserts here in the 472 IPR that was filed several weeks after the petition in the 337 IPR, but several months prior to the Petition that was filed here. In other words, there was a significant gap between the filing of the 472 IPR (at which time Petitioner knew about the prior art before us in this case) and the filing of the Petition here. Accordingly, we determine that the fourth and fifth *General Plastic* factors weigh in favor of denying institution of the proceeding.

Factor 6: "the finite resources of the Board"

Patent Owner argues that based on Petitioner's conditional motion to join, Petitioner requests "that this *inter partes* review go forward as an independent proceeding, not joined to the earlier 337 Proceeding . . . if the 472 Proceeding is instituted." Prelim. Resp. 9–10. Patent Owner argues that

such a result would require the Board to adjudicate identical issues in two separate proceedings and would also harass Patent Owner. *Id.* at 10. Because we instituted review in 472 IPR, the condition upon which Petitioner seeks joinder with the 337 IPR has not materialized. *See* Mot. 1. Thus, Patent Owner is correct that the result of no joinder (which Petitioner requested in its Conditional Motion) would be to maintain Petitioner's challenge in the 472 IPR, while also adjudicate identical issues in the 337 IPR and this proceeding. We determine that such a result would be an inefficient use of Board resources.[8] Accordingly, we determine that the sixth *General Plastic* factor weighs in favor of denying institution of the proceeding.

> Factor 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"*

Patent Owner argues that like the sixth *General Plastic* factor, the seventh factor is also concerned with efficiency considerations and that here, this factor is neutral. Prelim. Resp. 10. Petitioner argues that the Board is capable of issuing a final written decision within one year. Pet. 77. We determine this factor's weight is neutral.

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[8] Petitioner appears to have changed the condition upon which its motion to join should be granted. Reply 2–3. But even if we were to entertain this late request, the result would still be burdensome upon the Board, because Petitioner requests that we "grant Apple's pending Motion if, and only if, the Board will align in time the issuance of final written decisions in the 337 Proceeding and the 472 Proceeding." *Id.* at 3. Compressing the due date for a final written decision in the 472 IPR by six weeks would be burdensome on the Board.

Conclusion

In light of the *General Plastic* factors, the *Uniloc* decision, the guidance in the TPG, and the arguments presented for and against the exercise of discretionary denial, we conclude that it is appropriate here to exercise our discretion under 35 U.S.C. § 314(a).

IV. DENIAL OF MOTION FOR JOINDER

As stated above, the Director may join a party to an ongoing IPR only if the filed petition warrants institution under § 314. 35 U.S.C. § 315(c). Because we exercise discretion to deny institution under § 314, we deny Petitioner's Conditional Motion for Joinder.

V. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), the Petition is *denied*; and

FURTHER ORDERED that the Conditional Motion for Joinder is *denied*.

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