

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EBAY INC., EXPEDIA, INC., HOMEAWAY.COM, INC., SQUARESPACE,
INC. WIX.COM, LTD. AND WIX.COM, INC.
Petitioner

v.

EXPRESS MOBILE INC.,
Patent Owner

U.S. Patent No. 7,594,168 B2
Issue Date: September 22, 2009

Title: Browser Based Web Site Generation Tool and Run Time Engine

**PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER
UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22 AND § 42.122(b)**

IPR Trial No. IPR2022-00572

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<i>Z-Shade Co., Ltd. v. Caravan Canopy Int’l, Inc.</i> , IPR2021-00449, Paper 11 (May 17, 2021)	2

Other Authorities

37 C.F.R. § 42.101(b)	1
37 C.F.R. § 42.122(b)	1, 4

I. INTRODUCTION

Patent Owner's opposition ("Opp.") to Petitioner's Joinder Motion ("Mot.") is premised on misstatements of fact and law. Patent Owner's contention that Petitioner is time-barred from seeking joinder is plainly incorrect, as is its characterization of Board precedent, all of which is based on factual circumstances different from this Petition. Patent Owner's argument that Petitioner is not entitled to a "second bite at the apple" is also baseless, as Petitioner has not previously sought *inter partes* review of the '168 Patent. For the reasons set forth in the Petition ("Pet.") and Joinder Motion, and as discussed further below, the *General Plastic* and *Fintiv* factors do not support denial of institution, and joinder is warranted.

II. PETITIONER'S PETITION AND MOTION ARE TIMELY

Patent Owner's assertion that the Petition is time-barred is wrong. Rule 42.122(b) sets a deadline for joinder petitions of one month after the institution date of the IPR for which joinder is requested and confirms that the one-year time bar of § 42.101(b) does not apply when a petition is accompanied by a request for joinder. *See Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38, 17–18 (POP Mar. 13, 2019) ("*Proppant*"). Patent Owner argues, contrary to the law, that petitions accompanied by a request for joinder should be time barred "to prevent *inter partes* review from being 'used as a tool for harassment.'" Opp. at 2. But there can be no plausible harassment from this Petition, because Petitioner has agreed not

to expand the scope of the already-instituted proceedings. Pet. at 12; Mot. At 5–6.

III. PATENT OWNER MISCHARACTERIZES BOARD PRECEDENT, WHICH SUPPORTS INSTITUTION OF THE PETITION.

The Petition explains why discretionary denial is not warranted under *General Plastic* and *Fintiv* and why its motion for joinder should be granted. Pet. at 11–12. Patent Owner largely ignores Petitioner's explanation and instead asserts, without any support, that Petitioner “disregards current Board precedent and cites obsolete law.” Opp. at 4. Not so. *Uniloc* did not create a “new standard,” as Patent Owner contends; it simply clarified that the *General Plastic* and *Fintiv* factors remain applicable to “me too” petitions. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 5 (Oct. 28, 2020). Indeed, the Board continues to routinely grant “me-too” petitions. See, e.g., *STMicroelectronics, Inc. v. Monterey Research, LLC*, IPR2021-00704, Paper 8 (Aug. 2, 2021); *Z-Shade Co., Ltd. v. Caravan Canopy Int'l, Inc.*, IPR2021-00449, Paper 11 (May 17, 2021); *AT&T Servs., Inc. v. Broadband iTV, Inc.*, IPR2021-00556, Paper 14 (Aug. 25, 2021). And the Board has itself explicitly distinguished *Uniloc* from petitions such as this one, where Petitioner has not previously filed an IPR against the same patent. See *Sony Mobile Comm. AB v. Ancora Techs., Inc.*, IPR2021-00663, Paper 17, 11 (June 10, 2021) (“Sony”).

Patent Owner cites several cases in support of its view that “me-too” petitions have become disfavored (Opp. at 1–2), but in a majority of these cases the party seeking joinder had previously filed unsuccessful IPR challenges to the same patent.

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Uniloc, Paper 9; *LG Elecs., Inc. v. Ancora Techs. Inc.*, IPR2021-00581, Paper 16 (June 10, 2021) (“*LG*”); and *Proppant*, Paper 38. This is not the case here; this is Petitioner's first and only petition against the '168 Patent, not a “serial petition,” as Patent Owner contends. Opp. at 2.

Patent Owner's suggestion that *HTC Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17 (June 10, 2021) (“*HTC*”) stands for the proposition that “it has been found inappropriate to grant joinder to a time-barred petitioner, even if it has not previously filed any IPR against the patent” (Opp. at 7) is also incorrect. Patent Owner fails to note that HTC had previously filed a petition **for CBM review**, and the Board's denial of joinder was premised on this fact. *HTC*, Paper 17 at 13.

