

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IXI IP, LLC,
Patent Owner.

Case Nos.
IPR2019-00124, IPR2019-00125,
IPR2019-00139, IPR2019-00140,
IPR2019-00141, IPR2019-00181.
Patent 7,039,033 B2

Before JANET A. GONGOLA, MICHAEL P. TIERNEY, and
WILLIAM M. FINK, *Vice Chief Administrative Patent Judges.*

TIERNEY, *Vice Chief Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

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I. Introduction

On November 8, 2018, Apple Inc. (“Petitioner”) filed six petitions for *inter partes* review of U.S. Patent No. 7,039,033 (Ex. 1001, “the ’033 patent”), issued on May 2, 2006. Paper 2, 67 (“Pet.”).¹ Accompanying the petitions for each proceeding, Petitioner filed identical motions for joinder and/or consolidation under 35 U.S.C. § 315(c). Paper 3 (“Motion”).² Specifically, Petitioner seeks to join and/or consolidate the six *inter partes* reviews with previously filed IPR2015-01444. Motion 1.

IXI IP, LLC (“Patent Owner”) opposes Petitioner’s request for joinder and/or consolidation and contends that Petitioner’s six petitions are time barred under 35 U.S.C. § 315(b). Paper 9 (“Opposition”). Patent Owner also filed a Preliminary Response (Paper 12, “Prel. Resp.”), repeating its contention that the six petitions are time barred under 35 U.S.C. § 315(b). Prel. Resp. 1, 7.

We have reviewed the parties’ contentions and, for the reasons discussed in detail below, deny Petitioner’s request for joinder and/or consolidation and deny its six petitions for institution.

II. Background

On October 2, 2014, Patent Owner filed a patent infringement suit against Petitioner in district court, alleging infringement of the ’033 patent.

¹ Unless otherwise specified, all papers referred to herein are from IPR2019-00124.

² Upon Patent Owner’s request for an extension of the time to file an opposition to Petitioner’s motions for joinder, on December 7, 2018, we granted a two-month extension by email.

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On June 19, 2015, Petitioner, together with two Samsung entities, filed an IPR petition (IPR2015-01444) challenging every claim in the '033 patent asserted in the district court litigation. *Id.* at 45; Motion 2. The Board instituted review and ultimately issued a final written decision on December 21, 2016, holding every challenged claim unpatentable. Ex. 1030. The Board's decision was appealed and subsequently upheld by the Federal Circuit. *IXI IP, LLC v. Samsung Elecs. Co., Ltd.*, 903 F.3d 1257 (Fed. Cir. 2018). Thereafter, on January 16, 2019, the Board issued a trial certificate cancelling all claims challenged in the IPR, specifically, claims 1, 4–7, 12, 14, 15, 22, 23, 25, 28, 34, 39, 40, 42, and 46. Ex. 2001.

On March 24, 2017, while the previously filed IPR2015-01444 was on appeal, Patent Owner sought *ex parte* reexamination of the '033 patent. Prosecution History of Reexamination Control No. 90013925, Ex. 1032, 3. The Office granted the reexamination request on May 17, 2017. *Id.* at 180–197. A reexamination certificate issued on February 1, 2018, cancelling original claims 48–55, amending claim 56, and adding claims 57–124. *Id.* at 5–9.

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III. The Motion for Joinder and/or Consolidation is Denied

Joinder to an already-instituted proceeding may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c). As provided for by the trial rules, any request for joinder must be filed as a motion under 37 C.F.R. § 42.22 no later than one month after the institution date of any *inter partes* review for which joinder is requested. *See* 37 C.F.R. § 42.122(b). Consolidation, like joinder, is discretionary and may occur “during the pendency of an *inter partes* review, if another proceeding or matter involving the patent is before the Office.” 35 U.S.C. § 315(d). When exercising discretion, the Board is mindful that the trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 37 C.F.R. § 42.1(b).

As a moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should, among other things, set forth the reasons why joinder is appropriate. *See, e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15); FAQ H5 on the Board’s website at <https://go.usa.gov/xmwXS>.

Previously filed IPR2015-01444 was instituted on December 30, 2015. Petitioner filed its six petitions on November 8, 2018—more than 34 months after IPR2015-01444 was instituted. As such, Petitioner’s motion requesting joinder was filed several years after the one-month deadline set by rule for joinder and thus was untimely.

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We recognize that the '033 patent reexamination certificate adding claims 57–124 was not issued until February 1, 2018. Assuming for the sake of argument that the rules provide for joinder within one month of the issuance of the reexamination certificate, which the rules do not expressly cover, Petitioner still was several months late in filing its request for joinder. Therefore, under either possible trigger date—institution of IPR2015-01444 or issuance of the reexamination certificate—Petitioner's motion for joinder is time barred under our rules.

