

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

EXPRESS MOBILE INC.,
Patent Owner.

Case No. IPR2022-00597
Patent No. 7,594,168

**PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR *INTER PARTES* REVIEW**

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2002	Proof of Service of Google in <i>Express Mobile, Inc. v. Google LLC</i> , No. 6-20-cv-00804 (W.D. Tex.) (transferred to No. 3-21-cv-08944 (N.D. Cal.))
2003	Complaint filed against eBay in <i>Express Mobile, Inc. v. eBay Inc.</i> , No. 6-20-cv-00802 (W.D. Tex.) (transferred to the Northern District of California as case 3-21-cv-06656) [NEWLY ADDED]
2004	Proof of Service of eBay in <i>Express Mobile, Inc. v. eBay Inc.</i> , No. 6-20-cv-00802 (W.D. Tex.) (transferred to the Northern District of California as case 3-21-cv-06656) [NEWLY ADDED]
2005	Complaint filed against Expedia in <i>Express Mobile, Inc. v. Expedia, Inc.</i> , No. 6-20-cv-00801 (W.D. Tex.) (transferred to the Western District of Texas, Austin Division as case 1-21-cv-01141) [NEWLY ADDED]
2006	Proof of Service of Expedia in <i>Express Mobile, Inc. v. Expedia, Inc.</i> , No. 6-20-cv-00801 (W.D. Tex.) (transferred to the Western District of Texas, Austin Division as case 1-21-cv-01141) [NEWLY ADDED]
2007	Complaint filed against SquareSpace in <i>Express Mobile, Inc. v. Squarespace, Inc.</i> , No. 1-20-cv-01163 (D. Del.) [NEWLY ADDED]
2008	Proof of Service of SquareSpace in <i>Express Mobile, Inc. v. Squarespace, Inc.</i> , No. 1-20-cv-01163 (D. Del.) [NEWLY ADDED]
2009	Facebook's Petition in <i>Facebook, Inc. v. Express Mobile, Inc.</i> , IPR2021-01226 (Jul. 6, 2021) [NEWLY ADDED]
2010	Express Mobile Inc.'s Opposition to Motion for Joinder in <i>eBay Inc. et al. v. Express Mobile Inc.</i> , IPR2022-00572 (Apr.

	1, 2022) [NEWLY ADDED]
2011	Complaint filed against SAP in <i>Express Mobile, Inc. v. SAP SE</i> , No. 3-20-cv-08492 (N.D. Cal.) [NEWLY ADDED]
2012	Waiver of Service of Complaint in <i>Express Mobile, Inc. v. SAP SE</i> , No. 3-20-cv-08492 (N.D. Cal.) [NEWLY ADDED]
2013	Express Mobile Inc.’s Opposition to Motion for Joinder in <i>SAP Am., Inc. v. Express Mobile, Inc.</i> , IPR2022-00518 (Apr. 1, 2022) [NEWLY ADDED]
2014	Complaint filed against Facebook in <i>Express Mobile, Inc. v. Facebook Inc.</i> , No. 6-20-cv-00803 (W.D. Tex.) [NEWLY ADDED]
2015	Express Mobile Inc.’s Patent Owner Preliminary Response in <i>Facebook, Inc. v. Express Mobile, Inc.</i> , IPR2021-01226 (Oct. 20, 2021) [NEWLY ADDED]
2016	Institution Decision in <i>Facebook, Inc. v. Express Mobile, Inc.</i> , IPR2021-01226 (Jan. 14, 2022) [NEWLY ADDED]
2017	eBay Inc. et al.’s Petition in <i>eBay Inc. et al. v. Express Mobile Inc.</i> , IPR2022-00572 (Feb. 10, 2022) [NEWLY ADDED]
2018	SAP’s Petition in <i>SAP Am., Inc. v. Express Mobile, Inc.</i> , IPR2022-00518 (Feb. 11, 2022) [NEWLY ADDED]

I. INTRODUCTION

This is the fourth of four IPR petitions filed against the '168 patent. Petitioner Google LLC ("Google") had a chance to file its own petition for review of the '168 patent, but Google passed on that opportunity, even though it had notice and was served of Patent Owner's complaint alleging it infringed. Google made the strategic choice **not** to file a petition against the '168 patent within the one year time period, as evidenced by the fact that Google was sued for infringing five Express Mobile patents (U.S. Patent 6,546,397, U.S. Patent 7,594,168, U.S. Patent 9,063,755, U.S. Patent 9,471,287, and U.S. Patent 9,928,044), but before the one year time bar expired, Google filed petitions against ***the other four*** of the five allegedly infringed patents. (Google's four petitions against the other four allegedly infringed patents were all denied on the merits.) As the one year time bar under § 315(b) has expired, Google is time-barred from filing any more attacks on any of the patents in that complaint, including the '168 patent here.

