UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

EXPRESS MOBILE, INC.,
Patent Owner.

IPR2022-00790
Patent 9,063,755 B2

Before JEFFREY S. SMITH, AMBER L. HAGY, and AARON W. MOORE *Administrative Patent Judges.*

MOORE, *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, 2, 5–7, and 11 of U.S. Patent No. 9,063,755 B2 ("the '755 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.*, IPR2021-01455 ("the Facebook IPR"), which involves the same claims of the '755 patent. Paper 3 ("Motion" or "Mot."). Express Mobile, Inc. ("Patent Owner") opposed the Motion (Paper 7, "Opp."), Petitioner filed a reply in support of the Motion (Paper 8, "Reply"), and Patent Owner filed a Preliminary Response (Paper 9, "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 we grant Petitioner's Motion for Joinder.

B. Related Matters

The parties identify various related matters, including twenty-one pending District Court cases, five terminated District Court cases, two pending Board IPRs (including the Facebook IPR), and four IPR petitions that were denied. *See* Pet. 1–4; Paper 5, 1–3.

C. Asserted Grounds of Unpatentability

Petitioner presents the following grounds, which are identical to the grounds instituted in the Facebook IPR:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5–7	103(a)	Anderson,[1] Bowers,[2] Jacobs,[3] Ambrose-Haynes[4]
11	103(a)	Anderson, Bowers, Jacobs, Ambrose-Haynes, NFS Administration[5]

II. ANALYSIS

Joinder in *inter partes* review proceedings is governed by 35 U.S.C. § 315(c):

> 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.

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[1] G. Anderson & P. Anderson, *JAVA Studio Creator Field Guide*, 2d ed. (Prentice Hall 2006) (Ex. 1003, "Anderson").

[2] B. Bowers & S. Lane, *Advanced FileMaker Pro 6 Web Development* (Wordware Pub. 2003) (Ex. 1004, "Bowers").

[3] S. Jacobs, *Foundation XML for Flash* (Springer-Verlag 2006) (Ex. 1005, "Jacobs").

[4] N. Ambrose-Haynes et al., *Professional ColdFusion 5.0* (Wrox Press. Ltd. 2001) (Ex. 1006, "Ambrose-Haynes").

[5] *Unix System V NFS Administration* (D. Herman, ed., Prentice Hall 1993) (Ex. 1007, "NFS Administration").

In deciding whether to join a party to an instituted *inter partes* review, "the plain language of § 315(c) requires [that we make] two different decisions." *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). First, "the statute requires that [we] determine whether the joinder applicant's petition for IPR 'warrants' institution under § 314." *Id.* Second, we must decide whether to exercise discretion to join the Petitioner to the existing proceeding. *See id.*

A. Whether the Petition Warrants Institution

35 U.S.C. § 314(a) 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."

This Petition presents the same patentability challenges as those we found sufficient in the Facebook IPR, and Patent Owner does not argue the patentability merits of Petitioner's challenges at this stage. *See* Pet. 1 ("[this] petition and the petition in the Facebook IPR Proceeding are substantively identical"); Prelim. Resp. 9, n.2 ("Patent Owner is not including technical merits arguments in its Preliminary Response."). We thus conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to the challenged claims of the '755 patent for the reasons given in the Institution Decision in the Facebook IPR.

Even if a petition meets the "reasonable likelihood" standard, however, 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.").

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) and *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential). Prelim. Resp. 7–24.

General Plastic identifies a list 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:

> 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

> 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.

General Plastic, Paper 19 at 15–18. This is a "non-exhaustive list," and "additional factors may arise in other cases for consideration, where appropriate." *Id.* at 16, 18.

In *Uniloc*, the petitioner (Apple) sought to join an instituted *inter partes* review by filing a petition that was substantially the same as the petition on which a trial had been instituted. *Uniloc*, Paper 9 at 2–3. It was the petitioner's second petition challenging the patent, and the panel applied the *General Plastic* factors and denied the petition. *Uniloc*, Paper 9 at 8–13.

