

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RFCYBER CORP.,
Patent Owner.

PGR2022-00003
Patent 10,600,046 B2

Before PATRICK R. SCANLON, KEVIN W. CHERRY, and
JAMES A. WORTH, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION

Denying Institution of Post-Grant Review
35 U.S.C. §§ 321, 324

Denying Motion for Joinder
35 U.S.C. § 325(c); 37 C.F.R. § 42.222

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting post-grant review of claims 1–17 of U.S. Patent No. 10,600,046 B2 (Ex. 1001, “the ’046 patent”). Petitioner also filed a Motion for Joinder (Paper 3, “Mot.”) requesting that it be joined to PGR2021-00028 (the “Google PGR”) filed by Google LLC (“Google”). Mot. 1. RFCyber Corp. (“Patent Owner”) filed a Response to Petitioner’s Motion for Joinder (Paper 7, “Resp.”), and Petitioner filed a Reply in support of its Motion for Joinder (Paper 8, “Reply”). Patent Owner also filed a Preliminary Response (Paper 9).

For the reasons stated below, we deny Petitioner’s Motion for Joinder and do not institute a post-grant review.

II. BACKGROUND

A. Related Matters

The parties identify the following proceedings as related matters involving the ’046 patent: *RF Cyber Corp. v. Apple Inc.*, Case No. 6:21-cv-00916 (W.D. Tex.); *RF Cyber Corp. v. Google LLC*, Case No. 2:20-cv-00274 (E.D. Tex.); and *RF Cyber Corp. v. Samsung Electronics Co. Ltd.*, Case No. 2:20-cv-00335 (E.D. Tex.). Pet. 2; Paper 6, 1–2.

In the Google PGR, the Board instituted a post-grant review of claims 1–5, 12–14, and 17¹ of the ’046 patent on the following grounds:

Claims Challenged	35 U.S.C. §	Reference/Basis
1–5, 12–14, 17	112(a)	Written Description
1–5, 12–14, 17	101	Eligibility

¹ The Board considered only claims 1–5, 12–14, and 17 in the Google PGR in view of Patent Owner’s statutory disclaimer of claims 6–11, 15, 16, 19, and 20 of the ’046 patent. Google PGR, Paper 10, 9.

B. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 2. Patent Owner identifies itself as the real party in interest. Paper 6, 1.

C. Asserted Grounds

The Petition in this proceeding asserts the same grounds of unpatentability as those upon which the Board instituted review in the Google PGR. Pet. 23.

III. ANALYSIS

A. Motion for Joinder

Under Board rules, “[a]ny request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant review for which joinder is requested.” 37 C.F.R. § 42.222(b). Petitioner’s Motion for Joinder was filed October 20, 2021, which is more than one month after the Board instituted post-grant review in the Google PGR on July 23, 2021. Petitioner, however, argues that special circumstances warrant that the Board exercise its discretion under 37 C.F.R. § 42.5 to waive the one-month joinder period. Mot. 3–6.

First, Petitioner argues that the present circumstances are the same as the circumstances in two Board decisions in which the one-month joinder period was waived. *Id.* at 3–4 (citing *Sony Corp. of Am. v. Network-1 Security Solutions, Inc.*, IPR2013-00495, Paper 13 at 4 (PTAB Sept. 16, 2013); *GlobalFoundries U.S. Inc. v. Godo Kaisha IP Bridge 1*, IPR2017-00925, Paper 13 at 8–11 (PTAB June 9, 2017)). In particular, Petitioner asserts that in *Sony Corp.*, “[t]he Board concluded that waiver was merited, highlighting that such joinder would not expand the grounds instituted, would require no change to the trial schedule, and would impose no additional burden because the joining party agreed to serve in an understudy

role.” *Id.* (citing *Sony Corp.*, Paper 13 at 4). According to Petitioner, its requested joinder will not expand the grounds instituted because the Petition is substantively identical to the petition in the Google PGR. *Id.* at 4.

Petitioner also contends that the requested joinder will not require changing the trial schedule or impose additional burden and that Petitioner has agreed to serve in an understudy role unless and until Google is terminated. *Id.*

Second, Petitioner argues that good cause exists to waive the one-month joinder period in view of “Patent Owner’s strategically sequenced lawsuits.” *Id.* Specifically, Petitioner contends that Patent Owner waited more than one month after institution in the Google PGR (i.e., after the one-month joinder period) to file suit against Petitioner on September 7, 2021, and this timing was “a strategic decision that appears designed to deprive [Petitioner] the opportunity to join Google’s challenge or bring its own PGR challenge.” *Id.* at 4–5. In Petitioner’s view, “[p]ermitting Patent Owner to deploy such tactics undermines the AIA’s and USPTO’s objectives of improving patent quality.” *Id.* at 5.

Patent Owner argues that the Motion for Joinder is untimely and the Board should not waive the one-month period. Resp. 10–13. Specifically, Patent Owner disputes Petitioner’s assertion that joinder will not require changing the trial schedule, arguing that Petitioner has necessitated a wholesale change to the trial schedule by filing its Motion for Joinder after the original due date of patent owner’s response in the Google PGR and after Google and Patent Owner reached a settlement agreement. *Id.* at 10–11. Patent Owner contends that it reasonably relied on its agreement with Google to put off deposing Google’s expert and submitting its patent owner response in the Google PGR, and, in filing its Motion for Joinder after Google and Patent Owner had filed a joint motion to terminate the Google

PGR, Petitioner was aware that Patent Owner did not expect to file its patent owner response. *Id.* at 11.