Patent Owner also relies on *Micro Motion, Inc. v. Invensys Sys.*, IPR2014-01409, Paper 14, 15 (Feb. 18, 2015), but in that proceeding, the Board denied institution and joinder where the oral hearing in the IPR proceeding to be joined was less than a month away, and where granting joinder would require reopening discovery. Such is not the case here, as the Meta IPR is in early stages and joinder will have no impact on the schedule. Mot at 4.

IV. GENERAL PLASTIC DOES NOT SUPPORT DISCRETIONARY DENIAL

Patent Owner does not address any specific *General Plastic* factors explicitly in its opposition, but implies that they support discretionary denial. Opp. at 4–5. Not so. As Petitioner previously explained, **Factors 1, 3 and 5** do not support

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discretionary denial. Pet. at 11–12; Mot. at 2. Moreover, as discussed above, the Petition and motion for joinder are timely under Rule 42.122(b). *See Sony*, Paper 17 at 13–14 (finding Factors 3 and 5 weighed “strongly in favor of institution” where Petitioner’s petition and motion for joinder were timely under Rule 42.122(b) and Petitioner had not filed a prior petition challenging the patent).

Factors 2 and 4 also weigh against discretionary denial. Pet. at 12. Patent Owner argues that “it must be assumed” that Petitioner knew of the art in Meta’s case (Opp. at 7–8), but fails to explain why. Before the Meta petitions were filed, Petitioner was not aware of the prior art relied upon by Meta. Thus, *HTC* is readily distinguishable, because HTC filed a follow-on IPR based on prior art that *HTC itself* had relied upon years earlier. *HTC*, Paper 17 at 13. *See also Sony*, Paper 17 at 11–14.

Factors 6-7 do not support discretionary denial, because Petitioner has agreed to assume an understudy role and to not actively participate in the proceedings, unless and until Meta’s role is terminated.

V. *FINTIV* DOES NOT SUPPORT DISCRETIONARY DENIAL

Patent Owner does not argue that any of the *Fintiv* factors support

discretionary denial and indeed it cannot.¹ All of the cases involving Petitioner remain in the early stages, two of them have been stayed, and the remaining two have stay motions pending in the relevant district courts.

VI. JOINDER WOULD NOT COMPLICATE THE PROCEEDINGS

Patent Owner fails to offer any plausible explanation of how joinder would complicate the proceedings, given Petitioner's agreement to take an "understudy" role to Meta. Petitioner has agreed to abide by Meta's substantive filings and deadlines, and will only actively participate in the proceedings if Meta terminates its participation, or Petitioner receives Meta and/or the Board's permission. Mot. at 5. Furthermore, as Petitioner explained in its motion, to the extent Patent Owner and the Board do not themselves raise issues that solely involve Petitioner, Petitioner will not actively participate in the Meta proceedings at all. Mot. at 5.

Accordingly, Petitioner's motion for joinder should be granted.

¹ Patent Owner cites *LG* to show that the *Fintiv* factors are applicable to follow-on petitions accompanied by motions for joinder. Opp. at 5. While true, in *LG*, trial was expected to occur more than eight months before the final written decision in the proceeding to which joinder was sought. *LG*, Paper 16 at 8. That is not so here.

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Dated: April 29, 2022

By: */Adam R. Brausa/*

Adam R. Brausa (Reg. No. 60,287)

DURIE TANGRI LLP

217 Leidesdorff Street

San Francisco, CA 94111

Tel: (415) 362-6666

Fax: (415) 236-6300

abrausa@durietangri.com

LEAD COUNSEL FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22 AND § 42.122(b)** is being served via electronic service on the 29th day of April, by consent, at the following electronic service addresses:

MSXMO-IPR@McKoolSmith.com,
SJXMOIPR@Steptoe.com
Steven J. Rizzi, srizzi@mckoolsmith.com
Steven Peters, speters@mckoolsmith.com
Christopher P. McNett, cmcnett@mckoolsmith.com
James R. Nuttall, jnuttall@steptoe.com
Christopher A. Suarez, csuarez@steptoe.com
Kenneth J. Weatherwax, weatherwax@lowensteinweatherwax.com

Dated: April 29, 2022

By: /Adam R. Brausa/

Adam R. Brausa (Reg. No. 60,287)
DURIE TANGRI LLP
217 Leidesdorff Street
San Francisco, CA 94111
Tel: (415) 362-6666
Fax: (415) 236-6300
abrausa@durietangri.com

LEAD COUNSEL FOR PETITIONER