Patent Owner argues that the present situation is similar to the circumstances in *Uniloc* that favored denial under *General Plastic* and, therefore, that the Petition should be denied. Prelim. Resp. 7–24.

For the reasons explained below, we find the present circumstances distinguishable from those in *Uniloc*, and we decline to deny the Petition based on the *General Plastic* factors.

Whether Petitioner Previously Filed a Petition Directed to the Same Claims

Petitioner filed an earlier petition challenging the '755 patent, although it challenged a slightly different set of claims—1, 2, 7, and 11, instead of 1, 2, 5–7, and 11 as in the instant Petition. *See* IPR2021-00709, Paper 1, 1.

Despite the differences in the challenged claims, we find that the first *General Plastic* factor favors denial because Petitioner did file a petition challenging claims of the '755 patent before.

Whether Petitioner Knew or Should Have Known of the Prior Art

In *Uniloc*, the panel found that the second *General Plastic* factor favored denial because "Apple ha[d] failed to set forth facts or offer an explanation concerning its knowledge, at the time it filed the first petition, of the prior art asserted in" the second petition. *Uniloc*, Paper 9 at 9.

In contrast to the situation in *Uniloc*, Petitioner "represents that, at the time of filing of the first petition . . . counsel for [Petitioner] in any of the actions involving [Patent Owner] did not identify or consider the prior art used in the Facebook IPR proceeding and in the present Petition, despite extensive prior art search." Pet. 6.[6]

Patent Owner argues that "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 claims." Prelim. Resp. 17. We do not agree, because the assertion is clear that counsel "did not identify or consider the prior art." In any event, Petitioner's representation is sufficient to distinguish the present situation from *Uniloc*, in which there was *no* explanation of the facts relevant to the second *General Plastic* factor. *See Uniloc*, Paper 9 at 9.

Patent Owner also argues that "the question is not whether Petitioner knew of the art in Facebook's case" but "whether it ***should have known*** of it." Prelim. Resp. 17. Patent Owner, however, does not explain why Petitioner "should have known" of the prior art, and Petitioner asserts that it

[6] As explained below, Petitioner received the Anderson reference used in the Facebook IPR on March 13, 2021, but was "unable to identify [it] by the time of filing of the first petition on March 31, 2021 . . . particularly given that it was produced among over three thousand other documents." Pet. 6–7.

did not locate the prior art despite an "extensive prior art search." *Id.* We find Petitioner's representation sufficient, and see nothing to support a conclusion that Petitioner "should have known" of the prior art before filing the petition for the '709 IPR.

We accordingly find that the second *General Plastic* factor does not favor denial.

Whether the Petitioner Had Received the Preliminary Response to the First Petition or the Board's Institution Decision

The third factor requires us to consider whether, at the time of the filing of this petition, Petitioner had received the preliminary response or the Board's institution decision in the first petition.

The instant Petition was filed on April 1, 2022, which was after institution was denied in IPR2021-00709 (the "'709 IPR"). However, this factor is concerned with whether the Petitioner was holding back the prior art, or used the preliminary response to gain an advantage in the second petition. *See General Plastic*, Paper 19 at 9 n.13. Neither is a concern here, because (a) Petitioner asserts that it had not identified the prior art at the time of the earlier Petition, and (b) this Petition is a copy of the Petition in the Facebook IPR, which was filed before the denial in the '709 IPR. *See* Pet. 7. Although Petitioner might, in the end, benefit from the filing of the Facebook IPR, there is no reason to conclude that Petitioner used the filings or decision in the '709 IPR to obtain an unfair advantage in this Petition, which was essentially prepared by someone else.

Patent Owner also lists the other IPRs that have been filed against the '755 patent and argues that this Petition is "exactly 'the kind of serial attack that *General Plastic* was intended to address.'" Prelim. Resp. 20 (quoting

Uniloc, Paper 9 at 4). We do not agree. This "me too" Petition is not a new "serial attack," but rather an attempt to join a proceeding that has already been instituted.[7]

For these reasons, we conclude that *General Plastic* factor three does not favor denial.

