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Filed on behalf of Meta Platforms, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01127
U.S. Patent No. 8,019,091

**MOTION FOR JOINDER TO AND CONSOLIDATION WITH
RELATED *INTER PARTES* REVIEW IPR2023-00253
PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)**

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I. INTRODUCTION

Meta Platforms, Inc. (“Petitioner”) respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 8,019,091 (“the ’091 Patent”) filed contemporaneously herewith. 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 IPR2023-00253 (“the Amazon IPR”). That IPR presents identical grounds for the challenged claims as Petitioner’s IPR, and it was instituted less than one month ago, on June 6, 2023 (IPR2023-00253, Paper 9).

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 Amazon petition contain identical grounds for the challenged claims including the same prior art combinations. Thus, joinder would neither unduly complicate the Amazon IPR nor delay its schedule.

To streamline discovery and briefing, Petitioner agrees to take an “understudy” role should this Motion be granted, actively participating substantively in the Amazon IPR only if Amazon terminates its involvement after joinder.¹

¹ If Amazon terminates its involvement prior to this Motion being granted, then Petitioner requests this Motion be withdrawn as moot so that Petitioner’s timely-filed Petition may be considered on its merits.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 Samsung on May 27, 2021, asserting seven patents, including the '091 patent. (Case No. 2:21-cv-00186, E.D. Tex.) Patent Owner filed suits against Apple and Google on September 23, 2021, and has asserted nine patents against each of them, including the seven patents asserted against Samsung. (Case Nos. 6:21-cv-00985 and 6:21-cv-00984, W.D. Tex.) Patent Owner filed suit against Amazon on Nov. 29, 2021, asserting the same nine patents. (Case No. 2:21-cv-00435, E.D. Tex., transferred to Case No. 3:22-cv-06727, N.D. Cal.) Patent Owner filed suit against Petitioner on Feb. 28, 2023, asserting eight of these same patents including the '091 patent. (Case No. 6:23-cv-00158, W.D. Tex.) The patents asserted by Jawbone all relate to microphone arrays and noise filters.

Samsung, Apple, Google, and Amazon filed IPR Petitions against each of the patents asserted against them. Petitioner is filing a petition asserting identical grounds for the challenged claims to those previously filed by Amazon against the '091 patent, and is seeking joinder to Amazon's IPR.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Board has the authority to join Petitioner as a party to the Amazon 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.” *Central Security Group — Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01609, Paper 11, at 8-9 (PTAB Feb. 26, 2020).

This Motion for Joinder is timely. Amazon's petition was instituted on June 6, 2023, and this motion is being filed less than one month later. Thus, Petitioner is filing its motion for joinder within the time limit set forth in 37 C.F.R. § 42.122(b).

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 (April 24, 2013). Here, each of the four factors weighs in favor of joinder.

1. Joinder is Appropriate.

Joinder is appropriate here because the concurrently filed Petition involves the same patent, relies on the same exhibits, is based on identical grounds, and includes the same combinations of prior art submitted in the Amazon IPR. The concurrently filed Petition contains minor differences from the Amazon IPR, 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. Otherwise, there are no changes to the facts, citations, evidence, or arguments presented in the grounds for unpatentability set forth in the Amazon Petition. Because the proceedings present identical grounds, good cause exists for joining Petitioner as a party to the Amazon IPR and consolidating the proceedings, so that the Board can efficiently resolve the challenges in a single proceeding. *Cent. Sec. Group*, IPR2019-01609, Paper 11 at 8; *ZyXEL*, IPR2021-00739, Paper 17 at 20.

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 Amazon 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 identical grounds as the Amazon Petition. Therefore, Petitioner does not propose any new grounds of unpatentability and this factor also favors joinder.

3. Joinder Will Not Unduly Burden or Negatively Impact the Amazon IPR Trial Schedule.

Because Petitioner's Petition presents the identical grounds and the same evidence, there are no new issues for Patent Owner to address. Further, joinder with the Amazon IPR will not unduly burden or negatively impact 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 (granting motion where joinder does "not necessitate any additional briefing or discovery from Patent Owner beyond that already required [by the original IPR]").

4. How Briefing and Discovery May Be Simplified

The concurrently filed Petition and the Amazon Petition have identical grounds, including the same combinations of art and the same obviousness

arguments. Additionally, if this motion for joinder is granted, Petitioner agrees to take an “understudy” role, adhering to the following restrictions:

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

Mylan Pharms. Inc. v. Novartis AG, IPR2015-00268, Paper 17 at 5 (PTAB April 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 Amazon ceases to participate in the Amazon IPR.

By joining Petitioner in the Amazon 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 joinder motion and 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 Amazon 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. *Central Security Group*, IPR2019-01609, Paper 11

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at 8; *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9-11 (PTAB Oct. 30, 2018).²

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 '091 patent. Petitioner and the prior petitioners are not the same party and have no significant relationship. They are not co-defendants. They are competitors accused of infringement—in different actions pending in different courts—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).

² Unlike in *Apple v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB Oct. 28, 2020) (precedential) (“*Uniloc*”), where joinder was denied, this is Meta’s first IPR petition challenging these claims of the '091 Patent, and Meta’s “me-too” petition is not otherwise time-barred. Accordingly, the factors that influenced the Board’s application of the *General Plastic* factors in *Uniloc*—where the petitioner had already filed a previous petition, was time-barred from filing a second petition and sought to bring a second petition through joinder after denial of the first petition (*id.* at 4, 7)—are not present.

The second through fifth factors relate to timing issues that are largely irrelevant. When Petitioner learned of the prior art, whether Petitioner received Patent Owner's preliminary response or an institution decision, and the length of time between the filing of the petitions, are all irrelevant. Petitioner did not previously file any IPR petition, has substantively duplicated the Amazon IPR, alleging the same facts, grounds, and prior art, and has agreed to take an understudy role. 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 Amazon IPR rather than pursuing a separate IPR based on different grounds.

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 not impact the Board's resources (beyond those dedicated to deciding this Motion), and would not impact the Board's ability to meet the one-year statutory deadline.

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

IV. CONCLUSION

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

Respectfully submitted,

ALLEN & OVERY, LLP

Dated: June 27, 2023

/Lisa Nguyen/

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CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of this **MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2023-00253 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)** is being served on June 27, 2023, via FedEx Priority Overnight on counsel of record for U.S. Pat. 8,019,091 patent owner Jawbone Innovations, LLC at the address below:

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A courtesy copy is also being served via electronic mail on counsel for the patent holder in the pending district court litigation, *Jawbone Innovations, LLC v. Meta Platforms, Inc.*, 6:23-cv-00158 (W.D. Tex., filed February 28, 2023), and all counsel for the patent owner in IPR2023-00253:

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