Paper No. __
Filed: July 6, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

JAWBONE INNOVATIONS, LLC,
Patent Owner.

IPR2023-01155
U.S. Patent No. 8,326,611

MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2023-00286 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)

Table of Contents

I. INTRODUCTION

LG Electronics Inc. ("Petitioner") respectfully submits this Motion for Joinder, together with a Petition for *Inter Partes* Review ("IPR") of U.S. Patent No. 8,326,611 ("the '611 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 IPR2023-00286 ("the Amazon IPR"). That IPR challenges the same claims and was instituted on June 7, 2023.

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). Petitioners' Petition and the Amazon Petition are substantively identical— they contain the same grounds, based on the same prior art combinations against the same claims. Thus, joinder would neither unduly complicate the Amazon IPR nor delay its schedule.

To streamline discovery and briefing, Petitioner agrees to take an "under-study" role, actively participating substantively in the Amazon IPR only if Amazon terminates its involvement after joinder. (If Amazon were to terminate its involvement prior to this motion being granted, then Petitioner would withdraw this motion so that Petitioner's timely-filed Petition could 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. (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 also asserted against Samsung. (Case Nos. 6:21-cv-00985, E.D. Tex., and 6:21-cv-00984, W.D. Tex.) Patent Owner filed suit against Amazon on Nov. 29, 2021, and has asserted the same nine patents. (Case No. 2:21-cv-00435, E.D. Tex., transferred to Case No. 5:22-cv-06727, N.D. Cal.) Patent Owner filed suit against Petitioner on February 28, 2023, asserting eight of the nine patents it previously asserted against Apple, Google, and Amazon. Also on February 28, 2023, Patent Owner filed suit against Sony, HTC, OPPO, Panasonic, ZTE Corp., and Meta. Apple, Google, and Amazon have filed IPR Petitions against each of the patents asserted against them.

For some of the patents asserted against it, including the '611 Patent, Petitioner is filing substantively identical petitions to those previously filed and is seeking joinder.

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 filed November 28, 2022, and IPR was instituted on June 7, 2023. Thus, Petitioner is filing its motion for joinder within the time limit enumerated 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 for Several Reasons.

Joinder is appropriate here because the concurrently filed Petition involves the same patent, challenges the same claims, relies on the same substantive exhibits, and is based on the same grounds and combinations of prior art submitted in the Amazon IPR. The concurrently filed Petition is substantively identical to the Amazon Petition, containing only minor differences 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. 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 are substantively identical, good cause exists for joining Petitioner as a party to the Amazon IPR and consolidating the proceedings, so that the Board can efficiently resolve identical challenges in a single proceeding. *Central Security 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 the same grounds of unpatentability as the Amazon Petition and challenges the same claims. Therefore, Petitioners do 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 is substantively identical to the Amazon Petition—presenting the same grounds and challenging the same claims using 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 present substantively identical grounds of unpatentability, including the same combinations of art against the same claims. Additionally, if this motion for joinder is granted, Petitioners agree

to take an "understudy" role, adhering to the following restrictions, as described by the Board:

> "(a) ***all*** filings by [Petitioner] in the joined proceeding 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); *see also 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 ("[J]oinder 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 these 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 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 at 8; *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9-11 (PTAB Oct. 30, 2018).

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 '611 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* 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).

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 Petition, alleging the same facts, grounds, and prior art, and has agreed to take an understudy

role. As a result, this Petition 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 then join Petitioner as a party to the Amazon IPR.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: July 6, 2023

/Indranil Mukerji/
Indranil Mukerji (Reg. No. 46,944)
John C. Moulder (Reg. No. 70,490)

Attorneys for Petitioner
LG ELECTRONICS INC.

CERTIFICATE OF SERVICE

I hereby certify that true and correct copies of the foregoing **MOTION FOR JOINDER TO AND CONSOLIDATION WITH RELATED *INTER PARTES* REVIEW IPR2023-00286 PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)** is being served on July 6, 2023, via FedEx Priority Overnight on counsel of record for U.S. Pat. 8,326,611 patent owner Jawbone Innovations, LLC at the address below:

Mark Leonardo
Nutter McClennen & Fish LLP
Seaport West
155 Seaport Blvd.
Boston, MA 02210-2604

A courtesy copy is also being served on counsel for the patent holder in the pending litigation *Jawbone Innovations, LLC v. LG Electronics Inc.*, 2:23-cv-00078-JRG-RSP (E.D. Tex. filed February 28, 2023):

Alfred R. Fabricant
Peter Lambrianakos
Vincent J. Rubino, III
Richard M. Cowell
Jacob D. Ostling
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Telephone: (212) 257-5797
Facsimile: (212) 257-5796
Email: ffabricant@fabricantllp.com
Email: plambrianakos@fabricantllp.com

Email: vrubino@fabricantllp.com
Email: jostling@fabricantllp.com
Email: rcowell@fabricantllp.com
Email: jawbone@fabricantllp.com

WILLKIE FARR & GALLAGHER LLP

Dated: July 6, 2023

/Indranil Mukerji/

Counsel for Petitioner,
LG ELECTRONICS INC.