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Filed on behalf of Amazon.com, Inc.
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-00561
U.S. Patent No. 8,503,691

MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2022-01061 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)

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I. INTRODUCTION

Petitioner Amazon.com, Inc., respectfully submits this motion for joinder, together with a petition for *inter partes* review ("IPR") of U.S. Patent No. 8,503,691 ("the '691 patent"). Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner requests institution of this IPR and joinder and consolidation with IPR2022-01061 ("the Google IPR"), which was instituted on January 3, 2023. In the Google IPR, the Board is reviewing the same claims that Petitioner challenges.

Joinder here would be consistent with the overarching policy of securing "the just, speedy, and inexpensive resolution" of every IPR proceeding. 37 C.F.R. § 42.1(b). Petitioner's Petition and the Google petition are substantively identical—they contain the same grounds, based on the same prior art combinations against the same claims. Thus, joinder would neither unduly complicate the Google IPR nor delay its schedule.

To streamline discovery and briefing, Petitioner agrees to take an "understudy" role, actively participating substantively in the Google IPR only if Google terminates its involvement after joinder. (If Google were to terminate its involvement prior to this Motion being granted, then Petitioner would withdraw this Motion so that Petitioner's timely filed Petition could be considered on its merits.)

Because joinder would promote judicial efficiency in determining patentability without prejudicing Patent Owner, the Board should grant this Motion.

II. STATEMENT OF FACTS

Patent Owner filed suit against Google on September 23, 2021, and has asserted nine patents against Google, including the '691 patent. (Case No. 6:21-cv-00985, W.D. Tex.) Patent Owner filed suit against Petitioner on November 29, 2021, asserting the same patents except for the '691 patent. (Case No. 2:21-cv-00435, E.D. Tex., transferred to Case No. 5:22-cv-06727, N.D. Cal.) Patent Owner did not amend its complaint to add the '691 patent until February 28, 2022.

Google has filed IPR Petitions against each of the nine patents. For most of the patents, Petitioner has filed independent petitions. For other asserted patents, including the '691 patent, Petitioner is filing substantively identical petitions to those Google filed and is seeking joinder.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority to join Petitioner as a party to the Google IPR. 35 U.S.C. § 315(c); *see also* 35 U.S.C. § 315(d) (Board also has the authority to consolidate proceedings). Whether a request for joinder should be granted is discretionary. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB April 24, 2013).

B. Petitioner's Motion for Joinder Is Timely.

A petitioner may request joinder "no later than one month after the institution

date" of the original IPR. 37 C.F.R. § 42.122(b). This is the "only timing requirement for a motion for joinder." *Cent. Sec. Grp. — Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11 at 8-9 (PTAB Feb. 26, 2020).

This Motion for Joinder is timely. The Board instituted trial on Google's petition on January 3, 2023. Thus, Petitioner is filing its motion for joinder within the time limit specified in 37 C.F.R. § 42.122(b).

If Google terminates its involvement prior to the Board ruling on this Motion, Petitioner requests that this Motion be withdrawn as moot and that Petitioner's Petition be considered on the merits under Petitioner's full control, as Petitioner is not estopped from requesting IPR of the '691 patent at the time of this filing.

C. The Board Should Permit Joinder.

In deciding whether to exercise its discretion and permit joinder, the Board considers: (1) why joinder is appropriate; (2) whether the new petition presents any new grounds of unpatentability; (3) any impact joinder would have on the trial schedule for the existing review; and (4) how briefing and discovery may be simplified. *Kyocera Corp.*, IPR 2013-00004, Paper 15 at 4 (Apr. 24, 2013). Here, each of the four factors weighs in favor of joinder.

1. Joinder Is Appropriate for Several Reasons.

Joinder is appropriate here because the concurrently filed Petition involves the same patent, challenges the same claims, relies on the same substantive exhibits, and

is based on the same grounds and combinations of prior art submitted in the Google IPR. The concurrently filed Petition is substantively identical to Google's petition, containing only minor differences relating to (a) the procedural formalities of having a different Petitioner file the Petition, and (b) changes to arguments regarding discretionary denial under § 314(a) that result from a different co-pending litigation. There are no changes to the facts, citations, evidence, or arguments presented in the grounds for unpatentability set forth in Google's petition. Because the proceedings are substantively identical, good cause exists for joining Petitioner as a party to the Google IPR and consolidating the proceedings, so that the Board can efficiently resolve identical challenges in a single proceeding. *Cent. Sec. Grp.*, IPR2019-01609, Paper 11 at 8 (PTAB Feb. 11, 2020); *ZyXEL Commc'ns Corp. v. Unm Rainforest Innovations*, IPR2021-00739, Paper 17 at 20 (PTAB Oct. 1, 2021).