Now, over five months after the § 315(b) bar expired, Google seeks to join the lone petition that has been instituted against the '168 patent, so that it can avoid the bar and seize a second chance to attack the claims in IPR. Under the Board's precedent, however, the narrow § 315(c) exception should not be granted in a situation like this one, where the would-be joiner has already had a full and fair

opportunity to challenge the patent, but chose to wait until after it was time-barred and after the Facebook IPR was instituted.

Google provides no good reason why it should be given a second chance after the time bar has elapsed. As analyzed below, all seven *General Plastic* factors favor denial. As the Board made clear in *Uniloc*, in these circumstances Google should not get a second bite at the apple. See Section III.

Moreover, Patent Owner opposes joinder. Paper 8. If joinder is denied, this Petition is time-barred as a matter of law and institution must be denied in any event. Because institution is impossible without joinder, and vice versa, Patent Owner's Opposition to Google's motion for joinder, *id.*, and the present Preliminary Response should be considered in conjunction with each other.

For the following reasons, the Petition should be denied.

II. FACTUAL BACKGROUND

A. Petitioner Was Served With A Complaint For Infringement Of The '168 Patent More Than One Year Before This Petition Was Filed.

Petitioner was sued for infringing the '168 patent on September 1, 2020. Ex. 2001 [Complaint]. Petitioner was served of the complaint on September 2, 2020. Ex. 2002 [Proof of Service]. Under § 315(b) the last day Petitioner could have filed a petition for an *inter partes* review was September 2, 2021.

Petitioner, however, waited until February 14, 2022—after the Facebook IPR was instituted—to file this Petition.

B. The Facebook IPR Petition Against Claims 1-4 And 6 Of This Patent Was Granted Institution.

On July 6, 2021, Facebook, now known as Meta (herein “Facebook”) filed a petition in IPR2021-01226, challenging claims 1-4 and 6 of the ’168 patent.

Facebook proposed two grounds challenging the patentability of claim 1: (1)

Ground 1 includes a combination of *Reynolds*, *Lemay Web*, *Lemay Java*, *Perry*, and *Witkowski*; and (2) Ground 2 includes a combination of *Reynolds*, *Lemay Web*, *Lemay Java*, *Perry*, *Witkowski*, and *Coombs*. Ex. 2009 [-01226 Pet.] 10.

On January 14, 2022, review was granted (the “01226-ID”).

C. The Second IPR Petition Against Claims 1-4 And 6 Of This Patent Is Time-Barred Unless Joinder To The Instituted IPR Is Granted.

On February 10, 2022, eBay Inc., Expedia, Inc., Homeaway.Com, Inc., Squarespace, Inc., Wix.Com, Ltd., and Wix.Com, Inc. (“the 00572 Petitioner”) filed a petition in IPR2022-00572, challenging, *inter alia*, claims 1-4 and 6 of the ’168 patent. The 00572 Petition proposed the same grounds as Facebook in the instituted IPR2021-01226.

An accompanying motion for joinder to IPR2021-01226 was also filed. Absent joinder, this petition against claims 1-4 and 6 is subject to the one-year time bar of § 315(b), because constituents of the 00572 Petitioner were served with a

complaint for infringement of the '168 patent well over one year before filing their IPR petition against claim 1. Ex. 2003 [Complaint filed against eBay]; Ex. 2004 [Proof of Service of eBay]; Ex. 2005 [Complaint filed against Expedia]; Ex. 2006 [Proof of Service of Expedia]; Ex. 2007 [Complaint filed against SquareSpace]; Ex. 2008 [Proof of Service of SquareSpace].¹ Accordingly, institution cannot be granted unless the motion for joinder is granted, and vice versa.

Before filing, the IPR2022-00572 Petitioner had an opportunity to review Facebook's IPR2021-01226 petition against claims 1-4 and 6, Patent Owner's October 20, 2021 Preliminary Response to Facebook's IPR2021-01226 petition against claims 1-4 and 6, and the Board's January 14, 2022 decision in IPR2021-01226 granting review (the 01226-ID).