We agree with Patent Owner that joinder would require changing the trial schedule. In the Google PGR, the parties extended by stipulation the due date for the patent owner response from October 15, 2021 to November 15, 2021. Google PGR, Paper 12, 1. The parties filed the joint motion to terminate the Google PGR on October 19, 2021. Google PGR, Paper 14. As noted above, Petitioner's Motion for Joinder was filed October 20, 2021. With this timing, joinder would impact the trial schedule significantly. Indeed, as Patent Owner notes, the Board has already extended the due date of the patent owner response in the Google PGR indefinitely. *See* Resp. 4 (citing Ex. 2005), 11. Moreover, Patent Owner indicates that it has not yet deposed the expert witness or prepared a response in the Google PGR, and we agree that this step was reasonable in view of the settlement agreement with Google. We also note that Petitioner, as a non-party, even requested that the Board delay its decision on the joint motion to terminate the Google PGR. Ex. 2004.

We also agree with Patent Owner's assertion that the cases relied on by Petitioner do not support waiving the one-month joinder period. *See* Resp. 12 n.1. In *Sony Corp.*, the Board determined that the fact that the petitioners had attempted previously—within the one-month period—to be joined to the proceeding weighed in favor of considering the joinder request outside the one-month period. *Sony Corp.*, Paper 13 at 7. The Board also noted that the petitioners in *Sony Corp.* were not seeking to replace an existing petitioner that had settled with the patent owner. *Id.* at 9. Similarly, in *GlobalFoundries*, the petitioner was attempting to join a proceeding after the one-month period, but the petitioner's parent company previously had

attempted to join the proceeding within the one-month period.

GlobalFoundries, Paper 13 at 7. In addition, it appears that the existing petitioner in the proceeding sought to be joined had not settled with the patent owner. *See id.* at 10 (indicating that the patent owner argued that permitting joinder would frustrate the *possibility* of settlement).

These unique facts, however, are not present here. Petitioner has not attempted previously to join the Google PGR within the one-month period. Also, in this case, Patent Owner and Google reached a settlement agreement prior to Petitioner's attempt to join, unlike the situation in *Sony Corp.* and *GlobalFoundries*. In other words, Petitioner is essentially seeking to replace Google in the proceeding, in direct contrast to the petitioners in *Sony Corp.* and *GlobalFoundries*. This case also differs from the facts in *Sony Corp.* and *GlobalFoundries* in that, for the reasons discussed above, joinder would require changing the trial schedule. Furthermore, Petitioner's agreement to serve in an understudy role provides little or no weight in favor of waiving the one-month joinder period here because Petitioner filed its Motion for Joinder knowing that Google and Patent Owner had already reached a settlement agreement and filed a joint motion to terminate the Google PGR.

Regarding Petitioner's second argument (i.e., the Board should waive the one-month joinder period in view of the timing of Patent Owner's lawsuit against Petitioner), Patent Owner argues that Petitioner "cites no law that allows or encourages the Board to consider [Patent Owner's] subjective intentions on when to file suit." Resp. 12. According to Patent Owner, "there are many drivers on when a patent owner may file suit—including the patentee's limited resources and time—and a patent owner is not required to sue all infringers at once." *Id.* (citing *Pfizer, Inc. v. Teva Pharms., USA, Inc.*, 429 F.3d 1364, 1381 (Fed. Cir. 2005)).

Petitioner’s contention that Patent Owner timed the lawsuit to thwart Petitioner’s ability to challenge the ’046 patent is speculative at best. Indeed, Petitioner asserts that the timing of the lawsuit only “*appears* designed to deprive [Petitioner] the opportunity to join Google’s challenge or bring its own PGR challenge.” Mot. 4–5 (emphasis added). Petitioner does not point to any factor other than the timing of the lawsuit to suggest that Patent Owner was intentionally gaming the system. Nor does Petitioner point out any evidence or reasoning to suggest that Patent Owner should have brought the lawsuit earlier. We also agree with Patent Owner that there could be many different factors influencing a patent owner’s decision of when to file suit. Thus, based on the record before us, we decline to speculate that Patent Owner was attempting to game the system by waiting until September 7, 2021, to file suit against Petitioner.

In the Reply, Petitioner argues that “it could not have followed” the one-month joinder rule because of the sequenced timing of Patent Owner’s lawsuit, and that it “acted diligently” after Patent Owner’s lawsuit was filed. Reply 2–3. This argument is not persuasive. We disagree that Petitioner “could not have followed” the one-month joinder rule because of the timing of Patent Owner’s lawsuit. Petitioner was free to file its Petition and Motion for Joinder at any time; it did not need to be sued by Patent Owner first. More importantly, recognizing that Petitioner may not have been motivated to attempt to join the Google PGR until it was sued on September 7, 2021, we nevertheless disagree that Petitioner acted diligently in filing the Petition and Motion for Joinder on October 20, 2021. Petitioner filed its Petition and Motion for Joinder slightly more than six weeks after September 7, 2021. That is, despite being past the one-month period provided by 37 C.F.R.

§ 42.222(b) when sued, Petitioner still took more than another month to file its Petition and Motion for Joinder.

In view of the above, we do not waive the one-month period to file a motion for joinder under 37 C.F.R. § 42.222(b) and therefore deny Petitioner's Motion for Joinder as untimely.

B. Eligibility for Post-Grant Review under 35 U.S.C. § 321

Institution of post-grant review is barred when a petition is filed more than 9 months after the challenged patent is granted. 35 U.S.C. § 321(c). The '046 patent issued on March 24, 2020 (*see* Ex. 1001, code (45)), and the Petition in this proceeding was accorded a filing date of October 20, 2021 (*see* Paper 1). Thus, the Petition was filed outside the 9-month statutory period for requesting post-grant review under § 321(c).

Accordingly, in view of our decision to deny Petitioner's Motion for Joinder, we deny the Petition because it was not filed within the time limit imposed under 35 U.S.C. § 321(c).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion for Joinder is denied; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 321, the Petition is denied.

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