

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,

Petitioner,

v.

EXPRESS MOBILE INC.,

Patent Owner.

Case IPR2022-00518

U.S. Patent No. 7,594,168

**MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b)
TO *INTER PARTES* REVIEW IPR2021-01226**

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I. PRELIMINARY STATEMENT

SAP America, Inc. (“Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review of U.S. Patent No. 7,594,168 (“the SAP Petition”) filed contemporaneously herewith. Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of an *inter partes* review and joinder with the *inter partes* review in *Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01226 (“the Facebook IPR”), which the Patent Trial and Appeal Board (the “Board”) instituted on January 14, 2022. Petitioner’s Motion for Joinder is timely under 37 C.F.R. § 42.22 and 42.122(b) as it is submitted no later than one month after the January 14, 2022 institution date of the Facebook IPR. The SAP Petition is also narrowly tailored to the same claims, prior art, and grounds for unpatentability that are the subject of the Facebook IPR.

Petitioner submits that joinder is appropriate because it will not unduly burden or prejudice the parties to the Facebook IPR while efficiently resolving the question of the validity of U.S. Patent No. 7,594,168 (the “’168 patent”) in a single proceeding.

II. STATEMENT OF MATERIAL FACTS

1. Express Mobile, Inc. (“Express Mobile” or “Patent Owner”) filed civil actions against numerous companies, as explained in Section I.B. of the Petition. Those companies included Petitioner (*Express Mobile, Inc. v. SAP SE*, No. 3-20-cv-

08492-RS (N.D. Cal.)) and Facebook (*Express Mobile, Inc. v. Meta Platforms, Inc.*, No. 3-21-cv-06657-RS (N.D. Cal.)).

2. On July 6, 2021, Facebook filed a petition for *inter partes* review (IPR2021-01226) requesting cancellation of claims 1-4 and 6 of the '168 patent.

3. On January 14, 2022, the Board instituted Facebook's Petition in IPR2021-01226, finding a reasonable likelihood existed that Facebook's Petition for *inter partes* review would prevail in showing the unpatentability of claims of the '168 patent. See IPR2021-01226, Decision Granting Institution of IPR Review, Paper No. 8 (Jan. 14, 2022).

4. On February 11, 2022, contemporaneously with this Motion, SAP filed its Petition for *inter partes* review (IPR2022-00518) requesting cancellation of claims 1-4 and 6 of the '168 patent, which is substantively identical to Facebook's IPR.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority under 35 U.S.C. § 315(c) to join a properly filed *inter partes* review petition to an instituted *inter partes* review proceeding. See 35 U.S.C. § 315(c). A motion for joinder must be filed within one month of the Board instituting an original *inter partes* review. 37 C.F.R. § 42.122(b). "To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires

two different decisions. First, 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. . . . Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to ‘join as a party’ the joinder applicant.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020).

Under the first step, the Board analyzes the merits of the petition and whether it should exercise its discretion to deny institution. *See e.g., AT&T Servs., Inc. v. Broadband iTV, Inc.*, IPR2021-00556, Paper No. 14 (Aug. 25, 2021). Under the second step, the Board considers factors, including: (1) the reasons why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) what impact, if any, joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper No. 15 at 4 (Apr. 24, 2013).

B. Petitioner’s Motion for Joinder is Timely

This Motion for Joinder is timely because it is filed within one month of the January 14, 2022 institution decision of the Facebook IPR. *See* 37 C.F.R. § 42.122(b).

C. The Board Should Not Exercise Its Discretion Under §314(a)

As explained in the SAP Petition (*see* SAP Pet. at §III.C.) the Board should not exercise its discretion to deny this Petition. Additionally, the Facebook IPR was instituted and is substantively identical to the SAP IPR.

D. Each Factor Weighs in Favor of Joinder

Each of the four factors considered by the Board weighs in favor of joinder here. Specifically, the SAP Petition does not present any new grounds of unpatentability; rather it is substantively identical to the Facebook Petition. Further, joinder will have minimal, if any, impact on the trial schedule, as all issues are substantively identical and Petitioner will accept an “understudy” role. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 5-8 (May 30, 2019) (granting IPR where petitioners requested an “understudy” role); *Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (Oct. 15, 2015). Lastly, the briefing and discovery will be simplified by resolving all issues in a single proceeding.

Accordingly, joinder is appropriate here. *See, e.g., Apple*, IPR2019-00958, Paper 9 at 5-8; *Sony*, IPR2015-01353, Paper 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration.”).