This efficiency gain extends to the litigation. In the Petition, Petitioner stipulates that, if Petitioner's Petition is instituted, then Petitioner will not pursue the grounds identified in its Petition in the district court. Thus, joinder will ensure that the grounds presented in the Google IPR are not inefficiently and unnecessarily adjudicated in another forum (e.g., the district court litigation involving Petitioner).

Because joinder will increase efficiency and reduce duplicative proceedings involving the same patentability challenges, this factor favors joinder.

2. Petitioner Proposes No New Grounds of Unpatentability.

The concurrently filed Petition presents the same grounds of unpatentability as the Google petition and challenges the same claims. Therefore, Petitioner does not propose any new grounds of unpatentability, and this factor also favors joinder.

3. Joinder Will Neither Unduly Burden nor Negatively Impact the Google IPR Trial Schedule.

Because Petitioner's Petition is substantively identical to Google's, there are no new issues for Patent Owner to address and therefore no reason joinder will unduly burden or negatively affect the schedule in that proceeding in any way. Thus, this factor also favors joinder. *Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 10, 2015) (granting motion where joinder does "not necessitate any additional briefing or discovery from Patent Owner beyond that already required [by the original IPR]").

4. Joinder Will Simplify Briefing and Discovery Overall.

The concurrently filed Petition and the Google Petition present substantively identical grounds of unpatentability, including the same combinations of art against the same claims. If this motion for joinder is granted, Petitioner agrees to take an "understudy" role, adhering to the following restrictions the Board has approved in other cases:

> "(a) ***all*** filings by [Petitioner] in the joined proceeding be consolidated with [Google's], unless a filing solely concerns issues that do not involve [Google]; (b) [Petitioner] shall not be permitted to raise any new grounds not already instituted by the Board in the [Google IPR], or introduce any argument or discovery not already introduced by [Google]; (c) [Petitioner] shall be bound by any agreement between [Patent Owner] and [Google] concerning discovery and/or depositions; and (d) [Petitioner] at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted for [Google] alone under either 37 C.F.R. § 42.53 or any agreement between [Patent Owner] and [Google]."

Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17 at 5 (PTAB Apr. 10, 2015) (emphasis in original); *Sony*, IPR2015-01353, Paper 11 at 6 (granting joinder where petitioners requested an "understudy" role). Petitioner will assume the primary role only if Google ceases to participate in the Google IPR.

As the Board has repeatedly concluded in similar cases, by joining Petitioner in the Google IPR and allowing Petitioner to take on an understudy role, both briefing and discovery will be simplified because Patent Owner can maintain its current trial schedule and avoid duplicative efforts. The understudy role will minimize any potential complications or delay that potentially could result by joinder, including duplicative discovery and filings. *Sony*, IPR2015-01353, Paper 11 at 6-7 ("joinder

would increase efficiency by eliminating duplicative filings and discovery, and would reduce costs and burdens on the parties as well as the board" where petitioners sought an "understudy" role). Thus, this factor also favors joinder.

For the foregoing reasons, each of the factors that the Board considers in evaluating potential joinder weighs in favor of granting this motion.

D. *General Plastic* Is Inapplicable.

The *General Plastic* analysis is inapplicable to this Motion and the concurrently filed Petition. In *General Plastic*, the Board set forth factors for analyzing follow-on petitions. Generally, these factors are intended to help conserve the Board's resources and to prevent a subsequent petitioner from gaining a strategic advantage from filing a later petition. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).

Here, Petitioner is not filing a follow-on petition. Rather, Petitioner seeks to join the Google IPR as an understudy and does not present any new grounds. This is not the type of serial petition necessitating a *General Plastic* analysis. Indeed, the Board has found that the *General Plastic* factors are "not particularly relevant" in this situation, i.e., where a different petitioner files a "me-too" or "copycat" petition with a timely motion for joinder. *Cent. Sec. Grp.*, IPR2019-01609, Paper 11 at 8; *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9-11 (PTAB Oct. 30, 2018).

