

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

**PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION
TO PETITIONER'S MOTION FOR JOINDER**

Exhibit No.	Description of Document
1001	U.S. Patent No. 7,594,168 B2 to Steven R. Rempell (filed January 24, 2003, issued September 22, 2009) (“’168” or “’168 patent”)
1002	Declaration of Vijay K. Madisetti, Ph.D. (“Madisetti”)
1003	U.S. Patent No. 6,052,717 to Brian Reynolds et al. (filed October 23, 1996, issued April 18, 2000)
1004	Excerpts from Laura Lemay et al., <i>Teach Yourself Web Publishing with HTML 3.2 in a Week</i> (3d ed.1996)
1005	Excerpts from Laura Lemay et al., <i>Teach Yourself Java in 21 Days</i> (1996)
1006	Excerpts from Greg Perry, <i>C++ Programming 101</i> (1992)
1007	U.S. Patent No. 6,125,360 to Andrew Witkowski et al. (filed July 2, 1998, issued September 26, 2000)
1008	Excerpts from Jason Coombs et al., <i>Setting up an Internet Site for Dummies</i> (3d ed. 1998)
1009	Excerpts from <i>Microsoft Press Computer Dictionary</i> (3d ed. 1997)
1010	<i>Reserved</i>
1011	Prosecution History of U.S. Patent No. 7,594,168 B2
1012	Complaint for Patent Infringement (Dkt. 1) in <i>Express Mobile, Inc. v. Facebook, Inc.</i> , Case No. 6:20-cv-00803-ADA (W.D. Tex. Sept. 1, 2020)
1013	Scheduling Order (Dkt. 46) in <i>Express Mobile, Inc. v. Facebook, Inc.</i> , Case No. 6:20-cv-00803-ADA (W.D. Tex. April 6, 2021)
1014	Preliminary Infringement Contentions and Identification of Priority Dates, served February 5, 2021, in <i>Express Mobile, Inc. v. Facebook, Inc.</i> , Case No. 6:20-cv-00803-ADA (W.D. Tex.)
1015	Order Granting in Part and Denying in Part Stay Motions, <i>Express Mobile, Inc. v. SAP SE</i> , No. 3:20-cv-08492-RS, D.I. 34 (N.D. Cal. Apr. 5, 2021)

Exhibit No.	Description of Document
1016	Amended Order Construing Claims (Dkt. 81) in <i>X Commerce, Inc. d/b/a Magento, Inc. v. Express Mobile, Inc.</i> , No. 17-cv-02605 (N.D. Cal. Sept. 12, 2018)
1017	Oral Order (Dkt. 35) in <i>Express Mobile, Inc. v. eGrove Systems Corporation</i> , No. 1-17-cv-00703 (D. Del. Aug. 22, 2018.)
1018	Claim Construction Memorandum Opinion and Order (Dkt. 97) in <i>Express Mobile, Inc. v. Svanaco, Inc.</i> , No. 2-17-cv-00130 (E.D. Tex. Feb. 7, 2018)
1019	<i>Reserved</i>
1020	Order on Claim Construction (Dkt. 142) in <i>Shopify Inc. et al. v. Express Mobile, Inc.</i> , No. 1-19-cv-00439 (D. Del. June 30, 2020)
1021	Memorandum Opinion (Dkt. 121) in <i>Express Mobile v. GoDaddy.Com, LLC</i> , No. 1-19-cv-01937 (D. Del. June 1, 2021)
1022	Request for Ex Parte Reexamination of U.S. Patent No. 7,594,168, Control No. 90/014,583 (September 25, 2020)
1023	<i>Reserved</i>
1024	Declaration of Sylvia Hall-Ellis, Ph.D.
1025	Joint Claim Construction Chart (Dkt. 23) in <i>Express Mobile, Inc. v. eGrove Systems Corporation</i> , No. 1-17-cv-00703 (D. Del. April 6, 2018.)
1026	Joint Claim Construction Brief (Dkt. 64) in <i>Express Mobile, Inc. v. GoDaddy.Com, LLC</i> , No. 1:19-cv-01937 (D. Del. March 19, 2021)
1027	Defendant's Amended List of Proposed Claim Constructions in <i>Express Mobile, Inc. v. Facebook, Inc. et al</i> , No. 6-20-cv-00803 (W.D. Tex. May 12, 2021)
1028	Email, Maria King, Deputy Chief Clerk for Trials to Kenneth Weatherwax, Counsel for Patent Owner Express Mobile, Inc. (Mar. 10, 2022)

