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Paper 17
Entered: August 19, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

EXPRESS MOBILE, INC.,
Patent Owner.

IPR2022-00597
Patent 7,594,168 B2

Before JEFFREY S. SMITH, MITCHELL G. WEATHERLY, and DANIEL J. GALLIGAN, *Administrative Patent Judges.*

GALLIGAN, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314
Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

Google LLC ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–4 and 6 of U.S. Patent No. 7,594,168 B2 ("the '168 patent," Ex. 1001). Paper 1 ("Pet."). Petitioner also filed a Motion for Joinder seeking to be joined as a party to *Facebook, Inc. v. Express Mobile Inc.*, IPR2021-01226 ("the Facebook IPR"), which involves the same claims of the '168 patent. Paper 3 ("Motion" or "Mot.").

Express Mobile, Inc. ("Patent Owner") opposed the Motion (Paper 8 ("Opposition" or "Opp.")),[1] and Petitioner filed a reply in support of the Motion (Paper 9).

Patent Owner also filed a Preliminary Response. Paper 10 ("Prelim. Resp.").

For the reasons explained below, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the Facebook IPR and grant Petitioner's Motion for Joinder.

B. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters, including the Facebook IPR, which involves the '168 patent. Pet. 1–9; Paper 6, 1–9.

C. Real Parties in Interest

The parties identify themselves as the real parties in interest. Pet. 1; Paper 6, 1.

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[1] Patent Owner's Opposition was timely filed on April 1, 2022, pursuant to our email extending the deadline. Ex. 3001.

D. Asserted Grounds of Unpatentability

Petitioner presents the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1–4, 6	103(a)	Reynolds,[2] Lemay Web,[3] Lemay Java,[4] Perry,[5] Witkowski[6]
1–4, 6	103(a)	Reynolds, Lemay Web, Lemay Java, Perry, Witkowski, Coombs[7]

II. ANALYSIS

Joinder for purposes of an *inter partes* review is governed by 35 U.S.C. § 315(c), which states:

> JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

"To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). "First, the statute requires that the Director (or the Board acting through a

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[2] US 6,052,717, issued Apr. 18, 2000 (Ex. 1003).
[3] L. Lemay, *Teach Yourself Web Publishing with HTML 3.2 in a Week*, 3rd ed. © 1996 (Ex. 1004).
[4] L. Lemay and C. Perkins, *Teach Yourself JAVA in 21 Days*, © 1996 (Ex. 1005).
[5] G. Perry, *C++ Programming 101*, © 1992 (Ex. 1006).
[6] US 6,125,360, issued Sept. 26, 2000 (Ex. 1007).
[7] J. Coombs et al., *Setting Up an Internet Site for Dummies*, 3rd ed. © 1998 (Ex. 1008).

delegation of authority . . .) determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* "Second, to effect joinder, § 315(c) requires the Director to exercise his discretion to decide whether to 'join as a party' the joinder applicant." *Id.*

A. Whether the Petition Warrants Institution

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition and the Preliminary Response shows "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

The patentability challenges in the Facebook IPR met the "reasonable likelihood" standard of § 314(a). IPR2021-01226, Paper 8, 27. There is no dispute that the Petition presents the same patentability challenges as those for which a trial was instituted in the Facebook IPR. *See* Mot. 1 (asserting that "[t]he Google petition and the petition in the Facebook IPR Proceeding are substantively identical"); Prelim. Resp. 12 ("Google's petition is a copy of Facebook's petition."). In the present proceeding, Patent Owner does not dispute the patentability merits of Petitioner's challenges. *See* Prelim. Resp. 7, n.2.

We conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the '168 patent challenged in the Petition for the reasons set forth in the Facebook IPR. *See* IPR2021-01226, Paper 8, 7–27.

Even if a petition meets the "reasonable likelihood" standard, institution of *inter partes* review is still discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is

permitted, but never compelled, to institute an IPR proceeding."); 35 U.S.C. § 314(a) ("The Director *may not* authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." (emphasis added)).

Patent Owner contends that we should deny institution based on the Board's precedential decisions in *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (designated precedential in relevant part). Prelim. Resp. 7–24. *General Plastic* sets forth a non-exhaustive series of factors to be considered by the Board in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a petition that challenges a patent that was previously challenged before the Board. *General Plastic*, Paper 19 at 15–18.

These factors are as follows:

> 1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
>
> 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;
>
> 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;
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> 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;

> 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;
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> 6. the finite resources of the Board; and
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> 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.