On April 1, 2022, Patent Owner filed an opposition to the IPR2022-00572 motion for joinder to the instituted IPR2021-01226. Ex. 2010 [-00572 Opposition].

¹ “[T]he Federal Circuit has held that a petition is time-barred under §315(b) if at least one of the petitioner entities is in privity with a time-barred party.” *PayPal, Inc. v. Personal Web Techs., LLC*, IPR2019-01111, paper 27, 9 (Nov. 22, 2019); *cf. ARM Ltd. v. AMD, Inc.*, IPR2018-01148, Paper 16, 7 (Dec. 12, 2018).

The IPR2022-00572 Petition is awaiting decisions whether to institute and whether to grant joinder.

D. The Third IPR Petition Against Claims 1-4 And 6 Of This Patent Is Time-Barred Unless Joinder To The Instituted IPR Is Granted.

On February 11, 2022, SAP America, Inc. (“SAP”) filed a petition in IPR2022-00518, challenging, *inter alia*, claims 1-4 and 6 of the ’168 patent. The 00518 Petition proposed the same grounds as Facebook in the instituted IPR2021-01226.

An accompanying motion for joinder to IPR2021-01226 was also filed. Absent joinder, SAP’s petition against claims 1-4 and 6 of the ’168 patent is subject to the one-year time bar of § 315(b), because SAP’s petition was filed on February 11, 2022, more than one year after SAP was served with the complaint of the district court litigation 3-20-cv-08492 (N.D. Cal.) on December 22, 2020. Ex. 2011 [Complaint filed against SAP]; Ex. 2012 [Waiver of Service by SAP]. Accordingly, institution cannot be granted unless the motion for joinder is granted, and vice versa.

Before filing, SAP had an opportunity to review Facebook’s IPR2021-01226 petition against claims 1-4 and 6, Patent Owner’s October 20, 2021 Preliminary Response to Facebook’s IPR2021-01226 petition against claims 1-4 and 6, the

Board's January 14, 2022 decision in IPR2021-01226 granting review (the 01226-ID), and the 00572 petition against claims 1-4 and 6.

On April 1, 2022, Patent Owner filed an opposition to SAP's motion for joinder to the instituted IPR2021-01226. Ex. 2013 [-00518 Opposition].

The IPR2022-00518 Petition is awaiting decisions whether to institute and whether to grant joinder.

E. This Petition (The Fourth IPR Petition Against Claims 1-4 And 6 Of This Patent) Is Time-Barred Unless Joinder To The Instituted IPR Is Granted.

On February 14, 2022, Google filed this Petition against claims 1-4 and 6 of the '168 patent. Google proposed the same grounds as Facebook in the instituted IPR2021-01226.

An accompanying motion for joinder to IPR2021-01226 was also filed. Absent joinder, this IPR petition by Google against this patent claim is subject to the one-year time bar of § 315(b), because this Petition was filed on February 14, 2022, more than one year after Google was served with the complaint of the district court litigation on September 2, 2020. Ex. 2001 [Complaint]; Ex. 2002 [Proof of Service]. Accordingly, institution cannot be granted unless the motion for joinder is granted, and vice versa.

On April 1, 2022, Patent Owner filed an opposition to Google's motion in this case for joinder to the instituted IPR2021-01226. Paper 8.

Patent Owner now files its Preliminary Response to Google’s petition against claims 1-4 and 6 of the ’168 patent.²

III. INSTITUTION SHOULD BE DENIED UNDER NUMEROUS BOARD PRECEDENTS.

This is a “me-too” petition in which a time-barred petitioner, Google, now seeks to circumvent the time bar by seeking joinder to Facebook’s instituted IPR2021-01226 against this patent claim. The Board should reject Google’s attempts to circumvent the one-year time bar.

A. The Board’s Joinder Precedents Show That A Grant Of Petitioner’s Request Is Inappropriate.

In *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (designated precedential December 4, 2020) (“*Uniloc*”), the Office clarified that

² While Patent Owner strongly believes Google’s grounds lack technical merit, in view of the Board’s Institution Decision in IPR2021-01226, Patent Owner is not including technical merits arguments in its Preliminary Response. See, e.g., *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 4 (Oct. 28, 2020) (precedential) (denying institution of joinder petition where time-barred petitioner brought second IPR challenge, even though grounds had been held to present reasonable likelihood of unpatentability); *Apple Inc. v. Koss Corp.*, IPR2022-00053, Paper 10, 2-3 (Apr. 4, 2022) (same, applying *Uniloc* and *General Plastic*).

