

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,

Petitioner,

v.

JAWBONE INNOVATIONS, LLC,

Patent Owner.

Patent No. 8,321,213

Filing Date: October 26, 2009

Issue Date: November 27, 2012

Inventors: Nicolas Petit, Gregory Burnett, and Zhinian Jing

Title: ACOUSTIC VOICE ACTIVITY DETECTION (AVAD)  
FOR ELECTRONIC SYSTEMS

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**PATENT OWNER'S  
OPPOSITION TO PETITIONER'S MOTION FOR JOINDER**

Case No. IPR2023-01074

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## **I. INTRODUCTION**

On June 23, 2023, Petitioner Google LLC (“Petitioner”) filed a Petition for *Inter Partes* Review (Paper 1, “Petition”) against U.S. Patent No. 8,321,213 (Ex. 1001, the “’213 Patent”). At the same time, Petitioner filed a “Motion For Joinder To And Consolidation With Related *Inter Partes* Review IPR2023-00279 Pursuant To 35 U.S.C. § 315(c) And 37 C.F.R § 42.122(b)” seeking to join IPR2023-00284 (the “Amazon IPR”). Paper No. 3 (“Motion”).

The Board should deny Petitioner’s Motion because joinder will needlessly complicate the Amazon IPR. Moreover, as explained in the precedential *Uniloc* case, the *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017) factors weigh in favor of denial of Google’s Petition. *See Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 5 (P.T.A.B. Oct. 28, 2020) (precedential) (“*Uniloc*”).

## **II. ARGUMENT**

### **A. Legal Standard**

“To join a party to an instituted 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). The first decision is “whether the joinder [to] applicant’s petition for IPR ‘warrants’ institution under § 314.” The second is “whether to ‘join as a party’ the joinder applicant.” *Id.* “Joinder may be authorized

when warranted, but the decision to grant joinder is discretionary.” *Sony Corp. of Am. v. Network-1 Sec. Sols., Inc.*, IPR2013-00386, Paper 16, 3 (P.T.A.B. Jul. 29, 2013). “The fact that the [Director or his delegate the] Board has the *discretion* to join a party does not mean that joinder is automatic, particularly given the need to complete proceedings in a just, speedy, and inexpensive manner.” *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17, 6 (P.T.A.B. July 29, 2013).

As the moving party, Petitioner has the burden of proof to establish that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). When considering a motion for joinder, the Board examines factors including: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell Inc.*, IPR2013-00385, Paper 17 at 3-4.

## **B. Granting Joinder Will Complicate the Proceedings**

Petitioner states that it will participate in an “understudy” role “so long as Amazon remains an active party.” Motion at 8. However, Petitioner then immediately undercuts that statement by carving out exceptions. For example, Petitioner would seek to participate in depositions, with the only restriction being that it could not receive any time beyond that allotted for Amazon. Motion at 8.

Petitioner also would reserve the ability to make filings that “concern[s] issues solely involving Google.” *Id.*

This list of carve-outs leaves open the possibility that Petitioner, in its sole judgment, could deem any issue is subject to the exceptions and decide to take an active role. In such circumstances, joinder would cause needless complication.

### **III. PATENT OWNER WILL ADDRESS WHETHER PETITIONER’S PETITION WARRANTS INSTITUTION IN ITS PRELIMINARY RESPONSE**

Patent Owner is preparing its Patent Owner Preliminary Response which will address whether Petitioner’s Petition warrants institution. A Petition that does not warrant institution cannot join another proceeding. *Facebook*, 973 F.3d at 1332 (“The statute makes clear that the joinder decision is made after a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.”).

### **IV. THE *GEN. PLASTIC* FACTORS WEIGH AGAINST JOINDER**

The Board has clarified that discretionary factors must be considered before determining a joinder motion. *Uniloc*, IPR2020-00854, Paper 9, 5 (“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).”) *See also Gen. Plastic*,

IPR2016-01357, Paper 19 at 15-19 (precedential). The *Gen. Plastic* factors weigh in favor of exercising discretion to deny the petition and joinder. Indeed, the facts here are almost identical to those in *Uniloc*.

As to Factor 1, Petitioner previously filed a petition challenging the same claims as those in this Petition. See *Google LLC v. Jawbone Innovations, LLC*, IPR2022-00888, Paper 1 (P.T.A.B. May 20, 2022). The Board denied Google's Petition in the -00888 proceeding. *Google*, IPR2022-00888, Paper 12 (P.T.A.B. Nov. 28, 2022); see generally Motion at 3, 10-13. Google does not substantively address that it has already had one bite at the apple, and instead simply argues that this factor favors joinder because its Petition is "substantively identical" to Amazon's. Motion at 6. However, identical or not, the Board has held in a precedential decision that this factor weighs against institution when a time-barred petitioner files a second petition. *Uniloc*, IPR2020-00854, Paper 9, at 8.

As to Factor 2, Petitioner refuses to indicate when it first learned of the references in the Petition. Motion at 7, 10-13. Given Petitioner's failure to provide this information, it should be presumed that Petitioner was aware of the references long before filing this Petition. Indeed, Petitioner should have been aware of the references when it first performed its prior art search to file its earlier, failed petition. In any case, it was Petitioner's responsibility to explain when it learned of the

references. This factor, accordingly, weighs in favor of denial. *Uniloc*, IPR2020-00854, Paper 9, at 9 (“Because of the lack of explanation, we conclude that this second *General Plastic* factor weighs in favor of denying institution of the proceeding.”). Unlike the *Express Mobile* decision on which Petitioner relies, Petitioner has not provided any explanation of when it learned of the references. *Google LLC v. Express Mobile, Inc.*, IPR2022-00790, Paper 15 at 7-8 (P.T.A.B. Sept. 27, 2022) (relying on “Petitioner’s representation” that it did not identify or consider the references to find this factor to not favor denial).

As to Factor 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;” Petitioner cannot deny that it had Patent Owner’s Preliminary Response and the Board’s decision denying institution in Google’s first IPR at the time it filed the instant Petition. This factor, accordingly, weighs in favor of denial. *Uniloc*, IPR2020-00854, Paper 9 at 10. Google relies on the non-precedential decision in *Express Mobile*; the panel there disregarded this factor, despite the precedential *Uniloc* decisions holdings. Mot. at 10-13 (citing *Express Mobile, Inc.*, IPR2022-00888, Paper 12 at 8-9). Patent Owner respectfully submits that *Express Mobile* was

wrongly decided, and the Board here should follow *Uniloc*'s unequivocal holding that this factor favors denial.

With respect to Factor 4, as discussed above, Petitioner does not state when it first learned of the references in the Petition. Motion at 9. Petitioner makes no substantive argument as to this factor and, accordingly, this factor weighs in favor of denial.

As to Factor 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," Petitioner makes no explanation for the elapsed time. *Id.*

Finally, Factors 6 and 7 weigh in favor of denial for the reasons stated above as to the increased complexity from joinder.

## **V. CONCLUSION**

Allowing joinder will needlessly complicate the proceedings in the Amazon IPR. Moreover, the *Gen. Plastic* factors favor denial of Petitioner's Petition and Motion. Accordingly, the Board should deny the Petitioner's Motion.

Respectfully submitted,

Dated: July 24, 2023

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