I. PO'S OPPOSITION IS NOT TIMELY

As an initial matter, while PO claims that the “Opposition is timely under the Board’s March 29, 2022 email order authorizing Patent Owner to file an opposition to the motion for joinder...by April 1, 2022” (Paper 7 (“Opposition” or “Opp.”), 1 n.1), Petitioner is not aware of any such authorization. The only email from the Board that Petitioner received came from the Deputy Chief Clerk for Trials on March 10, 2022 indicating that she “cannot authorize” PO’s request for an extension. EX1028. Petitioner is unaware of any other email to the Board by PO regarding an extension or any authorization granted by the Board. PO’s Opposition is accordingly not timely and should not be considered.

II. §315(b)’S TIME BAR DOES NOT APPLY

The Petition is timely and the Motion for Joinder (Paper 3 (“Motion” or “Mot.”)) should be granted. An IPR petition may not be “filed more than 1 year after the date on which the petitioner...is served with a complaint alleging infringement of the patent” **except** this limit “shall not apply to a request for joinder under [§315(c)].” 35 U.S.C. §315(b); *see Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1333 (Fed. Cir. 2020); 37 C.F.R. §42.122(b). The Federal Circuit and Board have unambiguously found joinder an exception to the time bar. *Id.*; *LG Elecs. Inc. v. Uniloc 2017 LLC*, IPR2019-01530, Paper 8, *7 (“the 35 U.S.C. § 315(b) time bar does not apply to a request for joinder”); *Sun Pharm. Indus. Ltd.*

v. *Merck Sharp & Dohme Corp.*, IPR2020-01072, Paper 12, *6, n.9 (similar).

Indeed, joinder is appropriate where, as here, a “copycat” petition has been filed by a petitioner who has not previously challenged the patent before the Board.

Yet in the face of explicit statutory language, Federal Circuit precedent, and previous panel interpretation, PO incorrectly and repeatedly argues that the Board should deny the Motion because the Petition is time-barred. In so arguing, PO inappropriately attempts to shoehorn the facts of this case into the Board’s recent precedential joinder decisions. First, PO mischaracterizes *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38 (Mar. 13, 2019), incorrectly arguing that “[j]oinder will be denied where ‘the Petitioner’s own conduct’—such as failing to timely file a petition when it could have—‘created the need for it to request joinder.’” Opp., 2; *see also id.*, 5-6. But PO cites no authority for its expansive application of *Proppant*—and other panels explicitly found *Proppant* does not apply where a petition “does not seek same party or issue joinder.” *LG Elecs. Inc. v. CyWee Group Ltd.*, IPR2019-01203, Paper 12, *47-48; *see also Kingston Tech. Co., Inc. v. SecureWave Storage Sols., Inc.*, IPR2020-00139, Paper 12, *14 (similar); *Xilinx, Inc. v. FG SRC LLC*, IPR2021-00633 Paper 15, *15 n.4 (granting motion for joinder over PO’s time bar argument). Unlike here, *Proppant* involved a prior art ground **rejected on the merits**, and an attempt to overcome that rejection (after the 1-year time bar) by joining a **new** petition with **new** invalidity

arguments to petitioner's **own** instituted proceeding. *Proppant*, 2. *Proppant* does not apply here because Petitioner "does not seek same party or issue joinder," this is Petitioner's first challenge of '168, and Petitioner presents the same grounds and prior art as the instituted Facebook IPR (IPR2021-01226).