discretionary § 314(a) factors are directly relevant to “a ‘me-too petition’” like this one, and must be analyzed to determine whether such joinder requests should be rejected. *Uniloc*, 4-5 (holding that “before determining whether to join ..., **even though the Petition is a ‘me-too petition,’** we first determine whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).”) (emphasis added). Such discretionary factors apply under “a holistic view of whether efficiency and integrity of the system are best served” by rejecting it. *E.g.*, *LG Elecs., Inc. v. Ancora Techs. Inc.*, IPR2021-00581, Paper 16, 7 (June 10, 2021) (“*LG*”) (denying me-too joinder request).

Uniloc is hardly the first binding PTAB precedent to deny an unfair joinder request by a time-barred petitioner. In *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38 (POP Mar. 13, 2019) (precedential) (“*Proppant*”), the Precedential Opinion Panel explained, for example:

The one-year time limitation of § 315(b) is important to ensure “quiet title to patent owners” and to prevent *inter partes* review from being “used as [a] tool[] for harassment.” H.R. Rep. No. 112-98, pt. 1, 48 (June 1, 2011). Broadly exercising the discretion granted to the Director in § 315(c) could effectively circumvent the time limitation in § 315(b) in many cases. This would obviate the careful statutory balance.

Proppant, 18. When deciding whether to grant joinder requests, “[e]vents in other

proceedings related to the patent at issue,” discretionary § 314(a) factors, and “[t]he conduct of the parties and attempts to game the system may also be considered” in “carefully balanc[ing] the interest in preventing harassment against fairness and prejudice concerns.” *Proppant*, 18-19.

The present case warrants denial under this standard. Because Petitioner already had a full opportunity to challenge these claims after being alleged to infringe them, and forfeited that opportunity, joining Petitioner would simply “effectively circumvent the time limitation in § 315(b).” *Proppant*, 18.

In its Petition, Petitioner briefly argues that *Uniloc* does not apply, essentially simply because Petitioner chose not to previously challenge this Patent. Petition, 11. First, this fact ignores most of *Uniloc*’s reasoning, including, for example, *Uniloc*’s holding that a time-barred joinder petitioner should not necessarily be allowed to join a later attack such that it can block termination due to settlement as if it had brought the later attack in the first instance. Petitioner does not allege that it did not know of the art in Facebook’s case. It must be assumed that it did, and its delay in filing its IPR counts against discretionary joinder. See, e.g., *HTC Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17, 10-12 (June 10, 2021) (“*HTC*”) (rejecting joinder request where, *inter alia*, joinder petitioner “had the opportunity [years earlier] to file an *inter partes* review

petition” against the patent, and “should have known” of basis of challenge for years “instead of waiting ... to join” in joinder petition and motion).

This precedent establishes that a time-barred party should not get a second chance, after years of voluntary delay, to take a bite at the apple. Petitioner should not get that bite here.

B. The *General Plastic* Factors Strongly Favor Discretionary Denial.

As discussed below, each of the *General Plastic* factors either favor denial or are neutral. *General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 16-17 (Sept. 6, 2017) (precedential).

While the IPR2021-01226 Board did not conduct a *General Plastic* analysis (01226-ID), the Board likely reached that conclusion because no prior petition for *inter partes* review was filed, Facebook’s petition was timely filed, Facebook was not a party to Google’s district court litigation, and Facebook was not sufficiently related to Google.

In contrast, all of the *General Plastic* factors weigh against institution of Google’s petition. Google has the benefit of Facebook’s, the 00572 Petitioner’s, and SAP’s prior filings, is now time-barred, and is refiling on grounds it has been long aware of. When movant’s petition “is admittedly time-barred under 35 U.S.C. § 315(b)” it “weighs against joinder.” *E.g., Micro Motion, Inc. v. Invensys Sys.*, IPR2014-01409, Paper 14, 15 (Feb. 18, 2015). For example, 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, in circumstances that would allow the time-barred petitioner to continue the target proceeding, even after settlement with the primary petitioner, as if, in effect, the joining petitioner “had brought the second challenge to the patent in the first instance.” *HTC*, 9-13; *Uniloc*, 4.

Like the petition in *HTC*, Google’s petition should be denied.

