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
Patent 7,594,168 B2

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

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2002	Waiver of Service of Complaint in *Express Mobile, Inc. v. SAP SE*, No. 3-20-cv-08492 (N.D. Cal.)

Petitioner's motion for joinder should be denied.[1]

Petitioner had a chance to file a petition for review of this patent (the "Patent"). And Petitioner passed on that opportunity, even though it had notice, and waived service, of Patent Owner's complaint alleging it infringed. Petitioner is time-barred from filing any more attacks on any of the patents in that complaint, including the Patent here.

Now, another company who (like Petitioner) is an alleged infringer of the Patent has had institution granted on an IPR against this Patent. And Petitioner has filed this "me-too" petition and moved for joinder, seeking to take advantage of 35 U.S.C. § 315(c)'s narrow joinder exception to 35 U.S.C. § 315(b)'s time bar. 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 an opportunity to challenge the patent, but chose to wait without doing so until after it was time-barred.

The statutes, rules and current PTAB precedent governing joinder make clear that such attacks are now disfavored and generally should be denied. *See*,

[1] This Opposition is timely under the Board's March 29, 2022 email order authorizing Patent Owner to file an opposition to the motion for joinder in each of IPR2022-00518, IPR2022-00570, IPR2022-00572, IPR2022-00597, and IPR20220-0598 by April 1, 2022.

e.g., *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (designated precedential Dec. 4, 2020) ("*Uniloc*").

Congress' restrictions on IPR, including the one-year time bar, and grant of discretionary to deny joinder are intended to be applied "to prevent *inter partes* review from being 'used as a tool for harassment'" and "ensure 'quiet title to patent owners.'" *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38, 18 (POP Mar. 13, 2019) (precedential) ("*Proppant*") (quoting H.R. Rep. No. 112-98, pt. 1, 48 (June 1, 2011)), *rev'd in other respects*, *Facebook, Inc. v. Windy City Innovs., LLC*, 973 F.3d 1321, 1332 (Fed. Cir.), *reh'g denied*, 819 Fed. App'x 936 (Fed. Cir. 2020). Because granting joinder of time-barred petitions "could effectively circumvent" the time bar, the "Board will exercise this discretion only in limited circumstances—namely, where fairness requires it." *Proppant*, 18-19 (emphasis added). The Board therefore considers the "conduct of the parties and attempts to game the system" and "carefully balanc[es] the interest in preventing harassment [of patent owners] against fairness and prejudice concerns." *Id.*, 18-19. Joinder 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." *Id.*, 19.Multiple harassing attacks on the same patent are disfavored. Granting petitions (especially serial petitions like this one) and joinder is always discretionary. The Office should not reward Petitioner by

granting this request just so it can now inject itself into an IPR against a Patent, one of several long asserted against it, that it failed to timely challenge.

Petitioner did not file a petition against this Patent in the time § 315(b) allowed it to do so. It made that choice with full knowledge of the Patent and the pending complaint. And now, after years of waiting, it belatedly tries to join someone else's petition, to increase its settlement leverage. Petitioner has shown no reason it should be given a second chance, after long delay, to attack the Patent in a way calculated to increase harassment and excuse its own deliberate and strategic delay.

I. THE PETITION IS TIME-BARRED.

Petitioner was served with a complaint for infringement of the Patent well over one year before the Petition in this case was filed. Ex. 2001 [Complaint]; Ex. 2002 [Waiver of Service].[2] Therefore, the petition in this case is subject to the one-year time bar of § 315(b).

[2] SAP affirmatively waived its defense of improper service or no service. A formal waiver of service was filed with the district court. *Id.*; *see* Fed. R. Civ. P. 4(l)(1). Accordingly, for purposes of the time bar, the date formal waiver of service was effected is deemed to be the date the complaint was served. *See, e.g.*, *Brinkmann Corp. v. A&J Mfg., LLC*, IPR2015-00056, Paper 10, 6–7 (Mar. 23,

The only exception to the statutory § 315(b) bar is the joinder exception in § 315(c). Accordingly, in this case institution cannot be granted unless the motion for joinder is granted, and vice versa.

II. THE PETITION FOR IPR SHOULD BE DENIED INSTITUTION.

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

disregards current Board precedent and cites obsolete law. In the past, the Board analyzed "me-too" joinder requests (*i.e.*, petitions that are the same as the petition they seek to join), under the view that "the *General Plastic* factors [we]re not particularly relevant" to such requests. *E.g., Central Sec. Grp.—Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, 8 (Feb. 26, 2020).