Second, PO incorrectly argues that the Board should deny joinder under *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9. Opp., 1-2, 4-5. *Uniloc* also does not apply. There, Apple's rejected joinder request came after denial of an earlier Apple petition **on the merits** and sought to join an IPR for **entirely different** prior art and grounds. But here, the Board has never addressed the merits of Petitioner's invalidity arguments (because Petitioner has not previously challenged '168) and Petitioner is relying on the same prior art/grounds as Facebook. At least one panel has explicitly found that "[u]nlike [*Uniloc*], where the petitioner had filed a prior petition before filing a joinder petition, Petitioner [] here has not filed a prior petition challenging the [patent-at-issue]." *Sony Mobile Commc'ns Ab v. Ancora Techs., Inc.*, IPR2021-00663 Paper 17, *11.

PO further mischaracterizes panel decisions in a misguided attempt to support its position that the Board should exercise its discretion to deny joinder in view of the 1-year time bar. Opp., 7-8. But PO's cited cases are easily distinguishable. First, in *Micro Motion, Inc. v. Invensys Sys.*, IPR2014-01409, Paper 14, *15, the petitioner **did not file a copycat petition**—instead, it filed a follow-on petition that attempted

to correct deficiencies the Board identified in a previously filed IPR. *See id.* *13-14 (explaining that the Board previously denied institution of claim 43, and “Petitioner now comes forward with an analysis, in its Petition, of how claim 43 is unpatentable...and seeks to join to the earlier-filed proceeding”). Second, *HTC Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17, *9-13, is similarly distinguishable because there, (1) petitioner previously filed a CBM petition; (2) it had been over four years since petitioner was served with a complaint; and (3) petitioner benefitted from third party petitions.

The Board should reject PO’s mischaracterizations of Board precedent and panel decisions and grant Petitioner’s Motion.

III. PO’S REMAINING ARGUMENTS TO DENY JOINDER FAIL

As explained in the Motion, each factor the Board considers favors joinder. This is Petitioner’s first challenge of ’168. The Petition is substantially identical to the Facebook IPR petition, presenting the same grounds, prior art, and arguments. Mot., 5. Joinder will not impact the Facebook IPR trial schedule. Mot., 5-7. And Petitioner agreed to take an understudy role with limitations approved by numerous panels. Mot., 7-8. The Board should grant Petitioner’s motion.

PO incorrectly asserts that an analysis of the *General Plastics* factors is necessary. Opp., 5-6. But *General Plastics* provides little—if any—guidance where, as here, the “copy-cat” petitioner has not previously filed an IPR petition.

See Ericsson Inc. v. Uniloc 2017 LLC, IPR2020-00376, Paper 16, *13. Indeed, the *General Plastics* panel articulated its concern over giving second bites at the apple to the same petitioner; here, Petitioner has not had a first bite, so *General Plastics* does not apply. And in any event, despite PO's criticisms, it did not even apply the *General Plastics* factors.

Finally, joinder would not complicate the proceedings. Petitioner agreed to the understudy role described by the Board. Mot. 7-8 (quoting *Noven Pharms., Inc. v. Novartis AG*, IPR2014-00550, Paper 38, *5). PO incorrectly complains that "joinder would also add complexity to the proceedings" because "Petitioner does not pledge to refrain from participation in the proceeding if joined." Opp. 8-9. But PO fails to cite **any** decisions where the understudy limitations described in *Noven* were insufficient for joinder, and panels continue to accept the same limitations as those described in *Noven* and proposed by Petitioner. *See, e.g., Navico, Inc. v. Garmin Switzerland GmbH*, IPR2017-02051 Paper 8, *4-6 (determining that PO's proposed limitations on petitioner's participation in the understudy role beyond those enumerated in *Novartis* "more restrictive than necessary at this time"); *Edwards Lifesciences Corp. v. Colibri Heart Valve LLC*, IPR2021-00775, Paper 8, *10-11.

IV. CONCLUSION

The Board should grant Petitioner's Motion.

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

IPR2022-00518

Respectfully submitted,

Dated: April 29, 2022

By: /James L. Davis, Jr./

Name: James L. Davis, Jr.

Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on April 29, 2022, I caused a true and correct copy of the foregoing Petitioner's Reply to Patent Owner's Opposition to Petitioner's Motion for Joinder and supporting exhibit to be served via electronic mail to the following attorneys of record of the Patent Owner listed below:

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