

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

VOIP-PAL.COM, INC.,
Patent Owner

Patent No. 10,880,721

**MOTION FOR JOINDER TO *INTER PARTES*
REVIEW IPR2022-01235**

TABLE OF CONTENTS

	Page
I. STATEMENT OF THE PRECISE RELIEF REQUESTED	1
II. STATEMENT OF MATERIAL FACTS	2
III. STATEMENT OF REASONS FOR RELIEF REQUESTED	4
A. Legal Standard.....	4
B. Each of the Factors Weighs in Favor of the Board Granting the Motion for Joinder.....	5
1. Joinder with the Meta IPR Proceeding Is Appropriate.....	5
2. Petitioner Does Not Propose New Grounds of Unpatentability.....	6
3. Joinder Will Not Negatively Impact the Meta IPR Proceeding Trial Schedule	7
4. Procedures to Simplify Briefing and Discovery	8
IV. CONCLUSION.....	9

TABLE OF AUTHORITIES

Page(s)

Cases

<i>HTC v. Parthenon Unified Memory Architecture LLC</i> , IPR2017-00512, Paper No. 12 (June 1, 2017).....	1
<i>LG v. Memory Integrity, LLC</i> , IPR2015-01353, Paper No. 11 (Oct. 5, 2015)	5, 6, 7, 9
<i>Noven Pharm., Inc. v. Novartis AG</i> , IPR2014-00550, Paper No. 38 (Apr. 10, 2015).....	8
<i>Par Pharm., Inc. v. Novartis AG</i> , IPR2016-01023, Paper No. 20 (Oct. 27, 2016)	6
<i>Samsung Elecs. Co. v. Demaray LLC</i> , IPR2021-01091, Paper 8 (Dec. 20, 2021)	4
<i>Samsung Elecs. Co. v. Raytheon Co.</i> , IPR2016-00962, Paper No. 12 (Aug. 24, 2016)	5

Statutes

35 U.S.C. § 315(c)	1, 4
--------------------------	------

Other Authorities

37 C.F.R. § 42.1(b)	1, 6
37 C.F.R. § 42.22	1
37 C.F.R. § 42.103	4
37 C.F.R. § 42.122(b)	1

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Google LLC (“Petitioner” or “Google”) respectfully submits this Motion for Joinder, concurrently with a Petition (“the Google petition”) for *inter partes* review of U.S. Patent No. 10,880,721 (“the ’721 patent”), filed herewith.

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), Google requests institution of an *inter partes* review and joinder with *Meta Platforms, Inc. v. VoIP-PAL.com, Inc.*, Case No. IPR2022-01235 (“the Meta IPR Proceeding”), which the Board instituted on January 31, 2023 concerning the same claims of the ’721 patent that are at issue in the Google petition. This request is being submitted within the time set forth in 37 C.F.R. § 42.122(b).

Google 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.” *See* 37 C.F.R. § 42.1(b); *see also HTC v. Parthenon Unified Memory Architecture LLC.*, IPR2017-00512, Paper No. 12 at 5-6 (June 1, 2017). The Google petition and the petition in the Meta IPR Proceeding are substantively identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims. (*See* Ex. 1027, illustrating changes between the instant petition and the petition in IPR2022-01235.) Further, upon joining the Meta IPR Proceeding, Google will act as an “understudy” and will not assume an active role unless the current petitioner

ceases to participate in the instituted IPR. Accordingly, the proposed joinder will neither unduly complicate the Meta IPR Proceeding nor delay its schedule. As such, the joinder will promote judicial efficiency in determining the patentability of the '721 patent without prejudice to Patent Owner. Moreover, Google has spoken with counsel for Meta Platforms, Inc. ("Meta"), and Meta does not oppose joinder.

II. STATEMENT OF MATERIAL FACTS

1. The '721 patent is at issue in an infringement action against Google in the Northern District of California: Case No. 3-22-cv-03199 (N.D. Cal.). This action was transferred from the Western District of Texas, wherein the complaint was filed on June 25, 2021 and the action was assigned Case No. 6-21-cv-00667 (W.D. Tex.).
2. The '721 patent is or was at issue in other patent infringement actions: Case No. 6-21-cv-00674 (W.D. Tex.); Case No. 6-21-cv-00672 (W.D. Tex.); Case No. 6-21-cv-00671 (W.D. Tex.) (terminated Oct. 13, 2021); Case No. 6-21-cv-00670 (W.D. Tex.) (terminated Oct. 22, 2021); Case No. 6-21-cv-00668 (W.D. Tex.); Case No. 6-21-cv-00665 (W.D. Tex.) (transferred May 31, 2021); Case No. 3-21-cv-05078 (N.D. Cal.) (terminated Oct. 13, 2021); Case No. 3-21-cv-05110 (N.D. Cal.) (terminated Oct. 22, 2021); Case No. 3-21-cv-05275 (N.D. Cal.) (terminated Jan. 18, 2023); Case No. 6-21-cv-01247 (W.D. Tex.)