Notwithstanding the time bar, in previously filed IPR2015-01444, a trial certificate issued on January 16, 2019, cancelling all challenged claims in the '033 patent. Ex. 2001. As such, that *inter partes* review is no longer pending before the Office. Accordingly, the previously filed IPR cannot serve as a base proceeding to which another proceeding may be joined or consolidated. In other words, there is nothing to join to and, therefore, for this additional and independent reason, the motion is denied.

Based on the record presented, we determine that Petitioner has not met its burden to show that joinder and/or consolidation would be appropriate.

IV. The Petitions are Time Barred and thus Denied

Petitioner filed the six petitions on November 8, 2018, well more than a year after being served with a complaint alleging infringement of the '033 patent on October 2, 2014. An *inter partes* review may not be instituted if the petition requesting the proceeding was filed more than one year after the date on which the petitioner was served a complaint alleging infringement of

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the patent. 35 U.S.C. § 315(b). Accordingly, Petitioner’s six petitions are time barred under § 315(b).

Petitioner contends, however, that the Board should treat Patent Owner’s *ex parte* reexamination certificate adding new claims as creating a new, materially different “patent.” Pet. 2. Thus, the one-year bar of § 315(b) does not apply because the six petitions were filed a little more than nine months after the reexamination certificate was granted on February 1, 2018. *Id.* Petitioner states that the Federal Circuit addressed this issue in *Click-to-Call Technologies, LP v. Ignenio Inc.*,³ and it provided a framework for the Board to decide on a case-by-case basis whether new reexamination claims should be considered part of the same “patent” as that term is used in the statute. Pet. 7–9.

Patent Owner disagrees with Petitioner’s analysis of the time-bar issue and contends that the Federal Circuit’s decision in *Click-to-Call* rejects the very argument raised by Petitioner. Prel. Resp. 2. According to Patent Owner, *Click-to-Call* held that a reexamination certificate does not create a new “patent” or affect the § 315(b) time bar. *Id.* at 4.

We agree with Patent Owner. The issue in *Click-to-Call* was whether the time bar of § 315(b) applied where a petitioner was served with a complaint of infringement more than one year before the petition for IPR but where the complaint had been voluntarily dismissed without prejudice. *Click-to-Call*, 899 F.3d at 1326–27. *Click-to-Call* held that the plain and unambiguous language of § 315(b) does not contain any exceptions for complaints subsequently dismissed. *Id.* at 1329–32. In reaching this

³ 899 F.3d 1321 (Fed. Cir. 2018) (en banc).

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determination, the Federal Circuit analyzed the impact of a subsequent *ex parte* reexamination of the underlying patent. *Id.* at 1336–37. Specifically, the petitioners in *Click-to-Call* alleged that the claims of the underlying patent were materially changed during reexamination and that the reexamined patent “should be treated as a new patent for purposes of § 315(b).” *Id.* at 1336. The Federal Circuit disagreed with the petitioners and held that reexamination does not result in the issuance of a new patent for purposes of § 315(b), regardless of claim scope. *Id.* *Click-to-Call* held that arguments to the contrary “are mistaken.” *Id.*

Click-to-Call states that even if § 315(b) were ambiguous with respect to the term “the patent,” the argument that the time bar did not apply would not hold. *Id.* at 1337. Specifically, *Click-to-Call* cites to and relies upon *Senju Pharmaceutical Co. v. Apotex Inc.*, 746 F.3d 1344, 1352 (Fed. Cir. 2014), a case that focused on the question of whether a reexamined patent is a new patent for purposes of issue preclusion. The *Senju* decision concerned the applicability of claim preclusion to a second suit where the second suit involved reexamined claims issuing from the patent involved in a first suit. *Id.* at 1346. *Senju*, like *Click-to-Call*, confirmed that a reexamined patent is still the original patent. Specifically, the Federal Circuit explained that “[r]eexamination does not involve the filing of a new patent application nor the issuance of a new patent.” *Senju*, 746 F.3d at 1352.

Accordingly, Patent Owner’s reexamined ’033 patent is the original patent for purposes of 35 U.S.C. § 315(b). Although we recognize this means the potential unavailability of *inter partes* review for reexamined claims, “Congress could have included in . . . [§] 315(b) language regarding

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the effect of reexamination on the deadline to file an IPR—it chose not to do so.” *Click-to-Call*, 899 F.3d at 1337. Accordingly, we cannot institute an *inter partes* review as Petitioner filed its six petitions more than one year after it was served a complaint alleging infringement of the patent. 35 U.S.C. § 315(b). Petitioner’s six petitions therefore are denied.

V. Order

For the reasons given, it is:

ORDERED that Petitioner’s six petitions are denied as to the challenged claims of the ’033 patent; and

FURTHER ORDERED that no *inter partes* reviews are instituted.

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