

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC. and LG ELECTRONICS U.S.A., INC.,
Petitioner,

v.

GESTURE TECHNOLOGY PARTNERS, LLC,
Patent Owner.

IPR2022-00093
Patent 8,194,924 B2

Before PATRICK R. SCANLON, GREGGI. ANDERSON, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *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 and Summary

Petitioner, LG Electronics, Inc. and LG Electronics U.S.A., Inc., requests that we institute an *inter partes* review to challenge the patentability of claims 1–14 (the “challenged claims”) of U.S. Patent 8,194,924 B2 (Ex. 1001, “the ’924 patent”). Paper 1 (“Petition” or “Pet.”). Concurrently with its Petition, Petitioner filed a Motion for Joinder with *Apple Inc. v. Gesture Technology Partners, LLC*, Case IPR2021-00923 (“the Apple IPR”). Paper 3 (“Mot.”). Petitioner represents that the petitioner in the Apple IPR—Apple Inc.—does not oppose the Motion for Joinder. Mot. 1. Patent Owner, Gesture Technology Partners, LLC, argues that Petitioner’s request is deficient and should not be granted. Paper 7 (“Preliminary Response” or “Prelim. Resp.”).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we institute an *inter partes* review.¹ Further, for the reasons set forth below, we grant the Motion for Joinder.

B. Related Matters

The parties identify these related matters: *Gesture Technology Partners, LLC v. Huawei Device Co., Ltd.*, No. 2:21-cv-00040 (E.D. Tex.); *Gesture Technology Partners, LLC v. Samsung Electronics Co.*, No. 2:21-cv-00041 (E.D. Tex.); *Gesture Technology Partners, LLC v. Apple Inc.*, No. 6:21-cv-00121 (W.D. Tex.); *Gesture Technology Partners, LLC v. Lenovo Group Ltd.*, No. 6:21-cv-00122 (W.D. Tex.); and *Gesture Technology*

¹ Our findings and conclusions at this stage are preliminary, and thus, no final determinations are made.

Partners, LLC v. LG Electronics, Inc., No. 6:21-cv-00123 (W.D. Tex.). Pet. 73; Paper 5, 1. Patent Owner identifies these related Board proceedings: IPR2021-00917; IPR2021-00920; IPR2021-00921; IPR2021-00922; IPR2021-00923; IPR2021-01255; IPR2022-00090; IPR2022-00091; and IPR2022-00092. Paper 5, 1–2. Patent Owner identifies these related *Ex Parte* Reexaminations: No. 90/014,900; No. 90/014,901; No. 90/014,902; and No. 90/014,903. *Id.* at 3.

In the Apple IPR, we instituted an *inter partes* review of claims 1–14 of the ’924 patent as unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–6, 11, 14	103(a) ²	Mann, ³ Numazaki ⁴
7, 8, 10, 12, 13	103(a)	Mann, Numazaki, Amir ⁵
6, 9	103(a)	Mann, Numazaki, Aviv ⁶

See Apple IPR, Paper 10 (PTAB Dec. 6, 2021) (“Apple Dec.”).

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the Apple IPR. *Compare* Pet. 6, *with* Apple Dec. 5. Indeed, Petitioner contends that the “Petition is substantively identical to the original Apple IPR petition in all material respects” and that “[t]he Petition here and the Apple IPR petition

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent claims priority before March 16, 2013, we refer to the pre-AIA versions.

³ Canadian Published Patent Application 2,237,939, published Aug. 28, 1998 (“Mann”) (Ex. 1004).

⁴ U.S. Patent 6,144,366, issued Nov. 7, 2000 (“Numazaki”) (Ex. 1005).

⁵ U.S. Patent 6,539,100 B1, issued Mar. 25, 2003 (“Amir”) (Ex. 1006).

⁶ U.S. Patent 5,666,157, issued Sept. 9, 1997 (“Aviv”) (Ex. 1007).

challenge the same claims of the '924 patent on the same grounds relying on the same prior art and evidence, including a declaration identical in substance from the same expert.” Mot. 2; *see also, id.* at 6–7.