(transferred Jan. 18, 2023); Case No. 6-21-cv-01246 (W.D. Tex.); Case No. 3-21-cv-09773 (N.D. Cal.); Case No. 3-22-cv-03202 (N.D. Cal.); Case No. 3-23-cv-00151 (N.D. Tex.).

3. The '721 patent is or was formerly at issue in the following Board Proceedings: IPR2022-01075 (P.T.A.B.) (institution denied Dec. 19, 2022); IPR2022-01074 (P.T.A.B.) (institution denied Dec. 19, 2022); IPR2022-01181 (P.T.A.B.) (institution denied Dec. 22, 2022); IPR2022-01180 (P.T.A.B.) (institution denied Dec. 22, 2022); IPR2022-01234 (P.T.A.B.) (institution granted Jan. 31, 2023); IPR2022-01392 (P.T.A.B.) (institution pending).
4. On June 30, 2022, Meta Platforms, Inc. filed a petition for *inter partes* review (IPR2022-01235) ("the Meta petition") requesting cancellation of claims 51-52, 57, 60, 63, 65, 67, 73, 77, 103-104, 108-110, 124, 130, 133, and 138-139 of the '721 patent.
5. On August 23, 2022, Samsung Electronics Co. filed a petition for *inter partes* review (IPR2022-01393) seeking to join the Meta petition.
6. On January 31, 2023, the Board instituted the Meta petition as to all challenged claims and all grounds.
7. The Google petition and the Meta petition are substantively identical; they contain the same grounds (based on the same prior art

combinations and supporting evidence) against the same claims, using the same evidence and arguments.¹

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

Pursuant to 35 U.S.C. § 315(c), the Board may grant a motion for joining an *inter partes* review petition with another *inter partes* review proceeding. *See* 35 U.S.C. § 315(c). The Board, in determining whether to exercise its discretion to grant a motion for joinder, considers: (1) Petitioner's explanation why joinder is appropriate, (2) whether any new grounds of unpatentability are asserted in the second petition, (3) what impact, if any, joinder would have on the cost and schedule for the existing proceeding, and (4) whether granting joinder will add to the complexity of briefing and/or discovery. *Samsung Elecs. Co. v. Demaray LLC*, IPR2021-01091, Paper 8 at 9-10 (Dec. 20, 2021) (citing Consolidated Trial Practice Guide, 76 (Nov. 2019) (<https://www.uspto.gov/TrialPracticeGuide> Consolidated)).

¹ A few sentences that were included in the original Meta petition in Sections I ("Introduction"), III ("Payment of Fees Under 37 C.F.R. § 42.103"), IV ("Certification of Grounds for Standing"), VII ("The '721 Patent"), and IX ("Overview of the Prior Art") were not included in the Google petition to meet word count requirements. Ex. 1027 illustrates these non-substantive changes.

B. Each of the Factors Weighs in Favor of the Board Granting the Motion for Joinder

All four factors weigh in favor of granting the motion for Petitioner. The Google petition is substantively identical to the petition in the Meta IPR Proceeding. Google does not present any new grounds of unpatentability, as can be seen in the redline comparison between Google's petition and that in the Meta IPR Proceeding. *See* Ex. 1027. Additionally, as all issues are substantively identical and Google will act as an "understudy," joinder will have minimal or no impact on the pending schedule of the Meta IPR. *See LG v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6 (Oct. 5, 2015) (granting motion for joinder where petitioners requested an "understudy" role). Moreover, the briefing and discovery will be simplified by resolving all issues in a single proceeding. Accordingly, joinder is appropriate.

1. Joinder with the Meta IPR Proceeding Is Appropriate

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper No. 12 at 9 (Aug. 24, 2016) (citations omitted). Here, joinder with the Meta IPR Proceeding is appropriate because the Google petition introduces identical arguments and the same grounds raised in the existing Meta IPR proceeding (i.e., 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 Meta petition). *See* Ex. 1027. Other than minor differences, such as differences related to formalities of a different party filing the petition and discretionary denial analysis specific to the party, there are no changes to the facts, citations, evidence, or arguments introduced in the Meta petition. Because these proceedings are substantively identical, good cause exists for joining this proceeding with the Meta IPR Proceeding so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently “secure the just, speedy, and inexpensive resolution” of the Google and Meta petitions in a single proceeding.

