UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,

Petitioner,

v.

JAWBONE INNOVATIONS, LLC,

Patent Owner.

Patent No. 11,122,357
Filing Date: August 5, 2013
Issue Date: September 14, 2021

Inventor: Gregory C. Burnett
Title: FORMING VIRTUAL MICROPHONE ARRAYS USING DUAL OMNIDIRECTIONAL MICROPHONE ARRAY (DOMA)

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2023-00251 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R § 42.122(b)

Case No. IPR2023-01134

TABLE OF CONTENTS

Page(s)

I. INTRODUCTION 1

II. ARGUMENT 1

A. Legal Standard 1

B. Jawbone and Amazon Have Settled Their Dispute and the Amazon IPR Will Not Exist at the Time of Institution 3

C. Granting Joinder Will Disrupt the Amazon IPR Schedule 4

D. Patent Owner Will Address Whether Petitioner's Petition Warrants Institution in its Preliminary Response 5

E. The *Gen. Plastic* Factors Weigh Against Joinder 6

III. CONCLUSION 7

TABLE OF AUTHORITIES

Page(s)

Cases

Apple Inc. v. RFCyber Corp.,
IPR2022-00412, Paper 11 (P.T.A.B. Jul. 21, 2022) 3

Apple Inc. v. Uniloc 2017 LLC,
IPR2020-00854, Paper 9, 5 (P.T.A.B. Oct. 28, 2020) (precedential) 6, 7

Dell Inc. v. Network-1 Sec. Sols., Inc.,
IPR2013-00385, Paper 17, 6 (P.T.A.B. July 29, 2013) 2

Facebook, Inc. v. Windy City Innovations, LLC,
973 F.3d 1321 (Fed. Cir. 2020) 1, 5

Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha,
IPR2016-01357, Paper 19 (P.T.A.B. Sept. 6, 2017) 1, 6, 7

Kyocera Corp. v. Softview LLC,
IPR2013-00004, Paper 15 (P.T.A.B. April 24, 2013) 5

Samsung Elecs. Am., Inc. v. RFCyber Corp.,
IPR2021-00980, Paper 18 (P.T.A.B. Apr. 11, 2022) 3

Samsung Elecs. Co. v. Immersion Corp.,
IPR2018-01467, Paper 19 (P.T.A.B. June 18, 2019) 4

Sony Corp. of Am. v. Network-1 Sec. Sols., Inc.,
IPR2013-00386, Paper 16, 3 (P.T.A.B. Jul. 29, 2013) 1

ZTE (USA) LLC v. Seven Networks, LLC,
IPR2019-00460, Paper 18, 5 (P.T.A.B. Jun. 6, 2019) 4, 5

Statutes

35 U.S.C. § 317 3

35 U.S.C. § 317(a) 2, 3

Other Authorities

37 C.F.R. § 42.20(c).....2

37 C.F.R. § 42.122(b) 2

EXHIBIT LIST

Exhibit No.	Description of Document
2001	Joint Motion to Terminate Proceedings, *Amazon.com, Inc. v. Jawbone Innovations, LLC v. Amazon.com Inc.,* Case No. IPR2023-00251 (P.T.A.B. July 29, 2023)

I. INTRODUCTION

On June 29, 2023, Petitioner LG Electronics, Inc. ("Petitioner") filed a Petition for *Inter Partes* Review (Paper 2, "Petition") against U.S. Patent No. 11,122,357 (Ex. 1001). At the same time, Petitioner filed a "Motion For Joinder To And Consolidation With Related *Inter Partes* Review IPR2023-00251 Pursuant To 35 U.S.C. § 315(c) And 37 C.F.R § 42.122(c)" seeking to join IPR2023-00251 (the "Amazon IPR"). Paper No. 3 ("Motion").

The Board should deny Petitioner's Motion because the Amazon IPR will soon be terminated, and therefore joinder will needlessly disrupt its schedule. Moreover, 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 the Petition.

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.

Under 35 U.S.C. § 317(a) "[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." Further, "[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a)." *Id.*

The Board has recognized that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." PTAB Trial Practice Guide ("TPG") at 86 (Nov. 2019 Rev.). Indeed, "The Board expects that a proceeding will

terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id.* (citing 35 U.S.C. § 317(a)).