Even if the Board were to consider the *General Plastic* factors, they would weigh in favor of institution. Petitioner has not previously filed a petition against the '691 patent. Petitioner and Google are not the same party and have no significant relationship. They are not co-defendants. They are competitors accused of infringement—in different actions—based on sales of different products. This weighs against denial. *NetNut Ltd. v. Bright Data Ltd.*, IPR2021-00465, Paper 11 at 9 (PTAB Aug. 12, 2021) (declining to extend *General Plastic* and *Valve* to different petitioner with no relationship to previous petitioners); *Mercedes-Benz USA, LLC v. Carucel Invs. L.P.*, IPR2019-01404, Paper 12 at 11-12 (PTAB Jan. 22, 2020); *Toshiba Am. Info. Sys., Inc. v. Walletex Microelecs. Ltd.*, IPR2018-01538, Paper 11 at 20 (PTAB Mar. 5, 2019).

The second through fifth factors relate to timing issues that are irrelevant here. In considering these factors, the Board assesses whether a petitioner should have or could have raised its challenges earlier and whether the petitioner improved its petition by waiting, such as by addressing deficiencies identified in the Board's denial of an earlier petition. *General Plastic*, IPR2016-01357, Paper 19 at 17-18; *Google LLC v. Express Mobile, Inc.*, IPR2022-00597, Paper 17 at 8-9 (PTAB Aug. 19, 2022). In this case, when Petitioner learned of the prior art and the length of time between the filing of the petitions are irrelevant because Petitioner did not previously file any IPR petition, has substantively duplicated the Google IPR, alleging the same

facts, grounds, and prior art, and has agreed to take an understudy role. The second, fourth, and fifth factors "do not favor discretionary denial" where, as here, 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." *Express Mobile*, IPR2022-00597, Paper 17 at 8-9. As a result, this IPR cannot be considered an attempt to harass Patent Owner or otherwise engage in serial, tactical filings. Indeed, the exact opposite is true. Petitioner seeks to simplify and minimize the number of distinct proceedings by joining the Google IPR rather than pursuing a separate IPR based on different grounds.

The third factor also weighs against denial because the Petition presents the same grounds as those presented in the Google IPR. *Cisco Sys., Inc. v. Centripetal Networks, Inc.*, IPR2022-01151, Paper 12 at 48-51 (PTAB Jan. 4, 2023) ("factor (3) does not favor discretionary denial" when "Petitioner presents substantively identical challenges . . . based on the same prior art and the same unpatentability theories"); *Express Mobile*, IPR2022-00597, Paper 17 at 8 (granting institution because "copying a previously-instituted petition is an efficient mechanism by which to satisfy the requirement . . . to file a petition that 'warrants the institution of an inter partes review'"). Regardless of whether Petitioner had access to subsequent filings in the Google IPR, this IPR cannot be considered an attempt to harass Patent Owner or otherwise engage in serial, tactical filings because Petitioner did not use those

filings as a roadmap to draft its petition. Instead, Petitioner filed a substantively identical petition. Thus, the third factor weighs against denial. *Cisco*, IPR2022-01151, Paper 12 at 49.

The sixth factor considers the Board's resources and the seventh factor relates to the Board's ability to meet the one-year statutory deadline. Allowing joinder here would conserve Board resources and would not affect the Board's ability to meet the one-year statutory deadline. These two factors therefore weigh against denial. *Express Mobile*, IPR 2022-00597, Paper 17 at 9-10.

For the foregoing reasons, the *General Plastic* factors do not weigh against institution and joinder of Petitioner to Google's IPR.

IV. CONCLUSION

Petitioner respectfully requests that the Board institute Petitioner's concurrently filed IPR Petition, and then join Petitioner as a party to the Google IPR.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 3, 2023

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CERTIFICATE OF SERVICE

I hereby certify that true and correct copies of the foregoing **MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2022-01061 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)** is being served on February 3, 2023, via Federal Express overnight mail on counsel of record for U.S. Pat. No. 8,503,691 at the address below:

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