The Length of and Reasons for the Time that Elapsed from Learning of the Prior Art to the Filing of the Petition

The fourth and fifth *General Plastic* factors "assess and weigh whether a petitioner should have or could have raised the new challenges earlier." *General Plastic*, Paper 19 at 18. In *Uniloc*, the panel determined that the petitioner's lack of explanation of its knowledge of the prior art favored denial based on the fourth and fifth *General Plastic* factors. *Uniloc*, Paper 9 at 10–11.

Here, Petitioner was sued for infringement of the '755 patent and served on September 2, 2020. *See* Ex. 2002. Petitioner then filed the petition for the '709 IPR on March 31, 2021, the petition for the Facebook IPR was filed on September 1, 2021, the '709 IPR petition was denied on October 4, 2021, the Facebook IPR was instituted on March 4, 2022, and Petitioner filed the instant Petition with the joinder motion on April 1, 2022.

Petitioner asserts that "[w]hile the primary reference at issue in the Facebook IPR proceeding and in the present Petition . . . was produced by Express Mobile in the parallel district court litigation on March 13, 2021, [Petitioner] was unable to identify this reference by the time of filing of

[7] In the Facebook IPR, we considered Patent Owner's serial petition argument in detail but were not convinced that a discretionary denial was warranted. *See* IPR2021–01455, Paper 11, 8–14.

the first petition on March 31, 2021 . . . particularly given that it was produced among over three thousand other documents." Pet. 6–7. The "primary reference" is Anderson, Exhibit 1003.

Thus, although Petitioner admits that it had received Anderson in mid-March 2021, Petitioner also represents that it was not aware of the significance Anderson when it filed the petition for the '709 IPR eighteen days later.

Petitioner does not identify when it recognized that Anderson might bear on the patentability of claims of the '755 patent, but if that realization came more than a day after the September 1, 2001 filling of the Facebook IPR, Petitioner would have been barred from filing its own IPR using Anderson, due to service of the complaint on September 2, 2020. It cannot have been unreasonable for Petitioner to not have filed an IPR using Andersen when it was barred from doing so under § 315(b). But we also find that it would not have been unreasonable for Petitioner to not have filed its own IPR using Anderson earlier than the bar date, because Petitioner's '709 IPR was then pending.

After the '709 IPR was denied, Petitioner was unable to file this Petition until the Facebook IPR was instituted,[8] and then did so within the time provided by our rules. *See* 37 C.F.R. § 42.122(b).

We find that it was not unreasonable for Petitioner to not have filed an IPR using Anderson before the bar date because Petitioner had another petition pending, and that it was not unreasonable for Petitioner to not file

[8] Section 315(d) provides for joinder "[i]f the Director institutes an inter partes review."

between the bar date and the institution of the Facebook IPR because such a filing would have been prohibited by § 315(b).

Patent Owner also argues that Petitioner filed the Petition "three days before the last possible day under the joinder rule" and did not explain this "maximum delay." Prelim. Resp. 21–22. This is not a persuasive argument. As explained above, Petitioner was not able to seek to join the Facebook IPR until it was instituted, and then did so within the one month windows provided by our rules. *See* 37 C.F.R. § 42.122(b).

Under these unique circumstances, we cannot conclude that the amount of time that elapsed between Petitioner learning of the Facebook IPR prior art and filing of this Petition was unreasonable and, thus, we find that the fourth and fifth *General Plastic* factors do not favor denial.

Board Resources

Relying on *Uniloc*, Patent Owner argues that the sixth *General Plastic* factor favors denial because, in the event of a settlement with Facebook, this case will continue with Petitioner. *See* Opp. 5–6.

The question is whether joining Google to the Facebook IPR would have an adverse impact on Board resources. We think not.