1. *General Plastic Factor #1: Google’s Petition Is A Copy Of Facebook’s Petition.*

Factor #1—“whether the same petitioner previously filed a petition directed to the same claims of the same patent”—favors denial. While *General Plastic* involved petitions filed by the **same** petitioner, **different** petitioners may still be treated as the same under *GP* when they share a “significant relationship.” *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11, 9-10 (Apr. 2, 2019) (precedential). In *Valve*, the petitioner and the prior petitioner were co-defendants accused of infringement of the same patent and the same claims. *Id.*, 2. The status of being co-defendants favors a finding of a “significant relationship” between the petitioner and the prior petitioner. *Id.*, 10. Here, both Google and Facebook were sued for infringing the ’168 patent. Ex. 2001 [Complaint] 2; Ex. 2014 [Complaint against Facebook] 1. In view of *Valve*, the fact that both Google

and Facebook are co-defendants in infringing the '168 patent favors a finding of a “significant relationship” between Google and Facebook.

Additionally, Google’s petition is a copy of Facebook’s petition. A “significant relationship” is formed where the follow-on petitioner copies its predecessor’s arguments:

We determine ... that ***Petitioner implicitly created such a relationship by using the prior petitioners’ work as a menu and picking and choosing from their work product.*** The instant Petitioner’s decision to use the prior petitions as a roadmap for its own petition ties the interests of all of the petitioners together.

Ericsson Inc. v. Uniloc 2017, LLC, IPR2019-01550, Paper 8, 12 (Mar. 17, 2020). Here, Google did not merely “pick[] and choos[e]” from Facebook’s petition, but uses “identical arguments and the same grounds raised in the existing Facebook IPR proceeding.” Motion, 9. As Google admitted, it “challenges the same claims of the same patent, relies on the same expert declaration, and is based on the same grounds and combinations of prior art submitted in the Facebook Petition.” *Id.*

By wholesale copying Facebook’s arguments, refiling Facebook’s exhibits and experts’ declarations, Google has “implicitly created” a “significant relationship” with the previous petitioner, Facebook. *Ericsson*, IPR2019-01550, Paper 8, 12; *Samsung Elecs. Co., Ltd. v. Elm 3DS Innovations, LLC*, IPR2017-

01305, Paper 11, 18-19 (Oct. 17, 2017) (denying institution under *General Plastic* where petition had “high degree of similarity” to prior petitions filed by different petitioners and petitioner “use[d] the same expert”).

At most, the fact that Petitioner has not filed a prior petition only makes factor 1 weigh “somewhat” against discretionary denial. *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 17, 10 (Dec. 23, 2021) (“factor 1 weighs somewhat against discretionary denial because Petitioner has not filed a prior petition, but did copy its substantive grounds from a prior petition”). Here, Google made the strategic decision not to file against the ’168 before it was time-barred. Google’s deliberate choice not to file petition against the ’168 patent within the one year time period, as evidenced by the fact that Google was sued for infringing five Express Mobile patents (U.S. Patent 6,546,397, U.S. Patent 7,594,168, U.S. Patent 9,063,755, U.S. Patent 9,471,287, and U.S. Patent 9,928,044), but filed petitions against the other four of the five allegedly infringed patents before the one year time bar expired. Had Google wanted to challenge the ’168, it had a full and fair opportunity to have filed such a petition within the one year time bar under § 315(b). It made an intentional choice not to.

Notably, in granting discretionary institution in *OpenSky*, the Board found it significant that in that case, the Board had not yet substantively addressed the merits of the petition and, thus, “Patent Owner suffers no abuse from having this

tribunal consider the merits of these grounds for the first time.” *OpenSky*, 11.

That is the opposite of this case. As Facebook’s petition has been instituted, the present Petition would no longer be “the first time” the grounds are considered, and it would undoubtedly be abusive to institute a second petition raising precisely the same grounds, particularly where Google forfeited its opportunity to challenge the ’168’s validity before the one-year bar. *See HTC*, 9 (denying institution where petitioner “had the opportunity” to file the grounds in its joinder petition “concurrently” with an earlier petition but did not).

Therefore, *General Plastic* Factor #1 favors denial; and if the Board were to find it does not favor denial, then it may at most be found to only “somewhat” weigh against denial.

2. *General Plastic* Factors #2, 4: Google Fails To Provide Meaningful Explanation As To Its Actual Or Reasonable Knowledge Of The Prior Art.

The second and fourth factors are (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” and (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.” *General Plastic*, 16-17. These factors strongly favor denial.