1. Joinder is Appropriate with the Facebook IPR

Joinder with the Facebook IPR is appropriate because the SAP Petition involves the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Facebook Petition. *Id.* The SAP Petition is substantively identical to the Facebook Petition with only non-substantive modifications specific to the formalities of a different party filing the petition as well as an explanation that the Board should not exercise its discretion to deny SAP's petition.

Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Facebook IPR so that the Board can efficiently resolve all grounds in both the SAP and Facebook Petitions in a single proceeding. *Id.*

2. Petitioner Proposes No New Grounds of Unpatentability

The SAP Petition does not present any new grounds of unpatentability and is substantively identical to the Facebook Petition. The SAP Petition presents the unpatentability of the same claims of the same patent on the same grounds as the Facebook Petition.

3. Joinder Will Not Unduly Burden or Negatively Impact the Facebook IPR Trial Schedule

Because the SAP Petition is substantively identical to the Facebook Petition, with the same grounds challenging the same claims as instituted by the Board, there

are no new issues for Patent Owner to address. Due to the same issues presented in the Facebook Petition, Patent Owner will not be required to present any additional responses or arguments. *See Apple*, IPR2019-00958, Paper 9 at 8 (holding “joinder is appropriate in these circumstances because joinder will not unduly burden the parties to the [first] IPR while efficiently resolving the question of unpatentability of” the challenged claims); *Sony*, 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, the Patent Owner Preliminary Response already filed in the Facebook IPR addresses any and all issues in the SAP Petition, since the issues are substantively identical to the issues of the Facebook Petition. *See Facebook*, IPR2021-01226, Paper 7.

The Patent Owner Response will also not be negatively impacted because the issues presented in the Facebook Petition are identical to the issues presented in the SAP Petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the Facebook Petition. Also, because the SAP Petition relies on the same experts and identical declarations, only a single deposition of each expert is needed for the proposed joined proceeding.

Joinder of this proceeding with the Facebook IPR does not unduly burden or negatively impact the trial schedule in any meaningful way. Further, even if a small adjustment of the trial schedule were necessary, this is already provided for in the rules and is a routine undertaking by parties in IPR proceedings. See 37 C.F.R. § 42.100(c). Thus, a slight adjustment in the trial schedule, should one be needed, is not enough of a reason to deny joining the present SAP Petition with the Facebook IPR.

4. Procedures to Simplify Briefing and Discovery

The Facebook Petition and SAP Petition present substantively identical grounds of rejection, including the same art combinations against the same claims. Additionally, Petitioner explicitly agrees to take an “understudy” role, as described by the Board:

- (a) all filings by [SAP] in the joined proceeding be consolidated with [the filings of the petitioner in the Facebook IPR], unless a filing solely concerns issues that do not involve [the petitioner in the Facebook IPR];
- (b) [SAP] shall not be permitted to raise any new grounds not already instituted by the Board in the [Facebook IPR], or introduce any argument or discovery not already introduced by [the petitioner in the Facebook IPR];
- (c) [SAP] shall be bound by any agreement between [Patent Owner] and [the petitioner in the Facebook IPR] concerning discovery and/or depositions; and
- (d) [SAP] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [the petitioner in the Facebook IPR] alone under either 37

C.F.R. § 42.53 or any agreement between [Patent Owner] and [the petitioner in the Facebook IPR].

See Noven Pharms., Inc. v. Novartis AG, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015) (emphasis in original). Petitioner SAP will assume the primary role only if Facebook ceases to participate in the Facebook IPR.

By Petitioner accepting an “understudy” role, Patent Owner and SAP can comply with the current trial schedule and avoid any duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See Apple*, IPR2019-00958, Paper 9 at 5-8; *Sony*, 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.).

IV. CONCLUSION

Based on the factors discussed above, Petitioner SAP respectfully requests that the Board institute the SAP Petition for *Inter Partes* Review of U.S. Patent No. 7,594,168 and grant joinder with the instituted *Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01226 proceeding.

Respectfully submitted,

Dated: February 11, 2022

By: /James L. Davis, Jr./
Name: James L. Davis, Jr.
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on February 11, 2022, I caused a true and correct copy of the foregoing MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. §§ 42.22 AND 42.122(b) TO *INTER PARTES* REVIEW IPR2021-01226 to be served via express mail on the Patent Owner at the following correspondence address of record as listed on PAIR:

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A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel and counsel in IPR2021-01226 at the following addresses:

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Dated: February 11, 2022

By: /Dara Del Rosario/
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