2. Petitioner Does Not Propose New Grounds of Unpatentability

The Google petition is substantively identical to the petition in the Meta IPR proceeding (i.e., challenging the same claims of the same patent, relying on the same expert declaration, and on the same grounds and combinations of prior art submitted in the Meta petition). *See LG*, IPR2015-01353, Paper No. 11 at 5-6 (granting institution of IPR and motion for joinder where petitioners relied “on the same prior art, same arguments, and same evidence, including the same expert and a substantively identical declaration”); *see also Par Pharm., Inc. v. Novartis AG*, IPR2016-01023, Paper No. 20 at 14 (Oct. 27, 2016) (granting motion for joinder where petitioners “do not assert any new ground of unpatentability that is not already

being considered in [an instituted IPR proceeding], rely on the same arguments and evidence, and do not require any modification to the existing schedule”).

3. Joinder Will Not Negatively Impact the Meta IPR Proceeding Trial Schedule

Joinder will have minimal impact, if any, on the Meta IPR Proceeding's trial schedule because the Google petition presents no new issues or grounds of unpatentability. *See LG*, IPR2015-01353, Paper No. 11 at 6 (granting IPR and motion for joinder where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”). Further, Petitioner explicitly consents to the existing trial schedule. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments.

The Patent Owner's Response will also not be negatively impacted because the issues presented in the Google petition are identical to the issues presented in the Meta petition. Patent Owner will not be required to provide any additional analysis or arguments beyond what it will already provide in responding to the petition in the Meta IPR Proceeding. Also, because the Google petition relies on the same expert declaration, only a single deposition is needed for the proposed joined proceeding.

Accordingly, joinder with the Meta IPR Proceeding does not unduly burden or negatively impact the trial schedule.

4. Procedures to Simplify Briefing and Discovery

Google explicitly agrees to take an “understudy” role, which will simplify briefing and discovery. Specifically, Google explicitly agrees, upon joining the Meta IPR Proceeding, that the following conditions shall apply so long as the current petitioner in IPR2022-01235 remains an active party:

- a) Google shall not make any substantive filings and shall be bound by the filings of Meta Platforms, Inc., unless a filing concerns termination and settlement, or issues solely involving Google;
- b) Google shall not present any argument or make any presentation at the oral hearing on issues not solely involving Google;
- c) Google shall not seek to cross-examine or defend the cross-examination of any witness, unless the topic of cross-examination concerns issues solely involving Google; and
- d) Google shall not seek discovery from VoIP-PAL.com, Inc. on issues not solely involving Google.

See, e.g., Noven Pharm., Inc. v. Novartis AG, IPR2014-00550, Paper No. 38 at 5 (Apr. 10, 2015). Unless and until the current petitioner ceases to participate in the instituted IPR proceeding, Google will not assume an active role therein.

Thus, by Google accepting an “understudy” role, Patent Owner and the current petitioner can comply with the existing trial schedule without needing any

duplicative efforts by the Board or the Patent Owner. These steps will minimize any potential complications or delay that potentially may result by joinder. *See LG*, IPR2015-01353, Paper No. 11 at 6-7 (granting IPR and motion for joinder because “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 agreed to an “understudy” role). Google is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. CONCLUSION

Based on the factors discussed above, Google respectfully requests that the Board grant the Google petition and grant joinder with the Meta IPR Proceeding.

Respectfully submitted,

Dated: February 28, 2023

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on February 28, 2023, I caused a true and correct copy of the foregoing Motion for Joinder to *inter partes* review IPR2022-01235 to be served via express mail on the Patent Owner at the following correspondence address of record as listed on Patent Center:

THORPE NORTH & WESTERN, LLP.
P.O. Box 1219
SANDY UT 84091-1219
Customer Number: 20551

A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel at the following addresses:

Lewis E. Hudnell, III
lewis@hudnelllaw.com
Nicolas S. Gikkas
nick@hudnelllaw.com
Hudnell Law Group P.C.
800 W. El Camino Real Suite 180
Mountain View, California 94040
T: 650.564.3698
F: 347.772.3034

By: /Naveen Modi/
Naveen Modi (Reg. No. 46,224)