Here, Google merely asserts that “at the time of filing of the petition in IPR2021-00700, counsel for Google in any of the actions involving Express Mobile did not identify or consider the prior art used in the Facebook IPR proceeding and in the present proceeding, despite extensive prior art search.” Google’s Reply in Support of Motion for Joinder, 2. But this narrow and carefully worded statement leaves open the possibility that Google or its counsel were aware of the art after all, and simply did not conclude that it was the best art to bring against the challenged claim. And Google offers no description of the supposedly “extensive prior art search.” Moreover, the question is not whether Petitioner knew of the art in Facebook’s case. The question is whether it ***should have known*** of it. *See, e.g., HTC*, 10-12 (raising of grounds in earlier litigation favored denial, because petitioner “should have known” of basis of challenge for years, “instead of waiting ... to join”).

The Board has held that the second *General Plastic* factor weighs in favor of denying institution when Petitioner fails to provide meaningful explanation as to its actual or reasonable knowledge of the prior art. *Uniloc*, 9 (precedential) (“[petitioner] has failed to ... offer an explanation concerning its knowledge, at the time it filed the first petition, of the prior art asserted in the [earlier] IPR and here. Because of the lack of explanation, we conclude that this second *General Plastic* factor weighs in favor of denying institution of the proceeding”); *see also HTC*,

10-11 (denying time-barred petitioner's joinder IPR under *GP* and *Unlioc*, based on analysis of facts concerning likelihood of cited references escaping prior art search); *Koss*, 9-11, 12 (similar).

Similarly, the lack of meaningful explanation of when Google learned of the prior art weighs in favor of denial under the fourth *General Plastic* factor. *Uniloc*, 11 (“We are not persuaded that this factor is irrelevant to our analysis.... the lack of explanation by Apple provides no context by which to ascertain Apple’s knowledge of the prior art asserted in the 023 IPR.... Because of the lack of explanation, we conclude that this fourth *General Plastic* factor weighs in favor of denying institution of the proceeding”); *see also HTC*, 12 (finding factor 4 weighs against institution because joinder petitioner “should have known of” the art cited in the primary petition years earlier).

Accordingly, the second and fourth *General Plastic* factors strongly favor denial.

3. *General Plastic* Factor #3: Google Was Able To Study Express Mobile’s Preliminary Responses, The Board’s Institution Decision, And SAP’s And The -00572 Petitioner’s Petition Including The Same Grounds Against The Same Patent Claim.

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”—favors denial.

Per *General Plastic*:

factor 3 is directed to Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions. ... ***Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.*** The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, ***using our decisions as a roadmap***, until a ground is found that results in the grant of review. All other factors aside, ***this is unfair to patent owners and is an inefficient use of the inter partes review process ...***

General Plastic, 17-18 (internal citation and footnote omitted). Here we have the “multiple, staggered petitions challenging the same patent and same claims” that *General Plastic* warns against and restricts.

Here, Facebook challenged claims 1-4 and 6 of the ’168 patent in IPR2021-01226. Ex. 2009 [-01226 Pet.] 10. In response, Patent Owner filed its preliminary response on October 20, 2021. Ex. 2015 [-01226 POPR]. The Board granted institution on January 14, 2022. Ex. 2016 [-01226-ID]. On February 10, 2022, the 00572 Petitioner filed a petition in IPR2022-00572, challenging, *inter alia*, claims

1-4 and 6 of the '168 patent. Ex. 2017 [-00572 Pet.] 11. On February 11, 2022, SAP filed a petition in IPR2022-00518, challenging, *inter alia*, claims 1-4 and 6 of the '168 patent. Ex. 2018 [-00518 Pet.] 10. Thus, there can be no doubt that before filing this Petition, Google had the opportunity to study prior filings and be able to use these prior filings to adjust its own strategy.

After the one year time bar expired, Google now seeks to avoid the statutory bar to challenge claims 1-4 and 6 of the '168 patent under the guise of joining Facebook's IPR2021-01226. Google's Petition is the fourth petition against the same claims of the same patent, which constitutes the abusive use of the *inter partes* review process that is warned against in *General Plastic*. Google's strategy and abusive use of the IPR should not be rewarded. The third *General Plastic* factor also favors denial.

4. *General Plastic* Factor #5: Google Provides No Adequate Explanation For The Time Elapsed Before Its 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”—strongly favors denial.

Here, Petitioner was sued for infringing the '168 patent on September 1, 2020. Ex. 2001 [Complaint]. Petitioner was served the complaint on September 2,

2020. Ex. 2002 [Proof of Service]. Under § 315(b) the last day Petitioner may file the petition for an *inter partes* review was September 2, 2021.