Patent Owner’s Preliminary Response presents a number of arguments as to why the Petition should not be granted. Prelim. Resp. 6–29. We address each argument below and ultimately institute an *inter partes* review on the same grounds as the ones on which we instituted review in the Apple IPR.

A. Grounds of Unpatentability

Patent Owner’s Preliminary Response repeats the same arguments over the Petition’s grounds of unpatentability that Patent Owner presented in the Apple IPR. *Compare* Prelim. Resp. 6–19 *with* Apple IPR, Paper 8, 6–18. Thus, for the same reasons set forth in our institution decision in the Apple IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that claims 1–14 would have been obvious. *See* Apple Dec. 7–23. Accordingly, we institute an *inter partes* review on the same basis as we instituted review in the Apple IPR.

B. 35 U.S.C. § 314(a)

Patent Owner argues that “[t]he Petition should be denied . . . under 35 U.S.C. § 314(a) in view of the *General Plastic*⁷ factors.” Prelim. Resp. 19–20. Patent Owner argues that we should apply the *General Plastic* factors because:

Even when Petitioner files a motion to join, the Board first decides whether to institute the IPR before reaching the joinder decision. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 5 (PTAB Oct. 28, 2020) (precedential) [(“*Apple v. Uniloc*”)]

⁷ *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (PTAB Sept. 6, 2017) (precedential).

(“Under 35 U.S.C. § 315(c), the discretion of the Director to join a party to an ongoing IPR is premised on the Director’s determination that the petition warrants institution.”).

Id. at 19.

In *Apple v. Uniloc*, the petitioner filed a first petition for *inter partes* review that was denied and then, after another party filed an additional petition for *inter partes* review of the patent, the petitioner filed its second petition with a motion for joinder. *Apple v. Uniloc* at 6. However, not only was that the second petition for *inter partes* review filed by the petitioner, but the petitioner was also barred under 35 U.S.C. § 315(b) from filing any further petitions. *Id.* at 6–7. Thus, under these facts, among others, the panel exercised its discretion to decline institution of the petition after applying the *General Plastic* factors. *Id.* at 13.

Here, however, none of the unique facts in *Apple v. Uniloc* are present. The Petition is substantially identical to the petition in IPR2021-000923 (“the Apple IPR”), which it seeks to join, and it presents us with a standard “me too” petition with a motion for joinder. Patent Owner presents no unique facts here that separate the Petition from most other “me too” petitions with a motion for joinder, with the possible exception that Patent Owner sued both Petitioner and the petitioner in the Apple IPR for patent infringement, which is those parties only connection to one another identified by Patent Owner. *See Prelim. Resp.* 22–23.⁸

⁸ Patent Owner does not argue that Petitioner and the petitioner in the Apple IPR are also accused of infringement based on a product that involves both petitioners, as in *Valve* (IPR2019-00062, Paper 11, 9–10), rather Patent Owner merely states that they filed suit against both parties in separate suits, but on the same day.

The statutes and rules governing *inter partes* review expressly provide for joinder. *See* 35 U.S.C. § 315(c); 37 C.F.R. 42.122(b). For example, 35 U.S.C. § 315(c) 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 partes review under section 314.

Under Patent Owner’s reasoning (*see* Prelim. Resp. 19–27)⁹, essentially any petition with a motion for joinder would be denied under the *General Plastic* factors, even though our governing statutes and rules expressly allow the practice. Patent Owner does not address why we should ignore our governing statutes and rules allowing joinder to use the facts surrounding a motion for joinder to decline to institute the petition, and we decline to do so.

C. 35 U.S.C. § 315(d)

Patent Owner argues that “[i]n view of the finite resources of the Board and . . . co-pending [*ex parte*] reexamination [No. 90/014,902 of the ’924 patent], the Director should deny the Petition” under 35 U.S.C. § 315(d). Prelim. Resp. 27.

