UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RJ TECHNOLOGY, LLC,
Patent Owner.

Case IPR2024-00597
Patent No. 7,749,641

PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, AND § 42.122(b)

I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Apple Inc. ("Apple" or "Petitioner") **moves for joinder** with the *inter partes* review instituted against U.S. Patent No. 7,749,641 ("the '641 Patent") in *Samsung Electronics Co., Ltd. v. RJ Technology, LLC*, IPR2023-01183 ("the Samsung Proceeding"). This motion is timely filed no later than one month after the Board's institution decision in the Samsung Proceeding on January 22, 2024.

Apple's Petition being filed in the current proceeding ("the Joinder Petition") is substantively the same as the petition filed in the Samsung Proceeding ("the Samsung Petition"): it challenges the same claims, on the same grounds, and relies on the same prior art as the Samsung Petition and therefore would create no additional burden for the Board, the Samsung Proceeding Petitioner, or Patent Owner if joined. Joinder would therefore lead to an efficient resolution of the validity of the '641 Patent.

Apple stipulates that if joinder is granted, it will act as an "understudy" and will not assume an active role unless the Samsung IPR Petitioner ceases to participate in the proceeding. The Samsung IPR Petitioner will maintain the lead role in the proceeding so long as it remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Apple also will not seek additional

depositions or deposition time. Joinder will not impact the trial schedule because Apple expressly consents to the existing trial schedule in the Samsung Proceeding.

In fact, joinder will help efficiently resolve the disputes among the parties. By joinder, a single Board decision may dispose of the issues raised in the Samsung Proceeding for all interested parties.

Joinder will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or needlessly increase filings, any additional costs on Patent Owner will be minimal.

Given the similarities of the proceedings, the lack of undue prejudice to Patent Owner, and the potential benefit to the public and to the Board that would accrue by Apple's cooperative participation in the Samsung Petition in the event that the Samsung Proceeding Petitioner's participation terminates, the Board should institute IPR and grant Apple's Motion for Joinder.

Samsung does not oppose this request.

II. BACKGROUND AND RELATED PROCEEDINGS

RJ Technologies, LLC ("RJ") is the purported owner of the '641 Patent. RJ asserted the '641 Patent against Apple in *RJ Technology LLC v. Apple Inc.*, Case No. 8-22-cv-01874 (CDCA), filed October 13, 2022. RJ asserted the same patent against Samsung in *RJ Technology LLC v. Samsung Electronics Co., Ltd. et al.*, Case No. 2-22-cv-00401 (EDTX), filed October 13, 2022.

On July 21, 2023, Samsung Electronics Co., Ltd. petitioned for *inter partes* review of the '641 Patent in the Samsung Proceeding (IPR2023-01183). The Board instituted *inter partes* review in the Samsung Proceeding on January 22, 2024.

On August 23, 2023, entirely independent of Samsung and based on different prior art than that of the Samsung Proceeding, Apple petitioned for *inter partes* review of the '641 Patent in *Apple Inc.. v. RJ Technology, LLC*, IPR2023-01350 ("the first Apple Proceeding"). No institution decision has yet been issued in the first Apple Proceeding.

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

The Board has discretion to join a party that properly files an *inter partes* review petition to an existing instituted proceeding addressing the same patent. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell* at 4-6; *Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem*, IPR2013-00326, Paper 15 at 3-4 (PTAB Sep. 24, 2013); *Microsoft Corp. v. Proxyconn, Inc.*, IPR2013-00109, Paper 15 at 3-4 (PTAB Feb. 25, 2013). "The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." *Dell* at 3. The movants bear the burden of proof in establishing entitlement to the requested relief. 37 §§ 42.20(c), 42.122(b). A motion for joinder should:

> [A] set forth the reasons why joinder is appropriate; [B] identify any new grounds of unpatentability asserted in the petition; [C] explain what impact (if any) joinder would have on the trial schedule for the existing review; and [D] address specifically how briefing and discovery may be simplified.

Dell at 4.

A. Joinder With the Samsung Proceeding Would Be Appropriate

Apple submits that joinder with the Samsung Proceeding is appropriate. The challenge raised against the '641 Patent in the Joinder Petition is materially the same as that of the petition filed to initiate the Samsung Proceeding. More specifially, the Joinder Petition and the Samsung Petition challenge the same claims based on the same prior art grounds and evidence, including an identical declaration from the same expert.[1]

Further, in the Joinder Petition, Apple agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the Samsung Proceeding as instituted. The Petition therefore warrants institution under 35 U.S.C. § 314, and 35 U.S.C. § 315(c) permits Apple's joinder to the inter partes review instituted in the Samsung Proceeding.

[1] The declaration is a duplicate of the declaration in the Samsung Proceeding.

Upon joining the Samsung Proceeding, Apple will act as an "understudy" and will not assume an active role unless the current petitioner ceases to participate in the Samsung Proceeding. The current petitioner will maintain the lead role so long as the current petitioner remains in the proceeding. These limitations will avoid lengthy and duplicative briefing. Apple also will not seek additional depositions or deposition time. Apple further agrees to the foregoing conditions even in the event that other third-party petitioners are joined with the Samsung Proceeding. The proposed joinder will neither unduly complicate the Samsung Proceeding nor delay its schedule.

Joinder also will not unduly prejudice any party. Because joinder will not add any new substantive issues, delay the schedule, burden deponents, or increase needless filings, any additional cost to Patent Owner would be minimal. On the other hand, denial of joinder could prejudice Apple. Apple's interests with respect to the '641 Patent may not be adequately protected without joinder with the Samsung Proceeding if, for instance, the first Apple Proceeding is not instituted and/or the current petitioner of the Samsung Proceeding settles with Patent Owner.