Here, there is a significant time gap between the § 315(b) due date for Google to file the petition (September 2, 2021) and the actual date Google filed this Petition (February 14, 2022). Google does not offer any explanation justifying why it waited for over five months to file this Petition. And, of course, Google is time-barred from filing a petition against the patent.

Furthermore, this petition was filed on the last possible day under the joinder rule (the one month period under 37 C.F.R. § 42.122(b)). Google, again, fails to provide any explanation as to why it waited until the last possible day to file a me-too petition, which presumably requires only minimum effort to complete. Accordingly, there is maximum delay between Google's me-too petition and Facebook's petition.

The Board has held that reasonable explanation for the timing of the petition makes the fifth *General Plastic* factor at most neutral, not weighing against discretionary denial. *Patent Quality Assurance, LLC v. VLSI Tech. LLC*, IPR2021-01229, Paper 10, 10 (Jan. 26, 2022) ("We determine that PQA has offered a reasonable explanation for the timing of the Petition, and conclude that factors 2, 4, and 5 weigh neither for nor against discretionary denial."). Absent a reasonable

explanation from Google, the fifth *General Plastic* factor favors denial, or it is at least neutral.

5. *General Plastic* Factor #6: If Facebook Settles, Google, A Time-Barred Party, Would Be Able To Continue The Joined IPR As If Google Had Brought The Case In The First Instance.

Factor 6—“the finite resources of the Board”—favors denial. Here, were Facebook to settle with Patent Owner, the would-be joinder petitioner would be able to continue the litigation in its stead. That fact weighs against joinder under *General Plastic*. As the Board found in the binding *Uniloc* decision:

[W]e agree with Patent Owner that because this is [the would-be joinder petitioner] Apple’s second petition, should Microsoft settle, Apple would stand in to continue a proceeding that would otherwise be terminated. Joinder in this circumstance would allow Apple to continue a proceeding even after settlement with the primary petitioner, based on a second attempt by Apple. On balance, we conclude that this sixth *General Plastic* factor weighs in favor of denying institution of the proceeding.

Uniloc, 12 (denying institution); *id.*, 4 (“the copied petition is Petitioner’s second challenge to the patent, and should Microsoft settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated. In effect, it would be as if Apple had brought the second challenge to the patent in the first instance. This is the kind of serial attack that *General Plastic* was intended to address.”)

(underlining added); see also *Koss*, 13 (“Joinder in this circumstance would allow

Petitioner to continue a proceeding, even after settlement with the primary petitioner”). Just as in *Uniloc*, the would-be joinder petitioner here, a time-barred party, should not be permitted to prolong this IPR in the event of settlement of the first instituted IPR of all the serial attacks against this patent.

In *Uniloc*, the Board further explained how granting institution to the second petition filed by an otherwise time-barred Petitioner could be prejudicial to Patent Owner. The Board stated:

As explained in further detail below, Petitioner’s understudy argument is not persuasive here where the copied petition is Petitioner’s second challenge to the patent, and should Microsoft settle, Petitioner would stand in to continue a proceeding that would otherwise be terminated. In effect, it would be as if Apple had brought the second challenge to the patent in the first instance. This is the kind of serial attack that *General Plastic* was intended to address. *General Plastic*, Paper 19 at 17 (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

Uniloc, 4; see also *HTC*, 13 (finding that the sixth *General Plastic* factor weighs in favor of denying institution as “joinder in this circumstance would allow [the would-be joinder petitioner] to continue a proceeding even after settlement with the primary petitioner, based on a second attempt by [the would-be joinder petitioner]”).

Google states in its Motion for Joinder that “Google shall not make any substantive filings and shall be bound by the filings of Facebook, *unless a filing concerns termination and settlement*, or issues solely involving Google.” Motion, 12 (emphasis added). Therefore, Google fully intends to leave itself open to make such filings, and take over the case, in the event of settlement or termination of the original petitioner. As the Board explained in *Uniloc* and *HTC*, the sixth *General Plastic* factor therefore favors denial.

6. General Plastic Factor #7: Allowing Google To Join Complicates The Ability To Reach A Final Determination Within The One Year Period.

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”—favors denial.

Here, granting Google’s request for joinder would also add complexity to the proceedings. In addition to the difficulties concerning settlement noted above, see *Uniloc*, 4, 12, Petitioner does not pledge to refrain from participation in the proceeding if joined.