B. Jawbone and Amazon Have Settled Their Dispute and the Amazon IPR Will Not Exist at the Time of Institution

Jawbone and Amazon have settled their dispute and have filed a motion to terminate the Amazon IPR. Ex. 2001. The Board's practice is to grant such motions. 35 U.S.C. § 317 ("An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed."); Consolidated Trial Practice Guide (Nov. 2019) at 86 ("The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding."). The Board often terminates proceedings, even if a motion for joinder is pending. *E.g.*, *Samsung Elecs. Am., Inc. v. RFCyber Corp.*, IPR2021-00980, Paper 18, at 2-3 (P.T.A.B. Apr. 11, 2022) (terminating IPR despite pending motion for joinder); *Apple Inc. v. RFCyber Corp.*, IPR2022-00412, Paper 11 at 2 n.1 (P.T.A.B. Jul. 21, 2022) (dismissing motion for joinder as moot because the IPR seeking to be joined had settled).

Petitioner recognized this practice in its Motion and requested that the Board withdraw its motion in these circumstances. Motion at 1.

Accordingly, since the Amazon IPR will be terminated prior to ruling on this Petition, the Board should deny the Motion. *ZTE (USA) LLC v. Seven Networks, LLC*, IPR2019-00460, Paper 18, 5 (P.T.A.B. Jun. 6, 2019) ("Given that the Samsung IPR is no longer pending, it cannot serve as a proceeding to which this proceeding may be joined.").

C. Granting Joinder Will Disrupt the Amazon IPR Schedule

The Amazon IPR will suffer an unduly long delay if the Board were to terminate Amazon but nevertheless maintain the Amazon IPR. Patent Owner discovery has just begun and has stalled in view of the settlement and pending termination. Joining a new party to those proceedings would undoubtedly require a new scheduling order and thus would disrupt the Amazon IPR schedule.

Indeed, in situations where the original parties request termination of a proceeding after new petitioners file motions for joinder, the Board often terminates only the petitioner and vacates the scheduling order in the original proceeding because "no petitioner remains." *See*, *e.g.*, *Samsung Elecs. Co. v. Immersion Corp.*, IPR2018-01467, Paper 19 (P.T.A.B. June 18, 2019). This effectively stays the original proceeding, giving the Board time to decide whether to institute and join a subsequent, identical petition. *Id*. Doing so here would obviously disrupt the schedule in the Amazon IPR which weighs against joinder. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (P.T.A.B. April 24, 2013).

Jawbone's Preliminary Response in this proceeding is due on October 12, 2023. "Generally, we decide whether joinder is appropriate 'after receiving a preliminary response under section 313,' when we determine whether institution of an *inter partes* review is warranted." *ZTE*, IPR2019-00460, Paper 18, 7. The Board often takes up to three months to issue an institution decision; thus an institution decision may not issue until January 2024. The resulting delay in the Amazon IPR would prevent the Board from concluding the proceeding within one year of institution.

If joinder is granted now, a new scheduling order will be required, delaying Patent Owner's vindication of its rights far beyond the statutory deadlines. Accordingly, the key factor of whether joinder will impact the trial schedule weighs heavily against granting Petitioner's Motion. *Id.*, Paper 18, 7-8.

D. 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.") (citation omitted).

E. The *Gen. Plastic* Factors Weigh Against Joinder

The Board has clarified that discretionary factors must be considered before determining a joinder motion. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9, 5 (P.T.A.B. Oct. 28, 2020) (precedential) ("Uniloc") ("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.

As to Factor 2, Petitioner refuses to indicate when it first learned of the references in the Petition. Motion at 8-9. Given Petitioner's failure to provide this information, it should be presumed that Petitioner was aware of the references long before filing this 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.").

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;" (*id.* at 7). Petitioner cannot deny that it had Patent Owner's Preliminary Response in the Amazon IPR at the time it filed the instant Petition. This factor, accordingly, weighs in favor of 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 8-9. 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 an 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. *Uniloc*, IPR2020-00854, Paper 9, at 7.

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

III. CONCLUSION

Allowing joinder will needlessly disrupt and delay 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 31, 2023 By: /*Peter Lambrianakos* /
Peter Lambrianakos (Reg. No. 58,279)

FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
Email: plambrianakos@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of the foregoing Opposition to Petitioner's Motion for Joinder and to Consolidation with Related *Inter Partes* Review IPR2023-00251 Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122(b) and Exhibit 2001 have been served on Petitioner's counsel of record as follows:

Indranil Mukerji
Email: imukerji@wilkie.com
Email: LG_Jawbone_IPR_WFG@wilkie.com
John C. Moulder
Email: cmoulder@wilkie.com
WILKIE FARR & GALLAGHER LLP
1875 K Street, N.W.
Washington, D.C. 20006-1238

Attorneys for LG Electronics Inc.

July 31, 2023

By: /*Peter Lambrianakos* /

Peter Lambrianakos (Reg. No. 58,279)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796