As Petitioner observes, we generally do not speculate about settlement (*see* Pet. 7), but we are concurrently granting joinder to the Petitioner in IPR2022-00785, which means that this case would still proceed should Facebook settle. And, in any event, we find that "board resources" are not a concern here because this panel has the capacity to see the Facebook IPR to its conclusion regardless of the constitution of the Petitioner.

For these reasons, we conclude that the sixth *General Plastic* factor does not favor denial.

The Need to Issue a Final Determination Within a Year of Institution

The seventh *General Plastic* factor does not favor discretionary denial because Petitioner merely seeks to join an ongoing proceeding as an understudy, and we see no difficulty in timely issuing a final written decision in that proceeding.

* * *

As explained above, we find that only the first *General Plastic* factor favors denial. We thus conclude that, considered as a whole, the relevant factors do not favor a discretionary denial of institution.

We accordingly determine that the Petition warrants institution under Section 314, and 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 "submits that the request for joinder is consistent with the policy surrounding *inter partes* reviews, as it is the most expedient way 'to secure the just, speedy, and inexpensive resolution of every proceeding.'" Mot. 1 (quoting 37 C.F.R. § 42.1(b)). Petitioner asserts that this Petition and the petition in the Facebook IPR Proceeding "are substantively identical," that "they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims," and that "upon joining the Facebook IPR Proceeding, [Petitioner] will act as an

'understudy' and will not assume an active role unless the current petitioner ceases to participate in the instituted IPR." Mot. 1–2.

Patent Owner responds that "Petitioner already had the opportunity to take—and indeed took—one full and fair bite of the apple, *i.e.*, one challenge to the claims of the Patent before the Office, [and] Petitioner has not shown any reason the Office should exercise discretion to grant it yet another bite." Opp. 1. Patent Owner further argues that "Petitioner, although subject to a duty of candor, did not disclose to the Board, or serve on the party, any acknowledgement that it is subject to the time bar under § 315(b) unless joinder is granted," and that "[g]ranting Petitioner's request for joinder would also add complexity to the proceedings." Opp. 11.

Although we are sympathetic to Patent Owner's argument about a second bite at the apple, the Facebook IPR has already been instituted and there is no indication the Petitioner was aware of the significance of the prior art before it filed the petition in the '709 IPR, or before the Facebook IPR.

We are not persuaded that Petitioner violated its duty of candor because it is apparent from the Petition, which identified *Express Mobile, Inc. v. Google LLC*, No. 6-20-cv-00804 (W.D. Tex.), that Petitioner had been sued for infringement. Petitioner did not highlight the statutory bar, but it was not hidden.

We also are not persuaded by Patent Owner's argument that granting the Motion would increase complexity. Petitioner has agreed to act as a understudy and thus will not have a material role in this proceeding unless it becomes the sole petitioning entity.

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

Facebook IPR. Petitioner will be subject to the estoppel provisions of 35 U.S.C. § 315(e).

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;

FURTHER ORDERED that Petitioner's Motion for Joinder with Case IPR2021-01455 is *granted*, and Petitioner is hereby joined as a petitioner in Case IPR2021-01455;

FURTHER ORDERED that the grounds on which trial in Case IPR2021-01455 were instituted are unchanged, and no other grounds are added in Case IPR2021-01455;

FURTHER ORDERED that the Scheduling Order entered in Case IPR2021-01455 (Paper 12) and schedule changes agreed by the parties in Case IPR2021-01455 pursuant to the Scheduling Order shall govern the trial schedule in Case IPR2021-01455;

FURTHER ORDERED that Petitioner's role in Case IPR2021-01455 shall be limited as stated by Petitioner in the Motion for Joinder unless and until Facebook is terminated from that proceeding;

FURTHER ORDERED that the case caption in Case IPR2021-01455 shall be changed to reflect joinder of Petitioner and the petitioners in IPR2022-00790 as petitioners in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision be entered into the record of Case IPR2021-01455; and

FURTHER ORDERED that all further filings shall be made in Case IPR2021-01455.

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