The Office announced a new standard, however, in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (Oct. 28, 2020) (designated precedential Dec. 4, 2020) ("*Uniloc*"). The Office clarified in binding precedent that 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.

2015) (holding that for 315(b) timebar purposes, date waiver of service is filed with district court is date petitioner is deemed to have been served with complaint).

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). The *Fintiv* discretionary factors, like the *General Plastic* factors, also apply, under "a holistic view of whether efficiency and integrity of the system are best served" by rejecting it—particularly where a joinder petitioner is attacking a patent it already attacked before. *E.g.*, *LG Elecs., Inc. v. Ancora Techs. Inc.*, IPR2021-00581, Paper 16, 7 (June 10, 2021) ("*LG*") (applying *Fintiv*, denying me-too joinder request). Notably, such requests may be rejected even when the joinder petitioner's second petition raises different grounds than its first. *Uniloc*, 8-11.

Other recent decisions have followed *Uniloc*, and *Uniloc* is hardly the first binding PTAB precedent to deny an unfair joinder request by a time-barred petitioner. In *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 spurned that opportunity, joining Petitioner would simply "effectively circumvent the time limitation in § 315(b)." *Proppant*, 18.

Tellingly, the Petition and Motion ignore *Proppant* and *Uniloc* altogether.

B. The Preliminary Response Will Address Denial Of Institution.

Patent Owner is entitled to a preliminary response to the petition ("POPR") setting forth the reasons institution should not be granted. 35 U.S.C. § 313. In the POPR, Patent Owner will set forth the reasons granting institution is not warranted.

The remainder of this Opposition will accordingly address why, even if the Petition otherwise warranted institution, the Board should not grant discretionary joinder—meaning that institution must be denied in any event.

III. EVEN IF THE PETITION COULD OTHERWISE BE FOUND TO WARRANT INSTITUTION, JOINDER SHOULD BE DENIED.

Even if this petition warranted institution, which it does not, discretion should ***not*** be exercised to grant joinder under 35 U.S.C. § 315(c). *See LG Elecs., Inc. v. ATI Techs. ULC*, IPR2015-01620, Paper 10, 5 (Feb. 2, 2016) ("*ATI*")

("Joinder may be authorized when warranted, but the decision to grant joinder is discretionary."); 35 U.S.C. § 315(c); *see also Uniloc*, 4.

A. Petitioner Is Time-Barred And Deliberately Delayed Attacking The Patent.

As noted above, Petitioner is time-barred from filing any IPR against the Patent, absent a grant of joinder. 35 U.S.C. §315(c).

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). As noted above, the Precedential Opinion Panel has held that "[b]roadly exercising the discretion granted to the Director in § 315(c)" to grant joinder to time-barred petitioners "could effectively circumvent the time limitation in § 315(b) in many cases." 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 Corp. v. Ancora Techs., Inc.*, IPR2021-00570, Paper 17, 9-13 (June 10, 2021).

Moreover, Petitioner does not explain why it could not have filed an IPR petition earlier. *Cf. Id.*, 13. Notably, 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.*, *id.*, 10-12 (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.

These facts therefore weigh against a discretionary grant of Petitioner's motion for joinder.

B. Petitioner Failed To Candidly Disclose That It Is Time-Barred.

Petitioner, although subject to a duty of candor, did not disclose to the Board, or serve on the party, any acknowledgement that it is time-barred under § 315(b).

Because joinder is subject to denial as a matter of equitable discretion, *see*, *e.g.*, *Proppant*, 18, and those who would receive equity must themselves do equity, this lack of candor is an additional fact weighing against exercising discretion to grant Petitioner's otherwise time-barred joinder request.

C. Granting Joinder Would Complicate The Proceedings.

Granting Petitioner'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 without seeking 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 the "primary role," Motion, 8, but this is only true so long as the proceedings do not raise issues solely involving Petitioner, *id*., 7. 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*., 7-8. 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, and exacerbate what Petitioner concedes are the

"potential complications or delay that potentially may result by joinder." *Id.*, 8.

D. There Is No Consent To Joinder.

"[T]he Office may consider ... [the] consent of the patent owner[]." *ATI*, 5. Patent Owner opposes joinder. This lack of consent therefore weighs against a discretionary grant of Petitioner's request for joinder. *See id.*

IV. CONCLUSION

For these reasons, and the reasons to be set forth in the preliminary response to the Petition, joinder should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE

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

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

EXHIBITS 2001-2002

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