Petitioner pledges to join only as an “understudy” petitioner. However, Petitioner carves out many things from what it calls this “understudy” role. Petitioner makes no promise that it will take no action in the case, unless and until the primary petitioner ceases to participate and it requests and receives specific

authorization from the Board first. *Compare, e.g., GlobalFoundries U.S. Inc. v. Godo Kaisha IP Bridge I*, IPR2017-00919, Paper 12, 8-9 (June 9, 2017) (granting joinder to petitioner where joining petitioner was barred from taking any action in the case unless it first sought and received specific “authorization from the Board” for such action). Instead, Petitioner’s pledge to participate as an “understudy” has many caveats. Petitioner says it will not assume an “active role,” Motion, 12, but this is only true so long as the proceedings do not raise “issues solely involving Google” or, in any way, “concern[] termination and settlement,” *id.* Petitioner reserves a similar right to participate in depositions of both the primary petitioner’s and Patent Owner’s witnesses, to “seek discovery from [Patent Owner],” and to participate “at the oral hearing.” *Id.* It is easy to perceive that it is possible for Petitioner’s supposedly narrow exceptions that it grants itself to its understudy rule could, if Petitioner in its sole judgment deemed it warranted, become an active role indeed. This would exacerbate what Petitioner concedes are the “potential complications or delay that potentially may result by joinder.” *Id.* Google’s Reply in support of Motion for Joinder merely states that “[t]o the extent the Board finds Google’s conditions for accepting the ‘understudy role’ to be overbroad, Google is ‘willing to agree to any other reasonable conditions the Board deems necessary,’ as set forth in Google’s Motion for Joinder.” Google’s Reply in support of Motion for Joinder, 5. Again, Google’s Reply fails to address issues “solely involving

Google,” “concern[ing] termination or settlement,” or Petitioner’s rights to participate in depositions, to seek discovery from Patent Owner, and to participate at the oral hearing. Google’s Reply therefore does not alleviate the concerns of complicating the proceeding.

Accordingly, the seventh *General Plastic* factor favors denial. At the very least, the seventh *General Plastic* factor is neutral. *Uniloc*, 12 (“Because there is no evidence or persuasive argument towards this factor, we determine this factor’s weight is neutral.”).

* * *

For the reasons above, every *General Plastic* factor favors or strongly favors discretionary denial of review, or is at most neutral or “somewhat” against denial. Review should therefore be denied.

IV. IF GOOGLE’S MOTION FOR JOINDER IS DENIED, INSTITUTION MUST BE DENIED.

As noted above, Google is time-barred from filing this IPR petition against this patent claims, absent grant of its motion in this case (Paper 8) for joinder to the instituted IPR2021-01226. *See supra* Section II.E. Therefore, if Google’s motion for joinder is denied, the present Petition must be denied.

V. CONCLUSION

Google has already had a full and fair opportunity to challenge this patent

claim in IPR. Google chose not to file a petition for *inter partes* review before the one year time bar expired. Now, time-barred as a matter of law absent joinder, Google finally files this IPR, and the fourth overall, against claims 1-4 and 6 of the '168 patent. There is no good reason to grant Google a second full chance in these circumstances. All this would do is to help creating a cavalcade of multiple, staggered attacks against the same claims of the same patent, frustrate settlement, and absolve and indeed reward delay.

If Google is instituted as a joinder petitioner (the only way it can be instituted), and the petitioner in the instituted case were to settle, Google could take over the case just so “[i]n effect, it would be as if [Google] had brought the second challenge to the patent in the first instance. ***This is the kind of serial attack that General Plastic was intended to address.***” *Uniloc*, 4 (emphasis added). Google has had its chance to bite at the apple. It is not entitled to a second one. Institution should be denied.

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CERTIFICATE OF WORD COUNT

I hereby certify, pursuant to 37 C.F.R. section 42.24, that the foregoing Patent Owner Preliminary Response contains 5,568 words, excluding the words in the table of contents, table of authorities, exhibit list, this certificate of word count, and certificate of service. The word count is based on the word count of the Microsoft Word program used to prepare the Patent Owner Preliminary Response.

/ Vinson Lin /
Vinson Lin

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served
by electronic service, by consent, on the date signed below:

**EXPRESS MOBILE INC.'S
PATENT OWNER PRELIMINARY RESPONSE**

EXHIBITS 2003-2018

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Respectfully submitted,

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