Id. at 16. These factors are "a non-exhaustive list," and "additional factors may arise in other cases for consideration, where appropriate." *Id.* at 16, 18.

Petitioner has not previously filed a petition challenging the '168 patent, so the Petition does not present the same situation as in *General Plastic*. We recognize, however, that *General Plastic* has not been limited to instances in which multiple petitions are filed by the same petitioner. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (precedential). Rather, "when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General Plastic* factors." *Valve*, Paper 11 at 9. Patent Owner argues that there is a "significant relationship" between Petitioner and Facebook, the petitioner in the Facebook IPR, because both "were sued for infringing the '168 patent" and because Petitioner copied Facebook's petition. Prelim. Resp. 11–12 (citing *Valve*, Paper 11 at 2, 9–10).

We disagree with Patent Owner's assertion that there is a *Valve*-type relationship between Petitioner and Facebook that warrants denial. In *Valve*, the Board noted that "Valve and HTC were co-defendants in the District Court litigation and were accused of infringing the [challenged] patent based on HTC's VIVE devices that incorporate technology licensed from Valve." *Valve*, Paper 11 at 10. The Board determined that there was "a significant

relationship between Valve and HTC with respect to Patent Owner's assertion of the [challenged] patent." *Id.* Nothing in the record before us indicates any such relationship between Petitioner and Facebook. Rather, Petitioner and Facebook are two entities among nearly 100 entities that Patent Owner has sued for allegedly infringing the '168 patent. *See* Paper 6, 1–9 (Patent Owner's Mandatory Notices listing nearly 100 lawsuits involving the '168 patent filed by Patent Owner).

We also do not agree with Patent Owner's assertion that Petitioner's copying the petition from the Facebook IPR created a "significant relationship" between Petitioner and Facebook. *See* Prelim. Resp. 12 (citing *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8, 12 (Mar. 17, 2020)). The Board decision on which Patent Owner relies is not precedential and is readily distinguishable from the present situation because it did not involve joinder, unlike the case here. *See Ericsson*, Paper 8. Copying a previously-instituted petition is common in the joinder context because it is an efficient mechanism by which to satisfy the requirement of 35 U.S.C. § 315(c) to file a petition that "warrants the institution of an inter partes review."

Patent Owner also argues that Petitioner "provides no good reason why it should be given a second chance after the time bar has elapsed" and that Petitioner "should not get a second bite at the apple." Prelim. Resp. 2 (citing *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential)). Patent Owner's reliance on *Uniloc* is misplaced because that case involved a petitioner that had previously filed a petition against the challenged patent. *See Uniloc*, Paper 9 at 8 ("[T]his is the second petition Apple has filed challenging the claims of the '088 patent."). As discussed above, Petitioner has not previously filed a petition challenging

the ’168 patent. Furthermore, joinder based on a time-barred petition is expressly authorized by statute. *See* 35 U.S.C. § 315(b) (“An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).”). Thus, we disagree with Patent Owner’s characterization of Petitioner’s filing as “a second bite at the apple.” *See* Prelim. Resp. 2.

Patent Owner’s remaining arguments fail to persuade us that discretionary denial is appropriate under the circumstances of this case. For example, in addressing the third *General Plastic* factor, Patent Owner argues that Petitioner “had the opportunity to study prior filings and be able to use these prior filings to adjust its own strategy.” Prelim. Resp. 18. There is no question Petitioner studied prior filings. Indeed, Petitioner states that the Petition is “substantively identical” to Facebook’s petition. Mot. 1. As noted above, copying a previously-instituted petition is an efficient mechanism by which to satisfy the requirement of 35 U.S.C. § 315(c) to file a petition that “warrants the institution of an inter partes review.” Furthermore, Petitioner timely filed the Petition and Motion under our Rules, as Patent Owner acknowledges. *See* Prelim. Resp. 19 (“[T]his petition was filed on the last possible day under the joinder rule (the one month period under 37 C.F.R. § 42.122(b)).”).

The second, fourth, and fifth *General Plastic* factors are “to assess and weigh whether a petitioner should have or could have raised the new challenges earlier.” *General Plastic*, Paper 19 at 18. In this case, as noted above, Petitioner is not raising new challenges but merely presents the same

challenges that previously resulted in institution, and Petitioner acted within the time frame set forth under our Rules. Thus, the second, fourth, and fifth factors do not favor discretionary denial.