⁹ *E.g.*, prior petition by a first petitioner; same prior art, that the second petitioner became aware of at least before filing the second petition, i.e., when the prior petition was filed; delay between filing of the two petitions; finite resources of the Board will be called upon if first petitioner leaves contest and joinder (second) petitioner steps in.

35 U.S.C. § 315(d) states: “if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the inter partes review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding.”

Though we agree that 35 U.S.C. § 315(d) gives the Director authority to determine how to proceed in the present circumstances, we decline the invitation to deny the Petition based on the existence of co-pending *ex parte* reexamination No. 90/014,902 and our finite resources.

D. Jurisdiction over Expired Patents

Patent Owner argues that the USPTO does not have jurisdiction over expired patents. Prelim. Resp. 28–29. Rather, Patent Owner argues the USPTO only has jurisdiction over patents with claims that can be amended or cancelled. *Id.* at 28. Patent Owner states that, as explained by the Supreme Court, “Congress [has] significant latitude to assign [the] adjudication of public rights to entities other than Article III courts,” including for the USPTO to “reexamine—and perhaps cancel—a patent claim in an inter partes review.” *Id.* (quoting *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1368, 1374 (2018)). However, Patent Owner argues that this authority does not extend to expired patents because the public franchise associated with an issued patent no longer exists after expiration. *Id.* Thus, it is argued, the USPTO no longer has jurisdiction, even though the patent owner “may be entitled to collect damages” for patent infringement, because “the patent owner[] no longer has the right to exclude others” and the USPTO has nothing to cancel or amend. *Id.* at 28–29.

Patent Owner reasons that:

Expiration removes the patent from the [US]PTO's jurisdiction and returns it to the sole jurisdiction of the Article III courts, which have exclusive authority to govern claims for damages. If this were not so, the [US]PTO would purport to have authority to retroactively modify a public franchise that no longer exists, in a setting where the expired public franchise does not enjoy any presumption of validity and in which amendment of claims is no longer permitted.

Id. at 29.

Inter partes review of patents, whether expired or not, fits within the USPTO's mandate "for the granting and issuing of patents" (35 U.S.C. § 2(a)(1)), for as the Supreme Court has stated, "[i]nter partes review is 'a second look at an earlier administrative grant of a patent'" (*Oil States Energy Servs.*, 138 S. Ct. at 1374 (quoting *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016))). Our rules have also made clear *inter partes* review covers expired patents. 37 C.F.R. 42.100(b) (2012); *see also, e.g.*, 83 Fed. Reg. 51341 (Oct. 11, 2018) (Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board)¹⁰ ("The claim construction standard adopted in this final rule also is consistent with the same standard that the Office has applied in interpreting claims of expired patents and soon-to-be expired patents. *See, e.g., Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.*, 853 F.3d 1272, 1279 (Fed. Cir. 2017) (noting that '[t]he Board construes claims of an expired patent in accordance with *Phillips* . . . [and] [u]nder that standard, words of a claim are generally given their ordinary and customary meaning').").

Further, the statutes governing *inter partes* review do not limit them to non-expired patents. For example, 35 U.S.C. § 311(b), which sets forth the

¹⁰ Available at <https://www.federalregister.gov/d/2018-22006/p-13>.

scope of *inter partes* review, merely refers to patents with no mention of the expiration date. Further, 35 U.S.C. § 311(c) entitled “Filing Deadline” makes no mention of the expiration date of the patent. Elsewhere, 35 U.S.C. § 315 does limit the filing of IPRs based on civil actions and the serving of complaints, but again makes no mention of the expiration date of the patent. Patent Owner does not identify any statute or legal precedent that expressly limits *inter partes* review to non-expired patents.

Patent Owner fails to adequately explain why the Patent Office’s authority to take a second look at an earlier administrative grant of a patent ends when the patent term expires even though the rights granted by the patent are not yet exhausted.

For all of these reasons, we do not agree that the Board lacks jurisdiction over expired patents.

E. Conclusion

For the foregoing reasons, we determine that there is a reasonable likelihood that the Petitioner will prevail with respect to at least one of the claims challenged in the Petition. We therefore institute trial as to all challenged claims on all grounds stated in the Petition.