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., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (cleaned up) (emphasis added). Here, joinder with the

Samsung Proceeding is appropriate because Apple's Joinder Petition introduces **identical** unpatentability arguments and the **same** grounds raised in the petition of the Samsung Proceeding with no material changes to the facts, citations, evidence, or analysis on the merits. Because these proceedings introduce identical unpatentability arguments and the same grounds, good cause exists for joinder, so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of this proceeding and the Samsung Proceeding.

B. Joinder Would Not Add Any New Grounds of Unpatentability

Apple's Joinder Petition is based on the same grounds and combinations of prior art in the Samsung Proceeding. For simplicity and efficiency, Petitioner has copied the substance of the petition in the Samsung Proceeding and its accompanying expert declaration. Apple does not seek to introduce grounds or claims not currently in the Samsung Proceeding and seeks only to join the proceeding as instituted. Patent Owner should not require any discovery beyond that which it may need in the Samsung Proceeding—nor should the Board permit any. The present Joinder Petition introduces no new substantive issues relative to the Samsung Proceeding and does not seek to broaden the scope of the Samsung Proceeding.

C. Joinder Would Not Impact the Samsung Proceeding's Trial Schedule

Joinder will not impact the Samsung Proceeding's trial schedule because Apple's Joinder Petition presents no new issues or grounds of unpatentability. *See Sony Corp., et al. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting a motion where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). Indeed, Apple expressly consents to the existing trial schedule in the Samsung Proceeding.

Patent Owner's post-institution Response and Sur-Reply will not be negatively impacted because the substantive issues presented in the Joinder Petition are identical to the issues presented in the Samsung Proceeding. 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 Samsung Proceeding. Also, because Apple's Joinder Petition relies on the same expert declaration, only a single deposition is needed for the proposed joined proceeding.

For all these reasons, Apple's joinder with the Samsung Proceeding would not unduly burden or negatively impact the trial schedule.

D. Procedures to Simplify Briefing and Discovery

Apple expressly agrees to take an "understudy" role, which would simplify briefing and discovery. Specifically, Apple expressly agrees, upon joining the Samsung Proceeding, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as the current petitioner remains an active party:

a) all filings by Apple in the Samsung Proceeding shall be consolidated with the filings of the current petitioner, unless a filing concerns issues solely involving Apple;

b) Apple shall not be permitted to raise any new grounds not instituted by the Board in the Samsung Proceeding, or introduce any argument or discovery not introduced by the current petitioner;

c) Apple shall be bound by any agreement between Patent Owner and the current petitioner concerning discovery and/or depositions; and

d) Apple at deposition shall not receive any direct, cross-examination or redirect time beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and the current petitioner.

See Noven Pharmaceuticals, Inc. v. Novartis AG, IPR2014-00550, Paper 38 at 5 (PTAB Apr. 10, 2015). Unless and until the current petitioner ceases to participate, Apple will not assume an active role in the Samsung Proceeding.

Thus, by Apple accepting an "understudy" role, the parties can comply with the trial schedule assigned to the Samsung Proceeding without duplicative efforts. These steps minimize the possibility of any complication or delay from joinder. *See Sony*, IPR2015-01353, Paper 11 at 6-7 (granting a motion for joinder where petitioner agreed to an "understudy" role 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").

Furthermore, Apple stipulates that, should the first Apple Proceeding be instituted and should the instant Motion for Joinder be granted, Apple will request an adjustment of the briefing schedule in the first Apple Proceeding to align the schedules of the first Apple Proceeding and the Samsung Proceeding.

Apple is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. INSTITUTION IS APPROPRIATE UNDER *GENERAL PLASTIC*

Apple has previously challenged the '641 Patent. Nevertheless, institution of this second petition is appropriate. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017); *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00224, Paper 10 at 4-5 (PTAB Apr. 6, 2020).

Factor 1: Apple previously filed a petition against the '641 Patent. However, the Apple Petition and the Joinder Petition are directed to different claims, with the former challenging claims 5-14 and the latter challenging claims 1-18. Thus, this factor weighs in favor of institution.

Factors 2, 4, and 5: Apple became aware of the prior art relied upon in the Samsung proceeding no later than the filing date of the Samsung Petition, *i.e.*, July 21, 2023. However, because the Joinder Petition is substantively the same as the Samsung Petition, Apple's filing of the Joinder Petition did not unduly benefit from additional time with this art. Thus, these factors are do not weigh in favor of discretionary deial.

Factor 3: As of the filing date of the Joinder Petition, Apple received the Patent Owner's Preliminary Response ("POPR") in the first Apple Proceeding, but has not yet received an Institution Decision. However, because the Joinder Petition is substantively the same as the Samsung Petition, which was filed before Apple's receipt of the POPR in the first Apple Proceeding, Apple's filing of the Joinder Petition did not unduly benefit from receipt of the POPR in the first Apple Proceeding. Thus, this factor does not weigh in favor of discretionary denial.

Factors 6 and 7: As stated above, Apple seeks to join the Samsung Petition and is not raising arguments beyond those raised by the Samsung Petition. These factors thus weigh in favor of institution, as there should be no material impact on

the Board's finite resources or its ability to issue a final determination on the Samsung Petition within one year.

V. CONCLUSION

For the foregoing reasons, Apple respectfully requests that its Petition for *Inter partes* review of the '641 Patent be instituted and that Apple be joined to the Samsung IPR proceeding IPR2023-01183.

Respectfully submitted,

Dated: February 22, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on February 22, 2024, a complete and entire copy of this Petitioner's Motion for Joinder was provided by Federal Express, to the Patent Owner, by serving the correspondence address of record as follows:

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