Relying on *Uniloc*, Patent Owner argues that the sixth *General Plastic* factor favors denial because, in case of a settlement with Facebook, this case will continue with Petitioner. Prelim. Resp. 20–22. In *Uniloc*, the panel determined that the sixth *General Plastic* factor favored denial because it was the petitioner's second petition, which is not the case here. *Uniloc*, Paper 9 at 12. Indeed, *Uniloc* expressly acknowledges that "a joinder request is usually an efficient mechanism by which to become a petitioner in an IPR." *Uniloc*, Paper 9 at 12. We find this to be the case here where Petitioner merely seeks to join an existing proceeding rather than have a separate *inter partes* review. By arguing that the Petition and the Motion should be denied because "Petitioner already had a full opportunity to challenge these claims after being alleged to infringe them, and forfeited that opportunity" (Prelim. Resp. 9), Patent Owner suggests, in effect, that joinder based on a time-barred petition should never be granted. But this contravenes the express statutory authorization for granting a request for joinder after the one-year time bar. *See* 35 U.S.C. § 315(b). Patent Owner's arguments also suggest that every defendant should file a separate petition rather than take advantage of the efficient joinder mechanism authorized by statute. Such an approach would be particularly inefficient here, where Patent Owner has asserted the '168 patent against nearly 100 entities. *See* Paper 6, 1–9.

Finally, the seventh *General Plastic* factor does not favor discretionary denial because Petitioner merely seeks to join an ongoing

proceeding, and we discern no difficulty in timely issuing a final written decision in that proceeding.

Based on the foregoing, we determine that the Petition warrants institution, and we turn to Petitioner's request for joinder.

B. Whether the Motion Should Be Granted

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). Petitioner argues that its Motion is timely and should be granted because the Facebook IPR will not be impacted if it were to join that proceeding. Mot. 8–12. Petitioner also agrees to take an "understudy" role in the Facebook IPR. Mot. 11–13.

Patent Owner argues that the fact that the Petition is time-barred under 35 U.S.C. § 315(b) weighs against joinder. Opp. 7. We disagree because § 315(b) states that the one-year time bar "shall not apply to a request for joinder under subsection (c)." Patent Owner also argues that granting joinder would complicate the proceedings because Petitioner reserves the right to participate in the Facebook IPR under certain conditions. Opp. 9–10. We disagree because Facebook has already filed its reply in the Facebook IPR, and, therefore, the petitioner-side briefing on the merits in the Facebook IPR is complete. Furthermore, Facebook has not filed any objections to Patent Owner's evidence in the Facebook IPR, and, thus, there is no basis for a motion to exclude Patent Owner's evidence. As such, briefing on the petitioner's side in the Facebook IPR is essentially closed.

Having considered the parties' arguments, we determine that it is appropriate under these circumstances to join Petitioner as a party to the Facebook IPR.

III. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted on the challenges raised in the Petition; and

FURTHER ORDERED that Petitioner's Motion for Joinder with Case IPR2021-01226 is *granted*, and Petitioner is hereby joined as a petitioner in Case IPR2021-01226;

FURTHER ORDERED that the grounds on which trial in Case IPR2021-01226 were instituted are unchanged, and no other grounds are added in Case IPR2021-01226;

FURTHER ORDERED that the Scheduling Order entered in Case IPR2021-01226 (Paper 9) and schedule changes agreed by the parties in Case IPR2021-01226 (pursuant to the Scheduling Order) shall govern the trial schedule in Case IPR2021-01226;

FURTHER ORDERED that Petitioner's role in Case IPR2021-01226 shall be limited as stated by Petitioner in the Motion for Joinder (Paper 3, 1–2, 11–13) unless and until Facebook is terminated from that proceeding;

FURTHER ORDERED that the case caption in Case IPR2021-01226 shall be changed to reflect joinder of Petitioner and the petitioners in IPR2022-00572 as petitioners in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision be entered into the record of Case IPR2021-01226; and

FURTHER ORDERED that all further filings shall be made in Case IPR2021-01226.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., EBAY INC., EXPEDIA, INC., HOMEAWAY.COM, INC., SQUARESPACE, INC., WIX.COM, LTD., WIX.COM, INC., and GOOGLE LLC,[8]
Petitioner,

v.

EXPRESS MOBILE, INC.,
Patent Owner.

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[8] Expedia, Inc., eBay Inc., Homeaway.com, Inc., Squarespace, Inc., Wix.com, Ltd., and Wix.com, Inc. filed a motion for joinder and a petition in Case IPR2022-00572. Google LLC filed a motion for joinder and a petition in Case IPR2022-00597. All of these parties have been joined as petitioners in this proceeding.