III. MOTION FOR JOINDER

The statutory provision governing joinder in *inter partes* review proceedings (35 U.S.C. § 315(c)) reads:

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 partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

Petitioner timely filed the Motion no later than one month after institution of the Apple IPR. *See* 37 C.F.R. § 42.122 (b). As noted, the Petition in this case asserts the same unpatentability grounds on which we instituted review in the Apple IPR. *See* Mot. 2. Petitioner also relies on the same prior art analysis and expert testimony submitted by the Apple petitioner. *See id.* Indeed, the Petition is nearly identical to the petition filed by the Apple petitioner. *See id.* at 6. Thus, this *inter partes* review does not present any ground or matter not already at issue in the Apple IPR. *Id.*

If joinder is granted, Petitioner agrees to assume an “understudy role” and “will only assume the lead role in the proceedings if Apple 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).” *Id.* at 2. Petitioner further represents that it “will not advance any arguments separate from those advanced by Apple in the consolidated filings.” *Id.* at 3. Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the Apple IPR. *Id.*

Patent Owner did not file an Opposition to the Motion for Joinder. Patent Owner improperly¹¹ attempts to oppose the Motion for Joinder in the Patent Owner Preliminary Response. *See* Prelim. Resp. 19–27. Patent Owner argues that the Motion should be denied under 35 U.S.C. §§ 314, 315 for the same reasons discussed and rejected above with respect to institution of the Petition. *See supra* §§ II.B–C.

Patent Owner waived its arguments in opposition to the Motion for Joinder by choosing not to file such an opposition. To allow Patent Owner to circumvent the Rules would deny Petitioner their right to reply to arguments that should have been presented in an Opposition to the Motion for Joinder. *See* 37 C.F.R. § 42.25.

Based on the above, we determine that joinder with the Apple IPR is appropriate under the circumstances. Accordingly, we grant Petitioner’s Motion for Joinder.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, *inter partes* review of claims 1–14 of U.S. Patent 8,194,924 B2 is instituted on all grounds in the Petition;

FURTHER ORDERED that the Motion for Joinder with IPR2021-00923 is granted;

FURTHER ORDERED that IPR2022-00093 is terminated and joined with IPR2021-00923, pursuant to 37 C.F.R. §§ 42.72, 42.122, wherein Petitioner will maintain a secondary role in the proceeding, unless and until

¹¹ An opposition was due by December 5, 2021 (*see* 37 C.F.R. § 42.25.), while the Patent Owner Preliminary Response was filed February 18, 2022.

the Apple petitioner ceases to participate as a petitioner in the *inter partes* review;

FURTHER ORDERED that the Scheduling Order in place for IPR2021-00923 (Paper 11) remains unchanged, and shall govern the joined proceeding;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2021-00923;

FURTHER ORDERED that the case caption in IPR2021-00923 shall be changed to reflect joinder of LG Electronics, Inc. and LG Electronics U.S.A., Inc. as a petitioner in accordance with the below example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2021-00923.

Example Caption

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., LG ELECTRONICS, INC., and
LG ELECTRONICS U.S.A., INC.,
Petitioner,

v.

GESTURE TECHNOLOGY PARTNERS, LLC,
Patent Owner.

IPR2021-00923¹²
Patent 8,194,924 B2

¹² IPR2022-00093 (LG Electronics, Inc. and LG Electronics U.S.A., Inc.)
has been joined with this proceeding.

IPR2022-00093
Patent 8,194,924 B2

FOR PETITIONER:

Matthew D. Satchwell
Gianni Minutoli
Paul R. Steadman
DLA PIPER LLP
matthew.satchwell@dlapiper.com
gianni.minutoli@us.dlapiper.com
paul.steadman@dlapiper.com

FOR PATENT OWNER:

Todd E. Landis
John Wittenzellner
WILLIAMS SIMONS & LANDIS PLLC
tlandis@wsltrial.com
johnw@wsltrial.com